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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,358	12/08/2008	7177998	2805.001REX5	1953

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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95/001,159	03/24/2009	7177998	2805.001REX7	2219

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

Date: MAILED
SEP 30 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001159
PATENT NO. : 7177998
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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MENLO PARK, CA 94025

Date:

MAILED
SEP 30 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009358
PATENT NO. : 7177998
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. (For Patent Owner)
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MAILED
SEP 30 2010
CENTRAL REEXAMINATION UNIT

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DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: Fabio E. Marino
1000 Marsh Road
Menlo Park, CA 94025

In re Ware *et al.* *Inter partes* Reexamination Proceeding Control No.: 95/001,159 Filed: March 24, 2009 For: U.S. Patent No. 7,177,998	: DECISION : DISSOLVING : MERGER OF : REEXAMINATION : PROCEEDINGS
In re Ware *et al.* *Ex Parte* Reexamination Proceeding Control No.: 90/009,358 Filed: December 8, 2008 For: U.S. Patent No. 7,177,998	

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 February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*

2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is 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 '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).

5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).

8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.

9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the request).

10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed a petition in the '9358 proceeding to prevent merger with the '1159 *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 '1159 *inter partes* and '9358 *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 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 '998 patent has been ordered in the '9358 *ex parte* proceeding and '1159 *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 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.'"

[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 '998 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 '998 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 '9358 *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 '1159 *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

[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
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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CENTRAL REEXAMINATION UNIT

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Attn: Fabio E. Marino
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In re Ware *et al.*
Inter partes Reexamination Proceeding
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Filed: March 24, 2009
For: U.S. Patent No. 7,177,998

In re Ware *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,358
Filed: December 8, 2008
For: U.S. Patent No. 7,177,998

DECISION 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 February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*

2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.

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4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).

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6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.[1]

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9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.

10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

11. On October 14, 2009, patent owner filed a petition in the '9358 proceeding to prevent merger with the '1159 *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 '1159 *inter partes* and '9358 *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 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 request).

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

[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 '998 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 '998 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 '998 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.
90/009,358	12/08/2008	7177998	2805.001REX5	1953

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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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. : 90009358
PATENT NO. : 7177998
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.: 90/009,358 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,358	12/08/2008	7177998	2805.001REX5	1953

26111 7590 12/23/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2011

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Date: MAILED

DEC 23 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

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DEC 23 2011

CENTRAL REEXAMINATION UNIT

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(FOR THIRD PARTY REQUESTER)

In re Ware et al.	:	**DECISION RETURNING**
Reexamination Proceeding	:	**UNAUTHORIZED PAPER**
Control No. 90/009,358	:	**AND DISMISSING**
Filed: December 8, 2008	:	**PETITION AS MOOT**
For: U.S. Patent No. 7,177,998	:	

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. 7,177,998 (the '998 patent) issued on February 13, 2007.

2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in Rambus Inc. v. Nvidia Corp., {Civil Action No. 3:08-cv-3343-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. 90/009,358 (the '358 proceeding), was filed by a third party requester on December 8, 2008. Reexamination was requested for claims 7, 13, 21, and 22 of the '998 patent.

5. On January 16, 2009, the Office issued an order granting the '358 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 '998 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 '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '159 proceeding).

7. On May 26, 2009, the Office issued an order granting the '159 request for *inter partes* reexamination.

8. On October 14, 2009, patent owner filed a petition in the '358 *ex parte* proceeding to prevent merger with the '159 *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 '159 *inter partes* and '358 *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 '159 and the '358 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 '998 patent was filed on December 8, 2008. Reexamination was ordered on January 16, 2009. The record in the '358 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 '358 proceeding was merged with the '159 *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 '358 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 '358 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

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.
90/009,368	12/22/2008	6297751	14372-0045	7171

25883 7590 06/30/2011
HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

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
PERKINS COIE LLP
PATENT-SEA
P O BOX 1247
SEATTLE, WA 98111-1247

Date:
MAILED
JUN 3 0 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009368
PATENT NO. : 6297751
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.: 90/009,368

MAILED

JUN 30 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 24 June 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 03 May 2011 which sets a two (2) 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 one (1) month, 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. While the petition speaks to the considerations of the attorney of record being out of the country and the counsel being unable to contact the patent owner to discuss the filing of a reply brief prior to preparing a response. 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 petition lacks any explanation as to the diligence exercised up to and during the period for which the counsel is out of the country as well as explanations as to why the patent owner is unavailable. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as responding to any and all Office actions.

On balance there is not "sufficient cause" to warrant an extension of time under the facts as they are presented.

The petition for extension of time is hereby dismissed.

UNITED STATES PATENT AND TRADEMARK OFFICE

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
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MAILED

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester) JAN 06 2011
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DALLAS, TX 75219

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
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IP Prosecution Department
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Irvine, CA 92614

In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,201
Filed: June 23, 2009
For: U.S. Patent No. 7,330,953

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,369
Filed: December 23, 2008
For: U.S. Patent No. 7,330,953

DECISION ON PETITION

This is a decision on third party requester's July 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 July 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 June 28, 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 February 12, 2008, the Office issued U.S. Patent No. 7,330,953 (the '953 patent) to Barth *et al.*

2. The '953 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-28 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claim 25 of the '953 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,369 (the '9369 proceeding).

5. On March 6, 2009, the Office issued an order granting the '9369 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claim 25 of the '953 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9369 *ex parte* reexamination proceeding expired on May 6, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9369 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '953 patent. Therefore, the '953 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '953 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,201 (the '1201 proceeding).

10. On August 12, 2009, the Office issued an order granting the '1201 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '953 patent, claims 1-28, would be subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9369 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed a petition in the '9369 proceeding to prevent merger with the '1201 *inter partes* proceeding.

13. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1201 *inter partes* and '9369 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

14. On February 3, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the request).
[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

15. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision dismissing.

16. On April 2, 2010, patent owner timely filed responsive comments to the February 3, 2010 Office action, to include an amendment to the claims.

17. On April 30, 2010, third party requester timely filed responsive comments.

18. On June 28, 2010, the Office issued a decision dissolving the merger of the '1201 and the '9369 proceedings.

19. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.

20. On August 20, 2010, the Office issued a non-final Office action in the '1201 proceeding.

21. Also on August 20, 2010, the Office issued a final Office action in the '9369 proceeding.

22. On September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '1201 proceeding.

23. Also on September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '9371 proceeding.

24. On October 15, 2010, third party requester timely filed its comments in the '1201 proceeding.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 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 June 28, 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 16, 2009 Patent Owner Petition and December 17, 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 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 February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 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 February 5, 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 June 28, 2010, the Office issued a decision granting patent owner's February 5, 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 June 28, 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 June 28, 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 June 28, 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 '953 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 July 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

[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.

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]

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '953 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '953 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

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[5] See MPEP 2686.01 IV.

[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

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."

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 June 28, 2010 Office decision is not a violation of Requester's Rights

The requester asserts that the June 28, 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 June 28, 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

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Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

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 June 28, 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.

[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.

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 June 28, 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 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 June 28, 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 June 28, 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 June 28, 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 June 28, 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

[13] See MPEP 2686.01 IV.

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 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 June 28, 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 June 28, 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.

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[14] See the June 22, 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.

IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the June 28, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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

1/5/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

26111 7590 01/06/2011

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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
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001205 → 90/009370
PATENT NO. : 7360050
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JAN 06 2011

CENTRAL REEXAMINATION UNIT

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In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,205
Filed: July 1, 2009
For: U.S. Patent No. 7,360,050

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,370
Filed: December 23, 2008
For: U.S. Patent No. 7,360,050

DECISION ON PETITION

This is a decision on third party requester's July 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 July 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 June 28, 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 15, 2008, the Office issued U.S. Patent No. 7,360,050 (the '050 patent) to Barth *et al.*

2. The '050 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-31 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claims 29 and 31 of the '050 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,370 (the '9370 proceeding).

5. On March 16, 2009, the Office issued an order granting the '9370 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 29 and 31 of the '050 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9370 *ex parte* reexamination proceeding expired on May 16, 2009.[1]

7. On May 19, 2009, the Office issued a first Office action on the merits in the '9370 *ex parte* reexamination proceeding.

8. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '050 patent. Therefore, the '050 patent is no longer involved in the ITC investigation.

9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-31) of the '050 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,205 (the '1205 proceeding).

10. On August 13, 2009, the Office issued an order granting the '1205 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '050 patent, claims 1-31, would be subject to reexamination.

11. On August 19, 2009, Patent Owner filed a response in the '9370 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

12. On October 16, 2009, patent owner filed a petition in the '9370 proceeding requesting prevention of merger with the '1205 *inter partes* proceeding.

13. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1205 *inter partes* and '9370 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the request).

[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the May 19, 2009 Office action.

14. On February 3, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.

15. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.

16. On April 2, 2010, patent owner timely filed responsive comments to the February 3, 2010 Office action, to include an amendment to the claims.

17. On May 3, 2010, third party requester timely filed responsive comments.[3]

18. On June 28, 2010, the Office issued a decision dissolving the merger of the '1205 and the '9370 proceedings.

19. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.

20. On August 20, 2010, the Office issued a non-final Office action in the '1205 proceeding.

21. Also on August 20, 2010, the Office issued a final Office action in the '9370 proceeding.

22. On September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '1205 proceeding.

23. Also on September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '9370 proceeding.

24. On October 15, 2010, third party requester timely filed its comments in the '1201 proceeding.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 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.

[3] Third party comments were timely in accordance with 37 CFR 1.7(a) as May 2, 2010 was a Sunday.

Third party requester requests the relief of vacatur of the June 28, 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 16, 2009 Patent Owner Petition and December 17, 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 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 February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 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 February 5, 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 June 28, 2010, the Office issued a decision granting patent owner's February 5, 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 June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment[4] and argues that the June 28, 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 June 28, 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.[5] The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '050 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 July 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active

[4] Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).
[5] Id.

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.[6]

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '050 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '050 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),[7] 37 CFR 1.989(a),[8] MPEP 2686.01 I,[9] MPEP

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[6] See MPEP 2686.01 IV.

[7] "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).

[8] "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).

[9] "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

2686.01 IV,[10] MPEP 2283,[11] and MPEP 2286.[12] 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 (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 June 28, 2010 Office decision is not a violation of Requester's Rights

The requester asserts that the June 28, 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.

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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.'"

[10] "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."

[11] "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.'"

[12] "[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.'"

c. The June 28, 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.[13]

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.

[13] 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.

d. The June 28, 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 June 28, 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 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.[14] In the present instance, as noted in the June 28, 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 June 28, 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.

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[14] See MPEP 2686.01 IV.

In response, the June 28, 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 June 28, 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 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 June 28, 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.[15] 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 June 28, 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.[16] As to whether the subsequent request filed is

[15] See the June 22, 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.
[16] See Petition at page 9, section E.

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 June 28, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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

1/5/11

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.
90/009,371	12/22/2008	7,330,952	2805.002REX5	9883

26111 7590 09/07/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ORRICK,HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
4 PARK PLAZA SUITE 1600
IRVINE, CA 92614-2558

Date:
MAILED
SEP 07 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009371
PATENT NO. : 7330952
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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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. :(For Patent Owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP : (For Requester)
ATTN: WILLIAM H. WRIGHT
IP PROSECUTION DEPARTMENT
4 PARK PLAZA, SUITE 1600
IRVINE, CA 92614

In re Barth *et al.* : DECISION DISMISSING
Reexamination Proceeding : PETITION FOR
Control No. 90/009,371 : EXTENSTION OF TIME
Request Deposited: December 22, 2008 : [37 CFR 1.550(c)]
For: U.S. Patent No. 7,330,952 :

This is a decision on the August 30, 2010, "PETITION AND REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended "for a one-month extension of time to reply to the final Office action which issued on August 9, 2010".

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

1. U.S. Patent No. 7,330,952 (hereinafter, the '952 patent), issued to Barth *et al*, on February 12, 2008.

2. On December 22, 2008, a request for ex parte reexamination of claims 21, 22 and 24 of the '952 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,371 (the '9371 proceeding).

3. The reexamination order was granted in the '9371 proceeding on February 20, 2009.

4. The '952 patent is subject to litigation in the United States 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 1-28 against the requester in litigation.

5. A first office action on the merits was issued on April 29, 2009 setting a two month period for response.

6. Patent owner requested a two month extension of time on June 5, 2009 to respond to the first office action. A one month extension was granted on June 11, 2009.

7. An interview was held on July 22, 2009 followed by a response from owner on July 29, 2009 and a supplemental response from owner filed August 25, 2009.

8. An *inter partes* request for reexamination of the '952 patent was filed and granted in the order mailed August 13, 2009. The *inter partes* proceeding is denominated 95/001,196 ('1189). On October 16, 2009, the Office, *sua sponte*, issued a decision merging the ' 1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 16, 2009, patent owner filed a petition requesting reconsideration of the merger of the '9371 *ex parte* proceeding, with the ' 1196 *inter partes* proceeding.

10. On December 2, 2009, the Office issued a first Office action on the merits in the merged proceeding, setting a two month period for response.

11. Patent owner requested a one month extension of time on December 16, 2009 to respond to the merged office action on the merits. A one month extension was granted on December 23, 2009.

12. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting reconsideration of the October 16, 2009 decision to merge the '1196 *inter partes* and '9371 *ex parte* reexamination proceedings.

13. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.

14. On March 1, 2010, patent owner timely filed responsive comments to the December 2, 2009 Office action, to include an amendment to some of the claims.

15. On March 31, 2010, third party requester timely filed responsive comments.

16. On June 28, 2010 the Office granted owners requested relief and dissolved the merger of the '1196 *inter partes* proceeding and the '9371 *ex parte* proceeding.

18. On August 9, 2010 the Office issued a final rejection in the '9371 proceeding. The office action set a one month period for response.

19. On August 30, 2010 owner filed the instant petition requesting a one month extension of time in the '9371 proceeding in order to file a response and conduct an interview with the examiner.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. The request for extension is the second *ex parte* request for an extension of time. The present petition for extension of time was timely filed on August 30, 2010, together with the petition fee 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. 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 of the request for extension is submitted, an (B) why, in spite of the actions taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period...

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

Analysis and Findings

In the petition patent owner's representative requests a one-month extension of time to (i) perfect the patent owner's declaration under 37 CFR 1.131, (ii) request and conduct an after –final interview, (iii) because patent owner believes these two actions will resolve the issues of the case and (iv) because patent owner has three other responses to Office actions in other related cases due on the same day which may benefit from the resolution of the issues in the instant case. In further support of the request for additional time, patent owner's representative notes as 37 CFR 11.18 requires reasonable inquiry into any allegations or factual contentions made in any paper filed with the Office and submits 1) that the final Office action notes a number (three) of alleged deficiencies with the Rule 131 declaration which the patent owner wishes to fully address and resolve, 2) the patent owner needs additional time to investigate the factual details or to seek additional Rule 132 declaratory evidence, 3) that patent owner intends to seek an after Final interview to ensure a complete response will be filed and 4) additional responses in related proceedings will benefit from the interview.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative has conducted various 'reviews' as outlined on page 7 of the petition.

With respect to point 1), review of the file history reveals that the alleged deficiencies in the Rule 131 declaration were first noticed to patent owner in the merged Office action of December 2, 2009. It would seem patent owner has been fairly noticed of what steps need to be taken in order to resolve the outstanding issues regarding the sufficiency of the Rule 131 showing. It also appears that the instant issues with the Rule 131 showing are substantially identical as those in the closely related proceedings.

As to point 2), is not well taken in as much no explanation is offered in the instant petition as to why the required "additional investigations" are needed presently when they were not needed prior, or why they were not earlier conducted in as much as the same rejections were set forth in the prior Office actions. The issues regarding the evidence have been fairly notice to patent owner for over ten months while no diligent behavior directed to this point is discussed in the petition.

Regarding the desire to have an interview with the examiner as expressed in 3), the instant proceeding was unmerged in late June. Patent owner has had ample opportunity to request an interview from that date to the present. No such request has been received and no extenuating circumstance such as the unavailability of the examiner has been asserted. Further, nothing prevents patent owner from filing a timely response to the outstanding final Office action and requesting an interview therewith or shortly thereafter as any unsuccessful submission after final

rejection would necessarily result in an automatic one month extension of time (MPEP 2272) so that patent owner would be afforded sufficient time to consider options. This logic extends as a counter to petitioner's point 4).

On balance, it does not appear patent owners reasoning as to why additional time is needed, in light of the review actions taken thus far outweigh the need for special dispatch given the prolonged prosecution in the instant proceeding. Sufficient cause has not been shown. Therefore, the request fails to meet the requirements as outlined in MPEP 2265 for granting of a request for extension of time under 37 CFR 1.550(c).

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running one month from the date of the outstanding Office action.

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, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272- 4449.

/J. Harrison/

Jessica Harrison
Supervisory Primary Examiner
AU 3992 Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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In re Barth *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,196
Filed: June 4, 2009
For: U.S. Patent No. 7,330,952

In re Barth *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/009,371
Filed: December 22, 2008
For: U.S. Patent No. 7,330,952

DECISION ON PETITION

This is a decision on third party requester's July 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 July 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 June 28, 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 February 12, 2008, the Office issued U.S. Patent No. 7,330,952 (the '952 patent) to Barth *et al.*

2. The '952 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-28 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 22, 2008, a request for *ex parte* reexamination of claims 21, 22 and 24 of the '952 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,371 (the '9371 proceeding).

5. On February 20, 2009, the Office issued an order granting the '9371 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 21, 22 and 24 of the '952 patent, would be subject to reexamination.

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9371 *ex parte* reexamination proceeding expired on April 20, 2009.[1]

7. On April 29, 2009, the Office issued a first Office action on the merits in the '9371 *ex parte* reexamination proceeding.

8. On June 4, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '952 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,196 (the '1196 proceeding).

9. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '952 patent. Therefore, the '952 patent is no longer involved in the ITC investigation.

10. On July 29, 2009, Patent Owner filed a response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[2]

11. On August 13, 2009, the Office issued an order granting the '1196 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '952 patent, claims 1-28, would be subject to reexamination.

12. On August 25, 2009, Patent Owner filed a supplemental response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.

13. On October 16, 2009, the Office, *sua sponte,* issued a decision merging the '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding (the merged proceeding).

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[1] There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the request).
[2] Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

14. Also on October 16, 2009, patent owner filed a petition requesting prevention of merger of the '9371 *ex parte* proceeding with the '1196 *inter partes* proceeding.

15. On December 2, 2009, the Office issued a first Office action on the merits in the merged proceeding.

16. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1196 *inter partes* and '9371 *ex parte* reexamination proceedings.[3]

17. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.

18. On March 1, 2010, patent owner timely filed responsive comments to the December 2, 2009 Office action, to include an amendment to the claims.[4]

19. On March 31, 2010, third party requester timely filed responsive comments.

20. On June 28, 2010, the Office issued a decision dissolving the merger of the '1196 and the '9371 proceedings.

21. On July 10, 2010, the Office issued non-final Office Actions in both the '1196 and the '9371 proceedings.

22. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.

23. On August 9, 2010, the Office issued another non-final Office Action in the '1196 proceeding.

24. Also on August 9, 2010, the Office issued a final Office Action in the '9371 proceeding.

25. On September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '1196 proceeding.

26. Also on September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '9371 proceeding.

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[3] The petition was treated as a petition requesting reconsideration of merger, as the petition was filed concurrently with the Office's issuance of a *sua sponte* decision to merge the '1196 *inter partes* and '9371 *ex parte* reexamination proceedings

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

27. On October 8, 2010, third party requester timely filed its comments in the '1196 proceeding.

28. On December 21, 2010, the Office issued an Action Closing Prosecution (ACP) in the '1196 proceeding.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 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 June 28, 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 16, 2009 Patent Owner Petition and December 17, 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 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 February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 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 February 5, 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 June 28, 2010, the Office issued a decision granting patent owner's February 5, 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 June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment[5] and argues that the June 28, 2010 decision overturns long standing Office policy regarding merger and is without

[5] Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

any rational connection between the facts found and the decision rendered.

In response:

The June 28, 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.[6] The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '952 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 July 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.[7]

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '952 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '952 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

[6] Id.
[7] See MPEP 2686.01 IV.

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),[8] 37 CFR 1.989(a),[9] MPEP 2686.01 I,[10] MPEP 2686.01 IV,[11] MPEP 2283,[12] and MPEP 2286.[13] 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 (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 June 28, 2010 Office decision is not a violation of Requester's Rights

The requester asserts that the June 28, 2010 dissolution decision somehow alters requester's substantive rights.

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[8] "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).

[9] "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).

[10] "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.'"

[11] "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."

[12] "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.'"

[13] "[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.'"

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 June 28, 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.[14]

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 June 28, 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 June 28, 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 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.[15] In the present instance, as noted in

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[14] 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.
[15] See MPEP 2686.01 IV.

the June 28, 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 June 28, 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 June 28, 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 June 28, 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 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 June 28, 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.[16] 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 June 28, 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.[17] 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.

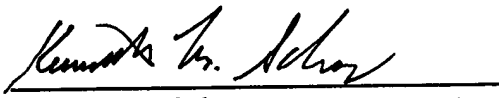
IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the June 28, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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

1/5/11

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[16] See the June 22, 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.
[17] See Petition at page 9, section E.

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CENTRAL REEXAMINATION UNIT

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Suite 1200
Washington, DC 20005-4051

(For Patent Owner)

Brinks Hofer Gilson & Lione
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(For Third Party Requester)

In re Williams et al.
Ex Parte Reexamination Proceeding
Control No. 90/009372
Request Deposited: January 2, 2009
For: U.S. Patent No. 6,425,401

: DECISION ON PETITION
: TO REOPEN
: REEXAMINATION
: PROCEEDING
:

This is a decision on the May 14, 2010 "Petition to reopen reexamination proceeding" and the May 17 "Supplemental petition to reopen reexamination proceeding".

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

For the reasons set forth below, the petition is **GRANTED IN PART**.

BACKGROUND

1. On September 11, 2009, a non-final action was mailed in this proceeding.

2. On October 22, 2009, an in-person interview was held with Examiners Jones, Ponnaluri and Brumback and Patent Owner's representatives Hoscheit, Rivard, McMillan and Lee.

3. According to the petition, a proposed agenda was faxed to Examiner Brumback on October 21, 2009.[1]

[1] It is noted that MPEP 2281 indicates that patent owner must file an informal written statement of the issues to be discussed at the interview at least three days prior to the interview. The facsimile transmission is understood to be the document attached to the petition of May 14, 2010. In view of the history of this case, the examiner should adhere to the three-day requirement in this proceeding and any related proceedings.

4. This interview was memorialized on the part of the USPTO by the interview summary of 10/22/2009.

5. Patent Owner responded to the non-final rejection on November 10, 2009. That communication included the following statement:

> The courtesy extended by Examiners Brumback, Ponneluri and Jones at the interview of October 22, 2009 is gratefully acknowledged. That interview was attended by Mr. Paul Rivard, Mr. Richard McMillan, Dr. Richard J. Lee, as well as the undersigned on behalf of the patentee. The matters discussed at the interview are reflected in the Outline for Interview Summary (previously made of record), as well as in following comments in response to the Office Action. Claim 41 of U.S. Patent 6,425,401 ("the '401 patent") is presently under reexamination.

6. No Brief Outline for Interview is present in the electronic record until the petition of May 12, 2010.

7. On May 12, 2010, a Notice of Intent to Issue a Reexamination Certificate was mailed, indicating that the proceeding was terminated due to failure to file a summary of the interview as required by 37 CFR 1.550(d) and 1.560(b).

DECISION

Initially, it is noted that the petition of May 12, 2010 seeks review in the alternative.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The petition has been treated under 37 CFR 1.181 as a petition to reopen prosecution.

To the extent that Patent Owner "alternatively petitions" for revival due to unintentional delay, said request is **dismissed** under 37 CFR 1.4(c) since that different matter is considered by a different branch or section of the office.

37 CFR 1.550(d) states:

> 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.

37 CFR 1.560(b) states:

> 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 2281 states, in part:

> If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview. These preliminary steps are for the purpose of providing structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> ...
>
> In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.

MPEP 2281 makes clear that the "informal written statement of the issues **to be discussed**" and the "complete written statement of the reasons **presented**" (emphasis added) are different documents with different purposes. It is conceptually possible that an interview would consist of patent owner representatives simply reading the "informal written statement" to the examiners and leaving; such does not appear to be contemplated.

In the response to the non-final rejection, Patent Owner refers to the "informal written statement" and the interview itself, but gives no other summary of the interview.

It is noted that the "informal written statement" is quite detailed and at least some of the items discussed in the contemporaneous interview summary are clearly within the "informal written statement". For example, "the processes by which TSNAs were formed were not completely understood" in the examiner's interview summary is adequately described by page 7 of the "informal written statement" discussion of the contribution from bacteria to the formation of

TSNA being unclear. However, other items – such as the discussion of wet bulb methods and the litigation documents – do not appear to be documented.

Rule 560 and MPEP 2281 require an after-the-fact summary of the interview. In the typical case, an agenda prepared before the fact is not sufficient to capture all that is discussed. To the extent that an "informal written statement" captures all that was discussed, a copy of that document might be sufficient.

In order to resolve this issue, the Notice of Intent to Issue a Reexamination Certificate of May 12, 2010 is **vacated**; however, no finding is made on whether the proceeding is terminated as described in 37 CFR 1.550(d).

Based on the record, the document attached to the petition of May 14, 2010 was the "informal written statement" and was submitted before the interview on October 21, 2009. The examiner's interview summary record of October 22, 2009 was prepared after the interview and given to patent owner's representative. To the extent that the examiner's interview summary contained no information not already in the "informal written statement", it may have been reasonable for the patent owner to simply submit a copy of the "informal written statement".

Patent owner is given a period of 30 days to either (a) show where **each** item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no response is filed, the NIRC will be reissued and the proceeding returned to publications.

In view of the above, the petition is **GRANTED-IN-PART**.

CONCLUSION

1. Patent Owner's May 14, 2010 petition is **GRANTED-IN-PART**.

2. Patent owner is given a period of 30 days to (a) show where **each** item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no sufficient response is filed, the NIRC will be reissued and the proceeding returned to publications.

3. Prosecution is not reopened at this time.

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

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

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

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

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

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

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

3. This decision is not a final agency decision and is without prejudice to a request for reconsideration or higher-level review.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to the undersigned.

Gregory Morse
Director, Center Reexamination Unit

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

(For Requester)

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

In re Williams et al.	:	
Reexamination Proceeding	:	
Control No.: 90/009,372	:	DECISION ON PETITION
Filed: January 2, 2009	:	UNDER 37 CFR 1.181
For: U.S. Patent No.: 6,425,401	:	

This is a decision on the petition filed under 37 CFR 1.181 by the patent owner on October 26, 2010. The petition is entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN REEXAMINATION PROCEEDING" ("181 petition") and is a renewed request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and withdraw the notice mailed May 12, 1010 and reopen prosecution in this proceeding. The alternative petition filed on October 26, 2010 is a petition under 37 CFR 1.137(b), which will be decided in a separate decision in due course.

The petition is before the Director of TC 1600, who oversees the Central Reexamination Unit.

The 181 petition, dated October 26, 2010, to invoke the supervisory authority of the Director is granted with respect to reopening prosecution in the proceeding.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,425,401 (hereinafter, the '401 patent) issued on July 30, 2002.

2. A request for *ex parte* reexamination, assigned control No. 90/009,372, was filed by a third party requester on January 2, 2009.

3. *Ex parte* reexamination was ordered for the '372 reexamination proceeding on March 5, 2009.

4. On September 11, 2009, a non-final action was mailed in this proceeding.

5. On October 22, 2009, an in-person interview was held with Examiners Jones, Ponnaluri and Brumback and Patent Owner's representatives Hoscheit, Rivard, McMillan, and Lee.

6. According to the petition, a proposed agenda was faxed to Examiner Brumback on October 21, 2009.

7. This interview was memorialized on the part of the Office by the interview summary mailed on October 22, 2009.

8. Patent Owner responded to the non-final rejection on November 10, 2009. That communication included the following statement:

   The courtesy extended by Examiners Brumback, Ponneluri and Jones at the interview of October 22, 2009 is gratefully acknowledged. That interview was attended by Mr. Paul Rivard, Mr. Richard McMillan, Dr. Richard J. Lee, as well as the undersigned on behalf of the patentee. The matters discussed at the interview are reflected in the Outline for Interview Summary (previously made of record), as well as in following comments in response to the Office Action. Claim 41 of U.S. Patent 6,425,401 ("the '401 patent") is presently under reexamination.

9. No Brief Outline for Interview is present in the electronic record until the petition of May 14 and 17, 2010.

10. On May 12, 2010, a Notice of Intent to Issue a Reexamination Certificate (NIRC)was mailed, indicating that the proceeding was terminated due to failure to file a summary of the interview as required by 37 CFR 1.550(d) and 1.560(b).

11. On May 14 and 17, 2010, patent owner filed petitions to reopen prosecution and supporting documentation.

12. On October 1, 2010, the Office mailed a decision that granted-in-part the May 14 and 17, 2010 petitions, pending the submission of additional information or a grantable petition under 37 CFR 1.137(b). This decision withdrew the NIRC to allow for the filing of additional information or petition by the patent owner.

13. On October 26, 2010, patent owner filed the instant 181 petition and alternative petition under 37 CFR 1.137(b).

DECISION

The October 1, 2010 decision vacated the NIRC mailed May 12, 2010, but required further action by the patent owner. Specifically, the decision stated:

> "Rule 560 and MPEP 2281 require an after-the-fact summary of the interview. In the typical case, an agenda prepared before the fact is not sufficient to capture all that is discussed. To the extent that an "informal written statement" captures all that was discussed, a copy of that document might be sufficient.
>
> In order to resolve this issue, the Notice of Intent to Issue a Reexamination Certificate of May 12, 2010 is vacated; however, no finding is made on whether the proceeding is terminated as described in 37 CFR 1.550(d).
>
> Based on the record, the document attached to the petition of May 14, 2010 was the "informal written statement" and was submitted before the interview on October 21, 2009. The examiner's interview summary record of October 22, 2009 was prepared after the interview and given to patent owner's representative. To the extent that the examiner's interview summary contained no information not already in the "informal written statement", it may have been reasonable for the patent owner to simply submit a copy of the "informal written statement".
>
> Patent owner is given a period of 30 days to either (a) show where each item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no response is filed, the NIRC will be reissued and the proceeding returned to publications.
>
> In view of the above, the petition is GRANTED-IN-PART."

In response to this decision, patent owner filed the petitions on October 26, 2010. The 181 petition has been reviewed and found to show where each item in the examiner's interview summary, mailed October 22, 2009, is described in the "informal written statement" attached to the May 14, 2010 petition. Therefore, based upon the facts of this proceeding, the director finds there are good and sufficient reasons to deem that the interview summary requirement has been met and to reopen prosecution in this reexamination for the reasons stated in the October 1, 2010 decision. Patent owner is reminded that, in the future, an after-the-fact summary statement must be filed 30 days or one month from the date of the interview, or with a response to an outstanding Office action, whichever is later. See MPEP 2281 and 37 CFR 1.560.

Therefore, patent owner's 181 petition, as it relates to reopening prosecution, is granted. The proceeding is not terminated as described in 37 CFR 1.550(d).

CONCLUSION

1. The petition under 37 CFR 1.181 for reopening prosecution dated October 26, 2010 is **granted**. The proceeding is not terminated as described in 37 CFR 1.550(d).

2. The proceeding will be forwarded to the examiner of record for further action in due course.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

Irem Yücel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,372	01/02/2009	6,425,401	004859.00064	6420

22907 7590 01/26/2011

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WASHINGTON, DC 20005-4051

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Rober S. Mallin
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
Chicago, IL 60610

Date:
MAILED
JAN 26 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009372
PATENT NO. : 6425401
ART UNIT : 3991

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

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

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(For Patent Owner)

MAILED

JAN 26 2011

CENTRAL REEXAMINATION UNIT

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Third Party Requester)

In re Jonnie R. Williams
Ex Parte Reexamination Proceeding
Control No. 90/009,372
Filed: January 2, 2009
For: U.S. Patent No. 6,425,401

: **DECISION**
: **DISMISSING AS MOOT**
: **PETITION**

This is a decision on the October 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response and revive the present reexamination prosecution ("the October 25, 2010 patent owner petition to revive").

The October 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

Subsequent to the October 25, 2010 patent owner petition to revive, the Office issued a Decision on Petition Under 37 CFR 1.181 on January 21, 2011, in response to patent owner's October 25, 2010 Renewed Petition Under 37 CFR 1.181 To Reopen Reexamination Proceeding. The January 21, 2011 Decision grants the October 25, 2010 renewed petition and states that the proceeding is not terminated as described in 37 CFR 1.550(d). Therefore, the October 25, 2010 patent owner petition to revive is **dismissed** as moot.

CONCLUSION

1. The October 25, 2010 petition to revive under 37 CFR 1.137(b) is **dismissed** as moot.

2. Art Unit 3991 of the Central Reexamination Unit will proceed to take appropriate action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Brenda Brumback, of CRU Art Unit 3991, at (571) 272-0961.

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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Chicago, IL 60610

In re Jonnie R. Williams :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,372 : **GRANTING**
Filed: January 2, 2009 : **PETITION**
For: U.S. Patent No. 6,425,401 :

This is a decision on the April 21, 2011 patent owner petition to vacate reexamination certificate No. C1 6,425,401, which was published in the Official Gazette on April 19, 2011, for the above-identified reexamination proceeding ("the April 21, 2011 patent owner petition").

The April 21, 2011 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration and is being treated as a petition under 37 CFR 1.181.

The April 21, 2011 patent owner petition is **granted**.

Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the present proceeding is hereby **vacated**.

A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

REVIEW OF SALIENT FACTS

1. Patent number 6,425,401 issued on July 30, 2002.

2. A request for reexamination was filed on January 2, 2009, by third party requester ("requester"), and was assigned control No. 90/009,372 ("the '9372 reexamination proceeding").
3. An Order Granting Request for *Ex Parte* Reexamination was mailed on March 5, 2009.
4. Prosecution proceeded to the point that the Office mailed a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) on March 10, 2011. The March 10, 2011 NIRC states that patent claim 41 is confirmed and patent claims 1-40 and 42-64 were not subject to reexamination.
5. Reexamination Certificate No. C1 6,425,401 was published in the *Official Gazette* on April 19, 2011, for the '9372 reexamination proceeding. The April 19, 2011 reexamination certificate erroneously states that patent claim 41 is canceled.
6. On April 21, 2011, patent owner filed the instant petition requesting that the April 19, 2011 reexamination certificate be vacated and a corrected certificate be issued consistent with the March 10, 2011 NIRC indicating that claim 41 is confirmed.

DECISION

As set forth above, consistent with the NIRC issued March 10, 2011, the reexamination certificate issued on April 19, 2011, for the present '9372 reexamination proceeding should have indicated that claim 41 of the 6,425,401 patent is confirmed. However, reexamination Certificate No. C1 6,425,401 erroneously stated that "claim 41 is canceled."

Accordingly, the April 21, 2011 patent owner petition is **granted**. Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the present reexamination proceeding is hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 6,425,401 to Jonnie R. Williams of Manakin-Sabot, VA (US) for METHOD OF TREATING TOBACCO TO REDUCE NITROSAMINE CONTENT, AND PRODUCTS PRODUCED THEREBY, appearing in the *Official Gazette* of April 19, 2011, should be deleted, since the reexamination certificate has been vacated.

A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 NIRC. The new reexamination certificate will state that claim 41 of the 6,425,401 patent is confirmed.

CONCLUSION

1. The April 21, 2011 patent owner petition is **granted**.

2. Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the '9372 proceeding is **vacated**.

3. A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

4. The Office of Patent Publications will take action with respect to the 6,425,401 patent consistent with this decision.

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

Brian E. Hanlon

Brian E. Hanlon
Director
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.
90/009,372	01/02/2009	6,425,401	004859.00064	6420

22907 7590 04/25/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Rober S. Mallin
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
Chicago, IL 60610

Date:

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APR 2 5 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009372
PATENT NO. : 6425401
ART UNIT : 3991

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

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

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APR 25 2011

CENTRAL REEXAMINATION UNIT

In re Jonnie R. Williams
Ex Parte Reexamination Proceeding
Control No. 90/009,372
Filed: January 2, 2009
For: U.S. Patent No. 6,425,401

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

This is a decision on the April 21, 2011 patent owner petition to vacate reexamination certificate No. C1 6,425,401, which was published in the Official Gazette on April 19, 2011, for the above-identified reexamination proceeding ("the April 21, 2011 patent owner petition").

The April 21, 2011 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration and is being treated as a petition under 37 CFR 1.181.

The April 21, 2011 patent owner petition is **granted**.

Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the present proceeding is hereby **vacated**.

A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

REVIEW OF SALIENT FACTS

1. Patent number 6,425,401 issued on July 30, 2002.

2. A request for reexamination was filed on January 2, 2009, by third party requester ("requester"), and was assigned control No. 90/009,372 ("the '9372 reexamination proceeding").
3. An Order Granting Request for *Ex Parte* Reexamination was mailed on March 5, 2009.
4. Prosecution proceeded to the point that the Office mailed a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) on March 10, 2011. The March 10, 2011 NIRC states that patent claim 41 is confirmed and patent claims 1-40 and 42-64 were not subject to reexamination.
5. Reexamination Certificate No. C1 6,425,401 was published in the *Official Gazette* on April 19, 2011, for the '9372 reexamination proceeding. The April 19, 2011 reexamination certificate erroneously states that patent claim 41 is canceled.
6. On April 21, 2011, patent owner filed the instant petition requesting that the April 19, 2011 reexamination certificate be vacated and a corrected certificate be issued consistent with the March 10, 2011 NIRC indicating that claim 41 is confirmed.

DECISION

As set forth above, consistent with the NIRC issued March 10, 2011, the reexamination certificate issued on April 19, 2011, for the present '9372 reexamination proceeding should have indicated that claim 41 of the 6,425,401 patent is confirmed. However, reexamination Certificate No. C1 6,425,401 erroneously stated that "claim 41 is canceled."

Accordingly, the April 21, 2011 patent owner petition is **granted**. Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the present reexamination proceeding is hereby **vacated**.

In due course, the following *erratum* will be published in the *Official Gazette*:

> All reference to Reexamination Certificate No. C1 6,425,401 to Jonnie R. Williams of Manakin-Sabot, VA (US) for METHOD OF TREATING TOBACCO TO REDUCE NITROSAMINE CONTENT, AND PRODUCTS PRODUCED THEREBY, appearing in the *Official Gazette* of April 19, 2011, should be deleted, since the reexamination certificate has been vacated.

A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 NIRC. The new reexamination certificate will state that claim 41 of the 6,425,401 patent is confirmed.

CONCLUSION

1. The April 21, 2011 patent owner petition is **granted**.

2. Reexamination Certificate No. C1 6,425,401 issued April 19, 2011, for the '9372 proceeding is **vacated**.

3. A new reexamination certificate for the 6,425,401 patent will be issued and published based on the March 10, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate.

4. The Office of Patent Publications will take action with respect to the 6,425,401 patent consistent with this decision.

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

Brian E. Hanlon

Brian E. Hanlon
Director
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.
90/009,375	12/31/2008	6202649	004859.00063	9970

22907 7590 10/01/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/01/2010

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Date:
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OCT 01 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009375
PATENT NO. : 6202649
ART UNIT : 3991

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

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

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CENTRAL REEXAMINATION UNIT

Brinks Hofer Gilson & Lione
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(For Third Party Requester)

In re Williams et al.	: DECISION ON PETITION
Ex Parte Reexamination Proceeding	: TO REOPEN
Control No. 90/009375	: REEXAMINATION
Request Deposited: December 31, 2008	: PROCEEDING
For: U.S. Patent No. 6,202,649	:

This is a decision on the May 14, 2010 "Petition to reopen reexamination proceeding" and the May 17 "Supplemental petition to reopen reexamination proceeding".

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

For the reasons set forth below, the petition is **GRANTED IN PART**.

BACKGROUND

1. On September 11, 2009, a non-final action was mailed in this proceeding.

2. On October 22, 2009, an in-person interview was held with Examiners Jones, Ponnaluri and Brumback and Patent Owner's representatives Hoscheit, Rivard, McMillan and Lee.

3. According to the petition, a proposed agenda was faxed to Examiner Brumback on October 21, 2009.[1]

[1] It is noted that MPEP 2281 indicates that patent owner must file an informal written statement of the issues to be discussed at the interview at least three days prior to the interview. The facsimile transmission is understood to be the document attached to the petition of May 14, 2010. In view of the history of this case, the examiner should adhere to the three-day requirement in this proceeding and any related proceedings.

4. This interview was memorialized on the part of the USPTO by the interview summary of 10/22/2009.

5. Patent Owner responded to the non-final rejection on November 10, 2009. That communication included the following statement:

> The courtesy extended by Examiners Brumback, Ponneluri and Jones at the interview of October 22, 2009 is gratefully acknowledged. That interview was attended by Mr. Paul Rivard, Mr. Richard McMillan, Dr. Richard J. Lee, as well as the undersigned on behalf of the patentee. The matters discussed at the interview are reflected in the Outline for Interview Summary (previously made of record), as well as in following comments in response to the Office Action. Claim 41 of U.S. Patent 6,425,401 ("the '401 patent") is presently under reexamination.

6. No Brief Outline for Interview is present in the electronic record until the petition of May 12, 2010.

7. On May 12, 2010, a Notice of Intent to Issue a Reexamination Certificate was mailed, indicating that the proceeding was terminated due to failure to file a summary of the interview as required by 37 CFR 1.550(d) and 1.560(b).

DECISION

Initially, it is noted that the petition of May 12, 2010 seeks review in the alternative.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The petition has been treated under 37 CFR 1.181 as a petition to reopen prosecution.

To the extent that Patent Owner "alternatively petitions" for revival due to unintentional delay, said request is **dismissed** under 37 CFR 1.4(c) since that different matter is considered by a different branch or section of the office.

37 CFR 1.550(d) states:

> 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.

37 CFR 1.560(b) states:

> 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 2281 states, in part:

> If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview. These preliminary steps are for the purpose of providing structure to the interview so as to facilitate the statutory mandate for special dispatch.
>
> ...
>
> In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.

MPEP 2281 makes clear that the "informal written statement of the issues **to be discussed**" and the "complete written statement of the reasons **presented**" (emphasis added) are different documents with different purposes. It is conceptually possible that an interview would consist of patent owner representatives simply reading the "informal written statement" to the examiners and leaving; such does not appear to be contemplated.

In the response to the non-final rejection, Patent Owner refers to the "informal written statement" and the interview itself, but gives no other summary of the interview.

It is noted that the "informal written statement" is quite detailed and at least some of the items discussed in the contemporaneous interview summary are clearly within the "informal written statement". For example, "the processes by which TSNAs were formed were not completely understood" in the examiner's interview summary is adequately described by page 7 of the "informal written statement" discussion of the contribution from bacteria to the formation of

TSNA being unclear. However, other items – such as the discussion of wet bulb methods and the litigation documents – do not appear to be documented.

Rule 560 and MPEP 2281 require an after-the-fact summary of the interview. In the typical case, an agenda prepared before the fact is not sufficient to capture all that is discussed. To the extent that an "informal written statement" captures all that was discussed, a copy of that document might be sufficient.

In order to resolve this issue, the Notice of Intent to Issue a Reexamination Certificate of May 12, 2010 is **vacated**; however, no finding is made on whether the proceeding is terminated as described in 37 CFR 1.550(d).

Based on the record, the document attached to the petition of May 14, 2010 was the "informal written statement" and was submitted before the interview on October 21, 2009. The examiner's interview summary record of October 22, 2009 was prepared after the interview and given to patent owner's representative. To the extent that the examiner's interview summary contained no information not already in the "informal written statement", it may have been reasonable for the patent owner to simply submit a copy of the "informal written statement".

Patent owner is given a period of 30 days to either (a) show where **each** item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no response is filed, the NIRC will be reissued and the proceeding returned to publications.

In view of the above, the petition is **GRANTED-IN-PART**.

CONCLUSION

1. Patent Owner's May 14, 2010 petition is **GRANTED-IN-PART**.

2. Patent owner is given a period of 30 days to (a) show where **each** item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no sufficient response is filed, the NIRC will be reissued and the proceeding returned to publications.

3. Prosecution is not reopened at this time.

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

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

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

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

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

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

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

3. This decision is not a final agency decision and is without prejudice to a request for reconsideration or higher-level review.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to the undersigned.

Gregory Morse
Director, Center Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JAN 21 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Banner & Witcoff
1100 13th Street, N.W.
Suite 1200
Washington, DC 20005-4051

(For Requester)

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

In re Williams et al.	:	
Reexamination Proceeding	:	
Control No.: 90/009,375	:	DECISION ON PETITION
Filed: December 31, 2008	:	UNDER 37 CFR 1.181
For: U.S. Patent No.: 6,202,649	:	

This is a decision on the petition filed under 37 CFR 1.181 by the patent owner on October 25, 2010. The petition is entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN REEXAMINATION PROCEEDING" ("181 petition") and is a renewed request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and withdraw the notice mailed May 13, 1010 and reopen prosecution in this proceeding. The alternative petition filed on October 25, 2010 is a petition under 37 CFR 1.137(b), which will be decided in a separate decision in due course.

The petition is before the Director of TC 1600, who oversees the Central Reexamination Unit.

The 181 petition, dated October 25, 2010, to invoke the supervisory authority of the Director is granted with respect to reopening prosecution in the proceeding.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,202,649 (hereinafter, the '649 patent) issued on March 20, 2001.

2. A request for *ex parte* reexamination, assigned control No. 90/009,375, was filed by a third party requester on December 31, 2008.

3. *Ex parte* reexamination was ordered for the '375 reexamination proceeding on February 12, 2009.

4. On September 11, 2009, a non-final action was mailed in this proceeding.

5. On October 22, 2009, an in-person interview was held with Examiners Jones, Ponnaluri and Brumback and Patent Owner's representatives Hoscheit, Rivard, McMillan, and Lee.

6. According to the petition, a proposed agenda was faxed to Examiner Brumback on October 21, 2009.

7. This interview was memorialized on the part of the Office by the interview summary mailed on October 22, 2009.

8. Patent Owner responded to the non-final rejection on November 10, 2009. That communication included the following statement:

   The courtesy extended by Examiners Brumback, Ponneluri and Jones at the interview of October 22, 2009 is gratefully acknowledged. That interview was attended by Mr. Paul Rivard, Mr. Richard McMillan, Dr. Richard J. Lee, as well as the undersigned on behalf of the patentee. The matters discussed at the interview are reflected in the Outline for Interview Summary (previously made of record), as well as in following comments in response to the Office Action. Claim 41 of U.S. Patent 6,425,401 ("the '401 patent") is presently under reexamination.

9. No Brief Outline for Interview is present in the electronic record until the petition of May 14 and 17, 2010.

10. On May 13, 2010, a Notice of Intent to Issue a Reexamination Certificate (NIRC)was mailed, indicating that the proceeding was terminated due to failure to file a summary of the interview as required by 37 CFR 1.550(d) and 1.560(b).

11. On May 14 and 17, 2010, patent owner filed petitions to reopen prosecution and supporting documentation.

12. On October 1, 2010, the Office mailed a decision that granted-in-part the May 14 and 17, 2010 petitions, pending the submission of additional information or a grantable petition under 37 CFR 1.137(b). This decision withdrew the NIRC to allow for the filing of additional information or petition by the patent owner.

13. On October 25, 2010, patent owner filed the instant 181 petition and alternative petition under 37 CFR 1.137(b).

DECISION

The October 1, 2010 decision vacated the NIRC mailed May 13, 2010, but required further action by the patent owner. Specifically, the decision stated:

> "Rule 560 and MPEP 2281 require an after-the-fact summary of the interview. In the typical case, an agenda prepared before the fact is not sufficient to capture all that is discussed. To the extent that an "informal written statement" captures all that was discussed, a copy of that document might be sufficient.
>
> In order to resolve this issue, the Notice of Intent to Issue a Reexamination Certificate of May 12, 2010 is vacated; however, no finding is made on whether the proceeding is terminated as described in 37 CFR 1.550(d).
>
> Based on the record, the document attached to the petition of May 14, 2010 was the "informal written statement" and was submitted before the interview on October 21, 2009. The examiner's interview summary record of October 22, 2009 was prepared after the interview and given to patent owner's representative. To the extent that the examiner's interview summary contained no information not already in the "informal written statement", it may have been reasonable for the patent owner to simply submit a copy of the "informal written statement".
>
> Patent owner is given a period of 30 days to either (a) show where each item in the examiner's interview summary is described in the "informal written statement" and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no response is filed, the NIRC will be reissued and the proceeding returned to publications.
>
> In view of the above, the petition is GRANTED-IN-PART."

In response to this decision, patent owner filed the petitions on October 25, 2010. The 181 petition has been reviewed and found to show where each item in the examiner's interview summary, mailed October 22, 2009, is described in the "informal written statement" attached to the May 14, 2010 petition. Therefore, based upon the facts of this proceeding, the director finds there are good and sufficient reasons to deem that the interview summary requirement has been met and to reopen prosecution in this reexamination for the reasons stated in the October 1, 2010 decision. Patent owner is reminded that, in the future, an after-the-fact summary statement must be filed 30 days or one month from the date of the interview, or with a response to an outstanding Office action, whichever is later. See MPEP 2281 and 37 CFR 1.560.

Therefore, patent owner's 181 petition, as it relates to reopening prosecution, is granted. The proceeding is not terminated as described in 37 CFR 1.550(d).

CONCLUSION

1. The petition under 37 CFR 1.181 for reopening prosecution dated October 25, 2010 is **granted**. The proceeding is not terminated as described in 37 CFR 1.550(d).

2. The proceeding will be forwarded to the examiner of record for further action in due course.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

Irem Yucel, Director
Technology Center 1600

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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JAN 26 2011

CENTRAL REEXAMINATION UNIT

Banner & Witcoff, Ltd.
1100 13th Street, N.W.
Suite 1200
Washington, DC 20005-4051

(For Patent Owner)

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Third Party Requester)

In re Jonnie R. Williams
Ex Parte Reexamination Proceeding
Control No. 90/009,375
Filed: December 31, 2008
For: U.S. Patent No. 6,202,649

: **DECISION**
: **DISMISSING AS MOOT**
: **PETITION**

This is a decision on the October 25, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response and revive the present reexamination prosecution ("the October 25, 2010 patent owner petition to revive").

The October 25, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

Subsequent to the October 25, 2010 patent owner petition to revive, the Office issued a Decision on Petition Under 37 CFR 1.181 on January 21, 2011, in response to patent owner's October 25, 2010 Renewed Petition Under 37 CFR 1.181 To Reopen Reexamination Proceeding. The January 21, 2011 Decision grants the October 25, 2010 renewed petition and states that the proceeding is not terminated as described in 37 CFR 1.550(d). Therefore, the October 25, 2010 patent owner petition to revive is **dismissed** as moot.

CONCLUSION

1. The October 25, 2010 petition to revive under 37 CFR 1.137(b) is **dismissed** as moot.

2. Art Unit 3991 of the Central Reexamination Unit will proceed to take appropriate action.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Brenda Brumback, of CRU Art Unit 3991, at (571) 272-0961.

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

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.
90/009,377	01/08/2009	7128744	SYNT-0702	4031

53443 7590 03/31/2011

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2011

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

SMITH & NEPHEW, INC.
Third Party Requester
v.
SYNTHES (U.S.A.)
Patent Owner

Merged *Inter partes* Reexamination Control 95/000,465

& *Ex parte* Reexamination Control 90/009,377

Patent 7,128,744

Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Request Artifact Folder for Color Version of Patent Owner's Appeal Brief under 37 C.F.R. § 1.182," filed February 2, 2011 ("Petition"). In the Petition, Patent Owner requests that the color versions of the appeal brief and the accompanying declarations of Clifford H. Turen, M.D., J. Russell Parsons, Ph.D., and René Haag be made available to the Examiner and the Board of Patent Appeals and Interferences. The petition fee of $400 pursuant to C.F.R. § 1.17(f) has been charged to petitioner's deposit account as authorized on page 2 of the petition.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Patent No. 7,128,744 issued on October 31, 2006, with 55 claims. The '744 patent is assigned to Patent Owner Synthes (U.S.A.). ("Synthes").

2. Third Party Requester Smith & Nephew, Inc. ("Smith") filed a request for *ex parte* reexamination on January 8, 2009, which was assigned Reexamination Control No. 90/009,377.

3. On February 13, 2009, the Office granted reexamination of claims 1-55 of the '744 patent in the '9377 proceeding.

4. Smith filed a request for *inter partes* reexamination on May 5, 2009, which was assigned Reexamination Control No. 95/000,465.

5. On June 19, 2009, the Office granted *inter partes* reexamination of claims 1-55 of the '744 patent in the '465 proceeding.

6. On July 14, 2009, a decision merging reexamination proceedings '9377 and '744 was mailed.

7. Prosecution was conducted and on November 2, 2010, a Right of Appeal Notice ("RAN") was mailed in the merged proceeding, rejecting claims 1-55.

8. On December 2, 2010, Synthes filed a Notice of Appeal for claims 1-55.

9. On February 2, 2011, Synthes filed an Appellant Brief, accompanied by the present petition.

10. On March 2, 2011, Smith filed a Respondent Brief.

RELEVANT AUTHORITY

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).

ANALYSIS

Synthes indicates that the appellant brief and accompanying declarations of Turen, Parsons, and Haag contain various illustrations and photographs in color. Synthes requests that these materials be made available to the examiner and to the Board of Patent Appeals and Interferences. Synthes requests the creation of an artifact folder to contain the original documents after they are scanned.

The petition is **granted**.

DECISION

In view of the forgoing, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

Counsel for Third Party Requester
Hunton and Williams, LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,377	01/08/2009	7128744	SYNT-0702	4031

53443 7590 07/13/2011

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2011

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

SMITH & NEPHEW, INC.
Third Party Requester
v.
SYNTHES (U.S.A.)
Patent Owner

Merged *Inter partes* Reexamination Control 95/000,465

& *Ex parte* Reexamination Control 90/009,377

Patent 7,128,744

Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Request Artifact Folder for Color Version of Patent Owner's Rebuttal Appeal Brief under 37 C.F.R. § 1.182," filed May 25, 2011 ("Petition"). In the Petition, Patent Owner requests that the color versions of the rebuttal brief be made available to the Examiner and the Board of Patent Appeals and Interferences. The petition fee of $400 pursuant to C.F.R. § 1.17(f) has been charged to petitioner's deposit account as authorized on page 2 of the petition.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Patent No. 7,128,744 issued on October 31, 2006, with 55 claims. The '744 patent is assigned to Patent Owner Synthes (U.S.A.). ("Synthes").

2. Third Party Requester Smith & Nephew, Inc. ("Smith") filed a request for *ex parte* reexamination on January 8, 2009, which was assigned Reexamination Control No. 90/009,377.

3. On February 13, 2009, the Office granted reexamination of claims 1-55 of the '744 patent in the '9377 proceeding.

4. Smith filed a request for *inter partes* reexamination on May 5, 2009, which was assigned Reexamination Control No. 95/000,465.

5. On June 19, 2009, the Office granted *inter partes* reexamination of claims 1-55 of the '744 patent in the '465 proceeding.

6. On July 14, 2009, a decision merging reexamination proceedings '9377 and '744 was mailed.

7. Prosecution was conducted and on November 2, 2010, a Right of Appeal Notice ("RAN") was mailed in the merged proceeding, rejecting claims 1-55.

8. On December 2, 2010, Synthes filed a Notice of Appeal for claims 1-55.

9. On February 2, 2011, Synthes filed an Appellant Brief.

10. On March 2, 2011, Smith filed a Respondent Brief.

11. An examiner's answer was mailed on April 25, 2011.

12. On May 25, 2011, Synthes filed a Rebuttal Brief, accompanied by the present petition.

RELEVANT AUTHORITY

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).

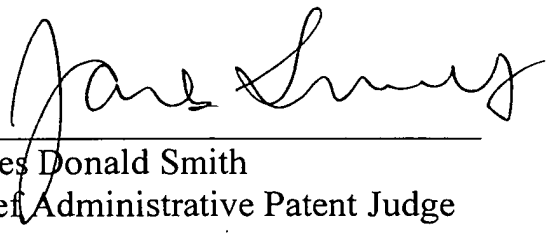
ANALYSIS

Synthes indicates that the rebuttal brief contains various illustrations and photographs in color. Synthes requests that these materials be made available to the Board of Patent Appeals and Interferences. Synthes requests the creation of an artifact folder to contain the original documents after they are scanned.

The petition is **granted**.

DECISION

In view of the forgoing, the Petition is GRANTED.



James Donald Smith
Chief Administrative Patent Judge

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Counsel for Third Party Requester
Hunton and Williams, LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,377	01/08/2009	7128744	SYNT-0702	4031

53443 7590 11/18/2011
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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

Smith & Nephew, Inc.

v.

Synthes (U.S.A.)

Merged *Inter partes* Reexamination Control 95/000,465 and *Ex parte* Reexamination Control 90/009,377
Patent 7,128,744
Technology Center 3900

DECISION ON PETITION

This is a decision on Third Party Requester's "Petition to the Chief Administrative Patent Judge Under 37 C.F.R. §§ 41.3 & 41.5(a) for *Pro Hac Vice* Admission of Bradley L. Lennie," filed October 26, 2011 ("Petition").

FINDINGS

1. In the Petition, Third Party Requester, Smith & Nephew, Inc, ("Smith & Nephew") describes Mr. Lennie's participation as trial counsel in related district court litigation. Petition, 2.

2. The Petition also represents that Mr. Lennie, although not registered to practice before the PTO, is familiar with the PTO Rules governing *inter partes* reexamination proceedings and appeals. Petition, 2.

RELEVANT LEGAL AUTHORITY

37 C.F.R. § 41.5(a) provides that:

While the Board has jurisdiction:

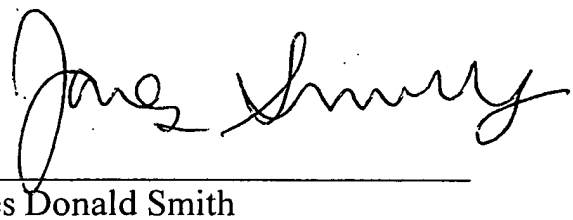
(a) *Appearance pro hac vice*. The Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.

ANALYSIS

Based on the representations in the Petition, it appears that Mr. Lennie is knowledgeable with the relevant PTO rules of practice and with the facts relevant to this appeal. Also, by the Petition, Smith & Nephew has clearly expressed a desire to be represented by Mr. Lennie in this appeal.

DECISION

In view of the foregoing, Smith & Nephew's Petition is GRANTED.



James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
David R. Bradley
Woodcock Washburn LLP
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Counsel for Third Party Requester:
Robert A. King
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Intellectual Property Department
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 06/23/2011
WOODCOCK WASHBURN LLP
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2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

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
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW SUITE 1200
WASHINGTON, DC 20006-1109

Date:
MAILED
JUN 23 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009378
PATENT NO. : 6623486
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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JUN 23 2011

CENTRAL REEXAMINATION UNIT

WOODCOCK WASHBURN LLP
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2929 ARCH STREET
PHILADELPHIA PA 19104-2891

(For Patent Owner)

ROBERT A. KING
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPT.
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes* & *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,468
Filed: May 8, 2009
For: U.S. Patent No. 6,623,486

Ex Partes Reexamination Proceeding
Control No. 90/009,378
Filed: January 8, 2009
For: U.S. Patent No. 6,623,486

DECISION ON PETITION

This is a decision on the patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.181 TO REVIEW DECISION OF TECHNICAL CENTER DIRECTOR," filed on March 28, 2011, which is being treated as a petition under 37 CFR 1.181(a)(3) seeking supervisory review of a Technology Center Director.

The petition under 37 CFR 1.181(a)(3) is granted only to the extent that the March 22, 2011 decision of the Director who oversees the Central Reexamination Unit (CRU) has been reconsidered, but is **denied** with respect to: (1) disturbing the Technology Center Director's March 22, 2011 decision dismissing patent owner's February 10, 2011 petition; or (2) directing that prosecution in this reexamination proceeding be reopened.

BACKGROUND

1. On September 23, 2003, United States Patent No. 6,623,486 ("the '486 patent") issued to Weaver *et al.*

2. On January 8, 2009, a request for *ex parte* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 90/009,378 ("the '9378 proceeding").

3. On February 14, 2009, the Office mailed an order granting *ex parte* reexamination in the '9378 proceeding.

4. On May 8, 2009, a request for *inter partes* reexamination of the '486 patent was filed by third party requester, Smith & Nephew, Inc., which request was assigned Reexamination Control No. 95/000,468 ("the '468 proceeding").

5. On June 19, 2009, the Office mailed an order granting *inter partes* reexamination in the '468 proceeding.

6. On July 10, 2009, the Office mailed a decision *sua sponte* merging the '9378 *ex parte* and the '468 *inter partes* proceedings ("the merged proceeding").

7. On November 30, 2009, the Office mailed a non-final Office action in the merged proceeding.

8. On March 22, 2010, patent owner timely responded to the November 30, 2009 non-final Office action.[1] Concurrently patent owner submitted a petition requesting a waiver of the page limitation requirements of 37 CFR 1.943.

9. On May 26, 2010, the Office mailed a decision granting patent owner's waiver of the regulatory page length limitations of 37 CFR 1.943 and setting third party requester's time period to respond at 30 day from the decision's date.

10. On June 25, 2010, third party requester timely submitted comments.

11. On August 24, 2010, the Office mailed an Action Closing Prosecution (ACP).

12. On October 22, 2010, patent owner timely filed comments after ACP,[2] triggering a third party requester right of comment. The patent owner submission included a declaration by Dr. Clifford H. Turen ("the Turen Declaration").

13. On November 22, 2010, third party requester timely filed comments after ACP. The requester submission included a declaration by Dr. J. Lawrence Marsh ("the Marsh Declaration").

14. On January 21, 2011, a Right of Appeal Notice (RAN) was issued by the Office stating that the post ACP submissions by both parties were entered and considered.

15. On February 10, 2011, patent owner filed a paper entitled "PETITION UNDER 37 C.F.R. §§ 1.181-1.182 TO REOPEN PROSECUTION AND FOR EXTENSION OF TIME TO FILE NOTICE OF APPEAL."

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[1] Patent owner petitioned for, and was granted, two extensions of time in order to respond the November 30, 2009 Office action.

[2] Patent owner again petitioned for, and was granted, an extension of time.

16. On February 22, 2011, patent owner filed a notice of appeal.

17. On March 7, 2011, third party requester filed a notice of cross appeal.

18. On March 22, 2011, the Office issued a decision denying patent owner's February 10, 2011 request to reopen prosecution.

19. On March 28, 2011, patent owner filed the following petitions:

    a. A petition entitled "PETITION UNDER 37 C.F.R. § 1.181 TO REVIEW DECISION OF TECHNICAL CENTER DIRECTOR," requesting reversal of the March 22, 2011 Office decision and a reopening of prosecution.

    b. A petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING EXPEDITED CONSIDERATION OF A PETITION FILED UNDER 37 CFR § 1.181," requesting the petition to review the March 22, 2011 petition be taken out of turn.

    c. A petition entitled "PETITION UNDER 37 C.F.R. §1.183 REQUESTING (1) WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF (37 CFR 41.66(a)), AND (2) A REQUEST FOR AN EXTENTION OF THE PERIOD TO FILE THE APPEAL BRIEF UNTIL AFTER A DECISION ON THE PETITION UNDER 37 CFR 1.181," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

    d. A petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING EXPEDITED CONSIDERATION OF A PETITION FILED UNDER 37 CFR § 1.183," requesting the petition to grant an extension of time to file an appeal brief be taken out of turn.

20. On April 14, 2011, the Office dismissed the two March 28, 2011 petitions to expedite (petitions b. and d.) and granted the extension of time petition (petition c.), granting a 30 day extension of time, and indicating the possibility of additional extensions of time if necessary.

21. On May 26, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. §1.182 REQUESTING SECOND WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," requesting a second extension of time.

22. On June 3, 2011, the Office granted the second extension of time petition, granting a 30 day extension of time, and indicating the possibility of additional extensions of time if necessary.

23. The present decision is directed to the March 28, 2011 patent owner petition under 35 CFR 1.181 for review of the "TECHNICAL CENTER DIRECTOR" decision (petition d. above).

RELEVANT AUTORITY AND GUIDANCE

35 U.S.C. § 314 provides:

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

(b) RESPONSE.-

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the *inter partes* reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

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

37 CFR 1.181(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 1.951 provides:

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

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

37 CFR 1.953 provides:

(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an inter partes reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an inter partes reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all of the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued.

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

MPEP 2673.01 provides (in pertinent part):

I. MANDATORY REOPENING
Where a submission after Action Closing Prosecution (ACP) has been filed pursuant 37 CFR 1.951(a) (and 37 CFR 1.951(b)) and the examiner decides to modify his/her position, the examiner should ordinarily reopen prosecution, in accordance with the following guidelines.

The patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. A Right of Appeal Notice (RAN) cannot be issued until the patent owner has had the opportunity to address each and every rejection prior to the appeal stage. Thus, the examiner should reopen prosecution where any new ground of rejection is made or any additional claim is rejected.
. . .

II. DISCRETIONARY REOPENING
In addition to the above situation which requires reopening of prosecution, the examiner should be liberal in reopening prosecution where the equities of the situation make such appropriate, because 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.

DECISION ON PETITION UNDER 37 CFR 1.181

Petitioner (patent owner) seeks intervention by the Director to reverse the March 22, 2011 decision of the Technology Center (TC) Director of TC 1600, who oversees the CRU (which decision denied patent owner's February 10, 2011 petition). Petitioner seeks this intervention on

the grounds that the Office: (1) Violated patent owner's procedural due process rights; and (2) Incorrectly found the January 21, 2011 RAN as setting forth the same rejections as the August 24, 2010 ACP.[3] Accordingly, petitioner seeks: (1) Vacatur of the March 22, 2011 decision dismissing patent owner's February 10, 2011 petition; and (2) Reopening of prosecution in this reexamination proceeding.[4]

For the Director to intervene, petitioner must show that the March 22, 2011 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). A review of the record indicates that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Therefore, petitioner has not provided a showing of clear error that would justify setting aside or otherwise disturbing the Technology Center Director's decision.

I. Discussion of Previous Petition and Decision

In the original petition requesting reopening prosecution, patent owner asserted that: (1) Patent owner should be permitted to respond to the requester's November 22, 2010 Marsh Declaration, because the examiner's incorporation by reference of the requester's Marsh declaration into the response to argument section is a new grounds of rejection and therefore constitutes a newly raised issue patent owner has not had an opportunity to respond to, thus justifying a reopening of prosecution.

The Office issued a decision dismissing patent owner's original petition. The decision pointed out that patent owner's general arguments to justify reopening prosecution did not provide a good and sufficient reason to do so. The decision explains that the record reflects the examiner followed all relevant Office policies, procedures and rules in the issuance of the ACP and RAN. The decision further noted Office policies, procedures and rules were established through notice and comment to implement the *inter partes* reexamination statutes. Accordingly the actions by the examiner were found to not violate patent owner's rights.

Specifically, the decision pointed out that the ACP maintained most of the rejections adopted in the November 30, 2009 Office action and the RAN maintained the positions set forth in the ACP. As the examiner either withdrew or maintained the exact same grounds of rejection throughout prosecution and did not add any new grounds of rejection in the RAN, the decision determined there was no basis to justify acting contrary to special dispatch and reopen prosecution. The decision specifically pointed out that the examiner discussed the post ACP submissions in the RAN's response to arguments after ACP section and that is did not modify or alter the grounds of rejection. 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.

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[3] Petitioner identifies the ACP as issuing on November 30, 2009 ACP, but the ACP issued on August 24, 2010 and not November 30, 2009. On November 30, 2009 the Office issued a non-final action and not an ACP. Therefore the Office interprets petitioner's arguments to be directed to the August 24, 2010 ACP. Petition at page 5.
[4] Petition at page 12.

II. Findings and Analysis

A. The March 22, 2011 Decision

1. Mischaracterization of the March 22, 2011 Decision

Petitioner erroneously mischaracterizes the March 22, 2011 as stating that only the statutory statement of the rejection and the references relied upon need stay the same, and that the reasoning can change.[5] The decision's reference to the grounds of rejection is directed not only to the statutory statement of the rejection and references relied upon, but also the corpus of the rejection as it appears just after the various rejection statements in the RAN's "Status of Grounds of Rejection as presented in the ACP" section. The March 22, 2011 decision simply explains that the comments made by the examiner in the separate and distinct "Response to Arguments after ACP" section of the RAN do not serve as a ground for rejection. The March 22, 2011 decision nowhere indicates that citation of the statutory provision and the references relied upon alone precludes the presence of a new ground of rejection.

2. MPEP 2673.01 Supports the March 22, 2011 Decision

MANDATORY REOPENING

The examiner has not modified any of his positions with regard to the rejections retained from the November 30, 2009 Office action, in either the ACP or the RAN; therefore, no mandatory reopening in accordance with MPEP 2673.01 I is implicated. The incorporation by reference of a portion of the Marsh Declaration into the RAN's "Response to Arguments after ACP" section does not constitute a new ground of rejection. There is no rejection statement, no citation of claims, no statutory basis set forth, no citation to patents or printed prior art and no reasoned basis. Thus petitioner's position that the examiner commentary in a response to arguments section serves as a ground of rejection is untenable, especially in light the very case law cited by petitioner (see the discussion of that case law below). The examiner is simply noting his consideration of the Marsh Declaration in the RAN's response to arguments section. Accordingly, as no new ground of rejection is being made, no mandatory reopening is implicated, as noted by the March 22, 2011 decision.

DISCRETIONARY REOPENING

Patent owner's argument that the March 22, 2011 decision does not balance the equities of the present proceeding is not relevant to the present 37 CFR 1.181 petition. Patent owner filed a petition under 37 CFR 1.181 and 1.182 on February 10, 2011. The March 22, 2011 decision, however, stated, at page 1:

> "This is a decision addressing Patent Owner's petition, filed February 10, 2011, under 37 CFR 1.181 requesting that prosecution be reopened. **Although the petition contains statements that an alternative relief sought is a granting of a request for continued reexamination under 37 CFR 1.182, the petition is being decided solely under 37 CFR 1.181.** Likewise, the request for

[5] Petition at page 10.

> an extension of time combined with a petition under 37 CFR 1.181 and 1.182 is improper. In other words, the Patent Owner's combined petition under 37 CFR 1.181, 1.182, and 1.956 is deemed improper because it combines three distinct petitions, which is not compliant with 37 CFR 1.4. **Patent Owner must file a separate petition if Patent Owner wants consideration of the issues under 37 CFR 1.182.**" [Emphasis added.]

The March 22, 2011 decision made it clear that the petition was being decided solely under 37 CFR 1.181, and that patent owner would need to file a separate petition under 37 CFR 1.182. Petitioner never filed a petition under 37 CFR 1.182. Likewise, patent owner has never petitioned the Office for waiver under 37 CFR 1.183. While patent owner could have filed a petition under 37 CFR 1.182 or 1.183 directed to equitable considerations, patent owner simply chose not to do so. (At this point, the proceeding is no longer ripe for such §§1.182 and 1.183 petitions). Rather, petitioner has petitioned for review of the March 22, 2011 decision made solely based on 37 CFR 1.181, and relief under 37 CFR 1.181 is based solely upon supervisory review of the actions or requirements of the examiner for compliance with the patent statutes, regulations, and examining procedures. See 37 CFR 1.181(a). Accordingly, patent owner's argument that the March 22, 2011 decision does not balance the equities of the present proceeding is not an argument relevant to the present petition.[6] It is, however, pointed out that 35 U.S.C. 314 provides that "[e]ach time that the patent owner files a response to an action on the merits ..., 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...." 35 U.S.C. 315 then provides for appeal. The patent owner is not given a right to respond to requester's comments; if such a right was provided, then requester could next respond patent owner's response to requester's comments, and the proceeding could continue indefinitely. In this instance, patent owner submitted evidence in response to the Office's ACP, and requester responded by submitting its own response. Patent owner is not being deprived of any equitable rights by the Office refusing to reopen the proceeding, because patent owner will have an opportunity to argue disputes of fact on appeal. However, it is inequitable to permit continued iterations in a proceeding that Congress required by statute (35 U.S.C. 314) to be carried out with special dispatch.

B. The January 21, 2011 RAN

1. A Response to Arguments Section does not Constitute a New Grounds of Rejection

The examiner's incorporation by reference of a portion of the requester's Marsh Declaration into the RAN's Response to Arguments after ACP section does not constitute a new ground of rejection. Therefore, no basis exists to justify acting contrary to special dispatch and reopening prosecution.

The rejection statements and the full grounds of each rejection, *i.e.* the rationale as to how the various teachings are combined and why they render the claims unpatentable, is set forth in the RAN's Status of Grounds of Rejection as presented in the ACP section and not in the RAN's

[6] Petition at 11. Asserting a conclusory statement that the "equities clearly call for reopening prosecution" is an insufficient showing of the facts and circumstances of a proceeding are so extraordinary that justice requires waiver of a rule. See 37 CFR 1.183

Response to Arguments after ACP section. Nowhere in the corpus of the RAN's Status of Grounds of Rejection as presented in the ACP section does the examiner incorporate by reference the Marsh declaration to modify any of the grounds of rejection therein set forth. None of the cases cited by petitioner stand for the proposition that an incorporation by reference to an evidentiary declaration into the arguments section of an Office action constitutes a modification of a ground of rejection set forth in a completely different section of the Office action. Petitioner makes the conclusory statement, "There is no question that the Examiner's adoption of and reliance upon the March 11/22/10 declaration in the RAN constitutes a new ground of rejection."[7] Petitioner provides no reasoned basis for this conclusory statement. The examiner not only maintained the same statutory basis for each rejection and relied upon the same references for each rejection, but also provided the very same rationale and reasoned basis in the RAN as was previously set forth in the ACP and in the November 30, 2009 Office action. No new ground of rejection was posited by the examiner in the RAN, therefore the issuance of a RAN was proper. The examiner is required to indicate whether post ACP submissions are entered and considered and to address them in the RAN.[8] The examiner, acting in accordance MPEP guidance in the response to arguments section of a RAN, did not alter any grounds of rejection and did not provide a new ground of rejection, but instead merely responded to all arguments made in the post ACP submissions.

2. *In re Hoch*[9] is not Analogous

Affidavits or declarations do not serve as prior art, therefore they do not serve as a reference that must be positively included in a statement of the rejection. The MPEP sets forth that rejections in a reexamination proceeding cannot be based upon affidavits or declarations, but instead must be based upon prior art patents or printed publications.[10] The examiner is not using the Marsh declaration as a component of ANY of the rejections of record in the RAN's "Status of Grounds of Rejection as presented in the ACP." Therefore, *In re Hoch* is not analogous to the situation where an examiner documents consideration of a declaration in the response to arguments section of an Office action. All the statements of rejection set forth in the RAN's "Status of Grounds of Rejection as presented in the ACP" comply with the tenet of law set forth in *Hoch.* Accordingly, because the examiner has never applied the Marsh Declaration basis for a ground of rejection against any of the claims currently at issue in the present proceeding, petitioner's *Hoch*-based arguments are not persuasive.

3. The Basic Thrust of the Rejections are the same across the ACP and RAN

The basic thrust of the rejections set forth in the November 30, 2009 Office action, retained in the ACP, and then later set forth in RAN was unaltered, *i.e.* the rationale as to how the various teachings are combined and why they render the claims unpatentable. Therefore the rejections are not inconsistent with *In re Kronig.*[11] The examiner sets forth in the RAN's "Status of Grounds of Rejection as presented in the ACP" section the same rejections as previously set

[7] Petition at page 9.
[8] MPEP 2673
[9] 428 F.2d 1341 (CCPA 1970)
[10] MPEP 2258 I E
[11] 539 F.2d 1300 (CCPA 1976)

forth in the ACP. Nowhere in the corpus of the RAN's "Status of Grounds of Rejection as presented in the ACP" section does the examiner modify any of the grounds of rejection from the grounds of rejection previously set forth in the ACP. The examiner is not using the Marsh declaration as a component of ANY of the rejections of record in the RAN's "Status of Grounds of Rejection as presented in the ACP," but merely addressing the Marsh declaration's consideration in the response to arguments section. In *Kronig* the BPAI affirmed the examiner's obviousness rejection based upon four different prior art references. However, the BPAI based the rejection on only three of the four prior art references. The court concluded that while the BPAI used only three of the four prior art references in the obviousness rejection, the rejection was not new as the basic thrust of the rejection was the same. Therefore, the applicant had a fair opportunity to react to that rejection. Accordingly, as the examiner has presented the same rejections in both the ACP and the RAN, the basic thrust of the rejections are the same, and patent owner has had a fair opportunity to react to all the rejections of record.

C. Patent Owner's Procedural Due Process Rights

Patent owner's procedural due process rights have not been violated by the Office. Patent owner argues that because the ACP to RAN procedure does not permit the submission of rebuttal declarations, patent owner's due process rights have been violated. Patent owner's rationale for justifying the need for a rebuttal declaration is that the examiner's consideration of the third party requester's post-ACP submitted Marsh declaration in the response to arguments section constitutes a new ground of rejection. As noted in both sections A and B of this decision, patent owner's rationale is in error and no such introduction of a new ground of rejection occurred. The examiner followed proper procedure and noted that both the patent owner's and the third party requester's post ACP submissions were considered, but the examiner was persuaded by third party requester and not patent owner. Simply because patent owner does not like the results of a due process compliant procedure does not mean the procedure is in violation of patent owner's due process rights.

The procedure has identified a genuine issue of material fact that is in dispute between the parties. Contrary to the assertions of patent owner regarding due process, identification of this disputed fact promotes and preserves patent owner's due process right, as this disputed fact can now be taken up and resolved on appeal. Patent owner will have the opportunity to argue disputes of fact on appeal. It is wholly inappropriate in an *inter partes* proceeding to seek unjustified additional comment as to a fact in dispute which can and will be decided on appeal.

As pointed out above, by statutory mandate, reexamination proceedings must be conducted "with special dispatch within the Office." Reexamination procedures that satisfy the Office's statutory mandate of special dispatch that also provide patent owner with an opportunity to be heard do not violate patent owner's procedural due process rights.[12] Patent owner will have an opportunity to argue disputes of fact on appeal. As pointed out above, by permitting a party to have multiple unjustified iterations of comments and rebuttals, the Office's statutory mandate of special dispatch and the statutory procedural scheme of patent owner response followed by

[12] *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 484-86 (Fed. Cir. 1985) (Citing *Mathews v. Eldridge*, 424 U.S. 319 (1976)

requester comments, followed by appeal, would be unduly frustrated. There is no indication anywhere in the reexamination statute, the legislative history, nor the case law, that multiple iterations of input regarding such matters prior to decision on appeal was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

For all the reasons noted above, the petition under 37 CFR 1.181(a)(3) is **denied.**

CONCLUSION

1. The petition is granted only to the extent that the March 22, 2011 decision of the Director of TC 1600, who oversees the CRU has been reconsidered; however, the petition is **denied** with respect to: (1) disturbing the Technology Center Director's March 22, 2011 decision dismissing patent owner's February 10, 2011 petition; or (2) directing that prosecution in this reexamination proceeding be reopened.

2. This decision becomes final agency action under 5 U.S.C. § 704 upon entry of a final decision by the Board.

3. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

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

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.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 06/24/2011

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

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

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
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW SUITE 1200
WASHINGTON, DC 20006-1109

Date: MAILED

JUN 24 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009378
PATENT NO. : 6623486
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
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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

(For Patent Owner)

MAILED

JUN 24 2011

CENTRAL REEXAMINATION UNIT

ROBERT A. KING
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPT.
1900 K STREET, N.W., SUITE 1200
WASHINGTON, DC 20006-1109

(For *Inter Partes* & *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,468
Filed: May 8, 2009
For: U.S. Patent No. 6,623,486

Ex Partes Reexamination Proceeding
Control No. 90/009,378
Filed: January 8, 2009
For: U.S. Patent No. 6,623,486

DECISION ON PETITION

This is a decision on the patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.182 REQUESTING THIRD WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed on June 21, 2011, which is taken as a petition under 37 CFR 1.183 for waiver of 37 CFR 41.66(a).

The petition is before the Office of Patent Legal Administration.

The patent owner petition is DISMISSED.

DECISION

Patent owner has filed the present petition under § 1.182 for a third extension of time on June 21, 2011, subsequent to the patent owner filing of a notice of appeal on February 22, 2011, the third party requester's March 7, 2011 filing of a notice of cross appeal; the Office's March 22, 2011 denial of patent owner's request to reopen prosecution after issuance of a RAN; and the Office's granting of two 30 day extensions of time, on April 14, 2011, and June 3, 2011, respectively, giving the parties until July 7, 2011, to file their appeal briefs.

Patent owner's basis for requesting a third extension of time for filing its appellant's brief is to obtain the results of a decision on petition filed under § 1.181 on March 28, 2011, requesting review of a Office's March 22, 2011 denial of patent owner's request to reopen prosecution after

issuance of a RAN. Patent owner's rationale is that a brief may not need to be filed in the event the § 1.181 petition is granted. Further, patent owner noted that he has plans for a vacation incident with the current due date of the brief.

The Office issued a decision denying the § 1.181 petition on June 23, 2011, giving the parties ample time to file their briefs by the due date of July 7, 2011, thus mooting this basis for the extension request.

Furthermore, a party's vacation plans do not constitute extraordinary circumstances to justify wavier of a rule under 37 CFR 1.183.

Accordingly, patent owner's petition for a third extension of time to file a brief is DISMISSED.

CONCLUSION

1. The patent owner petition is DISMISSED.

2. The due date for filing both the patent owner's and third party requester's briefs is July 7, 2011.

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

/Kenneth M. Schor/

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

6-24-11

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.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 08/18/2011
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/18/2011

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

Smith & Nephew, Inc.

v.

Synthes (U.S.A.).

Merged *Inter Partes* Reexamination Control No. 95/000,468

& *Ex Parte* Reexamination Control No. 90/009,378

Patent 6,623,486

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Under 37 C.F.R. § 1.183 Requesting Waiver of the Rule 1.943 Word Limit for an Appeal Brief," filed July 21, 2011 ("Present Petition"). In the petition, patent owner requests extension of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the accompanying appellant brief of 22,054 words. The petition fee

of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on July 22, 2011, as well as the fee for the appeal brief.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *ex parte* reexamination of U.S. Patent No. 6,623,486, on January 8, 2009, which was assigned control no. 90/009,378.
2. On February 14, 2009, reexamination was ordered in the '9378 proceeding.
3. The same third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,623,486, on May 8, 2009, which was assigned control no. 95/000,468.
4. On June 19, 2009, reexamination was ordered in the '468 proceeding.
5. On July 10, 2009, a decision merging *inter partes* reexamination '468 and *ex parte* reexamination '9378 was mailed.
6. On November 30, 2009, a non-final Office action was mailed in the merged proceeding, rejecting claims 1-18.
7. Patent owner filed a response to the non-final Office action on March 22, 2010, accompanied by a petition requesting waiver of the 50 page limit pursuant to 37 C.F.R. § 1.943(b), to permit a 167 page response, including attachments.

8. On May 26, 2010, the Office mailed a decision granting the petition to permit the 167 page response, and *sua sponte* granting requester the same amount of pages for the requester's comments.
9. Third party requester filed comments in reply to the Office action and patent owner's response on June 25, 2010, within the 167 page limit extended by the petition decision.
10. On August 24, 2010, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1-18.
11. Patent owner filed a response to the ACP on October 22, 2010, and requester filed comments on November 22, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
12. On January 21, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1-18.
13. Patent owner filed a Notice of Appeal on February 22, 2011, appealing the rejections of claims 1-18.
14. Requester filed a Notice of Cross Appeal on March 7, 2011, appealing the examiner's refusal to adopt 7 proposed grounds of rejection concerning claims 10-13.
15. Patent owner filed numerous requests for extensions of time to file an Appellant Brief, all of which were granted, except for one.
16. Patent owner filed an appellant brief on July 21, 2011, accompanied by the present petition.

DISCUSSION

In the present petition, patent owner requests waiver of the limits of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty

pages or 14,000 words in length. The patent owner's appellant brief of July 21, 2011, is stated to be 22,054 words.

Extension of the limits is requested for the following reasons stated by patent owner:

1. The breadth and complexity of the issues on appeal is necessitated by the requester filing the reexamination requests in this merged proceeding with over 90 grounds for rejection;
2. This is an uniquely complicated, merged reexamination based on the sheer magnitude of the issues presented for appeal;
3. There are approximately 73 grounds for rejection on appeal encompassing 11 different primary references, and 6 principle secondary references, plus several other secondary references, in myriad combinations;
4. There is a substantial, voluminous record, including 100 pages in the original requests, 100 pages of requester's comments, 7 declarations, and 600 pages of claim charts.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

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

37 CFR § 1.943(c) provides:

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

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:
For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Patent owner's appellant brief filed on July 21, 2011, is stated to be 22,054 words which count toward the limit of 30 pages and 14,000 words. It exceeds the page and word limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on the merged proceedings, the multitude of technically-complex rejections appealed, the numerous and technically dense references applied, the intricacies and complexities of the technology, the complex, factual and opinion declarations to be considered, evidence of commercial success, as well as the length of some of the documents in the prosecution history, *e.g.*, over 600 pages of claim charts. A review of the record reveals that the RAN contains 93 rejections under 35 U.S.C. 102(a), 102(b) and 103(a) of 18 claims. The RAN refers to the prior art rejections in the original requests, in the same manner that the non-final Office action and the ACP referred back to the requests. The patent owner was permitted to file a 167 page response to the non-final Office action, and requester was *sua sponte* granted the same number of pages for the requester's comments. The appellant has explained their attempts to comply with the page/word limits, and the reasons why they were unable to comply.

In this specific case, based on the particular and unique facts and complexities of the present merged proceedings, a persuasive showing has been made that this situation is extraordinary and that justice requires that more pages/words be allotted to appellant's brief. The present petition is **granted,** and the appellant brief of July 21, 2011, is entered.

The granting of patent owner's petition extends the word limit of the appellant brief permitted by 37 C.F.R. § 1.943(c) of 14,000 words, by 8054 words. The third party requester is *sua sponte* granted an extension of the word limit permitted by 37 C.F.R. § 1.943(c) of 7000 words for the respondent brief, by a proportional amount, *i.e.*, 4027 words. Therefore, the word limit for requester's respondent brief is extended to permit up to 11,027 words.

DECISION

In view of the foregoing, the present petition is GRANTED. The appellant brief of July 21, 2011, is entered. Third party requester's respondent brief is due pursuant to 37 C.F.R. § 41.66.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Woodcock Washbum LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

Counsel for Third Party Requester
Hunton and Williams, LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109

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.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 09/29/2011

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,468	05/08/2009	6623486	SYNT-0712	2083

53443 7590 09/30/2011
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2011

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

SMITH & NEPHEW, INC.
Third Party Requester
v.
SYNTHES (U.S.A.)
Patent Owner

Merged *Inter partes* Reexamination Control 95/000,468

& *Ex parte* Reexamination Control 90/009,378

Patent 6,623,486

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition to Request Artifact Folder for Color Version of Patent Owner's Respondent Brief under 37 C.F.R. § 1.182," filed August 22, 2011 (petition). In the petition, patent owner requests that the color versions of the respondent brief be made available to the examiner and the Board of Patent Appeals and Interferences.

The petition fee of $400 pursuant to 37 C.F.R. § 1.17(f) has been charged to petitioner's deposit account on August 30, 2011, as authorized on page 2 of the petition, along with the appeal brief fee.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Patent No. 6,623,486 issued on September 23, 2003, with 18 claims. The '486 patent is assigned to Patent Owner Synthes (U.S.A.). ("Synthes").

2. Third Party Requester Smith & Nephew, Inc. ("Smith") filed a request for *ex parte* reexamination of the '486 patent on January 8, 2009, which was assigned Reexamination Control No. 90/009,378.

3. On February 14, 2009, the Office granted reexamination of claims 1-18 of the '486 patent in the '9378 proceeding.

4. Smith filed a request for *inter partes* reexamination on May 8, 2009, which was assigned Reexamination Control No. 95/000,468.

5. On June 19, 2009, the Office granted *inter partes* reexamination of claims 1-18 of the '486 patent in the '468 proceeding.

6. On July 10, 2009, a decision merging reexamination proceedings '9378 and '468 was mailed.

7. Prosecution was conducted and on January 21, 2011, a Right of Appeal Notice ("RAN") was mailed in the merged proceeding, rejecting claims 1-18.

8. On February 22, 2011, Synthes filed a Notice of Appeal for claims 1-18.

9. Smith filed a Notice of Cross-Appeal on March 7, 2011.

10. On July 21, 2011, both Synthes and Smith filed an appellant brief.

11. On August 22, 2011, Synthes filed a respondent brief, accompanied by the present petition.

RELEVANT AUTHORITY

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).

ANALYSIS

Synthes indicates that the respondent brief contains various illustrations and photographs in color. Synthes requests that these materials be made available to the examiner and the Board of Patent Appeals and Interferences. Synthes requests the creation of an artifact folder to contain the original documents after they are scanned. A review of the record reveals that an artifact folder was created on August 22, 2011.

The petition is **dismissed as moot**.

DECISION

In view of the forgoing, the Petition is DISMISSED.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

Counsel for Third Party Requester:
Hunton and Williams, LLP
Intellectual Property Department
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109

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MAY 19 2011

CENTRAL REEXAMINATION UNIT

WOODCOCK WASHBURN LLP
CIRA CENTRE
2929 ARCH STREET, 12th FLOOR
PHILADELPHIA, PA 19104-2891

: For Patent Owner

Ex Parte Reexamination Proceeding
Control No. 90/009,382
Filed: February 11, 2009
For: US Patent No. 6,878,717

DECISION GRANTING PETITION

This decision is in response to the petition to correct inventorship under 37 C.F.R. §§ 1.530 and 1.324, filed April 5, 2011. Patent Owner seeks to add the following person as an inventor of the '717 patent:

Koenraad Jozef Lodewijk Marcel ANDRIES
Oosteneide 9, B2440 Beerse, Belgium
Citizenship: Belgium

Patent Owner has complied with all the requirements of 37 C.F.R. § 1.324. Accordingly, the petition is granted. The change of inventorship will be shown in the reexamination certificate as set forth in MPEP 2250.02.

5/18/2011

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.
90/009,390	02/10/2009	6565509	518852802100	4516

90259 7590 09/15/2010
Hughes Hubbard and Reed LLP
One Battery Park Plaza
New York, NY 10004

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date: MAILED

SEP 15 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009390
PATENT NO. : 6565509
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
P.O. Box 1450
Alexandria, VA 22313-1450
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Hughes Hubbard and Reed LLP	:	(For Patent Owner)
One Battery Park Plaza	:	
New York NY 10004	:	

MAILED

SEP 15 2010

CENTRAL REEXAMINATION UNIT

MORRISON & FOERSTER LLP	:	(For Third Party Requester)
12531 HIGH BLUFF DRIVE	:	
SUITE 100	:	
SAN DIEGO, CA 92130-2040	:	

In re: Say *et alia*	:	DECISION
Ex Parte Reexamination Proceeding	:	GRANTING –IN-PART
Control No. 90/009,390	:	PETITION FOR EXTENSION
Deposited on: 10 February 2009	:	OF TIME
For: US Patent No. 6,565,509 B1	:	[37 CFR §§ 1.50(c) & 1.181]

This is a decision on the 03 September 2010 petition titled, "Petition for Extension of Time Under 37 CFR § 1.550(c)" requesting the response period for response be extended by one (1) month for response to the non-final Office action dated 23 August 2010. The petition submitted 03 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 one (1) month for responding to the non-final Office action dated 23 August 2010, which sets one (1) months time for filing a response thereto. The petition for extension of time was timely filed on 03 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.

The delay in availability of the Office action for one (1) week supports and extension of time of one(1) week.

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....

ANALYSIS AND FINDINGS

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

The petitioner notes that the Office action was not available on PAIR nor received by the counsel for the patent owner until 30 August 2010.

The petitioner further articulates the need to coordinate in house counsel and other proceedings handled by the petitioner. The proceedings outside of the instant proceeding do not bear on the showing of "sufficient cause" with respect to the instant proceeding. Further it is unknown what is meant by coordination of in-house and outside counsel.

MPEP § 2265 requires (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. Further, the petition lacks a statement that must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

It is not clear why in spite of action taken thus far additional time is needed. There is also no specific outline of the factual accounting and why again in spite of this action additional time is needed. On balance, there is <u>not</u> "sufficient cause" for granting the extension of time based upon the reasons given in the petition for extension of time.

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

The unavailability of the Office action supports "sufficient cause" for an extension of one (1) week extension of time.

CONCLUSION

1. The patent owner's petition for extension for one (1) month time in which to file a response to the non-final Office action dated 23 August 2010 is hereby granted-in-part.

2. The period is extended by one (1) week.

3. The response is due 30 September 2010.

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

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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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
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.

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
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

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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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

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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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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 Requ[illegible])

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,418	02/25/2009	6865852	087558.00017	9562

27683 7590 09/20/2010

HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue
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Dallas, TX 75219

EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,418	02/25/2009	6865852	087558.00017	9562

27683 7590 09/20/2010

EXAMINER

J. Rodman Steele
Novak Druce & Quigg LLP
525 Okeechobee Blvd, Suite 1500
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ART UNIT	PAPER NUMBER

DATE MAILED: 09/20/2010

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90/009,418	02/25/2009	6865852	087558.00017	9562

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EXAMINER

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ART UNIT	PAPER NUMBER

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27683
Haynes and Boone, LLP
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Dallas ,TX 75219

(Patent Owner)

MAILED

SEP 20 2010

CENTRAL REEXAMINATION UNIT

J. Rodman Steele
Novak Druce & Quigg LLP, Suite 1500
West Palm Beach, Fl 33401

(Courtesy copy)

Malloy & Malloy, P.A.
2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129

(Requester)

Inventor: Gower	: **DECISION ON**
Reexamination Proceeding	: **§ 1.182 PETITIONS**
90/009,418	:
Filed: February 25, 2009	:
For: U. S. Patent No. 6,865,852	:
Issued: March 15, 2005	:
Title: Flexible Wind Abatement System	:

This is a decision on (1) a third party requester December 23, 2009 § 1.182 petition, seeking to disqualify a practitioner representing patent owner, and (2) a patent owner February 1, 2010 opposition to the third party requester petition supported by a patent owner § 1.182 petition. The petitions and opposition are now before the Office of Patent Legal Administration for decision.

The requester § 1.182 petition, and the patent owner opposition supported by a § 1.182 petition are dismissed and will be closed along with the instant decision.

Fees

A review of Office records reveals payment of the $400 § 1.182 requester petition fee pursuant to § 1.17(f).

The patent owner's § 1.182 petition does not authorize payment of the $400 fee required by § 1.17(f) and is additionally dismissed for lack of fee payment.[1]

[1] Inexplicably, a review of PALM Office records reveals a petition fee of $200 charged by the Office to deposit account 14-1437.

Brief Review of Facts

1. U.S. Patent No. 6,865,852 issued on March 15, 2005.

2. On February 25, 2009 a request for *ex parte* reexamination was filed with the transmittal form identifying:
   a. copending litigation styled *Armor Screen Corp. v. Storm Catcher, Inc. et al,* U.S. District Court, S.D. of Florida, Case No. 07-Civ-81091, and
   b. the party served as patent owner's representative Squire, Sanders, & Dempsey, L.L.P. The request was assigned Control No. 90/009,418 (the '9,418 reexamination proceedings).

3. On April 8, 2009 an Order Granting Request for Ex Parte Reexamination was mailed.

4. On May 21, 2009 a first Office action on the merits was mailed.

5. On July 12, 2009 a response to the Office action on behalf of the patent owner was submitted by Brad Chin of Squire, Sanders & Dempsey LLP.

6. On October 20, 2009 the practitioners of record associated with Customer No. 32294 requested withdrawal, which request was signed by Brad Chin. The request was granted on November 3, 2009.

7. On November 6, 2009 the Office issued a final Office action.

8. On November 30, 2009 a power of attorney was granted by the assignee to practitioners associated with Customer No. 86002, who are associated with the firm of Novak Druce & Quigg LLP, which power was acknowledged by the Office on December 2, 2009.

9. On December 23, 2009 third party requester filed the instant § 1.182 petition to disqualify the firm of Novak Druce & Quigg, LLP from representing the patent owner in the instant reexamination proceeding.

10. On January 5, 2009 an interview was had with the examiner that included representatives of the patent owner: Zylka, Steele, and Marquis.[2]

11. On February 1, 2010 patent owner submitted a § 1.182 petition and an opposition to requester's December 23, 2009 § 1.182 petition to disqualify patent owner's counsel.

12. On February 12, 2010 patent owner submitted a response to the November 6, 2009 final Office action. The response was submitted by Marquis of the Novak Druce & Quigg LLP firm.

13. On July 14, 2010 the assignee revoked power of attorney from the practitioners associated with Customer No. 86002 (practitioners associated with Novak Druce & Quigg LLP) in favor of practitioners associated with Customer No. 08933 (practitioners associated with Duane Morris LLP), which was recognized by the Office on July 16, 2010.

---

[2] Examiner interview summary of January 6, 2010.

14. On July 26, 2010 the assignee revoked power of attorney from the practitioners associated with Customer No. 08933 (practitioners associated with Duane Morris LLP) in favor of practitioners associated with Customer No. 27683 (practitioners associated with Haynes & Boone, LLP), recognized by the Office on July 28, 2010.

Requester Petition to Disqualify (former) Practitioner for Patent Owner

The requester's December 23, 2009 § 1.182 petition states that it seeks to disqualify the firm of Novak Druce & Quigg LLP from representing patent owner in the instant reexamination proceeding and was filed during the time that practitioners associated with Novak Druce & Quigg LLP were representing patent owner.

Preliminarily, the firm of Novak Druce & Quigg LLP no longer represents patent owner in this reexamination proceeding as of July 16, 2010, however, an employee of the firm has submitted on February 12, 2010 a response to a November 6, 2009 final Office action. As the petition to disqualify was submitted prior to the patent owner response, which petition has not been supplemented, it is not clear whether petitioner believes that the patent owner response contains or was based in any part upon confidential information that petitioner seeks to prevent use of by submission of the petition to disqualify.

The petition to disqualify has its basis on the fact that a current member of the Novak Druce & Quigg LLP firm that represented patent owner employees an attorney, Schneider, whom the requester had at least one discussion with regarding becoming an expert witness for requester in the concurrent litigation involving the patent being reexamined. At the time of the discussion, Schneider was employed by another firm but now works for Novak Druce & Quigg LLP. It is alleged that the discussion included facts of the case, defenses and litigation strategy,[3] and Schneider was provided confidential information.[4] Requester seeks relief from patent owner choosing the one law firm now employing an individual allegedly having confidential information given to him by requester so as to at least avoid the appearance of impropriety regarding the transformation of a potential expert in support of requester's position in litigation of the patent to a plaintiff's counsel for patent owner defending against requester in the reexamination proceedings.

Patent Owner Petition and Opposition to Disqualification of its Counsel

Patent owner initially takes that position that the requester's petition is improper as it is precluded under the provisions of 35 U.S.C. 304 and 37 CFR § 1.550(g). The instant reexamination is well past the stage at which third party requester is entitled to file a paper in an *ex parte* reexamination. Patent owner's position[5] is that after the request for reexamination is filed, the intent of the legislation is that the requester may only respond to a patent owner's statement in response to the request for reexamination and may not submit any papers once reexamination is ordered and the patentability determination stage has been entered,[6] as is the instant situation.

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[3] Requester petition at page 2.
[4] *Id.* at page 3.
[5] Stated to be reflected in the Manuel of Patent Examining Procedure (MPEP), MPEP 2254.
[6] Opposition at page 8.

A substantive response to the position taken by requester is set forth in the belief that should requester's petition for disqualification be entertained, so would an opposition thereto be entertained.

The position presented by patent owner is that:

1. the discussion had with Schneider was regarding the litigation in general and areas where expert testimony may be needed[7] and no client confidences were disclosed during the discussion,[8]

2. an attorney- client relationship and its consequent requirements for confidentiality are not established when the attorney serves only as an expert witness as was the expectation upon which the discussion with Schneider was based,[9] and

3. Schneider has been screened from any participation in matters involving the instant reexamination.[10]

Standard for Disqualification of Opposing Counsel.

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[11] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[12]

The Office has utilized the following standard in regard to representations of patent matters[13]:

> An attorney should be disqualified if a party can show that the:
> (1) attorney was its former attorney,
> (2) attorney now represents an adverse party, and
> (3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The assumption will be made where the standard is met that confidences were disclosed an inquiry will not be made into their nature and extent.[14] The Office has chosen a narrow

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[7] *Id.* at page 2, para 6.
[8] *Id.* at page 11.
[9] *Id.* at pages 9+.
[10] *Id.* at page 12.
[11] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." 37 CFR 11.19(c) states "[p]etitions to disqualify a practitioner in ex parte or inter partes matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate. The MPEP does not generally address Part 11, and in particular §11.19(c).
[12] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.
[13] SCM v. Aktieselskabet Niro Atomizer.
[14] *Anderson v Eppstein*

interpretation of the expression "substantially related" to mean 'identical or essentially the same."[15]

Decision

I. The requester petition seeking removal of counsel for patent owner is defective on three grounds:

A. The petition has not been properly signed. The signature block is as follows:

Respectfully submitted,

MALLOY & MALLOY, P.A.
2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129
(305) 858-8000

By: /s/Benjamin M. Hanrahan
Benjamin M. Hanrahan
Reg. No. 60,850
Date: December 23, 2009

37 CFR 1.4(d)(2)(i) requires insertion of the signature between the slash marks. Only an "s" has been inserted between the slash marks, which is obviously not the signature in view of the presence of "Benjamin M. Hanrahan," which should have been the part inserted between the slash marks.

B. The petition is an improper paper. While the Office does not believe that all requester papers would be bared after entry into the patentability determination stage of an *ex parte* reexamination, such as papers that do not attempt to participate in the reexamination,[16] the instant third party petition represents a clear attempt to participate in the reexamination by having the reexamination address the issue of attorney conflict.

C. Inappropriate forum: A review of the § 1.182 petition to disqualify a practitioner reveals that the intent of the petition is to raise the issue of attorney conflict in the context of the instant reexamination proceeding.[17] The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts. Therefore, the instant reexamination proceeding is not the forum for resolving this issue. Instead, the appropriate vehicle for addressing this issue is a request to the Director of the U.S. Patent & Trademark Office that the practitioner be disqualified.

II. The patent owner petition and opposition will not be treated in view of:

A. the dismissal of the requester petition,

---

[15] *Id.*

[16] Such as where a petition is filed to seal protected materials and does not amount to participation.

[17] *E.g.*, the heading of the petition is directed to the reexamination file as would any paper intended to be submitted in the reexamination file. Moreover, there is no explicit request that the Director of the Office address this matter.

B. the lack of any allegation by requester that patent owner papers of record already filed by a practitioner associated with the firm of Novak Druce & Quigg LLP, the February 12, 2010 response, would be prejudicial to requester, and the revocation of power of attorney by the patent owner to the firm complained of by requester, and

C. the failure to pay the petition fee.

Conclusion

1. The requester petition, seeking removal of counsel for patent owner, will not be treated.

2. The patent owner petition and opposition to requester petition will not be treated.

3. The following papers will be closed:

   A. December 23, 2009 § 1.182 petition by requester,

   B. February 1, 2010 § 1.182 petition and opposition to requester petition, and

   C. The instant decision.

4. Jurisdiction is returned to the Central Reexamination Unit to address the response of August 11, 2010.

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
(571) 272-7710

Appendix – Relevant Statutes, Rules, and MPEP Section

35 U.S.C. 304 Reexamination Order by Director.

If, in a determination made under the provisions of sub**section 303(a)** of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of **section 302** of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

§ 1.4 Nature of correspondence and signature requirements.

(d)(1) *Handwritten signature*. Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (e) and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original handwritten signature personally signed, in permanent dark ink or its equivalent, by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ **1.6**(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

(2) *S-signature*. An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by § **1.4**(d)(1). An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature not covered by a handwritten signature of § **1.4**(d)(1). Correspondence being filed in the Office in paper, by facsimile transmission as provided in § **1.6**(d), or via the Office electronic filing system as an attachment as provided in § **1.6**(a)(4), for a patent application, patent, or a reexamination proceeding may be S-signature signed instead of being personally signed (*i.e.*, with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

(i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation,

and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (*e.g.*, /Dr. James T. Jones, Jr./); and

(ii) A patent practitioner (§ **1.32**(a)(1)), signing pursuant to §§ **1.33**(b)(1) or **1.33**(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#) character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

§ 1.535 Reply by third party requester in *ex parte* reexamination.

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.

§ 1.550 Conduct of *ex parte* reexamination proceedings.

***

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § **1.535**, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, 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**.

2254 Conduct of *Ex Parte* Reexamination Proceedings

***

Once ex parte reexamination is ordered pursuant to 35 U.S.C. **304** and the times for submitting any responses to the order have expired, no further active participation by a third party reexamination requester is allowed, and no third party submissions

will be acknowledged or considered unless they are in accordance with **37 CFR 1.510**. The reexamination proceedings will be *ex parte*, even if ordered based on a request filed by a third party, because this was the intention of the legislation. *Ex parte* proceedings preclude the introduction of arguments and issues by the third party requester which are not within the intent of **35 U.S.C. 305** ("reexamination will be conducted according to the procedures established for initial examination under the provisions of sections **132** and **133** of this title").

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90/009,428	04/07/2009	6601104	2855.003REX0	5648

26111 7590 08/26/2010

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WASHINGTON, DC 20005

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CENTRAL REEXAMINATION UNIT

Robert Sterne Greene
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(For Patent Owner)

Michael A. Messina
MCDERMOTT WILL & EMORY LLP
600 13th Street N.W.
Washington, DC 20005-3096

(For Third-Party Requester)

In re James J Fallon
Reexamination Proceeding
Control No. 90 / 009,428
Request Deposited: April 7, 2009
For: U.S. Patent No. 6,601,104

DECISION ON
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.550(c)]

This is a decision on patent owner's petition for extension of time under 37 CFR 1.550(c) filed on August 17, 2010. 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

1. Reexamination of U.S. Patent No 6,601,104 was ordered in the Determination mailed June 1, 2009.

2. A final office action on the merits issued February 5, 2010 setting a one month period for response.

3. A petition for extension of time for one month to respond to the final rejection was granted on March 11, 2010.

4. On July 2, 2010 patent owner filed a notice of appeal.

5. On August 12, 2010 a power of attorney appointing new representation of patent owner was received.

6. On August 17, 2010 the instant petition for extension of time was received.

DECISION

The Patent Owner requests an extension of time of an additional one month in order to prepare an appeal brief. The request for extension is the **second** request for an extension of time during the proceeding after final rejection. The present petition for extension of time was timely filed on August 17, 2010 together with the requisite fee.

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 ....
>
> **Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...**
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The request states the owner retained new counsel on August 12, 2010. The request further states "Until the undersigned completes the review of the material produced in the litigation, the full scope of what needs to be accomplished in that regard is unknown. Despite these diligent actions, additional time is required for new reexam counsel to fully and completely understand the record below and the issues on appeal as required by 37 CFR 11.18". Accordingly, an additional month is being requested.

Analysis and Findings

On balance it is considered that the petition fails to explain the "sufficient cause" and the "extraordinary circumstances " warranting grant of a second extension of time. Second and subsequent requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time. 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 it is noted owner has been under final rejection a little less than seven months following prosecution which was conducted between order and final rejection in eight months. The petition speaks to the efforts of newly retained council in preparing a response yet it is Patent owner who must exercise diligence in responding to an outstanding office action. In as much as patent owner does have a right to retain new council at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council late in the proceeding, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause nor further to the level of extraordinary circumstances to warrant additional time. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council.

Accordingly no basis for relief is seen.

CONCLUSION

1. Petitioner's request is **dismissed.** The period during which Patent Owner may file a response to the rejection remains running and Patent Owner's appeal brief is due September 2, 2010.

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, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

/J. Harrison/

Jessica Harrison, SPE AU 3992
Central Reexamination Unit

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCDERMOTT WILL & EMERY LLP
600 13th STREET NW
WASHINGTON, DC 20005-3096

Date: MAILED

SEP 02 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009428
PATENT NO. : 6601104
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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Robert Sterne Greene STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 New York Avenue NW Washington DC 20005-3094	: (For Patent Owner)
Michael A. Messina MCDERMOTT WILL & EMORY LLP 600 13th Street N.W. Washington, DC 20005-3096	: (For Third-Party Requester)
In re James J Fallon Reexamination Proceeding Control No. 90 / 009,428 Request Deposited: April 7, 2009 For: U.S. Patent No. 6,601,104	: DECISION ON : PETITION FOR : EXTENSION OF TIME : [37 CFR 1.550(c)]

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SEP 02 2010

CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's second petition for extension of time under 37 CFR 1.550(c) filed on September 1, 2010. The petition is before the Director of the Central Reexamination Unit for consideration. The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 6,601,104 was ordered in the Determination mailed June 1, 2009.

2. A final office action on the merits issued February 5, 2010 setting a one month period for response.

3. A petition for extension of time for one month to respond to the final rejection was granted on March 11, 2010.

4. On July 2, 2010 patent owner filed a notice of appeal.

5. On August 12, 2010 a power of attorney appointing new representation of patent owner was received.

6. On August 17, 2010 a petition for extension of time was received. The petition was dismissed on August 26, 2010.

7. On September 1, 2010 a second request for extension of time was received.

DECISION

The Patent Owner continues in his request for an extension of time of an additional one month in order to prepare an appeal brief. The request for extension is the **third** request for an extension of time during the proceeding after final rejection with the first request granted and the second request dismissed. The present petition for extension of time was timely filed on September 1, 2010 together with the requisite fee.

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 ....
>
> **Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations...**
>
> The reasons stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

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

The renewed request states the patent owner began diligently working on preparing its Appeal Brief upon receipt of the Advisory Action which was mailed on May 24, 2010. The request further states that "on or about the time of the Advisory Action, business conflicts arose between the patent owner, Realtime Data, and its prior prosecuting attorneys" and that patent owner immediately began working on arrangements for disengagement. The requests alleges that the disengagement was complex yet provides no factual accounting of owners diligence in these matters to account for the elapse in time of May to August. Nor does the request provide reasoning or support as to why a business disengagement would rise to the level of "extraordinary circumstances".

Analysis and Findings

On balance it is considered that the petition fails to explain the "sufficient cause" and the "extraordinary circumstances " warranting grant of a second extension of time. Second and subsequent requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time. 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 it is noted owner has been under final rejection a little less than seven months following prosecution which was conducted between order and final rejection in eight months. The petition speaks to the need for patent owner to retain new counsel due to a "business conflict" but fails to convey why it took three months to retain new counsel when patent owner was aware a response was due. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new counsel late in the proceeding due to a business conflict, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause nor further to the level of extraordinary circumstances to warrant additional time. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new counsel.

Accordingly no basis for relief is seen.

CONCLUSION

1. Petitioner's request is **dismissed.** The period during which Patent Owner may file a response to the rejection remains running and Patent Owner's appeal brief is due September 2, 2010.

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, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

/J. Harrison/

Jessica Harrison, SPE AU 3992
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100924

DATE : September 24, 2010

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,247,090 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20101121

DATE : November 21, 2010

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,247,090 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 in the COCIN dated 11-18-2010 are approved

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 25 2011

CENTRAL REEXAMINATION UNIT

PITNEY BOWES INC. INTELLECTUAL PROPERTY & TECH. LAW DEPT. 35 WATERVIEW DRIVE MSC 26-22 SHELTON CT 06484	:	(For Patent Owner)
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314	:	(For Third Party Requester)
In re: Silverberg. *Ex Parte* Reexamination Control Nos. 90/009,442 Filed: 31 March 2009 For: U.S. Patent 5,091,790	:	**DECISION DISMISSING PETITION**

This is a decision on the patent owner petition, filed 03 November 2009, denominated "Petition/Declaration for Revival of Reexamination Based Upon Failure to Receive Office Action" requesting revival of the proceeding following termination and mailing of the Notice of Intent to Issue Reexamination Certificate filed pursuant to 37 CFR 1.13(b) and MPEP §§ 711.03(c) & 2269 .

The petition and declaration are before the Central Reexamination Unit.

The request for revival is **dismissed**, because the Office lacks jurisdiction over U.S. Patent 5,091,790, since reexamination proceeding Control No. 90/009,442 have now been concluded by the issuance and publication of a reexamination certificate.

REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,091,790 (hereinafter the '790 patent) issued on 25 February 1992 to Morton Silverberg.
2. On 31 March 2009, a request for *ex parte* reexamination was filed by a third party and was assigned control No. 90/009,442 (hereinafter the '9,442 proceeding).
3. On 20 May 2009, reexamination was ordered in the '9,442 proceeding of the '790 patent.
4. On 02 October 2009 a Notice of Intent to Issue Reexamination Certificate was mailed due to no response from the patent owner to the previously mailed Office action in the '9,442 proceeding.
5. On 03 November 2009 a petition and declaration were submitted under 37 CFR 1.13(b) to the '9,442 proceeding.
6. On 05 January 2010 the Certificate was mailed in the '9,442 proceeding of the '790 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.

37 CFR §§ 1.13 (b) Copies and certified copies.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his or her name, upon payment of the fee for the certified copy.

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 05 January 2010. The petition and declaration were filed under 37 CFR § 1.13 (b) which is directed to copies and certified copies. The citation of 37 CFR § 1.13(b) bears no relevance to the outcome sought by petition. The petition should have properly been filed under 37 CFR § 1.137 for revival of the proceeding. Further MPEP § 711.03 (c) is cited which is directed to applications. The patent owner is reminded that reexamination is a proceeding and not an application for patent. MPEP § 711.03(c) is not germane to the proceeding. Lastly MPEP § 2269 is directed to reconsideration of an Office action following patent owner response. Were the petition properly filed it might have been considered but in any event, the certificate has since issued and 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 Petition/Declaration for Revival of Reexamination Based Upon Failure to Receive Office Action is **dismissed** for lack of jurisdiction.

2. The reexamination proceedings have concluded, and the *Ex Parte* Reexamination Certificate for U.S. 5,091,790 has issued on 05 January 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/24 May 2010

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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Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

MAILED

AUG 24 2010

CENTRAL REEXAMINATION UNIT

Thomas H. Martin
Martin & Ferraro LLP
1557 Lake O'Pines St., NE
Hartville, OH 44632

3d Party Requester
(90/009,542)

Joseph A. Hynds
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W., Suite 800
Washington, DC 20005

3rd Party Requester
(90/010,655)

Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

DECISION ON PETITION
UNDER 37 CFR 1.59

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

This is a decision on the petition under 37 CFR 1.59(b), filed August 5, 2010, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The petition is **GRANTED**.

Petitioner requests that the following documents that are subject to a protective order be expunged from the record: "Amended Judgment Awarding Enhanced Damages, Prejudgment Interest and Attorney Fees", "Amended Order Denying Defendants' Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 103", Judgment Awarding Enhanced Damages, Post December 31, 2007 Damages, Pre- and Post-Judgment Interest, and Injunctive Relief", "Order Amending and Altering the Judgment Entered on August 26, 2009 to Alter the Amount of Damages and Interest Awarded and to Amend the Judgment to Provide for an Award of Attorney Fees", "Order Denying Defendants' Motion for Summary Judgment of Invalidity under 35 U.S.C. § 103", "Order Denying

Defendants' Motion for Summary Judgment of No Willful Infringement", Order Denying Defendants' Motion for Summary Judgment of Non-Infringement on O-MAV; Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment of Infringement of Claims 1 and 2 of U.S. Patent No. 6,939,071", "Order Denying Defendants' Motion for Summary Judgment of Non-Infringement, or in the Alternative for Invalidity; Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment Dismissing Medtronic's 35 U.S.C. §112 Defenses", "Order Denying Plaintiff Spine Solutions, Inc's Motion for Summary Judgment Regarding the Obviousness Defense", "Order Granting in Part and Denying in Part Plaintiffs' Motion for Treble Damages, Award of Attorney Fees, Expert Witness Fees, Expenses, Post December 31, 2007 Damages, and Pre- and Post-Judgment Interest", "Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment (1) that the Asserted Claims of the '071 Patent Are Not Anticipated; and (2) that the (a) '785 patent [No. 6,402,785], (b) Dr. Zdeblick and Mr. McKay's Alleged Invention, and (c) Numerous Unexplained References Are Not Prior Art", "Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment of Failure Of Defendants to State a Legal Defense or Claim for Relief Based on Inequitable Conduct", and "Order Granting Plaintiffs' Motion for Permanent Injunction". The petition indicates that these documents were filed 'under seal" in Spine Solutions, Inc v. Medtronic Sofamor Danek, Inc et al, 2:07cv2175, United States District Court for the Western District of Tennessee, and as such are under terms of a protective order in that action.

The petition fee set forth in 37 CFR 1/17(g) has been paid.

The information in question has been determined by the examiner to not be material to the examination of the instant reexamination proceeding.

Petitioner is required to retain the expunged material(s) for the life of the patent on which the instant reexamination proceeding is based on.

The expunged material has been removed from the file and is being returned herewith.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

Enclosure (to patent owner): envelop containing above-identified documents

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.
90/009,463	05/13/2009	5379057	128480.0101	9445

27557 7590 05/13/2011

BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2011

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
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

Date:
MAILED
MAY 13 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009463
PATENT NO. : 5379057
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
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P.O. Box 1450
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BRIAN W. HIGGINS
BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

: (For Patent Owner)

MAILED

MAY 13 2011

CENTRAL REEXAMINATION UNIT

DAVID L. FEHRMAN
MORRISON & FOERSTER LLP
555 WEST FITH STREET, SUITE 3500
LOS ANGELES, CALIFORNIA 90013

: (For Third-Party Requester)

In re CLOUGH *et alia*
Reexamination Proceeding
Control No. 90 / 009,463
Request Deposited: November 19, 2010
For: U.S. Patent No. 5,379,057

: DECISION DISMISSING PETITION UNDER 37 CFR 1.127 1.181, 1.182, and 1.183

This is a decision on patent owner's petition under 37 CFR 1.127, 37 CFR 1.181, 37 CFR 1.182, and 37 CFR 1.183. The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. Patent owner's single petition requests the following relief:

A. Withdraw of the Examiner's Final Rejection of July 26, 2010
B. Entry of the Supplemental Amendment filed April 15, 2010
C. Admission and consideration of the Wolfe Declaration
D. Extension of time under 37 CFR 1.550

For the reasons set forth below, the patent owner's petition is **DISMISSED**.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,379,057 was ordered in the Determination mailed July 24, 2009.

2. Prosecution of the reexamination proceeding was closed with the issuance of a final Office action on July 26, 2010.

3. An amendment and response was filed by owner after final Office action on September 14, 2010. The response included new claims and amended Wolfe Declaration.

4. On November 10, 2010, the Office issued an Advisory Action indicating the new claims would not be entered as they did not materially reduce or simplify the issues for appeal and had potential 112 issues. The Advisory Action denied entry the Wolfe declaration.

5. On November 19, 2010 the instant petition under 37 CFR 1.127, 37 CFR 1.181, 37 CFR 1.182, and 37 CFR 1.183 was timely filed.

6. On December 22, 2010 a Notice of Appeal was timely filed.

7. On February 22, 2011 Appellant timely filed its opening Appeal Brief.

Applicable Statute or Regulation

37 CFR 1.4 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 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)
(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) 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 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title...

DECISION

As an initial matter, Patent owner is cautioned that the instant petition improperly combines multiple, distinct matters considered by different branches of the USPTO in a single paper and is therefor improper under 37 CFR 1.4(c). Accordingly, the merits of the petition are being treated under 37 CFR 1.181.

(A) Regarding the merits of the request for withdrawal of the examiner's Final Rejection, Patent owner opines that the action was premature based on comments made by the examiner concerning the term "run-time utility" and the term "syntax library" in the First, Final, and Advisory actions. Patent owner characterizes the points raised by the examiner's comments, in the response to arguments section of the Final rejection, as new positions taken by the office. The section referenced in the petition is a rebuttal of Patent owner's arguments as to the claim

rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. In fact, the actual grounds for rejection under 35 USC 102/103 appears to be identical in the First and Final Office Actions. (See e.g. FOAM 12/7/09 pages 3-12, Final 7/26/10 pages 9-18 addressing claim 14) The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim terms "run-time utility" and "syntax library" in the non-final rejection. The examiner is simply rebutting Patent owner's argument that the references do not disclose a "run-time utility" and "syntax library" in light of the teachings of the specification, and Patent owner's purported claim construction and underlying reasoning as he/she is required to do. It is axiomatic that an examiner must reply to all arguments advanced by Patent owner in response to a rejection. See 37 CFR 1.104 and 1.112; see also MPEP 707 *et seq*, and in particular MPEP 707.07(f). Therefore, the examiner's Final Rejection was not issued prematurely. Accordingly, Patent owner's petition with regard to withdrawal of the examiner's Final Rejection is **dismissed**.

(B) As to the merits of the request drawn to the entry of the Supplemental Amendment filed April 15, 2010, Patent owner's first reasoning is based on the opinion that entry of the amendment would not create an additional search burden on the examiner, that there was plenty of time for the office to consider the amendment, and that the amendment would not adversely affect Office resources. Respectfully, consideration of additional search burden is not a standard required by 37 CFR 1.116 and these remarks fail to persuade. Patent owner also believes that, because the Final Rejection was allegedly premature, an additional office action is warranted and therefor consideration of new claims 21-31 would not delay the instant proceeding.

As to the second issue, it is noted Patent owner's petition to withdrawal of the examiner's Final Rejection is **dismissed** for the reasons explained above. Hence, Patent owner's point is moot. With regard to the first issue (entry of the amendment after final action), a review of the record shows that the examiner determined that the amendment did not cancel any claims or comply with a requirement in the Final Office action, did not simply the issues on appeal, and did not provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. (See: 37 CFR 1.116(b) parts 1-3) Thus the examiner's decision not to enter the amendment appears proper.
For the above reasons the requested relief can not be granted and the petition is **dismissed**.

(C) As to the merits of the request drawn to the admission of the Wolfe Declaration, the petition is **dismissed as moot** in light of the examiners entry of the Wolfe Declaration in the Advisory Action of May 2, 2011.

(D) As to the merits of the request drawn to the extension of time under 37 CFR 1.550 the petition is **dismissed as moot** in light of Appellant's Appeal Brief filed February 22, 2011.

CONCLUSION

Petitioner's request is **dismissed** for the reasons explained above.

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

By hand: Customer Service Window
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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.

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.

Bruce Kisliuk
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,464	05/13/2009	5675362	128480.0102	3176

27557 7590 05/13/2011

BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/13/2011

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Date:
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MAY 13 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009464
PATENT NO. : 5379057
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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BRIAN W. HIGGINS
BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

: (For Patent Owner)

MAILED

MAY 13 2011

CENTRAL REEXAMINATION UNIT

DAVID L. FEHRMAN
MORRISON & FOERSTER LLP
555 WEST FITH STREET, SUITE 3500
LOS ANGELES, CALIFORNIA 90013

: (For Third-Party Requester)

In re CLOUGH *et alia*
Reexamination Proceeding
Control No. 90 / 009,464
Request Deposited: November 19, 2010
For: U.S. Patent No. 5,675,362

: DECISION DISMISSING
: PETITION UNDER 37
: CFR 1.127 1.181, 1.182,
: and 1.183

This is a decision on patent owner's petition under 37 CFR 1.127, 37 CFR 1.181, 37 CFR 1.182, and 37 CFR 1.183. The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination unit. Patent owner's single petition requests the following relief:

A. Withdraw of the Examiner's Final Rejection of July 19, 2010
B. Entry of the Supplemental Amendment filed April 15, 2010
C. Admission and consideration of the Wolfe Declaration
D. Extension of time under 37 CFR 1.550

For the reasons set forth below, the patent owner's petition is **DISMISSED**.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No 5,675,362 was ordered in the Determination mailed July 24, 2009.

2. Prosecution of the reexamination proceeding was closed with the issuance of a final Office action on July 19, 2010.

3. An amendment and response was filed by owner after final Office action on September 8, 2010. The response included new claims and amended Wolfe Declaration.

4. On November 10, 2010, the Office issued an Advisory Action indicating the new claims would not be entered as they did not materially reduce or simplify the issues for appeal and had potential 112 issues. The Advisory Action denied entry the Wolfe declaration.

5. On November 19, 2010 the instant petition under 37 CFR 1.127, 37 CFR 1.181, 37 CFR 1.182, and 37 CFR 1.183 was timely filed.

6. On December 17, 2010 a Notice of Appeal was timely filed.

7. On February 17, 2011 Appellant timely filed its opening Appeal Brief.

Applicable Statute or Regulation

37 CFR 1.4 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 1.116 states in pertinent part:

§ 1.116 Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)
(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.
(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) 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 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title...

DECISION

As an initial matter, Patent owner is cautioned that the instant petition improperly combines multiple, distinct matters considered by different branches of the USPTO in a single paper and is therefor improper under 37 CFR 1.4(c). Accordingly, the merits of the petition are being treated under 37 CFR 1.181.

(A) Regarding the merits of the request for withdrawal of the examiner's Final Rejection, Patent owner opines that the action was premature based on comments made by the examiner concerning the term "run-time executor" and the term "syntax library" in the First, Final, and Advisory actions. Patent owner characterizes the points raised by the examiner's comments, in the response to arguments section of the Final rejection, as new positions taken by the office. The section referenced in the petition is a rebuttal of Patent owner's arguments as to the claim

rejections. The key point is that the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. In fact, the actual grounds for rejection under 35 USC 102/103 appears to be identical in the First and Final Office Actions. (See e.g. FOAM 12/1/09 pages 3-12, Final 7/19/10 pages 10-19 addressing claim 12) The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim terms "run-time executor" and "syntax library" in the non-final rejection. The examiner is simply rebutting Patent owner's argument that the references do not disclose a "run-time executor" and "syntax library" in light of the teachings of the specification, and Patent owner's purported claim construction and underlying reasoning as he/she is required to do. It is axiomatic that an examiner must reply to all arguments advanced by Patent owner in response to a rejection. See 37 CFR 1.104 and 1.112; see also MPEP 707 *et seq*, and in particular MPEP 707.07(f). Therefore, the examiner's Final Rejection was not issued prematurely. Accordingly, Patent owner's petition with regard to withdrawal of the examiner's Final Rejection is **dismissed**.

(B) As to the merits of the request drawn to the entry of the Supplemental Amendment filed September 8, 2010, Patent owner's first reasoning is based on the opinion that entry of the amendment would not create an additional search burden on the examiner, that there was plenty of time for the office to consider the amendment, and that the amendment would not adversely affect Office resources. Respectfully, consideration of additional search burden is not a standard required by 37 CFR 1.116 and these remarks fail to persuade. Patent owner also believes that, because the Final Rejection was allegedly premature, an additional office action is warranted and therefor consideration of new claims 18-28 would not delay the instant proceeding.

As to the second issue, it is noted Patent owner's petition to withdrawal of the examiner's Final Rejection is **dismissed** for the reasons explained above. Hence, Patent owner's point is moot. With regard to the first issue (entry of the amendment after final action), a review of the record shows that the examiner determined that the amendment did not cancel any claims or comply with a requirement in the Final Office action, did not simply the issues on appeal, and did not provide a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. (See: 37 CFR 1.116(b) parts 1-3) Thus the examiner's decision not to enter the amendment appears proper.
For the above reasons the requested relief can not be granted and the petition is **dismissed**.

(C) As to the merits of the request drawn to the admission of the Wolfe Declaration, the petition is **dismissed as moot** in light of the examiners entry of the Wolfe Declaration in the Advisory Action of May 2, 2011.

(D) As to the merits of the request drawn to the extension of time under 37 CFR 1.550 the petition is **dismissed as moot** in light of Appellant's Appeal Brief filed February 17, 2011.

CONCLUSION

Petitioner's request is **dismissed** for the reasons explained above.

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.

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.

Bruce Kisliuk
Assistant Deputy Commissioner for Patent Operations and
Acting 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.
90/009,472	09/03/2009	6,284,478	518852802600	8936

EXAMINER

ART UNIT	PAPER NUMBER

90259 7590 05/09/2011
Hughes Hubbard and Reed LLP
One Battery Park Plaza
New York, NY 10004

DATE MAILED: 05/09/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:
MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009472
PATENT NO. : 6284478
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:90/009,472

1. THIS IS A DECISION ON THE PETITION FILED May 5, 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 mailed on April 1, 2011, which sets a two-month period for filing a response thereto, be extended by one 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 _____, 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 **Response is due on June 7, 2011**

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535, in the Central Reexamination Unit.

   Deborah Jones 5/6/2011
   [Signature]

   DEBORAH D. JONES
   CRU SPE-AU 3991
   (Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,477	06/03/2009	6968513	3084-003	6490

7590 01/20/2012

ORUM & ROTH LLC
53 W JACKSON BLVD
SUITE 620
CHICAGO, IL 60604

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/20/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12th FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

Date: [illegible]

[illegible]

CENTRAL [illegible]

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009477
PATENT NO. : 6968513
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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Keith H. Orum ORUM & ROTH LLC 53 West Jackson Blvd. Suite 620 Chicago, IL. 60604	: : : : :	(For Patent Owner)
Stuart A. Schanbacher WOODCOCK WASHBURN LLP Circa Center 12th Floor 2929 Arch Street Philadelphia, PA 19014	: : : : :	(For Third Party Requester)
In re: Rienbold et al. *Ex Parte* Reexamination Proceeding Control No.: 90/009,477 For: U.S. Patent No.: 6,968,513	: : : :	DECISION ON PETITION

JAN 20 2012
CENTRAL REEXAMINATION UNIT

This is a decision on a petition filed by the Patent Owner: a petition filed on January 24, 2011, entitled "PETITION TO SEND FINAL OFFICE ACTION".

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

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,968,513 issued on November 22, 2005.
- A request for *ex parte* reexamination was June 3, 2009 and assigned control no. 90/009,477.
- *Ex partes* reexamination was ordered on August 31, 2009.
- Patent Owner filed a "Change of Address", which was acknowledged by the office, on December 16, 2009.

- A Non-Final Office Action was mailed on March 2, 2010.
- Patent Owner's Response to the Non-Final Office Action was received by the Office and serviced to the Third Party Requestor on May 3, 2010.
- A Final Office Action was mailed on September 13, 2010.
- Patent Owner filed a petition (instant petition) to resend final Office Action on January 24, 2011.
- Patent Owner filed a "Change of Address", which was acknowledged by the office, on January 25, 2011.

DECISION

This is a decision on patent owner's petition, dated January 24, 2011, and titled "Petition To Send Final Office Action" based on non-receipt of the Final Office Action dated September 13, 2010. The petition requests that the Office action mailed September 13, 2010 be re-mailed and further reset the time for response to the Final Office Action based on patent owner's failure to receive the Office action. There is no fee associated with this petition.

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

Under the reasoning promulgated in *Delgar v. Schuyler*, 172 USPQ 513 and as explained in section 711.03(c)(I)(A) of the MPEP, an allegation that an Office action that was properly addressed to the correspondence of record was never received may be considered in a petition to re-mail that Office action. If adequately supported, the Office may grant such a petition and re-mail the Office action.

To establish non-receipt of an Office communication, the petition must include: (1) a statement from patent owner describing the system used for recording an Office action received at the correspondence of record, and the statement should establish that the docketing system used is sufficiently reliable; (2) a statement from patent owner stating that the Office action was not received at the correspondence address of record, and indicate that a search of patent owner's record indicates that the Office action was not received; and (3) a copy of patent owner's records to show non-receipt of the Office action.

The instant petition lacks of the above required items. The Petition is therefore **DENIED** and the Office action of September 13, 2010 will **not** be re-mailed and the time period to respond to the Final Office Action will **not** be reset.

Furthermore, the Final Office Action was mailed to the address as cited in the Change of address filed on December 16, 2009, as was Non-Final Office Action dated March 2, 2010 which was indeed received. The Patent Owner filed another change of address dated January 25, 2011 after the Final Rejection was mailed, which has been accepted by the office for subsequent communications.

Any action, such as a renewed petition under 37 CFR 1.137 "Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent", taken in response to this decision must be taken **within two (2) months** of the mailing date of this decision, see 37 CFR 1.181(f). If no renewed petition is filed within the period indicated above, this reexamination proceeding will be terminated pursuant to 37 CFR 1.550(d) that states, in part, "the prosecution of an ex parte reexamination proceeding is terminated if the patent owner fails to file a timely and appropriate response". The termination of the reexamination proceeding would result in the issuance of a reexamination certificate that would be consistent with the position taken in the last Office action.

CONCLUSION

1. The petition filed January 24, 2011, is **denied**.

2. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Specialist, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.

Irem Yücel
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.
90/009,481	06/08/2009	5,905,274	7773.092.60	3772

24341 7590 03/16/2011

MORGAN, LEWIS & BOCKIUS, LLP. (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN, IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH,CA 92660

Date: MAILED
MAR 16 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009481
PATENT NO. : 5905274
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.: 90/009,481

1. THIS IS A DECISION ON THE PETITION FILED 10 March 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 Notice of Appeal dated 22 February 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

   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: _____.

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)

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need additional time. The patent owner has not shown what action was taken in the time preceding the request for extension of time and change of power of attorney.

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. This is the third request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Notice of Appeal in an *ex parte* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Notice of Appeal. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council late in the prosecution of this proceeding, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration collecting and review of all documents in a proceeding before the Office. Additionally the preparation of related petitions is not germane to the issue of "sufficient cause" for determining the extension of time.

MPEP § 2665 points out that second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations.

In as much as the Patent owner has only noted that they are new counsel and that documents were not available for response to the Notice of Appeal there is considered "sufficient cause" to grant two (2) weeks additional time.

The petition for extension of time is hereby granted-in-part for two (2) weeks additional time for responding to the Notice of Appeal dated 22 February 2011.

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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Joseph R. Keating, Esq.
Graham & James LLP
801 S. Figueroa Street, 14th Floor
Los Angeles, CA 90017 : (For Patent Owner)

MAILED
APR 22 2011
CENTRAL REEXAMINATION UNIT

Babak Redjaian, Irell & Manella LLP
840 Newport Center Drive
Suite 400
Newport Beach, CA 92660 : (For Requester)

Morgan, Lewis, & Bockius, LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306 : (Courtesy Copy)

In re Ahn *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/009,481
Filed: June 8, 2009
For: U.S. Patent No. 5,905,274

DECISION
DISMISSING PETITION
UNDER § 1.182

This is a decision on the April 1, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED REEXAMINATION."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On June 8, 2009, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/009,481 ("the '9481 proceeding").

- Reexamination of claims 1-6, all of the claims of the '274 patent, was ordered in an Office decision issued on August 7, 2009. This order indicated that a substantial new

question of patentability was raised by, *inter alia*, U.S. Patent Number 5,162,933 to Kakuda.

- On October 20, 2009, a nonfinal Office action was issued that included anticipation rejections of all original patent claims, claims 1-6, based upon Kakuda '933.

- On January 13, 2010, an interview was held between patent owner's representatives and Office personnel, including discussion of the Kakuda '933 reference.

- On January 20, 2010, patent owner submitted claim amendments to original claims 1 and 4, new claims 7-12, a declaration by James O'Connor, and remarks in response to the nonfinal Office action, and in particular, to the rejection over Kakuda '933.

- On September 20, 2010, the Office mailed a final Office action, including anticipation rejections of original patent claims 1-6 and newly added claims 8 and 11 based upon Kakuda '933. The January 20, 2010 declaration by O'Connor was addressed in this action.

- On November 8, 2010, a second interview was held between patent owner's representatives and Office personnel, including discussion of the Kakuda '933 reference.

- On November 22, 2010, patent owner submitted an after-final amendment to the claims (1-12 pending), and accompanying remarks.

- On January 21, 2011, the Office mailed an advisory Office action permitting entry of after-final claim amendments submitted on November 22, 2010, for purposes of appeal.

- On February 22, 2011, patent owner filed a Notice of Appeal.

- On March 16, 2011, the Office issued a decision on patent owner's March 10, 2011 petition for an extension of time, extending the time to respond to the notice of appeal for an additional two week period.

- On April 1, 2011, patent owner filed an after-final submission including claim amendments, entry of newly proposed claim 13, a new (second) declaration by James O'Connor, for which entry by the examiner is requested. Patent owner also filed the instant petition for continued reexamination pursuant to 37 C.F.R. § 1.182. Patent owner requests entry of claim amendments, entry of newly proposed claim 13, a new (second) declaration by James O'Connor, and accompanying remarks filed with the instant petition.

- On April 22, 2011, the Office issued an advisory Office action refusing entry of the after-final submission filed on April 1, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

> All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (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."[1] Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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. The petition should therefore clearly discuss the manner in which the entry of the submission would so act such that continued prosecution is warranted. Following the same rationale, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final rejection or action closing prosecution. 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).

---

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

In this instance, patent owner's response includes a submission including a (second) O'Connor declaration, new amendments to the claims and a new claim. This submission is requested entry because the O'Connor declaration is allegedly necessary to respond to a paper filed in an *inter partes* reexamination of a related patent, and the O'Connor declaration allegedly defines the issues for appeal with respect to the Kakuda reference. Patent owner did not provide any specific reason why the amendment was necessary, how the amendment would define the issues for appeal, or why the amendment could not have been earlier presented.

Patent owner's response is not persuasive as to the reasons why the instant proposed amendment and evidence submission warrants reopening of prosecution and the resulting delay in the resolution of the substantial new question of patentability for which the reexamination was ordered. With respect to the proposed amendment, patent owner has not provided any specific reasons why prosecution should be reopened for entry and consideration of the proposed amendment submitted with the instant petition, or why the amendment could not have been earlier presented. With respect to the instant declaration, patent owner has not provided any showing that the issue for which the declaration is intended to address, *i.e.*, the anticipation rejection of the claims over the Kakuda reference, arose at such a late date in the instant proceeding that patent owner had no earlier chance to present evidence addressing the issue.

B. Patent Owner Provides No Reason Why Prosecution Should Be Reopened For Entry and Consideration of New Claim Amendments and New Claim 13

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, after patent owner's filing of a notice of appeal on February 22, 2011. The new and amended claims proposed to be entered 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 October 20, 2009. Patent owner has had previous occasion to enter such amended and new claims as a matter of right, and an additional occasion for entry upon a showing of good and sufficient reasons why the amendment was necessary and was not earlier presented.

Patent owner has, in fact, availed himself of the opportunity to present new and amended claims throughout the prosecution of the instant reexamination. Patent owner submitted claim amendments to original claims 1 and 4, and added new claims 7-12, on January 20, 2010, in response to the initial Office action. Patent owner submitted an after-final amendment to the claims on November 22, 2010, in response to the final Office action. The examiner exercised his discretion to enter this amendment for purposes of appeal in the advisory Office action of January 21, 2011. Patent owner would extend the resolution of this proceeding further to enter still more amendments and a new claim through the instant petition.

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. 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 § 1.132 Declarations

As a further basis for this decision, patent owner has also had previous occasions to enter a declaration addressing the anticipation of the claims by the Kakuda reference. The (second) O'Connor declaration proposed to be entered and considered by the examiner is not alleged to be occasioned by any new ground of rejection recently made in the reexamination or by a newly raised issue, but rather, is in response to the original issues raised in the initial Office action of October 20, 2009. Patent owner has had previous occasion to enter such a declaration as a matter of right.

Patent owner has, in fact, availed himself of the opportunity to present a declaration by O'Connor addressing the anticipation of claims by the Kakuda reference during the normal course of prosecution of the instant reexamination. Patent owner submitted a (first) O'Connor declaration addressing the anticipation of claims by the Kakuda reference on January 20, 2010, in response to the initial Office action, which was entered and considered by the examiner. Patent owner had further opportunity, in his response of November 22, 2011, to submit any additional declarations on this issue. Patent owner would extend the resolution of this proceeding further to enter additional evidence by the same declarant on the same issue of anticipation as provided earlier by patent owner on January 20, 2010.

Since patent owner has had at least one previous opportunity under the rules to enter the requested submission, 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. 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).

With respect to patent owner's argument that entry of the (second) O'Connor declaration is necessary based upon a third party statement in a separate proceeding, such reasoning is not persuasive. The proper place to address a statement made in a separate proceeding is in that separate proceeding. The prosecution history of the instant '9481 proceeding has not relied upon any statement made in another proceeding, and therefore patent owner has no cause to seek relief not otherwise provided for under the rules to enter a declaration at this stage of the proceeding to address any such statement.

With respect to patent owner's additional contention that the new evidence would define the issues for appeal, such a contention is not persuasive. Patent owner does not present persuasive reasons why the issues for appeal would be better defined thereby. The declaration proposed for entry would add additional factors, in the form of new contentions in the declaration, to be considered in the patentability determination. Entry of this declaration would therefore add to,

and not simplify, any existing issue in the proceeding. The examiner's reasoning was earlier communicated to the patent owner in the first Office action on the merits in the proceeding, issued on October 20, 2009.[2] Furthermore, patent owner was first made aware of these assumptions in the initial Office action, and presents no reason in the instant petition why the substance of the proposed (second) O'Connor declaration could not have been submitted at an earlier date in the proceeding.

3. Summary

Patent owner has had numerous prior opportunities to present the instant new claim, amendments to the claims, and evidence submission. Neither patent owner, nor the file history, provides reasons why the contents of the instant submission could not have been presented at an earlier date, or explains the manner in which entry of the submission would advance the proceedings such that reopening of prosecution is warranted at this stage of the proceeding. 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 is not warranted.

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.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. Pursuant to 37 C.F.R. § 1.33(c), *the current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings*. The current correspondence address of record for the patent file is Joseph R. Keating, Esq., Graham & James LLP, 801 S. Fiqueroa Street, 14th Floor, Los Angeles, CA 90017 Accordingly, all future correspondence will be directed to that address, unless patent owner changes the correspondence address of record in the patent, which may be changed using form PTO/SB/123.

[2] *See, e.g.*, page 10 of the October 20, 2009 Office action.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- 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

April 22, 2011

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.
90/009,483	06/08/2009	7176489	7773.096.60	9949

30827 7590 10/14/2010

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN
840 NEWPORT CENTER DR.
SUITE 400
NEWPORT BEACH, CA 92660

Date:
MAILED
OCT 14 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000482
PATENT NO. : 7176489
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:95/000,482 & 90/009,483

1. THIS IS A DECISION ON THE PETITION FILED 11 October 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 20 September 2010, which sets a one (1) month period for filing a response thereto, 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 one (1) month 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

   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/	Supervisory Patent Examiner AU 3992
[*Signature*]	(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,486	06/10/2009	6480510	BINDER30 REX	8680

1444 7590 05/19/2011

Browdy and Neimark, PLLC
1625 K Street, N.W.
Suite 1100
Washington, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Edward Langer
c/o SHIBOLETH, YISRAELI, ROBERTS, ZISMAN & CO.
1 Penn Plaza-Suite 2527
New York, NY 10119

Date:
MAILED

MAY 19 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009486
PATENT NO. : 6480510
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.: 90/009,486

1. THIS IS A DECISION ON THE PETITION FILED 17 May 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 18 April 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

   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 one (1) month, 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: _____.

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)

There is no particular explanation in support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

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. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the unavailability of a technical expert and preparation for an interview there is no accounting of the time to date accounting for the reasonably diligent behavior of the patent owner. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration the time required both to find and the availability of technical experts.

MPEP 2665 states, "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.

On balance the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110615

DATE : June 15, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,175,752 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:

SPE: /Eric Keasel/ **Art Unit** 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,509	07/01/2009	5157391	347235US	9691

22850 7590 02/01/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,279	09/16/2008	5157391	347238US	8706

22850 7590 02/01/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2011

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE / DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

Date:

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009509
PATENT NO. : 5157391
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHAL/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date:

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CENTRAL REEXAMINATION UI

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010279
PATENT NO. : 5157391
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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FEB 01 2011
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

MOTOROLA, INC., PATENT DEPT.
1500 NW 22 AVE.,
BOYNTON BEACH FL 33426-8753

(For Requester)

WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

(For Requester)

WILMERHALE/DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

(Courtesy Copy)

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Weitzen	:
Reexamination Proceeding	: DECISION
Control No. 90/010,279	: MERGING
Filed: September 16, 2008	: REEXAMINATION
For: U.S. Patent No. 5,157,391	: PROCEEDINGS
In re Weitzen	:
Reexamination Proceeding	:
Control No. 90/009,509	:
Filed: July 1, 2009	:
For: U.S. Patent No. 5,157,391	:

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. 5,157,391 (hereinafter, the '391 patent), issued to Weitzen, on October 20, 1992.

2. On September 16, 2008, a third party deposited a request for *ex parte* reexamination of the '391 patent. The reexamination proceeding was assigned Control No. 90/010,279 (hereinafter, the '10279 proceeding).

3. The Reexamination Order was granted in the '10279 proceeding on November 10, 2008 finding a substantial new question of patentability (SNQP) as to claims 1, 5, 8, and 9.

4. During prosecution of the '10279 proceeding, claims 8 and 9 were cancelled. Also, a rejection of claims 1 and 5 was reversed by the Board of Patent Appeals and Interferences (BPAI).

5. On July 1, 2009, a third party requester deposited a Request for *ex parte* Reexamination of the '391 patent. The reexamination proceeding was assigned Control No. 90/009,509 (hereinafter, the '9509 proceeding).

6. The Reexamination Order was granted in the '9509 proceeding on August 19, 2009 finding a substantial new question of patentability (SNQP) as to claims 2 and 6.

7. During prosecution of the '9509 proceeding, a rejection of claims 2 and 6 was reversed by the BPAI.

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 usually be merged and result in the issuance of a single certificate of a single certificate under § 1.570.

In accordance with 37 C.F.R. § 1.565(c), the '10279 and '9509 reexamination proceedings are merged. The cancelled claims 8 and 9 are considered cancelled in the merged proceeding. Since the standing rejections of claims 1, 2, 5, and 6 have been reversed, the proceeding is being

forwarded to the examiner for action not inconsistent with this decision or the decisions of the BPAI.

CONCLUSION

1. Reexamination Control Nos. 90/010,279 and 90/009,509 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

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.
90/009,515	07/27/2009	6118894	A126.811.101	9831

7590 09/07/2010

Mark D. Saralino
RENNER OTTO BOISSELLE & SKLAR
1621 Euclid Avenue, 19th Floor
Cleveland, OH 44115-2191

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Todd R. Fronek

DICKE, BILLIG & CZAJA, PLLC

100 South 5th Street, Suite 2250

Minneapolis, MN 55402

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,515*.

PATENT NO. *6118894*.

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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Mark D. Saralino
Renner Otto Boisselle and Sklar
1621 Euclid Avenue
Ninteenth Floor
Cleveland OH 44115-2191

(For Patent Owner)

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SEP 07 2010

CENTRAL REEXAMINATION UNIT

Dicke, Billig & Czaja, PLLC
Attn: Christopher J. McLaughlin
Fifth Street Towers Suite 250
100 South Fifth Street
Minneapolis, MN 55402

(For Third Party Requester)

In re LeBrun *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/009,515	: MERGING
Request Deposited: July 8, 2009	: REEXAMINATION
For: U.S. Patent No. 6,118,894	: PROCEEDINGS
In re LeBrun *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,732	:
Request Deposited: April 26, 2010	:
For: U.S. Patent No. 6,118,894	:

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,118,894 (hereinafter, the '894 patent), issued to Schwartz *et alia*, on September 12, 2000.

2. On July 8, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '894 patent. The reexamination proceeding was assigned Control No. 90/009,515 (hereinafter, the '9515 proceeding).

3. On April 26, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '894 patent. The reexamination proceeding was assigned Control No. 90/009,732 (hereinafter, the '732 proceeding).

4. The Reexamination Order was granted for claims 1-22 in the '515 proceeding on October 1, 2009. Prosecution has resulted in amendments to the claims. In particular, claims have been added.

5. The Reexamination Order was granted for claim 1-22 in the '732 proceeding on June 21,2010.

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.

In accordance with 37 C.F.R. § 1.565(c), the '515 and the '732 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.

As noted above, claims have been added by amendment in the '515 proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

Patent owner is reminded that amendments in reexamination proceedings must meet the requirements of 37 CFR 1.530 (d) – (i). In particular, all changes to the patent claims must be indicated. New claims must be fully underlined. The "housekeeping" amendment must be in full compliance with 37 CFR 1.550 and bring the claims in the '732 proceeding in line with those presently presented in the '515 proceeding.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/009515 and 90/009732 are MERGED.

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.

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

/J. Harrison/

Jessica Harrison
SPE AU 3992 Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 2, 2011

TO SPE OF : ART UNIT 3992 SPE Eric Keasel

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/009,518 Patent No.: 6,634,461 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 reexamination certificate number **"6,634,461 C1"** be corrected to be displayed as **"RE41,554"(with the appropriatae suffix "E")** be approved as requested by applicant?

See COCIN dated 5-31-2011

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.
- ☐ **Denied** — State the reasons for denial below.

Comments: This reexamination certificate should be attached to RE41,554 (not USP 6,634,461)

SPE Eric Keasel **Art Unit** 3992

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Commissioner for Patents
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NOV 23 2010

CENTRAL REEXAMINATION UNIT

WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202	:	(For Patent Owner)
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO ONE FINANCIAL CENTER BOSTON, MA 02111	:	(For Third Party Requester)
In re: Devoe *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,525 Deposited : 23 July 2009 For: US Patent No. 6,816,356	:	DECISION *SUA SPONTE* MERGING PROCEEDINGS [37 CFR § 1.565(c)]
In re: Devoe *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,773 Deposited : 2 July 2010 For: US Patent No. 6,816,356	:	

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 9 November 2004 US Patent No. 6,816,356 was granted to Devoe *et alia.*

2. On 23 July 2009 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,525.

3. On 20 October 2009 the Order was granted for *ex parte* reexamination in control number 90/009,525.

4. On 23 March 2010 a non-final Office action was mailed in 90/009,525.

5. On 25 May 2010 an amendment and remarks were received in 90/009,525.

6. On 2 July 2010 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,773.

7. On 21 September 2010 the Order was granted for *ex parte* reexamination in control number 90/009,773.

8. There are no amendments to the claims in control number 90/009,773.

DISCUSSION

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 for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/009,525 & 90/009,773 *ex parte* reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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 triplicate, each bearing an original signature, for entry in each file.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,525 & 90/009,773 *ex parte* reexamination proceedings are hereby **merged**.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

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

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Woodcock Washburn LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

For Patent Owner

MAILED

AUG 24 2010

CENTRAL REEXAMINATION UNIT

Thomas H. Martin
Martin & Ferraro LLP
1557 Lake O'Pines St., NE
Hartville, OH 44632

3d Party Requester
(90/009,542)

Joseph A. Hynds
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W., Suite 800
Washington, DC 20005

3rd Party Requester
(90/010,655)

Ex Parte Reexamination Proceeding
Control No. 90/009,542
Filed: July 24, 2009
For: U.S. Patent No. 6,936,071

Ex Parte Reexamination Proceeding
Control No. 90/010,655
Filed: August 24, 2009
For: U.S. Patent No. 6,936,071

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed August 5, 2010, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The petition is **GRANTED**.

Petitioner requests that the following documents that are subject to a protective order be expunged from the record: "Amended Judgment Awarding Enhanced Damages, Prejudgment Interest and Attorney Fees", "Amended Order Denying Defendants' Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 103", Judgment Awarding Enhanced Damages, Post December 31, 2007 Damages, Pre- and Post-Judgment Interest, and Injunctive Relief", "Order Amending and Altering the Judgment Entered on August 26, 2009 to Alter the Amount of Damages and Interest Awarded and to Amend the Judgment to Provide for an Award of Attorney Fees", "Order Denying Defendants' Motion for Summary Judgment of Invalidity under 35 U.S.C. § 103", "Order Denying

Copied from 90010655 on 08/31/2010

Defendants' Motion for Summary Judgment of No Willful Infringement", Order Denying Defendants' Motion for Summary Judgment of Non-Infringement on O-MAV; Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment of Infringement of Claims 1 and 2 of U.S. Patent No. 6,939,071", "Order Denying Defendants' Motion for Summary Judgment of Non-Infringement, or in the Alternative for Invalidity; Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment Dismissing Medtronic's 35 U.S.C. §112 Defenses", "Order Denying Plaintiff Spine Solutions, Inc's Motion for Summary Judgment Regarding the Obviousness Defense", "Order Granting in Part and Denying in Part Plaintiffs' Motion for Treble Damages, Award of Attorney Fees, Expert Witness Fees, Expenses, Post December 31, 2007 Damages, and Pre- and Post-Judgment Interest", "Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment (1) that the Asserted Claims of the '071 Patent Are Not Anticipated; and (2) that the (a) '785 patent [No. 6,402,785], (b) Dr. Zdeblick and Mr. McKay's Alleged Invention, and (c) Numerous Unexplained References Are Not Prior Art", "Order Granting Plaintiff Spine Solutions, Inc's Motion for Partial Summary Judgment of Failure Of Defendants to State a Legal Defense or Claim for Relief Based on Inequitable Conduct", and "Order Granting Plaintiffs' Motion for Permanent Injunction". The petition indicates that these documents were filed 'under seal" in Spine Solutions, Inc v. Medtronic Sofamor Danek, Inc et al, 2:07cv2175, United States District Court for the Western District of Tennessee, and as such are under terms of a protective order in that action.

The petition fee set forth in 37 CFR 1/17(g) has been paid.

The information in question has been determined by the examiner to not be material to the examination of the instant reexamination proceeding.

Petitioner is required to retain the expunged material(s) for the life of the patent on which the instant reexamination proceeding is based on.

The expunged material has been removed from the file and is being returned herewith.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

Enclosure (to patent owner): envelop containing above-identified documents

Copied from 90010655 on 08/31/2010

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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.
90/009,550	09/17/2009	5825449	8733.1930.61	1964

30827 7590 06/01/2011

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI
20333 SH 249
SUITE 600
HOUSTON, TX 77070

Date:

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009550
PATENT NO. : 5414811
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

MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON DC 20006	: : :	(For Patent Owner)
WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI, LLP 20333 SH 249 6TH FLOOR HOUSTON, TX 77070	: : : :	(For Third Party Requester)

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

In re: Shin *Ex Parte* Reexamination Proceeding *Ex Parte* 90/009,550 Deposited : 17 September 2009 For: US Patent No. 5,825,449	: : : : :	**DECISION** **PETITION** **REQUESTING** **MERGER** **[37 CFR § 1.181]**

This is a decision on the petition dated 17 September 2009 for "Request for *Ex Parte* Reexamination of U.S. Patent 5,825,449 and for Merger of Reexamination Proceedings." The petition is before the director of the Central Reexamination Unit, the petition is dismissed-as-moot .

BACKGROUND

1. On 10 October 1998 US Patent No. 5,825,449 was granted to Shin.

2. On 05 October 2007 *ex parte* reexamination was ordered for US Patent 5,825,449 and assigned control number 90/008,737.

3. On 20 October 2009 the *ex parte* reexamination certificate issued thereby concluding the proceeding of control number 90/008,737.

4. On 10 October 2008 *ex parte* reexamination was ordered for US Patent 5,825,449 and assigned control number 90/010,221.

5. On 20 October 2009 the *ex parte* reexamination certificate issued thereby concluding the proceeding of control number 90/010,221.

6. On 17 October 2009 the instant petition was received.

DISCUSSION

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 § 1.570. Issuance and publication of *ex parte* reexamination certificate concludes *ex parte* reexamination proceeding.

(a) To conclude an *ex parte* reexamination proceeding, the Director will issue and publish an *ex parte* reexamination certificate in accordance with 35 U.S.C. § 307 setting forth the results of

the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.
(b) An *ex parte* reexamination certificate will be issued and published in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.
(c) The *ex parte* reexamination certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the *ex parte* reexamination certificate will also be mailed to the requester of the *ex parte* reexamination proceeding.
(d) If an *ex parte* reexamination certificate has been issued and published which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.
(e) If the *ex parte* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(d), the reissued patent will constitute the *ex parte* reexamination certificate required by this section and 35 U.S.C. § 307.
(f) A notice of the issuance of each *ex parte* reexamination certificate under this section will be published in the Official Gazette on its date of issuance.

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 <u>after</u> 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.

Since the certificate has issued in proceedings control numbers 90/008,737 & 90/010,221 merger is not possible since the Office lacks jurisdiction over the proceedings.

The petition to merge 90/009,550 with 90/008,737 & 90/010,221 is hereby <u>dismissed-as-moot</u>.

CONCLUSION

1. The request for merger is dismissed-as-moot .

2. The certificate will issue in due course for 90/009,550

3. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Patent No. : 7560123 C1
Ser. No. : 90/009,575
Inventor(s) : Giordano et al.
Issued : July 20, 2010
Title : COMPOSITIONS AND METHODS FOR NUTRITION SUPPLEMENTATION
Docket No. : 14ME-129032
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 and/or 1.323.

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. 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.

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

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1. 17(i) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request 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

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Ennis Young
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **756-1542** or (703) 756-1814

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,577	10/30/2009	5459522	19688-0042RX1	9113

26171 7590 02/09/2011
FISH & RICHARDSON P.C. (DC)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HOGAN & HARTSON, LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

Date:

MAILED

FEB 09 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009577
PATENT NO. : 5459522
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)

FISH & RICHARDSON P.C. (DC)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

(For Requester)

HOGAN LOVELLS US LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

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FEB 09 2011

CENTRAL REEXAMINATION UNIT

In re Pint	:
Reexamination Proceeding	: DECISION
Control No. 90/009,577	: DISMISSING
Filed: October 30, 2009	: PETITION
For: U.S. Patent No. 5,459,522	:

The above identified *ex parte* reexamination file is before the Central Reexamination Unit for consideration of a paper entitled, "PETITION TO VACATE REEXAMINATION", filed July 6, 2010.

The petition is **dismissed** as untimely.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,459,522 (hereinafter, the '522 patent), issued to Pint, on October 17, 1995.

2. On October 30, 2009, a third party deposited a corrected request for *ex parte* reexamination of the '522 patent. The reexamination proceeding was assigned Control No. 90/009,577 (hereinafter, the '9577 proceeding).

3. The Reexamination Order was granted in the '9577 proceeding on December 11, 2009 finding a substantial new question of patentability (SNQ) as to claims 1-3.

4. The office published a Federal Register Notice on June 25, 2010 entitled, "Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in *Ex Parte* Reexamination Proceedings"

5. On July 6, 2010, the present petition was filed.

DECISION

PO's petition is **dismissed** as untimely (see 37 CFR 1.181(f)).

It is noted that PO submitted substantially similar arguments in the response to the non-final office action also filed July 6, 2010 regarding the finding of an SNQ.

The Federal Register Notice of June 25, 2010 clarifies the procedure for seeking review of the SNQ, which states, in part:

"This notice clarifies that while issues related to a SNQ determination are procedural, the Chief Judge of the Board of Patent Appeals and Interferences (BPAI) has been delegated the authority to review issues related to the examiner's determination that a reference raises a SNQ in an ex parte reexamination proceeding...
The patent owner may seek review on the examiner's SNQ determination before the BPAI along with any appeal of the examiner's rejections. A patent owner must include the SNQ issue and the appropriate arguments in its appeal brief to the BPAI."

CONCLUSION

1. The petition is **dismissed** as untimely.

2. The proceeding is being forwarded to the examiner for action not inconsistent with this decision.

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.

Eric Keasel

Eric Keasel
SPE, AU 3992

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Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

For Patent Owner

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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

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

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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

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,589	10/01/2009	7557301	125448-38	9671

32914 7590 11/23/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,592	11/17/2009	7,557,301	023944.008686	2186

32914 7590 11/23/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
THOMPSON & KNIGHT, L.L.P.
PATENT PROPERTY DEPARTMENT
1722 ROUTH STREET, SUITE 1500
DALLAS, TX 75201-2533

Date:
MAILED
NOV 23 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009592
PATENT NO. : 7557301
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
PATENT GROUP
C/O DLA PIPER US LLP
203 N. LASALLE ST., SUITE 1900
CHICAGO, IL 60601

Date:

MAILED

NOV 23 2010

CENTRAL REEXAMINATION UN

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009589
PATENT NO. : 7557301
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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GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM STREET DALLAS, TX 75201-4761	:	(For Patent Owner)
PATENT GROUP C/O DLA PIPER US LLP 203 N. LASALLE ST. SUITE 1900 CHICAGO, IL 60601	:	(For Third Party Requester)
THOMPSON & KNIGHT, L.L.P. PATENT PROPERTY DEPARTMENT 1722 ROUTH STREET, SUITE 1500 DALLAS, TX 75201-2533	:	(For Third Party Requester)
In re: Kummer *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,589 Deposited on: 1 October 2009 For: US Patent No. 7,557,301 *In re*: Kummer *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,592 Deposited on: 17 November 2009 For: US Patent No. 7,557,301	:	DECISION *SUA SPONTE* MERGING PROCEEDINGS [37 CFR § 1.565(c)]

MAILED

NOV 23 2010

CENTRAL REEXAMINATION UNIT

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 7 July 2009 US Patent No. 7,557,301 was granted to Kummer *et alia*.

2. On 1 October 2009 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,589.

3. On 18 December 2009 the Order was granted for *ex parte* reexamination in control number 90/009,589.

4. On 17 November 2009 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,592.

5. On 5 February 2010 the Order was granted for ex parte reexamination in control number 90/009,592.

6. There have been amendments to the claims in each proceeding.

DISCUSSION

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 for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/009,589 & 90/009,592 *ex parte* reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

Note that Patent owner stated it was amending the claims so that they would be identical in both proceedings in a paper filed 25 October 2010 in 90/009,592. This amendment did not make the claims identical. As but one example, claim 22 had been cancelled in 90/009,589, but was not cancelled in the October 25 submission. Patent owner must ensure the claims are the same in each proceeding.

Patent owner is reminded that amendments must comply with 37 CFR 1.530(i)—amendments are made relative to the patent, not relative to any prior amendments. Patent owner's previous amendment filed 22 September 2010 in 90/009,589 was non-compliant in this regard.

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 triplicate, each bearing an original signature, for entry in each file.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,589 & 90/009,592 *ex parte* reexamination proceedings are hereby **merged**.

2. The patent owner's representative is required to to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

By Hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(For Patent Owner)

Henneman & Associates PLC
70 North Main Street
Three Rivers, MN 49093

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AUG 12 2010

CENTRAL REEXAMINATION UNIT

(For Requester)

Fish & Richardson, P.C.
60 South Street
Minneapolis, MN 55402

In re *Moore et al.*
Reexamination Proceeding
Control No. 90/009,591
Filed: October 2, 2009
For: U.S. Patent No. 5,784,584

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 4, 2009, styled as "PETITION TO RECONSIDER ORDER DENYING REQUEST FO EX PARTE REEXAMINATION", filed pursuant to 37 CFR 1.181 and 515(c), is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,784,584 (hereinafter, the '584 patent) issued on July 21, 1998.

2. On October 2, 2009, the third party requester deposited a request for *ex parte* reexamination for claim 29 of the '584 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,591 (hereinafter, the '591 proceeding).

3. On November 4, 2009, an order denying the request for reexamination for claim 29 was issued.

4. On December 4, 2009, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

DECISION

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, the review will determine whether the examiner's refusal to order reexamination for claim 29 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claim 29 of the '584 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability (SNQ) exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the

[1] Public Law 96-517, enacted on December 12, 1980.

> efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.[2] Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."[3,4] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated October 2, 2009.[5]

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[2] This requirement is not aplicable to Director ordered reexaminations.

[3] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

[4] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

[5] It is noted that the denial of reexamination in the '591 proceedings uses language that echoes the reasoning of In re Portola, 110 F.3d 786 (CAFC 1997). However, the 2002 amendments to 35 USC 303(a) indicate that consideration of a reference in a prior prosecution does not necessarily foreclose use of that reference in a later reexamination. To the extent that the denial suggests that a reference initialed by an examiner on an Information Disclosure Statement is presumed to have been fully considered in all aspects, that is an incorrect statement of the law.

A review of the request reveals that a substantial new question of patentability affecting Claim 29 of United States Patent Number 5,784,584 is raised by the request for reexamination.

Patent '584 Reexamination History

Claim 29 of the '584 patent was previously reexamined in a merged proceeding associated with control numbers 90/008,225 and 90/008,299. An Ex Parte Reexamination Certificate issued on July 21, 2009, determining that claim 29 was patentable as amended. Claim 29 reads,
29. In a microprocessor system including a central processing unit, memory, and an instruction register, a method for providing instructions and literal operands from said memory to said central processing unit comprising the steps of:

providing instruction groups to said instruction register from said memory;

wherein said instruction register is connected to circuits that decode instructions;

wherein each of said instruction groups is structured to comprise a set of locations, including a first location, that contain either instructions or operands or both, said operands comprising either literal operands or variable-length address operands, and said instructions including opcode bits or both opcode bits and address selection bits but not including variable-length address operands; and further

wherein certain of said instruction groups include at least one instruction that, when executed, causes an access to an instruction, or to a literal operand and an instruction, said accessed literal operand or said accessed instruction being located at a predetermined position from a boundary of said instruction groups, said accessed instruction positioned at only the first location of an instruction group;

decoding said at least one instruction to determine at least said predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction;

locating at least said predetermined position; and

supplying said accessed instruction, or said accessed literal operand and said accessed instruction, from said instruction groups to said central processing unit, using at least said predetermined position.

In the Notice of Intent to Issue a Reexamination Certificate, the examiner concluded that, "[T]he prior art of record fails to disclose among other limitations at least the limitation of 'said accessed instruction positioned at only the first location of an instruction group,' and 'predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction'." (NIRC, 04/21/2009, p. 5.)

Analysis of the Request

The requester has asserted that the following references present new, non-cumulative technical teachings that are not present in any prior art of record, (Request at 7):
(1) MC68020 32-Bit Microprocessor User's Manual, Motorola, Prentice-Hall, 1984 ("the Motorola reference"); and
(2) U.S. Pat. No. 5,134,701 to Mueller et al. ("the Mueller reference").

Although the Motorola reference appears to be substantially identical to a reference cited in the IDS filed April 8, 2008, in the previous merged reexamination proceeding for the '584 patent, the previously-cited version of the Motorola reference was neither applied in a rejection or specifically discussed on the record by the examiner.

The Motorola reference, as presented by the request, raises a substantial new question of patentability.

The request indicates that Requester considers that a substantial new question of patentability is raised as to claim 29 based on the Motorola reference.

Specifically, the requester asserts that the Motorola reference anticipates claim 29, including the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction."

The Motorola reference teaches a long word (32-bits) instruction group in which an instruction may be either in a first location, i.e., on the even word boundary (also known as the long word boundary) or in a second location, i.e., on the odd word boundary. See Motorola at pp. 5-10 and 9-1. Further, the Motorola reference teaches a branch instruction which causes the processor to access an instruction group containing a branch target that may be either in a first location (on an even word boundary) or a second location (on an odd word boundary). See Motorola at p. 9-1. In particular, when the branch target is on an odd word boundary, the prefetched long word will contain first a word that does not contain the branch target followed by a word that does contain the branch target. Id. When the branch target is on an even word boundary, the prefetched long word will contain the branch target and either a subsequent instruction or an extension word associated with the branch target instruction. Motorola at pp. 9-1, 2-4. Under the broadest reasonable interpretation, an instruction in the first location of the 32-bit instruction group may be considered "accessed" by a branch operation regardless of whether it is the branch target. Because the Motorola reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Motorola reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Motorola reference provides an independent basis for raising a substantial new question of patentability.

The Mueller Reference, as presented by the request, raises a substantial new question of patentability.

The request further indicates that Requester considers that a substantial new question of patentability is raised as to claim 29 based on the Mueller reference.

Specifically, the requester asserts that the Mueller reference anticipates claim 29, including the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction."

The cited teachings in the Mueller reference illustrate the same principles associated with the operation of the MC68020 microprocessor as taught by the Motorola reference (discussed above). Specifically, Mueller teaches that the MC68020 microprocessor is, "An example of a processor that retrieves a plurality of instructions on every instruction fetch cycle." Mueller at col. 4, lines 3-5. "[W]hen a jump operation such as 'JMP (a0)' instruction occurs, thirty-two bits of instruction are fetched from the designated address." Id. at col. 4, lines 11-13. "In the case of the MC68020 processor, either the upper sixteen bits [i.e., the second location,] or the lower sixteen bits [i.e., the first location,] of the thirty-two bit word that is retrieved is the instruction that processor 104 will continue execution with." Id. at col. 4, lines 39-42. Similarly to the BRA instruction of the Motorola reference discussed above, either location may reasonably be considered "accessed" by the jump operation of Mueller, regardless of whether it is the jump target.

Because the Mueller reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Mueller reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Mueller reference provides an independent basis for raising a substantial new question of patentability.

Conclusion

Because it is agreed that Motorola and Meueller raise a SNQ with respect to claim 29 of the '584 patent, the Petition is GRANTED. No other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claim 29 of the '584 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed under 37 CFR 1.530 by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248.

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

   Where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

5. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,591	10/02/2009	5,784,584	24567-0002RX4	8118

40972 7590 09/08/2010

HENNEMAN & ASSOCIATES, PLC
70 N. MAIN ST.
THREE RIVERS, MI 49093

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON, P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Date:
MAILED
SEP 08 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009591
PATENT NO. : 5784584
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
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Alexandria, VA 22313-1450
www.uspto.gov

(For Patent Owner)

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SEP 08 2010

CENTRAL REEXAMINATION UNIT

(For Requester)

Henneman & Associates PLC
70 North Main Street
Three Rivers, MI 49093

Fish & Richardson, P.C.
60 South Street
Minneapolis, MN 55402

In re *Moore et al.*
Reexamination Proceeding
Control No. 90/009,591
Filed: October 2, 2009
For: U.S. Patent No. 5,784,584

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 4, 2009, styled as "PETITION TO RECONSIDER ORDER DENYING REQUEST FO EX PARTE REEXAMINATION", filed pursuant to 37 CFR 1.181 and 515(c), is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is granted for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 5,784,584 (hereinafter, the '584 patent) issued on July 21, 1998.

2. On October 2, 2009, the third party requester deposited a request for *ex parte* reexamination for claim 29 of the '584 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,591 (hereinafter, the '591 proceeding).

3. On November 4, 2009, an order denying the request for reexamination for claim 29 was issued.

4. On December 4, 2009, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

DECISION

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, the review will determine whether the examiner's refusal to order reexamination for claim 29 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claim 29 of the '584 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC § 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability (SNQ) exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

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Looking to the legislative history for the original reexamination statute,[1] Congress stated:

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Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.[2] Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."[3,4] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated October 2, 2009.[5]

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[2] This requirement is not aplicable to Director ordered reexaminations.

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A review of the request reveals that a substantial new question of patentability affecting Claim 29 of United States Patent Number 5,784,584 is raised by the request for reexamination.

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providing instruction groups to said instruction register from said memory;

wherein said instruction register is connected to circuits that decode instructions;

wherein each of said instruction groups is structured to comprise a set of locations, including a first location, that contain either instructions or operands or both, said operands comprising either literal operands or variable-length address operands, and said instructions including opcode bits or both opcode bits and address selection bits but not including variable-length address operands; and further

wherein certain of said instruction groups include at least one instruction that, when executed, causes an access to an instruction, or to a literal operand and an instruction, said accessed literal operand or said accessed instruction being located at a predetermined position from a boundary of said instruction groups, said accessed instruction positioned at only the first location of an instruction group;

decoding said at least one instruction to determine at least said predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction;

locating at least said predetermined position; and

supplying said accessed instruction, or said accessed literal operand and said accessed instruction, from said instruction groups to said central processing unit, using at least said predetermined position.

In the Notice of Intent to Issue a Reexamination Certificate, the examiner concluded that, "[T]he prior art of record fails to disclose among other limitations at least the limitation of 'said accessed instruction positioned at only the first location of an instruction group,' and 'predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction'." (NIRC, 04/21/2009, p. 5.)

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The cited teachings in the Mueller reference illustrate the same principles associated with the operation of the MC68020 microprocessor as taught by the Motorola reference (discussed above). Specifically, Mueller teaches that the MC68020 microprocessor is, "An example of a processor that retrieves a plurality of instructions on every instruction fetch cycle." Mueller at col. 4, lines 3-5. "[W]hen a jump operation such as 'JMP (a0)' instruction occurs, thirty-two bits of instruction are fetched from the designated address." Id. at col. 4, lines 11-13. "In the case of the MC68020 processor, either the upper sixteen bits [i.e., the second location,] or the lower sixteen bits [i.e., the first location,] of the thirty-two bit word that is retrieved is the instruction that processor 104 will continue execution with." Id. at col. 4, lines 39-42. Similarly to the BRA instruction of the Motorola reference discussed above, either location may reasonably be considered "accessed" by the jump operation of Mueller, regardless of whether it is the jump target.

Because the Mueller reference appears to teach the limitations of "said accessed instruction positioned at only the first location of an instruction group," and "predetermined position of said accessed instruction as only the first location of the set of locations of the instruction group containing said accessed instruction," the request shows that the Mueller reference would be important to a reasonable examiner in deciding whether claim 29 of the '584 patent is patentable. The positions allegedly taken by the patent holder in confidential license negotiations, (see Request for Ex Parte Reexamination, pp. 14-15), are not a proper basis for a request for ex parte reexamination because they are not "prior art patents or printed publications," nor do they explain the contents or pertinent dates of such prior art patents or printed publications. However, as noted above, the Mueller reference provides an independent basis for raising a substantial new question of patentability.

Conclusion

Because it is agreed that Motorola and Meueller raise a SNQ with respect to claim 29 of the '584 patent, the Petition is GRANTED. No other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested. The examiner to whom this proceeding will be assigned may wish to reevaluate whether (1) the other references cited in the request raise a substantial new question of patentability, and (2) if so, whether rejections based upon these references should be made.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claim 29 of the '584 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed under 37 CFR 1.530 by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248.

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

   Where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

5. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,592	11/17/2009	7,557,301	023944.008686	2186

32914 7590 11/23/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/009,589	10/01/2009	7557301	125448-38	9671

32914 7590 11/23/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
THOMPSON & KNIGHT, L.L.P.
PATENT PROPERTY DEPARTMENT
1722 ROUTH STREET, SUITE 1500
DALLAS, TX 75201-2533

Date:
MAILED
NOV 23 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009592
PATENT NO. : 7557301
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PATENT GROUP
C/O DLA PIPER US LLP
203 N. LASALLE ST., SUITE 1900
CHICAGO, IL 60601

Date:

MAILED

NOV 23 2010

CENTRAL REEXAMINATION UI

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009589
PATENT NO. : 7557301
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

GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM STREET DALLAS, TX 75201-4761	:	(For Patent Owner)
PATENT GROUP C/O DLA PIPER US LLP 203 N. LASALLE ST. SUITE 1900 CHICAGO, IL 60601	:	(For Third Party Requester)
THOMPSON & KNIGHT, L.L.P. PATENT PROPERTY DEPARTMENT 1722 ROUTH STREET, SUITE 1500 DALLAS, TX 75201-2533	:	(For Third Party Requester)
In re: Kummer *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,589 Deposited on: 1 October 2009 For: US Patent No. 7,557,301 *In re*: Kummer *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,592 Deposited on: 17 November 2009 For: US Patent No. 7,557,301	:	DECISION *SUA SPONTE* MERGING PROCEEDINGS [37 CFR § 1.565(c)]

MAILED

NOV 23 2010

CENTRAL REEXAMINATION UNIT

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 7 July 2009 US Patent No. 7,557,301 was granted to Kummer *et alia*.

2. On 1 October 2009 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,589.

3. On 18 December 2009 the Order was granted for *ex parte* reexamination in control number 90/009,589.

4. On 17 November 2009 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,592.

5. On 5 February 2010 the Order was granted for ex parte reexamination in control number 90/009,592.

6. There have been amendments to the claims in each proceeding.

DISCUSSION

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 for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/009,589 & 90/009,592 *ex parte* reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

Note that Patent owner stated it was amending the claims so that they would be identical in both proceedings in a paper filed 25 October 2010 in 90/009,592. This amendment did not make the claims identical. As but one example, claim 22 had been cancelled in 90/009,589, but was not cancelled in the October 25 submission. Patent owner must ensure the claims are the same in each proceeding.

Patent owner is reminded that amendments must comply with 37 CFR 1.530(i)—amendments are made relative to the patent, not relative to any prior amendments. Patent owner's previous amendment filed 22 September 2010 in 90/009,589 was non-compliant in this regard.

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 triplicate, each bearing an original signature, for entry in each file.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,589 & 90/009,592 *ex parte* reexamination proceedings are hereby **merged**.

2. The patent owner's representative is required to to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

By Hand: Customer Service Window

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson P.C. (NY)
P.O. Box 1022
Minneapolis, MN 55440-1022

For Patent Owner

MAILED

APR 15 2011

CENTRAL REEXAMINATION UNIT

Wood, Phillips, Katz, Clark & Mortimer
500 W. Madison Street, Suite 3800
Chicago, Il 60601

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,598
Filed: November 17, 2009
For: U.S. Patent No. 5,922,021

Ex Parte Reexamination Proceeding
Control No. 90/011,439
Filed: January 17, 2011
For: U.S. Patent No. 5,922,021

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Unit 3993 for consideration of the Request for Merger under 37 CFR 1.565(d) filed March 24, 2011 (copy in each proceeding) to merge the above-identified proceedings.

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. 90/009,598 was ordered in a decision mailed December 17, 2009, indicating that only claims 23, 24, and 36 would be reexamined. Prosecution has progressed to the point where a non-final Office action was mailed February 18, 2011. The action included a rejection of claims 23, 24, and 36 and set forth a two-month period for response. That is, a response is due on or before April 18, 2011.

No response has been filed as of the mailing date of this decision. Further, there have been no amendments made to the claims, drawings and/or specification.

Reexamination in application Control No. 90/011,439 was ordered in a decision mailed February 28, 2011, indicating that only claims 23, 24, and 36 would be reexamined. On March 24, 2011, patent owner filed a Waiver of Patent Owner's Statement and the Request for Merger under 37 CFR 1.565(d). No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/009,598 and reexamination control No. 90/01,439 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, a decision under 37 CFR 1.565(c) is timely. Accordingly, the request 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

The patent Owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 23, 24, and 36, the only claims for which reexamination has been requested, 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(s) and requester(s) 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. 90/009,598 and 90/011,439 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits. In view of this merger, no response needs to be filed in reexamination Control No. 90/009,598 in response to the Office action mailed February 18, 2011.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : August 30, 2011

TO SPE OF : ART UNIT 2821

SUBJECT : Request for Certificate of Correction for Appl. No.: 90009607 Patent No.: 7C1-7533740

CofC mailroom date: July 1, 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: _____

_____

_____
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: _____

Andy Kashnow 3993

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE

Art 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.
90/009,612	12/01/2009	6,778,160	7773.0083	1312

24504 7590 08/09/2010

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA, GA 30339-5994

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/09/2010

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
McKENNA LONG & ALDRIDGE LLP
1900 K STREET, N.W.
WASHINGTON, DC 20006

Date:
MAILED

AUG 09 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009612
PATENT NO. : 6778160
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

Daniel R. McClure THOMAS, KAYDEN, HORSTEMEYER & RISELY, LLP 600 Galleria Parkway S. E. Atlanta, GA 30339	:	(For Owner)
Song K. Jung MCKENNA LONG & ALDRIDGE LLP 1900 K Street NW Washington, DC 20006	:	(For Requester)
In re Reexamination Control No.: 90/009,612 Deposited: October 26, 2009 For: US Patent No. 6,778,160	:	DECISION ON PETITION Under 37 CFR 1.59

MAILED

AUG 09 2010

CENTRAL REEXAMINATION UNIT

This is a response to the petition under 37 CFR 1.59(b), filed on May 2, 2010 by which petitioners request to expunge information from the above identified proceeding.

The petition was filed in a timely manner with the authorization for the appropriate fee from a deposit account pursuant to 37 CFR § 1.17 (g). The fee of $ 200 required by 37 CFR 1.17(g) has been received.

The petition is hereby dismissed.

REVIEW OF RELEVENT FACTS

1. On October 26, 2009 a third party requester requested *ex parte* reexamination of US Patent No 6,778,160 which is identified under control no. 90/009,612.

2. Reexamination was ordered. A timely patent owner statement and timely third party requester reply have been received.

3. On May 3, 2010 the instant petition with artifacts under seal were filed as part of the third party requester reply.

CITATION OF APPROPRIATE PROCEDURE

37 CFR § 1.59 (in-part)

Expungement of information or copy of papers in application file.

(a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

....

MPEP § 724.04(c) (in-part)

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR § 1.11(d) will be treated in the following manner:

(A) Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR § 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied. The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be denied and the information will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found not to be important to a reasonable examiner in deciding whether or not a claim is patentable, the petition to expunge will be granted and the information expunged.

(E) If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR §1.11(d).

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR § 1.59(b) will be treated in accordance with MPEP § 724.05.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02
A petition under 37 CFR § 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR § 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:
(A) a clear identification of the information to be expunged without disclosure of the details thereof;
(B) a clear statement that the information to be expunged is trade secret material, Proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
(E) the fee as set forth in 37 CFR § 1.17(g) for a petition under 37 CFR § 1.59(b).

DECISION

Petitioner requests that one document marked "Exhibit A" and submitted as an artifact pursuant to a protective order in related litigation be expunged from the record. These documents were filed concurrently with the reply and petition.

The petition is deficient because:

1) the petition does not contain a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information as required.

Petitioner may request reconsideration of the petition. Any such request must be resubmitted within two months of the mailing date of this decision and supply the omitted statement(s). No fee will be due with any request for reconsideration.

Any questions regarding this petition decision should be directed to Jessica Harrison, Supervisory Primary Examiner of AU 3992 at 571-272-4449.

PETITION DISMISSED.

/J. Harrison/

Jessica J. Harrison
SPE AU 3992
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
90/009,620	10/27/2009	6329161	518852802701	8417

90259 7590 04/12/2011
Hughes Hubbard and Reed LLP
One Battery Park Plaza
New York, NY 10004

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/12/2011

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

Date:

MAILED
APR 12 2011
CENTRAL REEXAMINATION U

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009620
PATENT NO. : 6329161
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
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HUGHES HUBBARD AND REED LLP (For Patent Owner)
ONE BATTERY PARK PLAZA
NEW YORK, NY 10004

MAILED
APR 12 2011
CENTRAL REEXAMINATION UNIT

MORRISON & FOERSTER LLP (For Third Party Requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

In re Heller et al.	:	**DECISION DISMISSING**
Control No. 90/009,620	:	**PETITION**
Deposited: October 27, 2009	:	**TO VACATE PROCEEDING**
For: US Patent No. 6,329,161	:	**PURSUANT TO**
	:	**37 CFR § 1.181(a)(3)**

This is a decision on the March 11, 2010 petition filed by the patent owner entitled, "Petition under 37 C.F.R. §§ 1.181-1.183 to vacate an *ultra vires* reexamination order ..." [hereinafter "the petition"]. The petition was filed again on March 12, 2010 with a certificate of service to the patent owner at the proper address. The petition contains issues related to petitions under 37 CFR 1.181, 1.182, and 1.183. The petition states, in part, that the order granting reexamination in the proceeding should be vacated because the request fails to raise a substantial new question of patentability. This petition is being treated as a petition under 37 CFR 1.181(a)(3), and is before the Central Reexamination Unit for decision.

37 CFR 1.4(c) states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Because petitions filed under 37 CFR 1.182 and 1.183 are decided by the Office of Patent Legal Administration while petitions filed under 37 CFR 1.181 are decided by the Central Reexamination Unit, the portions of the petition pertaining to 37 CFR 1.182 and 1.183 must be filed as separate petitions, in accordance with 37 CFR 1.4.

The third party requester filed a paper on March 25, 2010 in opposition to the petition. This decision addresses both patent owner's petition and third party requester's opposition with respect to issues raised under 37 CFR 1.181.

The petition, treated under 37 CFR 1.181(a)(3), is dismissed for the reasons set forth below.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 6,329,161 [hereinafter "the '161 patent"] was granted to *Heller et al.* on December 11, 2001.

2. On February 1, 2006, a request for *ex parte* reexamination for claims 1-10, 16-20, 22, 25-43, 47, and 48 of the '161 patent was submitted by third party requester Dexcom, Inc., and, assigned control No. 90/007,914 [hereinafter, the '914 proceeding].

3. On February 28, 2006, an order granting *ex parte* reexamination for patent claims 1-48 of the '161 patent was mailed in the '914 proceeding.

4. On July 25, 2007, a second request for *ex parte* reexamination for original patent claims 1-48, proposed amended claims 1, 30, and 42, and proposed new claims 49-90 was submitted by the same third party requester Dexcom, Inc., and, assigned control No. 90/008,713 [hereinafter, the '713 proceeding].

5. On October 18, 2007, an order granting the second request for reexamination was mailed in the '713 proceeding in regard to the original patent claims 1-48 of the '161 patent. This proceeding was merged with the '914 proceeding. The merged reexamination proceedings are terminated and a certificate issued on September 29, 2009.

6. On June 10, 2009, a third request for *ex parte* reexamination for the '161 patent was submitted by the same third party requester Dexcom, Inc., and, assigned control No. 90/009,488 [hereinafter, the '488 proceeding]. This request was terminated on August 7, 2009 because the response to the filing date notice was insufficient.

7. On October 27, 2009, a fourth request for ex parte reexamination for claims 1-57 (as printed in the published reexamination certificate) of the '161 patent was

submitted by the same third party requester Dexcom, Inc., and, assigned control No. 90/009,620 [hereinafter, the '620 proceeding].

8. On January 11, 2010, an order granting *ex parte* reexamination was mailed in the '620 proceeding. The order granted reexamination for patent claims 1-57.

9. On March 11, 2010, the petition, which is treated as a petition under 37 CFR 1.181(a)(3) requesting that the order in the '620 reexamination proceeding be vacated as *ultra vires*, was filed. This petition was filed again on March 12, 2010 with a proper certificate of service on the patent owner.

10. On March 25, 2010, an opposition to the petition by the third party requester was filed in the '620 reexamination proceeding.

11. On March 7, 2011, a first Office action was mailed in the '620 reexamination proceeding.

12. On April 1, 2011, the patent owner filed a one-month extension of time petition to respond to the first Office action in the '620 reexamination proceeding.

13. On April 4, 2011, the extension of time petition was granted.

STATEMENT OF RELEVANT AUTHORITY

35 U.S.C. 303 Determination of issue by Director.

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

MPEP 2240 provides in relevant part:

II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

If a second or subsequent request for *ex parte* reexamination is filed (by any party) while a first *ex parte* reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different from that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial

new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied.

Where the request raises a different substantial new question of patentability as to some patent claims, but not as to others, the request would be granted in part; see the order issued in reexamination control number 90/007,843 and 90/007,844.

The second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the first (or prior) pending reexamination proceeding.

MPEP 2242 provides in relevant part:

II.A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent.

A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded Office examination of the patent (e.g., in the examination of the application for the patent). For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362,1365-66,47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

In a decision to order reexamination made on or after November 2, 2002, **reliance on old art does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art**. See Public Law 107-273,116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a SNQ may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. (Emphasis added.)

MPEP § 2246 Decision Ordering Reexamination (in-part):

A petition under 37 CFR § 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR § 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

> ...
> (E) the reexamination order is based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the
> patent, a prior reexamination, an interference proceeding).

DECISION

The patent owner brings before the Office a petition, treated as a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding as not raising a proper substantial new question of patentability (SNQ). The procedure for such a petition is provided for in MPEP 2246. For this petition to be entertained, however, the patent owner must show that the Office had no discretion to grant the request for reexamination. See MPEP 2246.

Patent owner contends that the order for reexamination of the '161 patent is *ultra vires* and must be vacated. See pages 15-130 of the petition. Patent owner presents numerous bases for their contention that the request for reexamination fails to raise a substantial new question of patentability. Specifically, patent owner asserts individual bases for each asserted SNQ in the request.

Requester opposes the petition on the grounds that the petition filed by the patent owner is mischaracterizing the grounds for reexamination made in the request for reexamination, and the patent owner has not provided the necessary showing to support the petition.

The determination of whether an SNQ exists is a fact-specific inquiry, and is not governed by the mere fact that a reference was previously considered in an earlier examination of the patent. MPEP 2242(II)(A). Such a determination requires an evaluation of "the context in which the reference was previously considered and the scope of the prior consideration and determin[ation] of whether the reference is now being considered for a substantially different purpose." *In re Swanson*, 540 F.3d 1368, 1380 (Fed. Cir. 2008). An SNQ will not be raised solely by an "argument already decided by the Office," or where the issue merely questions the prior judgment of the examiner. *Id.* (*quoting* H.R. Rep. No 96-1307 *and citing* H.R. Rep. No. 107-120).

The USPTO published a notice in the Federal Register to clarify that while issues related to a substantial new question of patentability (SNQ) determination are procedural, the BPAI has been delegated the authority to review issues related to the examiner's determination that a reference raises a SNQ in an *ex parte* reexamination proceeding. *Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings*, 75 FR 36357 (June 5, 2010). A patent owner challenging the correctness of the decision to grant an order for *ex parte* reexamination on the basis that there is no SNQ may obtain further review by exhausting the patent owner's rights through the reexamination proceeding and ultimately seeking review before the BPAI along with an appeal of any rejections. Therefore, in order to preserve the right to have the BPAI review of the SNQ

issue, a patent owner should first request reconsideration of the SNQ determination by the examiner.

For an order for reexamination to be deemed an *ultra vires* action, petitioner patent owner has to show that the Office had "clearly exceeded its statutory authority" or acted "in brazen defiance of its statutory authorization" in the Office's determination to order reexamination. In other words, petitioner must show that the Office was without authority to order reexamination. Therefore, the petitioner must show that there is no SNQ for any claim for which reexamination is requested. If it is determined that there is a SNQ for at least one claim for which reexamination is request, then the order is not deemed an *ultra vires* action. Accordingly, this decision only needs to determine that the Office has the authority to order the reexamination by finding that there is a SNQ for at least one claim. To the extent that patent owner's arguments raise issues as to whether every asserted SNQ is not new, these arguments will not be specifically addressed in this decision. As stated above, patent owner can appeal such issues to the BPAI, as appropriate.

Analysis of the SNQs based on the Bindra reference

Determination of the scope of previous examination consideration begins "with an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions." *In re Swanson*, 540 F.3d at 1381. In the order in the instant proceeding, the examiner found that Bindra, alone or in combination with other references, raised a substantial new question of patentability for independent patent claims 1, 18, 25, 29, 30, 31, 34, and 49 (see SNQs#3, 24, 35, 39, and 40 on pages 9-10, 29, 37-38, 40-41, and 42 respectively, of the order). The order determined that Bindra was a reference that was previously cited but not applied in the prior examinations. The order found that Bindra had teachings relevant to the reasons for allowance stated in the Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) (dated May 29, 2009) in the merged '914 and '713 proceedings, which is reproduced, in part, below:

> 3. Claims 1 - 17, 30, 34 - 48, 71 - 72, 91 and 92 are allowable because the prior art of record neither discloses nor fairly suggests the following limitation:
>
> > "wherein the sensor is flexible and is adapted to provide an electrical signal that is substantially insensitive to relative motion between the implanted portion of the sensor and tissue surrounding the implanted portion of the sensor."
>
> 4. Claims 18 - 24, 57 - 58 and 91 are allowable because the prior art of record neither discloses nor fairly suggests the following limitation:
>
> > "a signal measuring device operatively connected to the sensor for measuring the signal generated by the sensor, the signal measuring device being configured to the signal generated by the sensor to reach a basal signal level for a predetermined period of time before the signal is used as an indicator of the glucose concentration."
>
> 5. Claims 29 and 92 are allowable because the prior art of record neither discloses nor fairly suggests the following limitation:
>
> > "allowing the signal generated by the sensor to reach a basal signal level for a predetermined period of time;"

Specifically, the order found that Bindra had teachings relevant to a flexible sensor that, as evidenced by Poitout's teachings, provides an electrical signal that is substantially insensitive to relative motion when implanted (see pages 9-10 of the order and page 1693 of Bindra). In addition, the order determined that Bindra, in combination with the teachings of Moatti-Sirat, had teachings relevant to the signal measuring device being configured to the signal generated by the sensor to reach a basal signal level for a predetermined period of time before the signal is used as an indicator of glucose concentration (e.g., a "run-in prior" time period) (see pages 37-38 of the order and page 1695 of Bindra). The order specifically addressed the issue of whether the request in the instant proceeding raised substantial new questions of patentability that was different from questions raised in the prior examinations. See, e.g. page 10 of the order.

Patent owner contends that Bindra failed to raise a substantial new question of patentability (SNQ) because of their conclusion that Bindra has no teachings relevant to the sensor being flexible and adapted to provide an electrical signal that is substantially insensitive to relative motion between the implanted portion of the sensor and tissue surrounding the sensor. Patent owner points to the partial sentence in Bindra that states "[t]his paper, however, will deal only with the design and the in vitro evaluation" for support. See pages 24-25 and 58 of the petition. Upon review of the record, it is determined that the petition fails to make a sufficient showing that Bindra has no teachings that are relevant to the limitations mentioned in the reasons for allowance in the NIRC. The quotation regarding Bindra's main focus is not dispositive that it has no teachings regarding flexibility, insensitivity to movement, or a "run-in prior" time period. No facts about Bindra were presented that clearly showed the examiner's analysis was without basis in fact. Patent owner may continue to contest the examiner's findings regarding SNQs during the examination phase of the reexamination proceeding, but the petition failed to show that the examiner lacked the discretion to order reexamination.

The essential inquiry is whether the order granting reexamination established a basis for granting the reexamination, as authorized by 35 U.S.C. 303 and 304 and 37 CFR 1.515 and 1.525. As discussed above, the examiner followed reexamination laws and policies in his determination that the request raises at least one SNQ for every claim of the '161 patent. The order also states that the combined teachings of Bindra with other secondary references are relevant to the limitations in claims 1, 18, 25, 29, 30, 31, 34, and 49 (every independent claim) found to be missing in the prior examination, and therefore, would be important to a reasonable examiner in determining the patentability of claims. Therefore, the record shows that there is a basis for the examiner's determination that Bindra provides a new technical teaching pertaining to the limitations of claims of the '161 patent, and accordingly, raises a SNQ. See MPEP 2240 and 2244. In other words, the determination that a SNQ was raised was in accordance with 35 U.S.C. 303 and 304, its implementing regulations, 37 CFR 1.515 and 1.525, and the guidelines set forth in MPEP 2240, 2242, 2244, and 2246. The record shows that the determination to order reexamination was within the discretion of the examiner.

Furthermore, as stated above, to the extent that patent owner's arguments raise issues as to whether the other SNQs are not new, these arguments will not be addressed in this decision. A patent owner challenging the correctness of the decision to grant an order for *ex parte* reexamination on the basis that there is no SNQ may obtain further review by exhausting the

patent owner's rights through the reexamination proceeding and ultimately seeking review before the BPAI along with an appeal of any rejections.

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must have shown that there was no discretion to grant the reexamination and not just disagreement with substantive determinations in the order.

Findings

It is found that the order was not based wholly on the same question of patentability raised by the prior art previously presented. Therefore, the order was not an *ultra vires* action on the part of the Office. For the reasons detailed above, patent owner has failed to show that the order was an *ultra vires* action. Petitioner is referred to *Heinl v Godici*, (E.D.Va. 2001), 143 F. Supp. 2d 593. In *Heinl*, 143 F.Supp.2d at 601, the court stated:

> "Under the well established *ultra vires* doctrine, the exhaustion and final agency requirements are excused 'only if plaintiff is able to show that the PTO clearly exceeded its statutory authority'", quoting from *Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985) (quoting *Mayor and City Council of Baltimore v. Mathews*, 562 F.2d 914, 920 (4th Cir. 1977), vacated on other grounds, 571 F.2d 1273 (4th Cir. 1978).

The court went on to state:

> "Put differently, when an agency acts in 'brazen defiance' of its statutory authorization, courts need not await the conclusions of the underlying proceedings."

After a review of the present record, and based upon the above discussion, it is found that petitioner patent owner has not shown the Office to have "clearly exceeded its statutory authority" nor acted "in brazen defiance of its statutory authorization" in the Office's determination to order reexamination.

In view of the above, the petition to vacate the reexamination proceeding is dismissed. The March 25, 2010 opposition by the third party requester was considered, and is granted to the extent that the Office has dismissed patent owner's petition.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181(a)(3) proceeding is hereby **dismissed.**

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, 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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,629	12/10/2009	6134092	7773.087.60	5300

26285 7590 11/29/2010

K&L GATES LLP
210 SIXTH AVENUE
PITTSBURGH, PA 15222-2613

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/29/2010

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
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCKENNA LONG & ALDRIGE LLP
1900 K STREET N.W.
WASHINGTON, D.C. 20006

Date:
MAILED
NOV 29 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009629
PATENT NO. : 6134092
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.:90/009,629

1. THIS IS A DECISION ON THE PETITION FILED 23 November 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 Final Rejection mailed 01-11-2010, which sets was extended to five (5) months period for filing a response thereto, 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 _____, 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.
      v. ☐ The petition is moot.
      vi. ☒ Other/comment: Time for an unscheduled interview does not warrant "sufficient cause" Petitioner has not shown how a time difference or a single holiday supports sufficient cause.

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 Art Unit 3992
[*Signature*]	(Title)

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.
90/009,635 ± 90/011404	11/09/2009	5861807	SEN-R-09-002	8611

7590 06/27/2011

EXAMINER

ART UNIT	PAPER NUMBER

John Mortimer
WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER
500 West Madison Street
Suite 3800
Chicago, IL 60661

DATE MAILED: 06/27/2011

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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Date: 6-27-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Stephen T. Scherrer, Esq.
c/o PATENTS & TMS, P.C.
2849 W. Armitage Ave.
Chicago, IL 60647

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009635 + 90/011404
PATENT NO. : 5861807
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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P.O. Box 1450
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MAILED

JUN 27 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

WOOD PHILLIPS VAN SANTEN
CLARK & MORTIMER
500 WEST MADISON STREET
SUITE 3800
CHICAGO IL 60661

(For Third Party Requester)

PATENTS+TMS, P.C.
2849 W. ARMITAGE AVE.
CHICAGO, IL 60647

(For Third Party Requester)

CHRISTOPHER C. DREMANN, P.C.
15015 LANCASTER HIGHWAY
CHARLOTTE, NC 28277

In re Leyden *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/009,635	: MERGING
Request Deposited: November 9, 2009	: REEXAMINATION
For: U.S. Patent No. 5,861,807	: PROCEEDINGS

In re Leyden *et alia*	:
Reexamination Proceeding	:
Control No. 90/011,404	:
Request Deposited: December 23, 2010	:
For: U.S. Patent No. 5,861,807	:

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. 5,861,807 (hereinafter, the '807 patent), issued to Leyden *et alia*, on January 19, 1999.

2. On November 9, 2009, a third party requester deposited a Request for *Ex Parte* Reexamination of the '807 patent. The reexamination proceeding was assigned Control No. 90/009,635 (hereinafter, the '9635 proceeding).

3. The Reexamination Order was granted in the '9635 proceeding on December 23, 2009 finding a substantial new question of patentability (SNQP).

4. During prosecution, Patent Owner amended claims and added new claims 27-78.

5. On December 23, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '807 patent. The reexamination proceeding was assigned Control No. 90/011,404 (hereinafter, the '11404 proceeding).

7. The Reexamination Order was granted in the '11404 proceeding on April 21, 2011 finding a substantial new question of patentability (SNQP).

8. The period for a Patent Owner statement has expired.

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.

In accordance with 37 C.F.R. § 1.565(c), the '9635, and '11404 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.

As noted above, claims have been amended in the '9635 reexamination proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner

is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/009,635 and 90/011,404 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

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 06 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Cha & Reiter, LLC
17 Arcadian Avenue
Suite 208
Paramus NJ 07652

(For Requester)

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

In re: Johnson *et alia*
Reexamination Proceeding
Control No. 90/009,636
Request Deposited: November 12, 2009
For: U.S. Patent No. 6,055,516

DECISION

This is a decision on the May 18, 2011 paper entitled "PETITION UNDER 37 C.F.R. § 1.181".

On June 30, 2011, a decision expunging papers filed May 12, 2011 was mailed.

Therefore, the May 18, 2011 petition is **dismissed** as moot.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,638	12/16/2009	7351248	PROP3001RX/FJD/JS	7505

7590 06/14/2011

Christopher J. Fildes
FILDES & OUTLAND AND PC
20916 MACK AVENUE
SUITE 2
GROSSE POINTE WOODS, MI 48236

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BACON & THOMAS PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

Date:

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JUN 14 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009638
PATENT NO. : 7351248
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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Rader, Fishman & Grauer (For Patent Owner)
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Bloomfield Hills, MI 48304-0610

Bacon & Thomas PLLC (For Third Party Requester)
625 Slaters Lane
Fourth Floor
Alexandria, VA 22314-1176

MAILED

JUN 14 2011

CENTRAL REEXAMINATION UNIT

In re Donald J. Propp et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/009,638 : **DISMISSING**
Filed: December 16, 2009 : **PETITION**
For: U.S. Patent No. 7,351,248 :

This is a decision on the June 6, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed corrected Appeal Brief and revive the present reexamination prosecution ("the June 6, 2011 patent owner petition to revive").

The June 6, 2011 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 6, 2011 patent owner petition is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part (emphasis added):

> 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 (emphasis added):

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

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 (emphasis added):

(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 (emphasis added):

(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).

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 Dismissed

On January 4, 2011, patent owner timely filed a Notice of Appeal in response to the October 6, 2010 final rejection action in the instant reexamination proceeding.[1] Patent owner then timely filed an Appeal Brief on March 4, 2011. The Office followed by issuing an Examiner's Answer on May 3, 2011.

The June 6, 2011 patent owner petition under 37 CFR 1.137(b) asks the Office to accept an unintentionally delayed corrected Appeal Brief. However, 37 CFR 1.550(e)(2) provides that a ***terminated*** *ex parte* reexamination prosecution may be revived by filing a petition in compliance with 37 CFR 1.137(b), if patent owner's ***delay*** in filing a response was unintentional. The record for the instant reexamination proceeding does not reveal a delay in filing a response by the patent owner, and the reexamination proceeding is not a terminated proceeding. Thus, 37 CFR §§ 1.550 and 1.137 do not apply to this situation.

Patent owner filed on May 27, 2011, a petition to strike the May 3, 2011 Examiner's Answer and to treat the May 3, 2011 Answer as a notice of non-compliant appeal brief. According to the May 27, 2011 petition, the March 4, 2011 Appeal Brief was non-compliant. However, the Office has yet to act on the May 27, 2011 petition. Even if the Office finds the March 4, 2011 Appeal Brief to be non-compliant when it acts on the

[1] The time period for response to the October 6, 2010 final rejection action was extended to three months by the January 3, 2011 Advisory Office Action.

May 27, 2011 petition, the Office will, pursuant to 37 CFR 41.37(d), provide patent owner with a period of time in which to file a corrected brief in response to any finding that the March 4, 2011 brief was non-compliant. Thus, in any event, there would remain no "delay" to excuse under 37 CFR §§ 1.550 and 1.137, and thus, no grounds for the instant petition to be granted.

In short, no regulatory or statutory provision supports the availability of 37 CFR §§ 1.550 and 1.137 for relief in the current situation.

For the foregoing reasons, the June 6, 2011 patent owner petition is **dismissed**.

CONCLUSION

1. The June 6, 2011 petition is **dismissed**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jeanne Clark, of CRU Art Unit 3993, at (571) 272-7714.

3. 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

June 14, 2011
Kept-ab/137 not a remedy/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,638	12/16/2009	7351248	67167-0003	7505

10291 7590 07/21/2011

RADER, FISHMAN & GRAUER PLLC
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BLOOMFIELD HILLS, MI 48304-0610

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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

Centurion Medical Products Corp.
Appellant and Patent Owner

Ex parte Reexamination Control 90/009,638
Patent 7,351,248

DECISION ON PETITION

This is a Decision on Appellant's "Petition to Strike Examiner's Answer and Treat Same as Notification of Non-Compliant Brief Pursuant to 37 C.F.R. § 41.37," filed May 27, 2011 ("Petition"). The Petition seeks to have the Examiner's Answer entered May 3, 2011 treated as notice that the Appeal Brief filed on March 4, 2011 is non-compliant, requiring the filing of a corrected Appeal Brief. Petition, pp. 1-2.

FINDINGS

1. In this reexamination proceeding, the Examiner entered a Final Rejection on October 6, 2010.

2. On December 17, 2010, Appellant filed an Amendment.

3. On January 3, 2011, the Examiner entered an Advisory Action advising Appellant that the Amendment of December 17, 2010 had not been entered.

4. Appellant filed a Notice of Appeal on January 4, 2011 and an Appeal Brief on March 4, 2011.

5. On May 3, 2011, the Examiner entered an Examiner's Answer. The Answer noted that:

> The copy of the appealed claims contained in the Appendix to the appellant's brief contains the proposed amendment of December 17, 2010 that was not entered.

Answer, p. 4.

6. On May 27, 2011, Appellant filed the present Petition.

7. On June 6, 2011, Appellant filed a Corrected Appeal Brief, stating:

> If the Petition [filed May 27, 2011] is granted, this Corrected Appeal Brief appeals the decision of the Examiner in the Final Office Action dated October 6, 2010 ("Final Office Action") and the Advisory Action dated January 3, 2011 ("Advisory Action").

8. Also on June 6, 2011, Appellant filed a Petition for Revival of an Unintentionally Abandoned Reexamination Proceeding.

9. On June 14, 2011, the Office denied the June 6, 2011 Petition finding that there had been no delay in filing a response and the reexamination proceeding had not been terminated. Decision, p. 3.

RELEVANT AUTHORITY

With respect to the jurisdiction and authority of the Chief Judge of the Board of Patent Appeals and Interferences in *ex parte* reexamination proceedings, 75 Fed. Reg. 29,321 (May 25, 2010) provides:

> [T]he Chief Judge will review the appeal brief to determine whether the appeal brief complies with 37 CFR 41.37 before it is forwarded to the Central Reexamination Unit or other Technology Center examiner

> for consideration. . . . *The Chief Judge will also have the sole responsibility for determining whether corrected briefs comply with 37 CFR 41.37, and will address any inquiries and petitions regarding notices of noncompliant briefs.*
> The Chief Judge's responsibility for determining whether appeal briefs comply with 37 CFR 41.37 is not considered a transfer of jurisdiction when an appeal brief is filed, but rather is only a transfer of the specific responsibility of notifying appellant under 37 CFR 41.37(d) of the reasons for non-compliance. *The Patent Examining Corps retains the jurisdiction over the ex parte reexamination proceeding to consider the appeal brief, conduct an appeal conference, draft an examiner's answer, and decide the entry of amendments, evidence, and information.*

(emphasis added.)

With respect to the contents of appeal briefs in ex parte reexamination appeals, 37 C.F.R. § 41.37(c)(2) specifies:

> A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

DICUSSION

As indicated, the Central Reexamination Unit retains jurisdiction over this proceeding during the briefing process, including the authority to decide the entry of evidence. However, the Chief Judge of the BPAI has been granted authority to review briefs in *ex parte* reexamination appeals and decide petitions relating to the compliance of briefs with applicable regulations. 75 Fed. Reg. 29,321 (May 25, 2010).

Appellant filed an Amendment on December 17, 2010, which was never entered. The claims as presented in the Appeal Brief filed on March 4, 2011 were the claims as amended by the non-entered Amendment of December 17, 2010. Thus, the Appeal Brief addressed claims which were

never entered and the Appeal Brief of March 4, 2011 was non-compliant with Rule 41.37.

DECISION

In view of the forgoing, the Petition is GRANTED. The Examiner's Answer of May 3, 2011 will be treated as a notice of non-compliant brief and the Corrected Appeal Brief of June 6, 2011 will be accepted.

The proceeding is now before the Examiner for consideration of the Corrected Appeal Brief of June 6, 2011 and consideration of filing a new Examiner's Answer.

James D. Smith
Chief Administrative Patent Judge

Counsel for Appellant and Patent Owner:
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Rader, Fishman & Grauer PLLC
39533 Woodward Ave., Suite 140
Bloomfield Hills, MI 48304

Third Party Requester:
Bacon & Thomas PLLC
625 Slaters Lane, 4th Floor
Alexandria, VA 22314-1176

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,657	12/24/2009	5828402	WLAN001USRE	2086

58293 7590 08/19/2010

FORTKORT & HOUSTON P.C.
9442 N. CAPITAL OF TEXAS HIGHWAY
ARBORETUM PLAZA ONE, SUITE 500
AUSTIN, TX 78759

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/19/2010

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

Date:
MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009657
PATENT NO. : 5828402
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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FORTKORT & HOUSTON P.C. 9442 N. CAPITAL OF TEXAS HIGHWAY ARBORETUM PLAZA ONE, SUITE 500 AUSTIN TX 78759	:	(For Patent Owner)
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850	:	(For Third Party Requester)

MAILED

AUG 19 2010

CENTRAL REEXAMINATION UNIT

In re: Timothy David Collings *Ex Parte* Reexamination Proceeding Control No. 90/009,657 Deposited on: 24 December 2009 For: US Patent No. 5,828,402	:	DECISION GRANTING-IN-PART PETITION FOR EXTENSION OF TIME [37 CFR §§ 1.550(c) & 1.181]

This is a decision on the 16 August 2010 petition entitled, "Petition For Extension of Time [37 CFR § 1.550(c)]" requesting the response period for response be extended by three(3) months. 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-in-part for the reasons set forth below.

DECISION

The Patent Owner's representative requests the period for response to be extended by three (3) month for responding to the Office action dated 29 July 2010, which sets two (2) months time for filing a response thereto. The petition for extension of time was timely filed on 22 July 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-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....

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 three(3) months to the period for response. The decision to extend the period for response is evaluated based upon a showing of "sufficient cause." There is always the consideration to balance the need for the patent owner to have a fair opportunity to respond to the Office action between the need for special dispatch.

The petition relates the patent owner requires additional time to prepare secondary evidence and to assemble additional experts for prosecution of the reexamination proceeding. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. On balance, the petition supports the requirement for "sufficient cause" to grant a 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 three(3) months time in which to file a response to the Office action dated 29 July 2010 is hereby **granted-in-part.**

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

3. The response is due **29 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,657	12/24/2009	5828402	WLAN001USRE	2086

58293 7590 06/30/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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ALEXANDRIA, VA 22320-4850

Date: MAILED
JUN 3 0 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009657
PATENT NO. : 5828402
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)

OLIFF & BERRIDGE, PLC
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(for Requester)

In re Collings
US Patent Number 5828402
Proceeding No.: 90/009,657
Filed: December 24, 2009
For: **METHOD AND APPARATUS FOR SELECTIVELY BLOCKING AUDIO AND VIDEO SIGNALS**

DECISION ON PETITIONS UNDER 37 CFR 1.59

This is a decision on the petitions under 37 CFR 1.59(b), filed December 20, 2010, February 3, 2011, and May 16, 2011, to expunge information from the above identified proceeding.

The petitions are **dismissed**.

Petitioner requests that numerous documents be expunged from the record.

The petitions are deficient because:

1) the petitions do not contain a commitment on the part of petitioner to retain the information to be expunged for the life of any patent with regard to which such information has been submitted; and

2) the petitions do not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

Eric Keasel

ERIC S. KEASEL
CRU SPE-AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,657	12/24/2009	5828402	WLAN001USRE	2086

58293 7590 09/14/2011

FORTKORT & HOUSTON P.C.
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/14/2011

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Date: MAILED
SEP 14 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009657
PATENT NO. : 5828402
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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Decision on Petition for Extension of Time in Reexamination	Control No.: 90/009,657

MAILED

SEP 14 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 09 September 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 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

   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 one (1) month 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/ [*Signature*]	SPE, AU 3992 Central Reexamination Unit (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. While the petition speaks to the considerations of the loss of a valued expert, these are the risks in any litigation.

The requirement for reasonably diligent behavior by the patent owner includes a reasonable expectation of resource management. Resource management takes into consideration the time needed to seek additional expert advice.

Pursuant to MPEP § 2265 (in-part) "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)

On balance there is "sufficient cause" to grant-in-part the extension of time for one (1) month.

The petition for extension of time is hereby granted-in-part for one (1) month.

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,658	05/17/2010	6043741	5580-101557	7531

28289 7590 04/14/2011

THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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
RATNERPRESTIA
PO BOX 980
VALLEY FORGE, PA 19482

Date: MAILED
APR 14 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009658
PATENT NO. : 6043741
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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The Webb Law Firm
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219

(For patent owner)

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

Kenneth N. Nigon
Ratner Prestia
P.O. Box 980
Valley Forge, PA 19482

(For requester)

In re Sean J. Whitmarsh
Ex Parte Reexamination Proceeding
Control No. 90/009,658
Filed: February 16, 2010
For: U.S. Patent No. 6,043,741

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

This is a decision on the March 3, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the March 3, 2011 patent owner petition to revive").

The March 3, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 3, 2011 patent owner petition to revive is **granted**.

The February 14, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 19, 2010 Office action is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 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:

(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 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.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the November 19, 2010 Office action pursuant to

37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The November 19, 2010 Office action set a two-month period for response. However, a response to the November 19, 2010 Office action was not filed until March 3, 2011, which was untimely. Nevertheless, for the purpose of evaluating whether the March 3, 2011 patent owner petition to revive is a grantable petition, patent owner's submission of the March 3, 2011 Request For Reconsideration satisfies item (1).[1]

Patent owner has been charged the $1,620.00 petition fee, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted on March 3, 2011, thereby satisfying item (3).

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Accordingly, the March 3, 2011 patent owner petition to revive is **granted**.

The February 14, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 19, 2010 Office action is **withdrawn**.

CONCLUSION

1. The March 3, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The February 14, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 19, 2010 Office action is **withdrawn**.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Christopher Lee, of CRU Art Unit 3992, at (571) 272-3637.

---

[1] This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's March 3, 2011 Request For Reconsideration as to each of the rejections set forth in the November 19, 2010 Office action or (ii) the March 3, 2011 request's compliance with formal matters; such is the examiner's province.

[2] *See*: 37 CFR 1.137(d)(3).

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

04/14/2011

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Pauley Petersen & Erickson
2800 West Higgins Road
Suite 365
Hoffman Estates, IL 60619

For Patent Owner

MAILED

SEP 21 2010

CENTRAL REEXAMINATION UNIT

Avery Dennison Corporation
Patent Group
Law Department – 3 South
P.O. Box 7090
Pasadena, CA 91109-7090

For 3rd Party Requester
(90/010,760)

Ex Parte Reexamination Proceeding
Control No. 90/010,760
Filed: December 30, 2009
For: U.S. Patent No. 6,364,198

Ex Parte Reexamination Proceeding
Control No. 90/009,679
Filed: April 02, 2010
For: U.S. Patent No. 6,364,198

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/010,760 and 90/009,679 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. 90/010,760 was ordered in a decision mailed February 5, 2010. The decision granted reexamination for original patent claims 1-7, 10-13, 16-18, and 21-25 of U.S. Patent No. 6,363,198, the only claims for which reexamination was requested. No patent owner statement has been filed and no Office action has been rendered since the mailing of the decision ordering reexamination.

Copied from 90009769 on 10/07/2010

Reexamination in application Control No. 90/009,679 was ordered in a decision mailed April 23, 2010, indicating that claims 1 and 10 of U.S. Patent No. 6,364,198 would be reexamined. No patent owner statement has been filed and no Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,760 and reexamination control No. 90/009,679 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-7, 10-13, 16-18, and 21-25, the only claims for which reexamination has been requested, 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. 90/010,760 and 90/009,679 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Copied from 90009769 on 10/07/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,680	02/12/2010	5997915	Acella 095259/16	9793

7590 06/23/2011

Peter Rogalskyj, Esq.
The Law Office of Peter Rogalskyi
PO Box 44
Livonia, NY 14487-0044

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PABST PATENT GROUP LLP
1545 PEACHTREE STREET N.E.
SUITE 320
ATLANTA, GA 30309

Date:

MAILED
JUN 23 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009680
PATENT NO. : 5997915
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:90/009,680

1. THIS IS A DECISION ON THE PETITION FILED June 21, 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 mailed on February 24, 2011, which sets a two-month period for filing a response thereto, be extended by one month from the Notice of Appeal.

   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 **The Appeal brief is due on July 28, 2011**

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535.

Deborah Jones 6/24/2011
[Signature] (Title) DEBORAH D. JONES
CRU SPE-AU 3991

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,689	02/19/2010	6410281	2901645-000015	5042

91335 7590 10/01/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/01/2010

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

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER DONELSSON BEARMAN, CALDWELL & BERKOWITZ, PC
920MASSACHUSETTS AVE, N.W.
SUITE 900
WASHINGTON, D.C. 20001

Date: MAILED
OCT 0 1 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009689
PATENT NO. : 6410281
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:90/009,689

1. THIS IS A DECISION ON THE PETITION FILED _____.

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 ___August 5, 2010_____, which sets a ___2 month_____ period for filing a response thereto, be extended by ___1 (one) 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 ___1 (one)__month_____, 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 Response is due November 5, 2010

   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.

   Deborah D. Jones 9/30/10 — [Signature]

   DEBORAH D. JONES
   CRU SPE-AU 3991 — (Title)

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.: 6,249,316 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 certificate of correction seeks to cancel claims, renumber claims, and change dependencies of other claims. If Patent Owner thinks any of their claims are inoperative or defective, they may wish to consider filing a reissue application.

Eric Keasel

SPE: Eric Keasel **Art Unit** 3992

ERIC S. KEASEL
CRU SPE-AU 3992

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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.
90/009,692	02/22/2010	6,504,575 B1	353991US91RX	2108

93143 7590 09/20/2010
Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/20/2010

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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,677. + 90/009,692

PATENT NO. 6504575.

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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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.

1940 DUKE STREET

ALEXANDRIA, VA 22314

MAILED

SEP 2 0 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,692*. +90/010,677

PATENT NO. *6,504,575* [redacted].

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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CENTRAL REEXAMINATION UNIT

Herskovitz & Associates, LLC
2845 Duke Street
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(For Third Party Requester)

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(For Third Party Requester)

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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In re Ramirez *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/010,677	: MERGING
Corrected Request Deposited: October 2, 2009	: REEXAMINATION
For: U.S. Patent No. 6,504,575	: PROCEEDINGS
In re Ramirez *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,692	:
Request Deposited: February 22, 2010	:
For: U.S. Patent No. 6,504,575	:

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. 6,504,575 (hereinafter, the '575 patent), issued to Ramirez *et alia*, on January 7, 2003.

2. On October 2, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '575 patent. The reexamination proceeding was assigned Control No. 90/010,677 (hereinafter, the '10677 proceeding).

3. The Reexamination Order was granted in the '10677 proceeding on November 14, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-7.

4. A non-final office action was mailed in the '10676 proceeding on February 26, 2010.

5. On February 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '575 patent. The reexamination proceeding was assigned Control No. 90/009,692 (hereinafter, the '9692 proceeding).

6. The Reexamination Order was granted in the '9692 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-7.

7. On May 26, 2010, Patent Owner (PO) responded to the outstanding office action in the '10677 proceeding and added new claims 8-32.

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.

In accordance with 37 C.F.R. § 1.565(c), the '10677, and '9692 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.

As noted above, claims 8-32 have been added in the '10677 reexamination proceeding. The office will place a USPTO prepared claim set in both the '9692 and '10677 proceedings rather than mail a requirement to have PO make such an amendment. So, the amendments are now the

same in both proceedings. Patent owner is required to maintain the same claims and specification in all merged files in the future.

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. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/010,677 and 90/009,692 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

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,694	02/22/2010	6177956	R132592-694	9926

93143 7590 09/21/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/21/2010

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

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Date:
MAILED

SEP 2 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009694
PATENT NO. : 6177956
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.
90/010,674	10/02/2009	6177956	R132592-674	9178

93143 7590 09/21/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/21/2010

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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NEW YORK, NY 10036-4003

Date: MAILED

SEP 2 1 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010674
PATENT NO. : 6177956
ART UNIT : 3992

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

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

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SEP 21 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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In re Anderson *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/010,674	: MERGING
Corrected Request Deposited: October 2, 2009	: REEXAMINATION
For: U.S. Patent No. 6,177,956	: PROCEEDINGS
In re Anderson *et alia*	:
Reexamination Proceeding	:
Control No. 90/009,694	:
Request Deposited: February 22, 2010	:
For: U.S. Patent No. 6,177,956	:

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. 6,177,956 (hereinafter, the '956 patent), issued to Anderson *et alia*, on January 23, 2001.

2. On October 2, 2009, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '956 patent. The reexamination proceeding was assigned Control No. 90/010,674 (hereinafter, the '10674 proceeding).

3. The Reexamination Order was granted in the '10674 proceeding on October 30, 2009 finding a substantial new question of patentability (SNQP) as to claims 1-18.

4. A non-final office action was mailed in the '10676 proceeding on February 19, 2010.

5. On February 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '956 patent. The reexamination proceeding was assigned Control No. 90/009,694 (hereinafter, the '9694 proceeding).

6. The Reexamination Order was granted in the '9694 proceeding on April 8, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-18.

7. On May 19, 2010, Patent Owner (PO) responded to the outstanding office action in the '10674 proceeding and added new claims 19-69.

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.

In accordance with 37 C.F.R. § 1.565(c), the '10674, and '9694 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.

As noted above, claims 19-69 have been added in the '10674 reexamination proceeding. The office will place a USPTO prepared claim set in the '9694 proceeding rather than mail a requirement to have PO make such an amendment. So, the amendments are now the same in

both proceedings. Patent owner is required to maintain the same claims and specification in all merged files in the future.

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. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/010,674 and 90/009,694 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

Eric Keasel
SPE, AU 3992

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AUG 25 2010

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For 3rd Party Requester
90/009,701

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For 3rd Party Requester
90/010,883

Ex Parte Reexamination Proceeding
Control No. 90/009,701
Filed: March 4, 2010
For: U.S. Patent No. Re 36,978

Ex Parte Reexamination Proceeding
Control No. 90/010,883
Filed: March 19, 2010
For: U.S. Patent No. Re 36,978

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/009,701 and 90/010,883 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. 90/009,701 was ordered in a decision mailed April 13, 2010, granting reexamination of claims 1, 16, and 17 of US Patent No. Re 36,978. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

Reexamination in application Control No. 90/010,883 was ordered in a decision mailed April 19, 2010, indicating that claims 1-8, 13, 16, and 17 of US patent No. Re 36,978 would be reexamined. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

As evidenced by the above facts, reexamination Control No. 90/009,701 and reexamination control No. 90/010,883 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-8, 13, 16, and 17 are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper will be entered into each of the 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 each of the third party requesters and requesters 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. 90/009,701 and 90/010,883 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,701 90/010,883	03/04/2010	RE36978		6956

EXAMINER

ART UNIT	PAPER NUMBER

54984 7590 05/09/2011

MASS ENGINEERED DESIGN INC.
474 WELLINGTON STREET WEST
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DATE MAILED: 05/09/2011

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

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Date:
MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009701; 90/010,883
PATENT NO. : re36978
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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MAY 09 2011

CENTRAL REEXAMINATION UNIT

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90/009,701

Nexsen Pruet, LLC
PO Box 10648
Greenville, SC 29603

(For Third Party Requester)
90/010,883

In re Jerry Moscovitch
Reexamination Proceeding
Control No.: 90/009,701
Filed: March 4, 2010
For: U.S. Patent No.: Re 36,978

In re Jerry Moscovitch
Reexamination Proceeding
Control No.: 90/010,883
Filed: March 19, 2010
For: U.S. Patent No.: Re 36,978

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the February 17, 2011 patent owner petition under 37 CFR 1.182 for entry and consideration of an information disclosure statement (IDS) filed after the termination of the prosecution in this merged 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 February 17, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. On December 5, 2000, the Office reissued U.S. Patent number 5,687,939 to Jerry Moscovitch as Re 36,978.
2. On March 4, 2010, a first request for *ex parte* reexamination, assigned control No. 90/009,701 (the '701 proceeding), was filed by a third party requestor.

3. On March 19, 2010, a second request for *ex parte* reexamination, assigned control No. 90/010,883 (the '883 proceeding), was filed by a second third party requestor.
4. On April 13, 2010 the Office issued an order granting the '701 reexamination request.
5. On April 19, 2010 the Office issued an order granting the '883 reexamination request.
6. On August 25, 2010, the Office issued a decision merging the '701 proceeding and the '883 proceeding. (the merged proceeding)
7. The merged proceeding progressed to the point where, on January 24, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the merged proceeding.
8. On January 28, 2011, the merged proceeding entered the print cycle and designated "452" status.
9. On February 17, 2011, patent owner filed the instant petition, accompanied by a new Information Disclosure Statement (IDS), which patent owner requests the Office to consider.
10. The reexamination proceeding is in the final phase of being prepared for printing of a reexamination certificate (*i.e.* it is in the printing cycle).

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

... 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

.....Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding. This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

Once the reexamination has entered the Reexamination Certificate 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 merged proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 C.F.R. 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2656 as follows:

> ... 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 any of the above noted criteria for the entry of information at this stage of the proceeding. The instant petition was filed very late in the examination of the reexamination, and it fails to provide a statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. Nor does patent owner provide an amendment to the claims and explain how the amendment causes the claim or claims to be patentable. To the contrary, patent owner provides no discussion whatsoever in the petition as to how the cited references render at least one claim unpatentable, let alone provide an amendment of the claims and explanation as to patentability in the present merged reexamination.

Furthermore, there is an insufficient factual accounting to provide an explanation as to why the information submitted could not have been submitted earlier in the reexamination proceeding. Patent owner does state in the one page petition: "To best knowledge [*sic*], the patent owner was unaware of the existence of these four patents before February 9, 2011." Presumably, patent owner came into possession and/or awareness of the references on February 9, 2011, which is after January 28, 2011 – the date the merged proceeding entered the print cycle. However, there is no factual accounting whatsoever as to why patent owner waited until February 17, 2011 to file the instant IDS. Further, the statement "to the best knowledge" does not explain what (if any) investigation was made to determine when the possession and/or awareness of the references took place, and what the "knowledge" is based upon. Therefore, for this additional reason the present petition does not satisfy the requirements for a petition submitted for

consideration of an IDS after the NIRC has been mailed, and the proceeding has entered the publication cycle.

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." 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, and 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 January 24, 2011, and the proceeding has now entered the final stages of the publication process. 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 to identify a question of patentability of the claims, the failure to provide the requisite discussion (explanation) of the submitted art citations, and the failure to provide an amendment to the relevant claims and explanation as to how the amendment renders the claims patentable over the cited art, the present merged reexamination proceeding will <u>not</u> be reopened at this late date to consider the proffered IDS papers. The petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

<u>If, however</u>, 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 <u>dismissed</u>.

CONCLUSION

1. The petition is <u>dismissed</u>.

2. The February 17, 2011 IDS papers will not been entered for consideration by the examiner. However, a copy of the IDS papers will be placed in the electronic file for 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

5-9-11

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MAILED
SEP 30 2010
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

In re Reissue Application of:
Christopher *et al.*
Application No. 11/031,952
Filed: January 7, 2005
For: U.S. Patent No. 6,502,567

In re Christopher *et al.*
Reexamination Proceeding
Control No. 90/009,715
Filed: June 3, 2010
For: U.S. Patent No. 6,502,567

DECISION
SUA SPONTE
MERGING
REISSUE AND
REEXAMINATION
PROCEEDINGS

Reissue application 11/031,952, and reexamination proceeding No. 90/009,715 are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565 at this time.

Reissue application No. 11/031,952 and reexamination proceeding No. 90/009,715 **are merged** into a single proceeding.

Patent owner is directed to Section II below for detailed guidance on the required housekeeping amendment to be submitted within **ONE MONTH** of this decision, placing the same amendments in both files of the present merged proceeding.

REVIEW OF FACTS

1. On January 7, 2003, the Office issued U.S. Patent No. 6,502,567 (the '567 patent) to James T. Christopher *et al.*, with 25 claims.

2. An application for reissue of the '567 patent, assigned application No. 11/031,952 (the '952 application), was filed by the patent owner on January 7, 2005. The application included a preliminary amendment that amended the text of claims 1, 2, 5, and 24; and added new claims 27-68.[1]

3. The notice of the filing of the '952 application for reissue of the '567 patent published in the *Official Gazette* on March 8, 2005.

[1] Patent owner-applicant misnumbered the claims by not starting with claim number 26.

4. On September 11, 2007, patent owner filed a second preliminary amendment amending claims 1-2, 4-9, 16, 20-24, 27-39, 43-44, 46-49, 52, 54-55, 57, 61-62, 64-67; and added new claims 26 and 69-98.

5. On April 23, 2008, the Office issued a request for information under 37 CFR 1.105.

6. On October 22, 2008, patent owner submitted a response to the request for information and an amendment to the specification.

7. On April 21, 2009, the Office issued a non-final Office action withdrawing claims 81-84 and 89 from consideration and rejecting claims 1-80, 85-88, and 90-98 was mailed in the '952 application.

8. On October 21, 2009, patent owner submitted a response to the outstanding Office action amending claims 1-2, 4-9, 16, 20-21, 23-24, and 57.

9. On March 31, 2010, patent owner deposited an *ex parte* request for reexamination of claims 1-25 of the '567 patent. A corrected request was filed on June 3, 2010, and it was assigned reexamination control No. 90/009,715 (the '9715 proceeding).

10. On June 11, 2010, the Office issued an order granting reexamination in the '9715 proceeding.

11. A patent owner's statement under 37 CFR 1.530 has not been filed in the '9715 proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 11/031,952 and reexamination proceeding No. 90/009,715 are both currently pending. The order to reexamine has been mailed in the reexamination proceedings, the time for filing a patent owner's statement under 37 CFR 1.530 has expired, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The

reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of multiple proceedings. In making a decision on whether or not to merge multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the instant reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the *ex parte* reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and multiple *ex parte* reexamination proceedings under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that the severed reexamination proceeding is an independent proceeding, and a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the reissue and reexamination proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the file for reissue application 11/031,952 reveals the presence of: amended claims 1-2, 4-9, 16, 20-24; original claims 3, 10-15, 17-19 and 25 amended by virtue of their dependence on amended claims; newly added claims 26-98 and an amendment to

the specification. A review of the file for reexamination control No. 90/010,128 reveals the presence of original claims 1-25 and the original specification. Accordingly, the claims and specification are not identical in both proceedings.

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision, placing the same amendments in both proceedings, specifically, Application No. 11/031,952 and Control Number 90/009,715. The response to this requirement must be **strictly limited** to formally placing the same amendment in each **file so that the specification, claims, and drawings are identical in both cases**. The patent owner must **NOT** address any issue of patentability in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for both files (i.e., the reissue application number and the *ex parte* reexamination proceeding control number) and a signature. The housekeeping amendment must be filed in duplicate for entry into the reissue application file and the *ex parte* reexamination file.

It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice. The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).**

To avoid confusion as to the number of times a claim has been amended in the '952 application and the reexamination proceeding in the present merged proceeding, it is preferred that patent owner use the status identifier "Amended" in the housekeeping amendment instead of "Twice Amended," etc. **No other amendments to the claims are permitted as part of this housekeeping amendment.**

See MPEP 1453 for a complete discussion of amendment practice in reissue applications.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) is to be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention. The disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data *for cases*, i.e, the reissue application and the reexamination proceeding, and each action will be entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in both files, with each of them bearing a signature. Any such response must contain identifying data *for both cases*, i.e, the reissue application and the reexamination proceeding.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application: "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

   Thus, the filing of any amendments to the specification, claims, or drawings must comply with the provisions of 37 CFR 1.173, and with the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claims fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example,

only one fee need be paid for any patent owner appeal brief, even though such a brief would relate to the merged multiple proceedings, and even though copies must be filed (as pointed out above) for each file of the merged proceeding.

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. 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 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 for consideration in reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, then the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/031,952 and Reexamination Proceeding No. 90/009,715 **<u>are merged</u>** into a single proceeding.

2. Pursuant to Part II of this decision, a housekeeping amendment is required within **ONE MONTH** of this decision, placing the same amendments in both files of the present merged proceeding.

3. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136**(b)** where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after a final rejection.

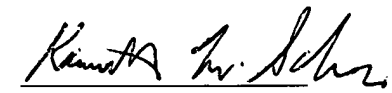
4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d).

5. The merged reissue and reexamination proceedings will be examined in Technology Center 3600. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '567 patent (e.g., by preparing/signing an action). See: MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

6. Patent owner is reminded to serve any responses on the requester.

7. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

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



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9-29-10

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In re Badorc et al.	:
Reexamination Proceeding	: DECISION ON
Control No. 90/009,721	: PETITION UNDER
Filed: April 5, 2010	: 37 CFR 1.515(c) AND
For: U.S. Patent No. 4,847,265 C1	: 1.181

The third party Requester filed a paper on July 23, 2010, entitled "PETITION UNDER 37 C.F.R. §§ 1.515(c) AND 1.181 TO REVIEW REFUSAL TO GRANT *EX PARTE* REEXAMINATION REQUEST" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed June 23, 2010. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 4,847,265 C1 (hereinafter, the '265 patent) issued on July 11, 1989.

2. A first request for *ex parte* reexamination was filed on June 1, 2009. The resulting reexamination proceeding was assigned Control No. 90/009,474 (hereinafter, the '474 proceeding). Reexamination was requested for claims 1-7 of the '265 patent based upon U.S. Patent 4,529,596 to Aubert (the '596 patent) and 30 other references. The request was granted and a Notice of Intent to Issue Reexamination Certificate (NIRC) confirming patentability of claims 1-7 was mailed March 26, 2010. The reexamination certificate was issued June 29, 2010.

3. A second request for *ex parte* reexamination was filed on April 5, 2010. The resulting reexamination proceeding was assigned Control No. 90/009,721 (the '721 proceeding). Reexamination was requested for claim 3 of the '265 patent based upon the prior art cited in the '474 proceeding and 107 additional references.

4. A Notice of Reexamination Request Filing Date for the '721 proceeding was issued on April 21, 2010.

5. An order denying the request for reexamination for claim 3 in the '721 proceeding was mailed on June 23, 2010.

6. On July 23, 2010, the third party requester filed the present petition under 37 CFR §§ 1.515(c) and 1.181 in the '721 proceeding.

<u>Petitioner's Grounds in Support of the Requested Relief</u>

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner improperly concluded that the teachings of the new references are cumulative to the prior art already considered by the USPTO.

DECISION

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, the review will determine whether the examiner's refusal to order reexamination for claim 3 was correct, and will

not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claim 3 of the '265 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claim 3. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition) nor any additional SNQs proposed for the first time in the petition.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

In order to raise a SNQ for old art, the old art must be presented/viewed in a <u>new light</u>, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. A SNQ is not raised by the old prior art, however, if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

[1] Public Law 96-517, enacted on December 12, 1980.

"Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."[2,3] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order, and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

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[2] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
[3] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

(A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.
Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

III. Prosecution History

Claim 3 is drawn to clopidogrel bisulphate. In prosecution of application 07/155,550, which became the '265 patent, the '596 patent was applied against claim 3 in a rejection under 35 U.S.C. 102(b) (Office action of November 4, 1988). The examiner noted that the '596 patent discloses a racemic mixture (MATTCPA), and that the rejection could be overcome by amending the claim to recite that the dextrorotary isomer is substantially pure. Applicant did so, and the claim was allowed.

In the '474 proceeding, claim 3 was rejected under § 103 and the doctrine of obviousness type double patenting over the '596 patent and other references which disclose salts of MATTCPA, in combination with references which teach the state of the prior art regarding separation of racemates into enantiomers and formation of pharmaceutically acceptable salts (Office action of December 18, 2009). The rejections were subsequently withdrawn in view of Patent Owner's response of February 18, 2010, which focused largely on the unpredictability of the art.

When the prior art discloses a genus of chemical compounds, a species within that genus may or may not be obvious (MPEP 2144.08). One factor to be taken into account is the number of species in the genus. The '596 patent discloses a generic structure and states that enantiomers and pharmaceutical salts are also part of the invention (col. 1). It is estimated that the generic structure encompasses approximately 75,000 different enantiomers. Berge (R26) provides a list of FDA approved, commercially marketed salts (p. 2) which includes 53 anions and 14 cations. Assuming the skilled artisan would be most likely to test these counter ions, one arrives at an estimate of approximately 4,000,000 pharmaceutical salts of enantiomers which might be made and tested for activity, which is a large genus. Even taking MATTCPA as a starting point, there would be over 100 enantiomeric salts in this subgenus.

Another important factor to be considered is the predictability of the technology. In the '474 proceeding, the Office essentially adopted Requester's positions in the non-final rejection of December 18, 2009. It was found that 1) the hydrochloride salt of

MATTPCA inhibited platelet aggregation and was well tolerated in test subjects, 2) one skilled in the art knew how to separate enantiomers from a racemic mixture, 3) there was motivation to do so because it was known that one enantiomer frequently possesses most or all of the biological activity and government agencies encourage study of the different isomers of racemic mixtures, and 4) hydrogen sulfate is conventionally used to produce pharmaceutical salts. Patent Owner's response pointed out the unpredictability of the art, viz., one can not predict 1) whether one enantiomer will possess all of the biological activity of a racemic mixture, 2) which method (solvent system, etc.) will be effective for separating enantiomers, nor 3) the properties of a pharmaceutical salt, and therefore which of the many possible salts will be most advantageous for drug formulation and clinical use. It was also unexpected that one enantiomer would possess all the desired biological activity while the other would possess all the toxicity of the racemic mixture. This unexpected result is a factor in the commercial success of the invention. Ultimately the Office concluded that the evidence showing unpredictability of the art outweighed the evidence of predictability, and patentability of claim 3 was confirmed.

IV. Analysis of the Request for Reexamination

Requester considers claim 3 unpatentable over the '596 patent, in combination with the other cited prior art, on the grounds of obviousness under 35 U.S.C. § 103 and obviousness type double patenting. The Request is framed as 15 separate SNQs.

A. The '596 patent in combination with R70-R73

Newly cited references R70-R73 are non-prior art patent documents which Requester casts as "admissions" that clopidogrel is disclosed in the '596 patent. The '596 patent discloses clopidogrel as a member of a very large genus, as discussed above, but it does not specifically disclose clopidogrel. This fact was acknowledged in the prosecution of the '550 application and the '474 proceeding. Since this information is not new, there is no new technological teaching that would be important to a reasonable examiner.

B. The '596 patent alone

Requester relies on the "admissions" discussed in section A above to craft an argument that claim 3 is unpatentable by double patenting over the '596 patent. There is no new technical information here, as noted above. Requester's comments are legal arguments. Since this information is not new, there is no new technological teaching that would be important to a reasonable examiner.

Turning to the petition, Requester argues that the Office incorrectly applied the law regarding obviousness-type double patenting in the '474 proceeding. This argument is not persuasive. The reexamination process does not include revisiting decisions

previously made on essentially the same facts; it is an opportunity for requesters to present new technological information that should have been considered. As discussed above, the newly cited references do not provide any new technical information.

C. The '596 patent in combination with R54 and R58-R62

The newly cited references describe production of hydrochloride and bisulfate salts of compounds structurally and functionally unrelated to clopidogrel. This does not provide any new technical information that would have been important to a reasonable examiner in determining the patentability of one or more claims because it was known that these types of salts, and many others, can be used for production of pharmaceuticals as shown by previously considered R26 (Berge). Berge teaches, "Unfortunately, there is no reliable way of predicting the influence of a particular salt species on the behavior of the parent compound" (p. 1). The obviousness analysis discussed above hinges on the predictability of the art. The new references, mostly published before Berge, are random data points which do nothing to establish that the art was predictable. Therefore a reasonable examiner would not find them important in determining whether claim 3 is patentable.

The petition argues that the new references "teach much to the skilled person, and promote the skilled person's chance of success." This argument is not persuasive because the fact that bisulfate salts were used for production of pharmaceuticals was specifically noted in the '474 proceeding. See Office action of December 18, 2009, paragraph bridging pp. 11-12. Absent any relationship between the pharmaceuticals disclosed in the new references and the one at issue in this proceeding, the new references do not provide any further information beyond what was already acknowledged (and relied upon in a rejection) in the '474 proceeding. This does not provide a new technological teaching that would be important to a reasonable examiner in determining the patentability of one or more claims.

D. The '596 patent in combination with R43-R49, R52, R53 and R66

Requester's purpose in citing the new references appears to be supplementation of Berge with more recent art showing that bisulfate salts were used as pharmaceuticals. As with the references in section C above, there is no correlation between these drugs and clopidogrel and the references do not tend to show that the art is predictable. According to previously cited R25 (Gould), published 9 years after Berge and less than a year before the '265 patent's foreign priority date, "Each drug and its associated range of dosage forms will present different salt form requirements" (p. 204) and, "The balance required in assessing the correct salt form to progress into drug development makes it a difficult semi-empirical exercise" (p. 213). Since the newly cited references do not relate directly to clopidogrel and do not relate to the overall predictability of the art, this does not provide a new technological teaching that would be important to a reasonable examiner in determining the patentability of one or more claims.

In the petition, Requester argues that the references provide new information because Berge indicates that bisulphate salts were not FDA-approved. This is not persuasive because Berge teaches that bisulphate salts were commercially marketed. Clearly this type of pharmaceutical salt had received regulatory approval in countries other than the U.S., and the Office relied on this finding in rejecting claim 3 in the '474 proceeding. The petition also relies on conclusory statements such as "it can be seen, *e.g.,* that cyclomethycaine sulfate, like clopidogrel, has its only nitrogen atom within a heterocyclic ring, and the nitrogen atom is bonded to three carbon atoms. Thus, this is suggestive that a bisulfate salt of clopidogrel would be formed similar to the bisulfate salt of cyclomethycaine sulfate" (p. 54) and "It can be seen there is a C-O-Y group directly adjacent (alpha) to the asymmetric carbon. This is exactly the same arrangement as clopidogrel, which likewise has a carbonyl (C=O) group adjacent to the asymmetric center. Thus, the "risk" of chemical racemization at the asymmetric carbon should be similar for both L-Dopa and clopidogrel" (p. 56). These conclusions are attorney arguments not supported by any evidence that the references would be so interpreted by one skilled in the art. Finally, even if Requester's arguments are accepted, they are contrary to the teachings of the prior art (previously submitted by Requester) which indicate that "paper chemistry" can not predict the properties of pharmaceutical salts – they must be determined empirically. Therefore a reasonable examiner would not find these new references important in deciding whether claim 3 is patentable given the state of the record in the prior examination and reexamination.

E. The '596 patent in combination with R32-R34, R65 and R67

The newly cited references review methods for resolution of enantiomers. This does not provide any technical information which was not available in the '474 proceeding, in which the Office found, "at the time of the invention, the general methods for resolving racemate, including the instant diastereomeric salt formation process employing the optically active camphorsulfonic acid as the resolving agent, were well-known in the art" (Office action of December 18, 2009, p. 9). This was reiterated in the NIRC mailed March 26, 2010, but it was also found that "the evidence of record supports the...finding of unpredictable and unusual therapeutic properties of the claimed dextro-rotatory isomer of MATTPCA or the salts thereof" (p. 3). The newly cited references do not relate to thienopyridines, nor do they address the unexpected properties of clopidogrel. Therefore a reasonable examiner would not find these new references important in deciding whether claim 3 is patentable given the state of the record in the prior examination and reexamination.

The petition argues that the methods used to resolve MATTPCA into its enantiomers were known in the art. This argument is not persuasive because, as Requester admits, the claims are drawn to a product, not a purification method.

F. The '596 patent in combination with R32, R34 and R37-39 and
G. The '596 patent in combination with R34

The newly cited references show that the "method of half quantities" was known in the art and that racemates with a C-O-Y group had been resolved. As with the references' in section E above, the newly cited references do not relate to thienopyridines, nor do they address the unexpected properties of clopidogrel. Therefore a reasonable examiner would not find these new references important in deciding whether claim 3 is patentable given the state of the record in the prior examination and reexamination.

Requester's arguments in the petition parallel those regarding (E) above, and are not persuasive for the same reason. In view of the unexpected properties of clopidogrel, a reasonable examiner would not consider further evidence regarding methods of resolving racemates important in determining whether claim 3 is patentable.

H. The '596 patent in combination with R4, R6, R13, R35, R36 and R42

The newly cited references teach that the ADP receptor in platelets is stereoselective. The fact that many receptors show stereoselectivity was brought out in the '474 proceeding. The "old" art also shows that platelets have more than one ADP receptor (R13), and there are other receptors throughout the body. Newly cited R35 and R36 do not add any new technical information that was not previously before the Office. Newly cited R42 provides more detail about the platelet ADP receptor's interaction with ADP, but there is no information regarding interaction with MATTCPA or its enantiomers. There is no direct evidence that these molecules bind the ADP receptor, nor that the chiral carbon is contained in the portion of the molecule that binds. There is also no information regarding the interaction of MATTCPA or its enantiomers with other receptors, which may account for toxicity or unwanted side effects. The unexpected separation of biological activities between the two enantiomers is summarized in the table at p. 88 of the request. Nothing in the newly cited references would have led the skilled artisan to predict this outcome. The new references do not relate directly to the claimed invention and do not demonstrate that the art is predictable. Therefore a reasonable examiner would not find them important in determining whether claim 3 is patentable and there is no SNQ.

In the petition, Requester argues that one skilled in the art would expect that one enantiomer of MATTPCA would be active. This argument is not persuasive for the reasons set forth above. In particular, the references do not show that one skilled in the art would expect the desirable effects of MATTPCA to be produced by one enantiomer while the other produces the undesirable effects.

I. The '596 patent in combination with R50

Newly submitted R50 teaches that vitamin D becomes active upon hydroxylation. This does not provide any new technical information with regard to the claimed invention. Absent any correlation between vitamin D and MATTPCA, this information would not

motivate the skilled artisan to modify MATTPCA or related compounds in any way. Therefore a reasonable examiner would not find R50 important in determining whether claim 3 is patentable and there is no SNQ.

J. Litigation documents and
N. Litigation documents

Requester submits various documents from previous litigation of the '265 patent. Whatever information might be contained in these documents, it would not have been publicly available before the effective filing date of the '265 patent. The documents provided here do not provide any new publicly available prior art, and so a reasonable examiner would not find them important in determining patentability of claim 3.

In the petition, Requester argues that the Office erred in confirming patentability of claim 3 in the '474 proceeding. As noted above, "examiner error" can not serve as the basis for a SNQ. Requester's accusations against Patent Owner (cherry picking, misleading the Office, lack of candor, chicanery, etc.) will not be entertained. A reexamination proceeding is a venue for determining patentability in light of new technical information found in the prior art, not for re-litigation of a patent. The documents provided here do not provide any new publicly available prior art, and so a reasonable examiner would not find them important in determining patentability of claim 3.

K. The '596 patent in combination with R40

Newly cited R40 describes toxicological testing of chemical compounds. There is nothing specific to clopidogrel or any related compound. To the extent that Requester intends to demonstrate that this would motivate the skilled artisan to resolve the racemic MATTPCA, the reference is cumulative because it was already found in the '474 proceeding that motivation to do so existed. To the extent that Requester argues that knowledge of how LD_{50}, therapeutic index, etc. are calculated would enable one to predict that the enantiomers of MATTPCA would have the properties summarized at p. 88 of the request, this line of reasoning is not credible absent any evidence that those skilled in the art can actually make such predictions accurately. Therefore a reasonable examiner would not find R40 important in determining whether claim 3 is patentable.

Requester's petition argues that there is no surprising result because other examples were known in which therapeutic effects and side effects were not correlated with the same enantiomer of a chiral compound. This argument is not persuasive. It is agreed that one skilled in the art might not be surprised to learn that such a result was obtained with any given compound, but that does not mean that the skilled artisan would know in advance that this would prove to be the case. Requester is essentially arguing that one could know, given the '596 patent and a toxicology textbook, that one particular enantiomer out of the many chiral compounds disclosed in the patent would prove to be a significant improvement over the corresponding racemic mixture. Absent evidence

that one can accurately predict such outcomes from the preliminary data presented in the '596 patent, this argument is essentially cumulative to information already considered by the examiner. Therefore a reasonable examiner would not consider the newly cited reference important in determining whether claim 3 is patentable.

L. The '596 patent in combination with R4, R8, R12, R41, R55, R63 and R64

The newly submitted references are cited for what they do not disclose, i.e. they do not state that ticlopidine can cause neurotoxicity. An absence of disclosure would not be viewed by a reasonable examiner as "new information," and therefore there is no new technological information that would form the basis for an SNQ.

The petition's argument that the Office did not correctly apply the case law regarding obviousness is not persuasive. The fact that neurotoxicity of ticlopidine was not disclosed in the prior art or the specification does not negate the fact that reduced neurotoxicity of clopidogrel provides an unexpected advantage over the prior art. Moreover, if the newly cited documents do not mention neurotoxicity of ticlopidine, and the prior art already considered in previous proceedings also does not mention the neurotoxicity, then even if lack of such disclosure can be considered "information," this information is not new.

M. The '596 patent in combination with R4, R6, R8, R10, R12, R41, R55-R57, R63, and R64

As with section L above, the newly cited references are cited to show lack of information regarding ticlopidine. It is not understood how lack of knowledge can be construed as new technical information. Moreover, the lack of prior knowledge of toxic properties of ticlopidine would not negate any advantage provided by use of clopidogrel instead. Therefore a reasonable examiner would not find the new references important in determining whether claim 3 is patentable.

O. Argument

Requester's proposed SNQ O is based on argument alone, with no citation of prior art. This is not new technological information that would be important to a reasonable examiner in determining the patentability of one or more claims.

CONCLUSION

1. The PETITION is DENIED.

2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered. This decision is without prejudice to requester's filing a new request for reexamination.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

Gregory A. Morse, Director 9/30/10
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,727	06/09/2010	7663091	CTEN01RXU2	7621

43344 7590 04/14/2011

KRAJEC PATENT OFFICES, LLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date: MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009727
PATENT NO. : 7663091
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

APR 14 2011

CENTRAL REEXAMINATION UNIT

Quinn Law Group PLLC
39555 Orchard Hill Place
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(For requester)

In re Theodore Bruce Ziemkowski et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,727
Filed: June 9, 2010
For: U.S. Patent No. 7,663,091

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

This is a decision on the March 22, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the March 22, 2011 patent owner petition to revive").

The March 22, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 22, 2011 patent owner petition to revive is **granted**.

The March 8, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 4, 2010 Office action is **withdrawn**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 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:

(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 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.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the November 4, 2010 Office action pursuant to

37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The November 4, 2010 Office action set a two-month period for response. However, a response to the November 4, 2010 Office action was not filed until January 16, 2011, which was untimely. Nevertheless, for the purpose of evaluating whether the March 22, 2011 patent owner petition to revive is a grantable petition, patent owner's submission of the January 16, 2011 Response To Office Action In Ex Parte Reexamination satisfies item (1).[1]

Patent owner has been charged the $810.00 petition fee, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted on March 22, 2011, thereby satisfying item (3).

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Accordingly, the March 22, 2011 patent owner petition to revive is **granted**.

The March 8, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 4, 2010 Office action is **withdrawn**.

CONCLUSION

1. The March 22, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The March 8, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an appropriate response to the November 4, 2010 Office action is **withdrawn**.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Alexander Kosowski, of CRU Art Unit 3992, at (571) 272-3744.

---

[1] This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's January 16, 2011 Response To Office Action In Ex Parte Reexamination as to each of the rejections set forth in the November 4, 2010 Office action or (ii) the January 16, 2011 response's compliance with formal matters; such is the examiner's province.

[2] *See*: 37 CFR 1.137(d)(3).

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

04/14/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,731	04/29/2010	5191525	1484.20	9139

32233 7590 12/14/2010

STORM LLP
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901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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180 PINE AVENUE NORTH
OLDSMAR, FL 34677

Date:

MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009731
PATENT NO. : 5191525
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,824	09/16/2010	5191525	1484.22	7688

32233 7590 12/14/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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Date:

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DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009824
PATENT NO. : 5191525
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,756	06/04/2010	5191525	1484.21	6813

32233 7590 12/14/2010

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EXAMINER

ART UNIT	PAPER NUMBER

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Date:

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DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009756
PATENT NO. : 5191525
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

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OLDSMAR, FL 34677

(For Third Party Requester)

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,824
Request Deposited: September 16, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,731
Request Deposited: May 29, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,756
Request Deposited: June 4, 2010
For: U.S. Patent No. 5,191,525

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,191,525 (hereinafter, the '525 patent), issued to LeBRUN *et alia*, on March 2, 2003.

2. On September 16, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,824 (hereinafter, the '9824 proceeding).

3. On May 29, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,731 (hereinafter, the '9731 proceeding).

4. On June 4, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,756 (hereinafter, the '9756 proceeding).

5. The Reexamination Order is granted in the '9824 proceeding on concurrently herewith.

6. The Reexamination Order was granted in the '9731 proceeding on July 17, 2010.

7. The Reexamination Order was granted in the '9756 proceeding on August 2, 2010.

8. There are currently no amendments in any pending proceeding.

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 each of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9824, '9731 and the '9756 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009824, 90/009731 and 90/009756 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

3. **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.

4. 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.

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, 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.
90/009,732	04/26/2010	6,118,894	A126.811.102	5871

7590 09/07/2010

MARK D. SARALINO
RENNER OTTO BOISSELLE AND SKLAR
1621 EUCLID AVENUE
NINTEENTH FLOOR
CLEVELAND, OH 44115-2191

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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.
90/009,732	04/26/2010	6,118,894	A126.811.102	5871

7590 09/07/2010

EXAMINER

DICKE, BILLIG & CZAJA, PLLC
FIFTH STREET TOWERS, SUITE 2250
100 SOUTH FIFTH STREET
MINNEAPOLIS, MN 55402

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark D. Saralino
Renner Otto Boisselle and Sklar
1621 Euclid Avenue
Ninteenth Floor
Cleveland OH 44115-2191

(For Patent Owner)

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Dicke, Billig & Czaja, PLLC
Attn: Christopher J. McLaughlin
Fifth Street Towers Suite 250
100 South Fifth Street
Minneapolis, MN 55402

(For Third Party Requester)

In re LeBrun *et alia*
Reexamination Proceeding
Control No. 90/009,515
Request Deposited: July 8, 2009
For: U.S. Patent No. 6,118,894

In re LeBrun *et alia*
Reexamination Proceeding
Control No. 90/009,732
Request Deposited: April 26, 2010
For: U.S. Patent No. 6,118,894

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,118,894 (hereinafter, the '894 patent), issued to Schwartz *et alia*, on September 12, 2000.

2. On July 8, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '894 patent. The reexamination proceeding was assigned Control No. 90/009,515 (hereinafter, the '9515 proceeding).

3. On April 26, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '894 patent. The reexamination proceeding was assigned Control No. 90/009,732 (hereinafter, the '732 proceeding).

4. The Reexamination Order was granted for claims 1-22 in the '515 proceeding on October 1, 2009. Prosecution has resulted in amendments to the claims. In particular, claims have been added.

5. The Reexamination Order was granted for claim 1-22 in the '732 proceeding on June 21,2010.

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.

In accordance with 37 C.F.R. § 1.565(c), the '515 and the '732 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.

As noted above, claims have been added by amendment in the '515 proceeding. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

Patent owner is reminded that amendments in reexamination proceedings must meet the requirements of 37 CFR 1.530 (d) – (i). In particular, all changes to the patent claims must be indicated. New claims must be fully underlined. The "housekeeping" amendment must be in full compliance with 37 CFR 1.550 and bring the claims in the '732 proceeding in line with those presently presented in the '515 proceeding.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/009515 and 90/009732 are MERGED.

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.

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

/J. Harrison/

Jessica Harrison
SPE AU 3992 Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,751	05/21/2010	6,206,349	15258-317	5294

7590 06/03/2011

J GEORG SEKA
TOWNSEND & TOWNSEND & CREW
TWO EMBARCADERO CENTER
8th FLOOR
SAN FRANCISCO, CA 94111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2011

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
WINSTEAD PC
P.O. BOX 50784
DALLAS, TX 75201

Date: MAILED
JUN 03 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009751
PATENT NO. : 6206349
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 90/009,751

1. THIS IS A DECISION ON THE PETITION FILED May 31, 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 mailed on April 14, 2011, which sets a two-month period for filing a response thereto, be extended by two months.

   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 **one month**, 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 Response is due on July 14, 2011

   Telephone inquiries with regard to this decision should be directed to Deborah Jones_____ at 571-272-1535 in the Central Reexamination Unit.

   Deborah Jones 6/2/2011 — DEBORAH D. JONES, CRU [illegible] 3991
   [Signature] (Title)

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,756	06/04/2010	5191525	1484.21	6813

32233 7590 12/14/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Anton J. Hopen
SMITH HOPEN PA
180 Pine Ave. North
Oldsmar, FL 34677

Date:

MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009756
PATENT NO. : 5191525
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

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.
90/009,824	09/16/2010	5191525	1484.22	7688

32233 7590 12/14/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

Date: MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009824
PATENT NO. : 5191525
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

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.
90/009,731	04/29/2010	5191525	1484.20	9139

32233 7590 12/14/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANTON J. HOPEN
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

Date:
MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009731
PATENT NO. : 5191525
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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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

DEC 14 2010

CENTRAL REEXAMINATION UNIT

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

(For Patent Owner)

SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

(For Third Party Requester)

SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

(For Third Party Requester)

SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

(For Third Party Requester)

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,824
Request Deposited: September 16, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,731
Request Deposited: May 29, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,756
Request Deposited: June 4, 2010
For: U.S. Patent No. 5,191,525

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,191,525 (hereinafter, the '525 patent), issued to LeBRUN *et alia*, on March 2, 2003.

2. On September 16, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,824 (hereinafter, the '9824 proceeding).

3. On May 29, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,731 (hereinafter, the '9731 proceeding).

4. On June 4, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,756 (hereinafter, the '9756 proceeding).

5. The Reexamination Order is granted in the '9824 proceeding on concurrently herewith.

6. The Reexamination Order was granted in the '9731 proceeding on July 17, 2010.

7. The Reexamination Order was granted in the '9756 proceeding on August 2, 2010.

8. There are currently no amendments in any pending proceeding.

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 each of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9824, '9731 and the '9756 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009824, 90/009731 and 90/009756 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

3. **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

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401 Dulany Street
Alexandria, VA 22314

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4. 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.

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Townsend and Townsend and Crew, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

For Patent Owner

MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

Jordan and Hamburg
122 East 42nd Street
Suite 4000
New York, NY 10168

For 3rd Party Requester
90/009,759

McAfee & Taft
Tenth Floor, Two Leadership Square
211 North Robinson Ave.
Oklahoma City, OK 73102

For 3rd Party Requester
90/011,241

Ex Parte Reexamination Proceeding
Control No. 90/009,759
Filed: June 14, 2010
For: U.S. Patent No. 6,588,863

Ex Parte Reexamination Proceeding
Control No. 90/011,241
Filed: September 29, 2010
For: U.S. Patent No. 6,588,863

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/009,759 and 90/011,241 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. 90/009,759 was ordered in a decision mailed July 23, 2010, granting reexamination of claims 1-24, all of the claims in U.S. Patent No.

6,588,863. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner and the requester.

Reexamination in application Control No. 90/011,241 was ordered in a decision mailed November 4, 2010, indicating that claims 1-24, all of the claims in U.S. Patent No. 6,588,863 would be reexamined. Pursuant to the pilot program "Pilot Program for Waiver of Patent Owner's Statement in *Ex Parte* Reexamination Proceedings", 75 Fed. Reg. 47,269 (August 5, 2010), a telephone call was placed to patent owner's counsel on September 15, 2010, requesting waiver of a Patent Owner's Statement. Patent owner's counsel agreed to waive its rights to file a statement under 35 USC 304. No Office action has been rendered since the mailing of the decision ordering reexamination, nor have any papers been filed by patent owner, the requester.

As evidenced by the above facts, reexamination Control No. 90/009,759 and reexamination control No. 90/011,241 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-24 are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper will be entered into each of the 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 each of the third party requesters and requesters 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.

Conclusion

Reexamination control Nos. 90/009,759 and 90/011,241 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

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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.
90/009,763	06/18/2010	6134461	TS-02-164-RE4	4634

30349 7590 01/20/2011

JACKSON & CO., LLP
6114 LA SALLE AVENUE
#507
OAKLAND, CA 94611-2802

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/20/2011

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130-2040

Date:

MAILED

JAN 20 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009763
PATENT NO. : 6134461
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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Jackson & Co., LLP 6114 La Salle Avenue #507 Oakland, CA 94611-2802	:	(For Patent Owner) MAILED JAN 20 2011 CENTRAL REEXAMINATION UNIT
Peng Chen Morrison & Foerster, LLP 12531 High Bluff Dr. San Diego, CA 92130-2040	:	(For Third Party Requester)
In re *Say et al.* *Ex Parte* Reexamination Proceeding Control No. 90/009,763 Filed: June 8, 2010 For: U.S. Patent No. 6,134,461	:	DECISION ON PETITION UNDER 37 CFR 1.181

The paper filed by requester on September 17, 2010, entitled "Petition Under 37 CFR § 1.515 or §§ 1.182-1.183" (hereinafter "the Petition") is being treated as a petition filed under 37 CFR § 1.181 and is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Granting the Request for *Ex Parte* Reexamination, which denied the request in part, mailed August 18, 2010.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,134,461 (hereinafter, the '461 patent) issued on October 17, 2000.

2. A first request for *ex parte* reexamination was filed by third party requester on August 16, 2006. The resulting reexamination proceeding was assigned Control No. 90/008,173 (hereinafter, the '173 proceeding).

3. A second request for *ex parte* reexamination was filed by third party requester on November 16, 2007. The resulting reexamination proceeding was assigned Control No. 90/008,928 (hereinafter, the '928 proceeding).

4. The '173 proceeding and the '928 proceeding were merged in a decision mailed September 4, 2008.

5. A third request for *ex parte* reexamination was filed by third party requester on January 27, 2010. The resulting reexamination proceeding was assigned Control No. 90/010,835 (hereinafter, the '835 proceeding).

5. A reexamination certificate was issued for the merged '173 and '928 proceedings on June 29, 2010. This certificate amended claim 1 and added new claims 30-188.

6. An order granting the request for reexamination in the '835 proceeding was mailed on March 12, 2010.

7. In the instant proceeding, the '763 proceeding, reexamination was requested for claims 1-4 and 33-188 of the '461 patent.

8. An order granting the request for claims 138-188 and denying the request for claims 1-4 and 33-137 was mailed on August 18, 2010.

6. On September 17, 2010, the third party requester filed the present Petition, which is being treated as a petition filed under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination for claims 1-4 and 33-137 is inconsistent with Office policy and procedures. Specifically, the petitioner argues that the Wilkins reference raises a substantial new question of patentability (SNQ) with respect to claims 1-4 and 33-137 because Wilkins teaches both the "rate of permeation" and "continuous operation" limitations in independent claims 1, 64 and 100.

DECISION

I. Standard of Review

37 CFR 1.515(c) provides for the filing of a petition under 37 CFR 1.181 to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-4 and 33-137 was correct, and will not necessarily indicate agreement or disagreement with

every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-4 and 33-137 of the '461 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 303 reveals that, by statute, *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination

[1] Public Law 96-517, enacted on December 12, 1980.

of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.[2] Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."[3,4] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

The Request was denied in part in the August 18, 2010 Order Granting the Request for *Ex Parte* Reexamination, wherein the examiner maintained that a SNQ was not raised by the Wilkins reference cited in the Request.

As pointed out above, 37 CFR 1.515(c) provides for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of Wilkins for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

---

[2] This requirement is not applicable to Director ordered reexaminations.
[3] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
[4] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

Turning to the petition, petitioner argues that the examiner improperly decided that the Wilkins reference did not raise an SNQ because, in the previous reexamination (the merged '173 and '928 proceedings), the examiner considered and applied the Shichiri I and Shichiri III references that collectively teach both the "rate of permeation" and "continuous operation" limitations. Petitioner points out at pages 19-21 of the petition that the examiner decided in the previous reexamination that neither Shichiri I nor Shichiri III taught both limitations, and the rejections based on these references were withdrawn (see pages 14-16 of the petition). A review of the record indicates that petitioner's assertions are correct. Wilkins does indeed teach a glucose sensor that can be stably operated *in vitro* for approximately two weeks (see pages 489-491 and Figs. 3 and 4 of Wilkins). Thus, Wilkins teaches the express limitation that was added to claim 1 during the previous merged reexamination and that resulted in the withdrawal of the rejections based upon the Shichiri I and Shichiri III references (see page 16 of the petition).

It is thus concluded that a reasonable examiner would consider the above evaluation of the Wilkins reference as important in determining the patentability of claims 1-4 and 33-137of the '462 patent. As such, it is agreed with requester that a substantial new question of patentability with respect to claims 1-4 and 33-137 of the '462 patent has been raised by the request.

Because it is agreed that Wilkins raises a SNQ with respect to claims 1-4 and 33-137 of the '462 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 1-4 and 33-137 of the '461 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served

upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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Jackson & Co., LLP
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For Patent Owner

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AUG 25 2011

CENTRAL REEXAMINATION UNIT

Morrison & Foerster LLP
12531 High Bluff Drive, Suite 100
San Diego, CA 92130-2040

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,835
Filed: January 27, 2010
For: U.S. Patent No. 6,134,461

Ex Parte Reexamination Proceeding
Control No. 90/009,763
Filed: June 18, 2010
For: U.S. Patent No. 6,134,461

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Art Unit 3993 of the Central Reexamination Unit 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. 90/010,835 was ordered in a decision mailed March 12, 2010. It is noted that the request for this reexamination indicates that claims of claims 1-4, 28, and 30-188 would be reexamined[1]. No patent owner statement under 37 CFR 1.530(b) was

[1] It is noted that claims 30-188 were formally added to US patent 6,134,461 by virtue of reexamination certificate No. 7,582 published June 29, 2010.

filed in this reexamination proceeding. No office action has been rendered since the mailing of the decision ordering reexamination.

Reexamination in application Control No. 90/009,763 was ordered for claims 1-4, and 30-188 by virtue of the order granting reexamination mailed August 18, 2010 and a decision on petition mailed January 20, 2011. No patent owner statement under 37 CFR 1.530(b) was filed in this reexamination proceeding. No office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,835 and reexamination control No. 90/009,763 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, 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

The patent Owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-4, 28, and 30-188 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(s) and requester(s) 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. 90/010,835 and 90/009,763 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow, SPE AU 3993
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,769	07/23/2010	5808045	BLG-RE-00002	5114

21967 7590 02/07/2011

HUNTON & WILLIAMS LLP
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WASHINGTON, DC 20006-1109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/07/2011

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009769
PATENT NO. : 5808045
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:90/009,769

1. THIS IS A DECISION ON THE PETITION FILED February 3, 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 mailed on December 21, 2010, which sets a two-month period for filing a response thereto, be extended by one 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 _____, 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 Response is due on March 21, 2011

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at _____, 517-272-1535. In his/her absence, calls may be directed to _____, _____ in the Central Reexamination Unit.

   Deborah Jones
   [Signature]

   DEBORAH D. JONES
   CRU SPE-AU 3991
   (Title)

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CENTRAL REEXAMINATION UNIT

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FOR PATENT OWNER

STETINA, BRUNDA, GARRED & BRUCKER
75 ENTERPRISE
SUITE 250
ALISO VIEJO, CA 92656

FOR THIRD PARTY REQUESTER

In re Sinofsky	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/009,771	:	**UNDER**
Filed: June 30, 2010	:	**37 CFR 1.181**
For: U.S. Patent No. 6,547,780	:	

This is a decision on the January 28, 2011 patent owner petition, entitled "PETITION TO STRIKE UNDER 37 C.F.R. 1.181." Patent owner is requesting that the requester's papers regarding litigation, dated November 30, 2010 and January 17, 2011, be expunged from the record as improper papers.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision.

The petition is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed from the proceeding record.

STATEMENT OF RELEVANT FACTS

1. Patent No. 6,547,780 (the '780 patent) issued on April 15, 2003.

2. A request for reexamination, assigned Control No. 90/009,771 (the '771 proceeding), was filed by a third party requester on June 30, 2010.

3. Reexamination was ordered in the '771 reexamination proceeding on August 2, 2010.

4. The patent owner filed a notice of concurrent proceedings and litigation with exhibits on September 7, 2010.

5. The patent owner did not file a statement under 37 CFR 1.530.

6. On November 30, 2010, a first set of litigation documents were filed by the third party requester.

7. On January 17, 2011, a second set of litigation documents were filed by the third party requester.

8. On January 28, 2011, patent owner filed the present petition paper requesting that the requester's papers, dated November 30, 2010 and January 17, 2011, be expunged from the record as improper papers. On the same day, the patent owner filed a notice of concurrent proceedings and litigation.

BASIS OF DECISION

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 1.565(a) states:

> (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.

MPEP 2282 states, in part:

> "... 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. .... 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."

DECISION

The present petition filed in the reexamination proceeding is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed from the proceeding record.

As noted, *supra*, the request for reexamination of the '780 patent was filed on June 30, 2010. Reexamination was ordered on August 2, 2010. The time for filing the patent owner filed a statement pursuant to 37 CFR 1.530 expired on October 2, 2010, and the record in the '771 reexamination proceeding shows that the patent owner did not make any statement pursuant to 37 CFR 1.530. Accordingly, 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 submissions filed in the reexamination proceeding, unless the submissions are bare notice of litigation proceedings.

The requester's papers, dated November 30, 2010 and January 17, 2011, go beyond bare notice of litigation proceedings. While it is important that the Office be aware of any prior or concurrent proceedings of the '780 patent, the requester's papers, dated November 30, 2010 and January 17, 2011, contain arguments and non-merit decisions, which are deemed improper papers as set forth in MPEP 2282, and would not be considered by the examiner in the determination of patentability in a reexamination proceeding. The presence of such information in the public record may potentially have a negative or prejudicial effect on the public perception of the patent. Further, the record would be made unduly long and complex by the inclusion of material not relevant to the conduct of a reexamination proceeding, potentially making consideration by the examiner difficult and unfocused. Therefore, the requester's papers, dated November 30, 2010 and January 17, 2011, are improper papers in an *ex parte* reexamination proceeding. See 37 CFR 1.565(a) and the policy in MPEP 2282.

Upon review of the record, it is deemed that patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated September 7, 2010, contain improper papers because the papers contain party arguments. For this reason, these papers will be closed from the proceeding record.

In view of the above, the requester's papers, dated November 30, 2010 and January 17, 2011, and patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated September 7, 2010, do not have an entry right. Therefore, these papers will be expunged from

record in the '771 reexamination proceeding. As the papers have been entered into the electronic Image File Wrapper (IFW) record, the papers will be closed in the IFW record, and marked nonpublic to expunge it from the record. See MPEP 2267.

CONCLUSION

1. The January 28, 2011 petition is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed because they do not have a right of entry.

2. No copy of the requester's papers, dated November 30, 2010 and January 17, 2011, and patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated September 7, 2010 will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.

3. Telephone inquiries related to the present decision should be directed to Supervisory Patent Examiner, Andy Kashnikow, at 571-272-4361.

Irem Yucel, Director
Technology Center 1600

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CENTRAL REEXAMINATION UNIT

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

For Patent Owner

Stetina, Brunda, Garred & Brucker
75 Enterprise
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Aliso Viejo, CA 92656

For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,771
Filed: June 30, 2010
For: U.S. Patent No. 6,547,780

Ex Parte Reexamination Proceeding
Control No. 90/011,284
Filed: October 15, 2010
For: U.S. Patent No. 6,547,780

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Art Unit 3993 for consideration of merger of the above-identified proceedings.

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. 90/009,771 was ordered in a decision mailed August 2, 2010. The decision indicated that claim 2, one of three claims left in the patent per the Reexamination Certificate No. 7547 issued June 1, 2010, would be reexamined. No patent owner statement was filed and no Office action on the merits has been issued in this proceeding.

Reexamination in application control No. 90/011,284 was ordered in a decision mailed November 22, 2010. The decision also indicated that claim 2, one of three claims left in the patent per the Reexamination Certificate No. 7547 issued June 1, 2010, would be reexamined. No patent owner statement was filed and no Office action on the merits has been issued in this proceeding.

As evidenced by the above facts, reexamination Control No. 90/009,771 and reexamination control No. 90/011,284 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, 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

The patent Owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claim 2, the only claim for which reexamination was requested and ordered 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(s) and requester(s) 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. 90/009,771 and 90/011,284 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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CENTRAL REEXAMINATION UNIT

Leason Ellis LLP 81 Main Street Suite 503 White Plains, NY 10601	:	(For Patent Owner)
Stetina Brunda Garred & Brucker 75 Enterprise Suite 250 Aliso Viejo, CA 92656	:	(For Third Party Requester)
In re *Sinofsky* *Ex Parte* Reexamination Proceeding Control No. 90/009,772 Filed: June 30, 2010 For: U.S. Patent No. 5,843,073	:	DECISION ON PETITION UNDER 37 CFR 1.181

The paper filed by requester on August 30, 2010, entitled "Petition From Denial of Request for Ex Parte Reexamination" (hereinafter "the Petition") is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed August 20, 2010.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 5,843,073 (hereinafter, the '073 patent) issued on December 1, 1998.

2. A request for *ex parte* reexamination was filed by third party requester on June 30, 2010. The resulting reexamination proceeding was assigned Control No. 90/009,772 (hereinafter, the '772 proceeding).

3. Reexamination was requested for claims 2 and 7 of the '073 patent.

4. A Notice of Reexamination Request Filing Date was issued on July 20, 2010.

5. An order denying the request for reexamination for claims 2 and 7 was mailed on August 20, 2010.

6. On August 30, 2010, the third party requester filed the present Petition, which is being treated as a petition filed under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges several grounds for which petitioner feels the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the following three main arguments:

1. The examiner's order improperly focuses on the citation of a "Nath" publication in the Goldman reference, stating that the Goldman reference could not have referred to the specific Nath reference cited in the request. Petitioner provides a declaration of Dr. Thomas Rox to support this argument.
2. The examiner's order does not appreciate that one of ordinary skill in the art would be motivated to combine the teachings of Goldman and Nath.
3. The examiner's conclusion that the flexible silica fibers having a low hydroxyl concentration, as taught by Nath, may be used for transmission of radiation in the near IR range, which has wavelengths that range from 0.7 to 1.3 μm, thereby excluding the possibility that the fibers of Nath could be used at wavelengths above 1.3 μm.

DECISION

I. Standard of Review

37 CFR 1.515(c) provides for the filing of a petition under 37 CFR 1.181 to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 2 and 7 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 2 and 7 of the '073 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 303 reveals that, by statute, *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The

[1] Public Law 96-517, enacted on December 12, 1980.

Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.[2] Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."[3,4] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

III. Analysis of the Request for Reexamination

The Request was denied in the August 20, 2010 Order Denying Request for *Ex Parte* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request.

As pointed out above, 37 CFR 1.515(c) provides for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of Goldman taken with Nath and combinations of Beck, Karbe and Bruckner for reasons set forth below. Accordingly, the petition is granted, and reexamination is hereby ordered.

Turning to the petition, petitioner's first argument is that the examiner improperly focused on the citation of a "Nath" publication in the Goldman reference, stating that the Goldman reference could not have referred to the specific Nath

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[2] This requirement is not applicable to Director ordered reexaminations.
[3] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
[4] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

reference cited in the request. Petitioner points out at pages 8-9 of the petition that the reference referred to in the Goldman patent could not have been the Bath reference cited in the request. The declaration of Dr. Thomas Rox supports this argument. A review of the record indicates that petitioner is correct: the "Nath" reference referred to in the Goldman patent is not the Nath reference cited in the request.

Furthermore, with respect to petitioner's second and third arguments, a review of the record indicates that, the disclosure in Goldman of the "Nath" publication, even if it is not the Nath reference cited in the request, provides the necessary SNQ required to grant a request for reexamination. In other words, the disclosure in Goldman suggests the use of high efficiency fibers, and provides an example of such fibers (e.g., the "Nath" publication mentioned). The Nath reference cited in the request teaches a special high efficiency tapered fiber that is designed to transmit near infrared radiation in medical procedures. The combination of the Goldman and Nath references thus raises the substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. Finally, the examiner's conclusion regarding the useable wavelengths for the Nath reference is unsupported and, as pointed out by petitioner, the Goldman reference itself defines the near infrared range as extending as high at 3.0 μm (see page 12 of the petition). Petitioner provides additional support of the extent of the near infrared range through exhibits attached to the petition (e.g., Cal Tech/NASA's Infrared Processing and Analysis Center's definition that extends the near infrared range to 5 μm. This evidence is also persuasive.

It is thus concluded that a reasonable examiner would consider the above evaluation of the Goldman patent taken with Nath and a combination Beck, Karbe and Bruckner as important in determining the patentability of claims 2 and 7 of the '073 patent. As such, it is agreed with requester that a substantial new question of patentability with respect to claims 2 and 7 of the '073 patent has been raised by the request.

Because it is agreed that the Goldman patent taken with Nath and a combination of Beck, Karbe and Bruckner raises a SNQ with respect to claims 2 and 7 of the '073 patent, the Petition is GRANTED. None of the other issues presented in the petition are addressed in this decision; it is not necessary to do so after it is determined that at least one substantial new question has been raised by the request for reexamination, as to all the claims requested.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *ex parte* reexamination of claims 2 and 7 of the '073 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2248.

4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

   For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

   For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 CFR 1.530(c), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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CENTRAL REEXAMINATION UNIT

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FOR THIRD PARTY REQUESTER

In re Sinofsky	:	
Reexamination Proceeding	:	**DECISION**
Control No. 90/009,772	:	**UNDER**
Filed: June 30, 2010	:	**37 CFR 1.181**
For: U.S. Patent No. 5,843,073	:	

This is a decision on the January 28, 2011 patent owner petition, entitled "PETITION TO STRIKE UNDER 37 C.F.R. 1.181." Patent owner is requesting that the requester's papers regarding litigation, dated November 30, 2010 and January 17, 2011, be expunged from the record as improper papers.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision.

The petition is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed from the proceeding record.

STATEMENT OF RELEVANT FACTS

1. Patent No. 5,843,073 (the '073 patent) issued on December 1, 1998.

2. A request for reexamination, assigned Control No. 90/009,772 (the '772 proceeding), was filed by a third party requester on June 30, 2010.

3. Reexamination was denied on August 20, 2010, but then ordered, upon petition, in the '772 reexamination proceeding on November 5, 2010.

4. The patent owner did not file a statement under 37 CFR 1.530.

5. On November 30, 2010, a first set of litigation documents were filed by the third party requester.

6. On January 17, 2011, a second set of litigation documents were filed by the third party requester.

7. On January 28, 2011, patent owner filed the present petition paper requesting that the requester's papers, dated November 30, 2010 and January 17, 2011, be expunged from the record as improper papers. On the same day, the patent owner filed a notice of concurrent proceedings and litigation with exhibits.

BASIS OF DECISION

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 1.565(a) states:

> (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.

MPEP 2282 states, in part:

> "... 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. .... 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."

DECISION

The present petition filed in the reexamination proceeding is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed from the proceeding record.

As noted, *supra*, the request for reexamination of the '073 patent was filed on June 30, 2010. Reexamination was ordered on November 5, 2010. The time for filing the patent owner filed a statement pursuant to 37 CFR 1.530 expired on January 5, 2011, and the record in the '772 reexamination proceeding shows that the patent owner did not make any statement pursuant to 37 CFR 1.530. The requester's first submission of litigation documents were deposited prior to and the requester's second submission of litigation documents were deposited after the expiration of the time period set by 37 CFR 1.530. 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 submissions filed in the reexamination proceeding, unless the submissions are bare notice of litigation proceedings.

The requester's papers, dated November 30, 2010 and January 17, 2011, go beyond bare notice of litigation proceedings. While it is important that the Office be aware of any prior or concurrent proceedings of the '073 patent, the requester's papers, dated November 30, 2010 and January 17, 2011, contain arguments and non-merit decisions, which are deemed improper papers as set forth in MPEP 2282, and would not be considered by the examiner in the determination of patentability in a reexamination proceeding. The presence of such information in the public record may potentially have a negative or prejudicial effect on the public perception of the patent. Further, the record would be made unduly long and complex by the inclusion of material not relevant to the conduct of a reexamination proceeding, potentially making consideration by the examiner difficult and unfocused. Therefore, the requester's papers, dated November 30, 2010 and January 17, 2011, are improper papers in an *ex parte* reexamination proceeding. See 37 CFR 1.565(a) and the policy in MPEP 2282.

Upon review of the record, it is deemed that patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated January 28, 2011, contain improper papers because the papers contain party arguments. For this reason, these papers will be closed from the proceeding record.

In view of the above, the requester's papers, dated November 30, 2010 and January 17, 2011, and patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated January 28, 2011, do not have an entry right. Therefore, these papers will be expunged from record in the '772 reexamination proceeding. As the papers have been entered into the electronic Image File Wrapper (IFW) record, the papers will be closed in the IFW record, and marked nonpublic to expunge it from the record. See MPEP 2267.

CONCLUSION

1. The January 28, 2011 petition is granted to the extent that the requester's papers, dated November 30, 2010 and January 17, 2011, will be closed because they do not have a right of entry.

2. No copy of the requester's papers, dated November 30, 2010 and January 17, 2011, and patent owner's exhibits labelled "Tab A" and "Tab C" in the notice of concurrent proceedings and litigation, dated January 28, 2011 will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.

3. Telephone inquiries related to the present decision should be directed to Supervisory Patent Examiner, Andy Kashnikow, at 571-272-4361.

Irem Yucel, Director
Technology Center 1600

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For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/009,772
Filed: June 30, 2010
For: U.S. Patent No. 5,843,073

Ex Parte Reexamination Proceeding
Control No. 90/011,285
Filed: October 15, 2010
For: U.S. Patent No. 5,843,073

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Art Unit 3993 for consideration of merger of the above-identified proceedings.

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. 90/009,772 was ordered in a decision on petition under 37 CFR 1.181 mailed November 5, 2010. The decision indicated that claims 2 and 7, two of the remaining claims left in the patent per the Reexamination Certificate No. 7772 issued September 28, 2010, would be reexamined. No patent owner statement was filed and no Office action on the merits has been issued in this proceeding.

Reexamination in application control No. 90/011,285 was ordered in a decision mailed November 22, 2010. The decision also indicated that claims 2 and 7, two of the claims left in the patent per the Reexamination Certificate No. 7772 issued September 28, 2010, would be reexamined. No patent owner statement was filed and no Office action on the merits has been issued in this proceeding.

As evidenced by the above facts, reexamination Control No. 90/009,772 and reexamination control No. 90/011,285 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, 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

The patent Owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 2 and 7, the only claims for which reexamination was requested and ordered 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(s) and requester(s) 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. 90/009,772 and 90/011,285 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 23 2010

CENTRAL REEXAMINATION UNIT

WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202	: : : :	(For Patent Owner)
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO ONE FINANCIAL CENTER BOSTON, MA 02111	: : : :	(For Third Party Requester)
In re: Devoe *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,525 Deposited : 23 July 2009 For: US Patent No. 6,816,356 *In re*: Devoe *et alia* *Ex Parte* Reexamination Proceeding Control No. 90/009,773 Deposited : 2 July 2010 For: US Patent No. 6,816,356	: : : : : : : : : : : :	DECISION *SUA SPONTE* MERGING PROCEEDINGS [37 CFR § 1.565(c)]

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

BACKGROUND

1. On 9 November 2004 US Patent No. 6,816,356 was granted to Devoe *et alia*.

2. On 23 July 2009 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,525.

3. On 20 October 2009 the Order was granted for *ex parte* reexamination in control number 90/009,525.

4. On 23 March 2010 a non-final Office action was mailed in 90/009,525.

5. On 25 May 2010 an amendment and remarks were received in 90/009,525.

6. On 2 July 2010 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/009,773.

7. On 21 September 2010 the Order was granted for *ex parte* reexamination in control number 90/009,773.

8. There are no amendments to the claims in control number 90/009,773.

DISCUSSION

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 for consolidation of the proceedings.

DECISION

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/009,525 & 90/009,773 *ex parte* reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files. Patent owner is required to submit an appropriate "housekeeping" amendment within **one month** of this decision placing the same amendment(s) in all files. The paper should be strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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 triplicate, each bearing an original signature, for entry in each file.

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web. EFS submissions must be made into each separate proceeding on the same date.

All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009,525 & 90/009,773 *ex parte* reexamination proceedings are hereby **merged**.

2. The patent owner's representative is required to submit an amendment placing the same amendment in all files within **one (1) month** of the mailing of this decision.

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

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

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

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

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

4. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, at (571) 272-1611, in the event that Mark Reinhart is unavailable Eric Keasel at (571) 272-4929, or Jessica Harrison at (571) 272-4449; Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992 may also be contacted..

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,774	07/29/2010	5,518,918	2901645-000007	4706

91335 7590 04/07/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 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
BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC
920 MASSACHSETTS AVE, NW
SUITE 900
WASHINGTON, DC 20001

Date:

MAILED

APR 07 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009774
PATENT NO. : 5518918
ART UNIT : 3991

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 90/009,774 MAILED

APR 07 2011
CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 05 April 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 10 February 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

   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 one (1) month, 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: _____.

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)

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

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. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of other pending proceedings before council and patent owner in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. 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 partes* 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. Resource management takes into consideration the volume of work associated with different proceedings.

The petitioner additionally notes that time is needed to gather evidence in the form of declaratory evidence from experts. On Balance there is "sufficient cause" to grant the extension of time.

Pursuant to MPEP § 2265, "[f]irst requests for extensions of these statutory time periods will be granted for sufficient cause, and for a reasonable time specified — usually 1 month. ... Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations." (emphasis added)

The petition for extension of time is hereby granted for a period of one (1) month.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,774	07/29/2010	5,518,918	2901645-000007	4706

91335 7590 02/22/2012

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC
920 MASSACHSETTS AVE, NW
SUITE 900
WASHINGTON, DC 20001

Date:

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FEB 2 2 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009774
PATENT NO. : 5518918
ART UNIT : 3991

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

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

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FEB 22 2012

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein, Fox PLLC
1100 New York Avenue, N.W.
Washington, DC 20005

(For Patent Owner)

Baker Donelson Bearman Caldwell Berkowitz PC
920 Massachusetts Ave, N.W.
Suite 900
Washington, DC 20001

(For Requester)

In re Barclay *et al.*
Ex Parte Reexamination Proceeding
Control No. 90/009,774
Filed: July 29, 2010
For: U.S. Patent No. 5,518,918

DECISION
DISMISSING PETITION
UNDER § 1.182

This is a decision on the December 22, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182 Request for Continued Reexamination."

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

The petition fee under 37 C.F.R. § 1.17(f) of $400 has been submitted.

The petition is **dismissed**.

BACKGROUND

- On October 22, 2010, the Office issued an order to reexamine claims 1-9 of U.S. Patent Number 5,518,918, based upon a third party request filed on July 29, 2010.
- On February 10, 2011, a nonfinal Office action was issued that included obviousness rejections of all original patent claims, claims 1-9, based upon Barclay (WO 91/07498) in view of other prior art references.
- On April 13, 2011, an interview was held between patent owner's representatives and Office personnel, in which the claims of the case were not specifically discussed.
- On June 10, 2011, patent owner submitted claim amendments to correct italicization in original claims 1 and 2, did not amend claims 3-9, added claims 10-18, submitted a

declaration by Dr. Kirk Apt, and submitted remarks in response to the nonfinal Office action.

- On July 13, 2011, the Office mailed a final Office action, in which the obviousness rejections of original patent claims 1-9 were repeated and extended to newly added claims 10-18. A rejection under § 112 was made on newly added claims 10-18. The June 10, 2010 declaration by Apt was addressed in this action.

- On August 25, 2011, a second interview was held between patent owner's representatives and Office personnel, including discussion of the rejections under §§ 112 and 103.

- On September 13, 2011, patent owner submitted no new claim amendments, but added new claims 19-27. The new claims 19-27 differed from previous claims 10-18 by further addressing a limitation added to the original claims to result in claims 10-18. A second declaration by Dr. Kirk Apt was filed, accompanied by remarks by patent owner.

- On September 29, 2011, the Office mailed an advisory Office action refusing entry of after-final claim amendments submitted on September 13, 2011, as failing to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal. The September 13, 2011 Apt declaration was noted to have been considered. A supplemental advisory Office action was issued on October 5, 2011 to set a response period.

- On November 10, 2011, patent owner submitted a paper that would cancel original claims 5-7 and proposed amended claims 14-16, and add new claims 19-27.

- On November 14, 2011, patent owner filed a Notice of Appeal.

- On November 21, 2011, the Office issued an advisory Office action refusing entry of the after-final submission filed on November 10, 2011, as failing to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal.

- On December 22, 2011, patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.182 Request for Continued Reexamination," which is the subject of this decision.

- On January 11, 2012, and again on February 6, 2012, the Office granted requests to extend the time for filing of an appeal brief, currently due on or before March 14, 2012.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

DECISION

1. The Instant Situation Does Not Justify Reopening of Prosecution

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

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. The petition should therefore clearly discuss the manner in which the entry of the submission would so act such that continued prosecution is warranted. Following the same rationale, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the final rejection or action closing prosecution. 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).

In this instance, patent owner's response includes proposed claim cancellations and new claims as submitted on November 10, 2011. This submission is requested entry because patent owner alleges that the addition of the November claims could not have been anticipated earlier, as they

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

"only became apparent as a result of a newly made statement in the final Office action dated July 13, 2011 and the in-person interview of August 25, 2011." Petitioner alleges that entry would further the prosecution because the examiner could find those claims allowable and thus quicken resolution of the reexamination.

The proposed set of claims to be entered for continued reexamination was first submitted on November 10, 2011. The November set of claims recited "same or better omega-3 production" whereas the previously entered June set of claims recited "same or better total fatty acid content or omega-3 production." The June set of claims had been rejected by the examiner, in the final Office action of July 13, 2011, as failing to comply with the written description requirement. In that rejection, the examiner had discussed the patent's Example 13, which was cited by patent owner as providing written description support for that phrase, but found that it failed to provide adequate support for the claimed invention.

With respect to the submission of new claims for entry via the instant petition, these claims address the original issues raised in the initial Office action of February 10, 2011; *i.e.*, the rejection of the claims as being obvious over Barclay (WO 91/07498) in view of other prior art references. Having been informed of that rejection, patent owner could have responded with an amendment to the claims to place them into their currently desired scope. The patent owner instead submitted new claims in response to the February 10, 2011 Office action of such a scope that they were held by the examiner as failing to comply with the written description requirement. It cannot be said, therefore, that the patent owner lacked the opportunity to add new claims in response to the rejection of the original claims.

Since patent owner has had previous opportunity 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. 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).

Furthermore, patent owner has not substantially amended the originally filed independent claims, nor does the November 10, 2011 amendment propose to do so. Neither has patent owner proposed to substantially amend the previously added independent claims. The issues raised by the rejection of the originally filed claims, and by the rejection of the claims added on June 10, 2011, remain in the case even should the desired new claims be entered. Entry of new claims at this point, where the new claims have a scope not previously examined under the statutes, would raise additional issues, but not act to resolve or simplify the issues that currently exist in the proceeding.

Neither patent owner, nor the file history, provides persuasive reasons why the contents of the instant submission could not have been presented at an earlier date, or persuasively explains the manner in which entry of the submission would advance the proceedings such that reopening of prosecution is warranted at this stage of the proceeding. In view of these facts, reopening of the

prosecution to consider this evidence submission at this stage in the proceedings is not warranted.

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**.
- A copy of this decision will be made of record in the reexamination file.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
- 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

February 17, 2012

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.
90/009,775	07/22/2010	6201217	0009-00023 US RX	5958

94979 7590 06/15/2011

Albrecht Tousi & Farnum PLLC
8200 Greensboro Drive
Suite 900
McLean, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2011

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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Date: 6-15-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert W. Diehl
BISHOP & DIEHL, LTD.
1750 East Golf Road, Suite 390
Schaumburg, IL 60173

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009775
PATENT NO. : 6201217
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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JUN 15 2011

CENTRAL REEXAMINATION UNIT

ALBRECHT TOUSI & FARNUM PLLC
8200 GREENSBORO DRIVE
SUITE 900
MCLEAN, VA 22102

(For Patent Owner)

Robert W. Diehl
BISHOP & DIEHL, LTD.
1750 EAST GOLF ROAD, SUITE 390
SCHAUMBURG, IL 60173

(For Requester)

In re Moon et al.
Control No.: 90/009,775
Filed: July 22, 2010
For: U.S. Patent No.: 6,201,217

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.181**
: **REQUESTING ENTRY**
: **OF AMENDMENTS**

This is a decision on the May 24, 2011, "Petition under 37 CFR Section 1.181 Requesting Entry of Amendment," requesting that the amendment and first response, dated May 2, 2011, (the "first after-final response") be entered into the record, or alternatively to enter the amendment and second response, dated May 24, 2011 (the "second after-final response"). The patent owner has petitioned under 37 CFR § 1.181(a)(3).

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition is dismissed as premature for the reasons set forth below, without consideration of the merits.

REVIEW OF THE RELEVANT FACTS

1. On March 13, 2001, U.S. Patent 6,201,217 (the '217 patent) issued to Moon et al.

2. On July 22, 2010, a request for *ex parte* reexamination of claims 1 and 3 of the '217 patent was filed by a third party requester. The request was assigned reexamination control number 90/009,775 (the '775 proceeding).

3. On September 3, 2010, the Office issued an order granting the'775 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that only claim 1 of the '217 patent would be subject to reexamination.

4. On November 3, 2010, the patent owner waived their right to file a Patent Owner's Statement.

5. Prosecution continued and on March 2, 2011, a final Office action was issued in the '775 proceeding.

6. On May 2, 2011, patent owner submitted a first after-final response under 37 CFR 1.116.

7. On May 24, 2011, patent owner filed a second after-final response under 37 CFR 1.116 in the '775 proceeding. On the same day, patent owner petitioned under 37 CFR 1.181 requesting entry of the first response, or alternatively entry the second response. Patent owner also filed a Notice of Appeal.

8. To date, the examiner has not issued an Office communication regarding the first or second after-final response.

DECISION

As pointed out, the patent owner filed present petition under 37 CFR 1.181 to invoke supervisory authority to enter the proposed amendments of patent owner's first response, dated May 2, 2011, or alternatively to enter the proposed amendments of patent owner's second response, dated May 24, 2011. However, there has been no decision by the examiner to either enter or not enter the proposed amendments of May 2, 2011 or May 24, 2011. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the proposed amendment because the examiner has not made his decision. Thus, the present petition is premature, and it is dismissed.

In addition, the petition under 37 CFR 1.181 is not electronically signed in accordance with the requirements of 37 CFR 1.4(d)(2)(i). See MPEP 502.02. Specifically, the signature must only include a first single forward slash mark as the first character and a second single forward slash mark as the final character in the electronic signature.

CONCLUSION

1. The patent owner's May 24, 2011 petition under 37 CFR § 1.181 to enter the proposed amendments of patent owner's first response, dated May 2, 2011, or alternatively to enter the proposed amendments of patent owner's second response, dated May 24, 2011, is hereby **dismissed**, as premature, without consideration of the merits.

2. 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

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,782	07/22/2010	6,193,856	097007-0104	5783

22428 7590 01/25/2012

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NIXON & VANDERHYE P.C.
901 NORTH GLEBE ROAD
11th FLOOR
ARLINGTON, VA 22203

Date:

MAILED

JAN 25 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009782
PATENT NO. : 6193856
ART UNIT : 3991

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:90/009,782

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed April 29, 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 Deborah Jones at 571-272-1535 in the Central Reexamination Unit

/Deborah Jones/ [*Signature*]	SPE, Art Unit 3991, CRU (Title)

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Jensen + Putnam, P.S.
2033 6th Avenue, Suite 1020
Seattle, WA 98121

For Patent Owner

MAILED

Lane Powell, PC
Attn: Brian G. Bodine
1420 Fifth Avenue, Suite 4100
Seattle, WA 98101-2338

For 3rd Party Requester
90/009,797

MAR 23 2011

CENTRAL REEXAMINATION UNIT

Larry D. Johnson
P.O. Box 470277
Celebration, FL 34747

For 3rd Party Requester
90/011,343

Ex Parte Reexamination Proceeding
Control No. 90/009,797
Filed: August 4, 2010
For: U.S. Patent No. 7,320,691

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Ex Parte Reexamination Proceeding
Control No. 90/011,343
Filed: November 19, 2010
For: U.S. Patent No. 7,320,691

Reexamination proceedings control Nos. 90/009,797 and 90/011,343 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. 90/009,797 was ordered in a decision mailed September 30, 2010, granting reexamination of claims 1, 2, 4-7, 16, 22, 31, 33-42, 44-46, and 49 appearing in US Patent No. 7,320,691. Patent owner file a letter on December 29, 2010 waiving his rights to file a patent owner statement. No Office action has yet been rendered in this proceeding.

Reexamination in application Control No. 90/011,343 was ordered in a decision mailed January 13, 2011, indicating that claims 1-52, all of the claims appearing in US patent No. 7,320,691 would be reexamined. Patent owner file a letter on March 11, 2011 waiving his rights to file a patent owner statement. No Office action has yet been rendered in this proceeding

As evidenced by the above facts, reexamination Control No. 90/009,797 and reexamination control No. 90/011,343 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-52, all of the claims in US patent No. 7,320,691, are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper will be entered into each of the 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 each of the third party requesters and requesters 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. 90/009,797 and 90/011,343 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,800	08/16/2010	5448520	1374.18758RE0	3220

20457 7590 04/15/2011

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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

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THE KENNEDY BUILDING
321 SOUTH BOSTON, SUITE 800
TULSA, OK 74103-3318

Date: MAILED
APR 15 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009800
PATENT NO. : 5448520
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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Antonelli, Terry, Stout, & Kraus
1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209-3873

(For Patent Owner)

MAILED

APR 15 2011

CENTRAL REEXAMINATION UNIT

James F. Lea III
Fellers, Snider, Blankenship, Bailey, & Tippens
321 S. Boston Avenue, Suite 800
Tulsa, OK 74103-3318

(For 3rd Party Requester)

In re Shimohigashi et al.	:
Reexamination Proceeding	: **DECISION**
Control No.: 90/009,800	: **DISMISSING PETITION**
Filed: August 16, 2010	: **UNDER 37 C.F.R. § 1.182**
For: U.S. Patent No.: 5,448,520	:

This is a decision on the March 30, 2011 patent owner petition under 37 C.F.R. § 1.182 to enter, and to have the examiner consider, an 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 February 18, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,448,520 (the '520 patent) issued on September 5, 1995.

2. On October 14, 2010, the Office issued an order granting an August 16, 2010 request for reexamination of claims 1-6 of the '520 patent by a third party requester, which was accorded control number 90/009,800 (the '9800 proceeding).

3. The proceeding progressed until, on February 15, 2011, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '9800 proceeding.

4. On February 18, 2011, the present proceeding entered the publication cycle.

5. Also on February 18, 2011, patent owner filed a Supplemental IDS under § 1.555.

6. The instant petition was filed on March 30, 2011, requesting the Office to consider the February 18, 2011 Supplemental IDS.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . 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.

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, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 C.F.R. § 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 C.F.R. §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 C.F.R. §1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 C.F.R. § 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 C.F.R. § 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the above-noted criteria. Although the supplemental IDS was filed on the date the proceeding entered the publication cycle (status 452), the instant petition was not filed until March 30, 2011, after the proceeding entered the publication cycle on February 18, 2011. Patent owner provides a statement as to why the references could not have been submitted earlier."[1] However, the petition fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, the petition stresses the fact that the references, when provided during litigation, did not result in the invalidity of any claims.[2] There is no statement by the patent owner that unequivocally states why any of the documents submitted make at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim(s) 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 has been required that the withdrawal criteria of 37 C.F.R. § 1.313(c) be complied with for an application, in which there is no statutory provision requiring special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 15, 2011, and the proceeding has now entered the final stages of the publication process. 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

[1] Petition at 1-5.
[2] Petition at 5-6.

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 and the failure to set forth a statement of unpatentability as to at least one claim under reexamination, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS paper.

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), presenting the patent owner's position.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on March 30, 2011.

2. The IDS papers have not been considered by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for 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 Michael Cygan, Legal Advisor, at (571) 272-7700.

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

April 14, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,800	08/16/2010	5448520	1374.18758RE0	3220

20457 7590 06/29/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2011

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TULSA, OK 74103-3318

Date:

MAILED

JUN 29 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009800
PATENT NO. : 5448520
ART UNIT : 3992

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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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(For Patent Owner)

MAILED

JUN 29 2011

CENTRAL REEXAMINATION UNIT

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Fellers, Snider, Blankenship, Bailey, & Tippens
321 S. Boston Avenue, Suite 800
Tulsa, OK 74103-3318

(For 3rd Party Requester)

In re Shimohigashi *et al.*
Reexamination Proceeding
Control No.: 90/009,800
Filed: August 16, 2010
For: U.S. Patent No.: 5,448,520

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

This is a decision on the April 11, 2011 patent owner petition under 37 C.F.R. § 1.182 to enter, and to have the examiner consider, an 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 April 11, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,448,520 (the '520 patent) issued on September 5, 1995.

2. On October 14, 2010, the Office issued an order granting an August 16, 2010 request for reexamination of claims 1-6 of the '520 patent by a third party requester, which was accorded control number 90/009,800 (the '9800 proceeding).

3. The proceeding progressed until, on February 15, 2011, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '9800 proceeding.

4. On February 18, 2011, the '9800 proceeding entered the printing cycle and was designated a 452 status.

5. Also on February 18, 2011, patent owner filed a Supplemental IDS under § 1.555.

6. A petition was filed on March 30, 2011, requesting the Office to consider the February 18, 2011 Supplemental IDS, and this petition was dismissed on April 15, 2011.

7. On April 11, 2011, patent owner filed a Supplemental IDS under § 1.555.

8. The instant petition was filed on April 11, 2011, requesting the Office to consider the April 11, 2011 Supplemental IDS.

9. On June 21, 2011, the reexamination certificate (8330th) for U.S. 5,448,520 C1 on the instant reexamination proceeding issued and was published in the *Official Gazette*.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . 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.

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

The present reexamination proceeding has concluded with the issuance of an *Ex Parte* Reexamination Certificate. On June 21, 2011, the reexamination certificate (8330th) for U.S. 5,448,520 C1 on the instant reexamination proceeding issued and was published in the Official Gazette. As of the issuance of the certificate, the Office was divested of jurisdiction over the '344 patent. Therefore, consideration of the submitted information by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

Even were the certificate to have not issued, the petition would be dismissed as lacking elements required under USPTO procedure as set forth in the MPEP. The requirements of 37 C.F.R. § 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the above-noted criteria. Although the supplemental IDS was filed on the date the proceeding entered the publication cycle (status 452), the instant petition was not filed until April 11, 2011, after the proceeding entered the publication cycle on February 18, 2011. Patent owner provides a statement as to why the references could not have been submitted earlier."[1] However, the petition fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, the petition stresses the fact that the references, when provided during litigation, did not result in the invalidity of any claims.[2] There is no statement by the patent owner that unequivocally states why any of the documents submitted make at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim(s) 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 has been required that the withdrawal criteria of 37 C.F.R. § 1.313(c) be complied with for an application, in which there is no statutory provision requiring special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

---

[1] Petition at 1-5.
[2] Petition at 5.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 15, 2011, and the proceeding has now entered the final stages of the publication process. 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 and the failure to set forth a statement of unpatentability as to at least one claim under reexamination, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS paper.

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), presenting the patent owner's position.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on April 11, 2011.

2. The IDS papers have not been considered by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for 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 Michael Cygan, Legal Advisor, at (571) 272-7700.

/Kenneth M. Schor/

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

June 28, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,803	10/04/2010	7690160	00772-32941	3536

57600 7590 06/15/2011

HOLLAND & HART
222 South Main Street, Suite 2200
P.O. Box 11583
Salt Lake City, UT 84110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/15/2011

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JUN 15 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,803*.

PATENT NO. *7,690,160*.

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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JUN 15 2011

CENTRAL REEXAMINATION UNIT

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222 South Main Street, Suite 2200
P.O. Box 11583
Salt Lake City, UT 84110

(For Patent Owner)

Peter M. de Jonge
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(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,803
Filed: October 4, 2010
For: U.S. Patent No. 7,690,160

: **DECISION DISMISSING**
: **PETITION UNDER 37 CFR 1.181**
: **REQUESTING WITHDRAWAL**
: **OF FINALITY OF ACTION**

This is a decision on the May 17, 2011, "Petition Under 37 C.F.R. § 1.181 and MPEP § 2272 To Withdraw Final Rejection and Reopen Prosecution" requesting that the finality of the Office action, mailed April 25, 2011, be withdrawn and that prosecution be reopened.

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.

SUMMARY OF RELEVANT FACTS

1. On April 6, 2010, U.S. Patent No. 7,690,160 (the '160 patent) issued to Moller, Jr.

2. On October 4, 2010, a request for *ex parte* reexamination was submitted by a third party requester and assigned reexamination control No. 90/009,803. The request asked for the reexamination of claims 1-6 of the '160 patent.

3. On November 5, 2010, an Order was mailed granting reexamination for claims 1-6 of the '160 patent in control No. 90/009,803.

4. The patent owner did not file a patent owner's statement under 37 CFR 1.530.

5. On January 24, 2011 a non-final Office action was mailed.

6. On February 24, 2011, a personal interview was held.

7. On March 24, 2011, a response was received from the patent owner, which included six declarations under 37 CFR 1.132.

8. On April 4, 2011, a final Office action was mailed.

9. On April 19, 2011, patent owner called the examiner to seek clarification as to whether the April 4, 2011 action was a final action. The examiner stated that it was and would mail a corrected action.

10. On April 25, 2011, a corrected final Office action was mailed.

11. On May 17, 2011, a petition requesting withdrawal of the finality of the April 25, 2011 Office action was filed.

12. On May 19, 2010, patent owner filed a summary of the April 19, 2011 telephone conversation.

DECISION

In response to patent owner's arguments that the examiner erred in making the Office action of April 25, 2011 final, the director finds there are not good and sufficient reasons to withdraw the finality of that Office action. 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. See MPEP 2271.

The criteria for making a rejection final in an *ex parte* reexamination proceeding is analogous to that set forth in MPEP § 706.07 and 706.07(a) for making a rejection final in an application. The policy is based on 37 CFR 1.113 that states in part:

> "(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under §1.510, patent owner's reply is limited to appeal in the case of rejection of any claim... or to amendment as specified in § 1.114 or § 1.116....
>
> (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof."

Further, in MPEP § 706.07(a) the current policy regarding making second action final is explained and it states, in part:

> "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

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."

Turning to the facts in this proceeding, the request for reexamination was based on a number of references. The order granting reexamination agreed that the request raised substantial new questions of patentability by the teachings of the Tylon and Fishman references. The patent owner chose not to file comments under 37 CFR 1.530. The first Office action mailed January 24, 2011, set forth rejections based on Tylon alone, and Tylon in combination with Kotler and Fishman. These rejections align with the determination that SNQs were raised in the order granting reexamination. Patent owner filed a response of March 24, 2011. No amendments were made in the response. The response included six declarations filed under 37 CFR 1.132, in which five of the declarations did not comply with the requirements for declarations filed at the Office. The final Office action maintained all of the rejections presented in the first Office action. No new grounds of rejections were added. All arguments and evidence presented by patent owner were responded to in the final Office action.

Patent owner is contending that the finality of the April 25, 2011 Office action must be withdrawn because (1) the examiner changed his position on the secondary evidence as expressed during the February 24, 2011 personal interview; (2) the evidence filed with the March 24, 2011 response was not considered in the April 25, 2011 Office action; and (3) reopening prosecution is required in order to respond to the examiner's new arguments in the April 25, 2011 Office action. See, e.g., pages 7-11of the instant petition. For these reasons, patent owner requests that the finality of the April 25, 2011 Office action should be withdrawn.

In reviewing the record, the examiner provided the patent owner information and references that are useful in defining the position of the Office. Both the order granting reexamination and the first Office action provided information and references that are useful in defining the position of the Office. For example, the first Office action provides a complete explanation of how the references are being applied to the claimed invention. See, e.g., pages 2-6 of the January 24, 2011 Office action. The record also shows that the final rejection maintained the obviousness rejection based upon the same references, and repeated the **identical grounds**. See, pages 2-6 in the April 25, 2011 Office action. In the petition, patent owner does not contend that the examiner changed the grounds of rejection. Therefore, the record shows that the patent owner was at least twice notified how the examiner was applying the references to the claimed invention as the basis for the obviousness rejections.

As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. In the petition, patent owner alleges three grounds for withdrawing the finality of the April 25, 2011 Office action. None of these grounds show that the examiner failed to follow Office policies and procedures in making the April 25, 2011 Office action final. To the contrary, the examiner properly issued a final rejection because the examiner set forth the *exact* same obviousness rejections based on the same references as in the non-final Office action of January 24, 2011.

In response to patent owner's first ground, the record does not show that the examiner arbitrarily changed his position regarding the evidentiary value of the filing of application no. 11/644,468 by patent owner's competitor. The examiner's summary of the February 24, 2011 interview states that the "filing" of application no. 11/644,468 is compelling evidence but "not necessarily

sufficient in and of itself." There is no indication that the examiner knew that application no. 11/644,468 went abandoned for failure to response to an Office action rejecting the claims during the interview. Furthermore, the outline for the interview agenda, submitted by the patent owner in the afternoon on February 23, 2011, briefly mentions that evidence of nonobviousness and secondary considerations will be discussed but fails to identify what the evidence is. The record does not show that the patent owner submitted the evidence for the interview. Therefore, the examiner did not have the opportunity to review the evidence in light of the entire record prior to the interview. Any perceived change in position by the examiner as to the weight of the filing of application no. 11/644,468 was due to consideration of the entire record, which is in accord with Office procedures and policies (see MPEP 716 et seq.) and the discovery that application no. 11/644,468 was abandoned due to the applicant's failure to reply to a rejection of the claims. See the Office action dated June 2, 2008 and the Notice of Abandonment dated December 15, 2008 in application no. 11/644,468. Similarly, the record does not reflect that the examiner was given the opportunity to read and fully consider the declarations submitted with the response during the February 24, 2011 interview. The interview summary only reflects that additional evidence of nonobviousness was generally discussed and that the examiners agreed to consider such evidence when filed to determine if it overcomes the obviousness rejections. Therefore, the record does not support patent owner's contention that the examiner arbitrarily changed his position. It was simply not possible for the examiners to identify or develop issues regarding the evidence during the February 24, 2011 interview when certain facts were not known to the examiners at the time and the evidentiary documents were not presented to the examiners (with sufficient time prior to the interview) in order to review the documents and the entire record. The record shows that the examiner properly followed Office policies and procedures in reviewing the evidence and the entire record when reconsidering the obviousness rejections in the action following the submission of the evidence. Accordingly, the record does not support patent owner's assertion that the examiner arbitrarily "flip-flop[ped] his position" and deprived the patent owner of their due process rights.

In response to patent owner's second contention, the record does not support that the declarations were not considered by the examiner. The examiner appropriately noted that the Wright, Axelrod, Struthers, Pollard, and Vince declarations failed to comply with statutory and regulatory requirements (e.g., 35 USC 25 and 37 CFR 1.68). Patent owner contends that the examiner should have waived the statutory requirement of 35 U.S.C. 25 because the defective is only a minor one. See pages 8-10 of the petition. The examiner does not have the authority to waive the requirements. Furthermore, the Office does not have the authority to waive statutory requirements. See, e.g., 37 CFR 1.183. Patent owner argues that the examiner should have notified them of the deficiencies and allowed the patent owner an opportunity to correct the deficiencies. See pages 10-11 of the petition. However, the policies set forth in MPEP 2266.01 allow for the examiner's discretion in determining when a response is deemed a *bona fide* response and when additional time should be given to correct a deficiency in the response. In other words, the Office procedures do not require the examiner to give notification and additional time for every type of deficiency noted. Therefore, it was in the examiner's discretion to act on the March 24, 2011 response, as it was filed, in the interest of special dispatch. Furthermore, the record shows, in the April 19, 2011 interview summary, that the examiner will consider corrected declarations that rectify the defects noted in the final Office action.

Therefore, patent owner has the opportunity to submit corrected declarations for consideration by the examiner. To date, patent owner has not submitted any corrected declarations. Finally, the examiner did consider the substance of the evidence of the Moller, Jr. declaration. See, e.g., pages 7-11 of the April 25, 2011 Office action. Accordingly, the record does not support patent owner's contention that prosecution must be reopened in order for the examiner to consider the evidence filed with the March 24, 2011 response.

In response to patent owner's third contention, it was not possible for the examiner to address issues regarding the Moller, Jr. declaration prior to the Final Office action because the declaration was not of record until March 24, 2011. In other words, the "new objections" to which petitioner refers is merely the examiner's response to arguments and evidence set forth in patent owner's response filed March 24, 2011. To reiterate, in the final Office action, the examiner was addressing arguments and evidence filed by the patent owner, not modifying or altering the grounds of rejection, and for the reasons expressed above in regards to patent owner's first contention, it was not possible for the examiner to address the evidence earlier in the prosecution. Patent owner may submit additional evidence and arguments in response to the April 25, 2011 Office action in compliance with Office requirements, including the showing required by 37 CFR 1.116. The examiner may enter such evidence and arguments into the record if, for example, it reduces or clarifies issues.

The record shows that the examiner appropriately followed Office policies and procedures, e.g., as set forth in MPEP 2271, and 706.07 *et seq.*, in making the determination that the April 25, 2011 should be designated as final in the interest of special dispatch. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to making the April 25, 2011 Office action final.

In summary, the final rejection in question did not introduce any new grounds of rejection for claims 1-6. These claims remain rejected for the reasons set forth in the first Office action. Accordingly, the examiner properly designated the April 25, 2011 Office action as final in accordance with the statutory mandate of special dispatch. Therefore, the final rejection was proper, and the petition is dismissed.

CONCLUSION

1. The Patent Owner's petition, filed May 17, 2011, requesting withdrawal of the finality of the Office action mailed April 25, 2011 and reopening of prosecution is **dismissed.**

2. All correspondence relating to this ex parte reexamination should be directed 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

3. Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,805	08/23/2010	5822267	000333-004	8967

20457 7590 04/15/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

LAW OFFICES OF SHRUTI COSTALES, PLLC
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/009,805*.

PATENT NO. *5822267*.

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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APR 15 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Shruti Costales
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(For 3rd Party Requester)

In re Watanabe et al.
Reexamination Proceeding
Control No.: 90/009,805
Filed: August 23, 2010
For: U.S. Patent No.: 5,822,267

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

This is a decision on the April 8, 2011 patent owner petition under 37 C.F.R. § 1.182 to enter, and to have the examiner consider, an 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 April 8, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 5,822,267 (the '267 patent) issued on October 13, 1998.

2. On November 17, 2010, the Office issued an order granting an August 23, 2010 request for reexamination of claims 1-49 of the '267 patent by a third party requester, which was accorded control number 90/009,805 (the '9805 proceeding).

3. The proceeding progressed until, on February 17, 2011, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '9805 proceeding.

4. On February 18, 2011, the present proceeding entered the publication cycle.

5. The instant petition was filed on April 8, 2011, accompanied by an IDS that the patent owner requests the Office to consider.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . 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.

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, in this instance, the reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 C.F.R. § 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 C.F.R. §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 C.F.R. §1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 C.F.R. § 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 C.F.R. § 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the above-noted criteria. The instant petition was filed on April 8, 2011, after the proceeding entered the publication cycle on February 18, 2011. Patent owner provides a statement as to why the references could not have been submitted earlier."[1] However, the petition fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. To the contrary, the petition stresses the fact that the references, when provided during litigation, did not result in the invalidity of any claims.[2] There is no statement by the patent owner that unequivocally states why any of the documents submitted make at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim(s) 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 has been required that the withdrawal criteria of 37 C.F.R. § 1.313(c) be complied with for an application, in which there is no statutory provision requiring special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 17, 2011, and the proceeding has now entered the final stages of the publication process. 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

[1] Petition at 1-5.
[2] Petition at 5.

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 and the failure to set forth a statement of unpatentability as to at least one claim under reexamination, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS paper.

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), presenting the patent owner's position.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on April 8, 2011.

2. The IDS papers have not been considered by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for 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 Michael Cygan, Legal Advisor, at (571) 272-7700.

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

April 14, 2011

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PAUL D. YASGER ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK IL 60064-6008	:	(For Patent Owner)
Public Patent Foundation 55 Fifth Avenue Suite 928 New York, NY 10003	:	(For Requester)
In re Kempf et al. Reexamination Proceeding Control No. 90/009,812 Request Deposited: August 25, 2010 Ex Parte Reexamination Certificate Issued: August 2, 2011 For: U.S. Patent No. 5,635,523	:	ON PETITION

MAILED
APR 10 2012
OFFICE OF PETITIONS

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.182 TO WITHDRAW TERMINAL DISCLAIMERS AND REPLACE WITH CORRECTED TERMINAL DISCLAIMERS" filed October 3, 2011, for withdrawal of the Terminal Disclaimers submitted March 25, 2011 in the above-identified Ex Parte reexamination and for replacement with a corrected Terminal Disclaimers filed October 3, 2011.

The petition is **DISMISSED** to the extent that the Terminal Disclaimers filed March 25, 2011 will not be removed from the record. However, the record will be complete with the placement of the Terminal Disclaimers filed October 3, 2011 therein.

Any request for reconsideration must be filed within **TWO (2) MONTHS**. This 2-month period is governed by 37 CFR 1.181(f) and is not extendable under 37 CFR 1.136.

The request for Ex parte reexamination of Patent No. 5,635,523 was filed on August 25, 2010. A reexamination certificate issued on August 2, 2011.

The Patent Owner states that due to a typographical error, the terminal disclaimers submitted on March 25, 2011 transposed two numbers - the number "5,635,523" was mistakenly written as "5,653,523." On petition, Patent Owner has submitted terminal disclaimers correctly directed to the Ex Parte reexamination of Patent No. 5,635,523.

It is noted that the error that is the subject of this petition is an error in identifying the patent number of the Ex Parte reexamination that the terminal disclaimers were being filed in. The re-examination number, title and docket number were correctly identified. That is, the only difference in the two disclaimers is the patent number identified in the header. (Given the correct identifying information thereon, the terminal disclaimers were only placed in and acted on in the correct Ex Parte reexamination). Further, Patent Owner does not request any correction with respect to what is being disclaimed.

The Terminal Disclaimers filed March 25, 2011 were accepted and recorded by the examiner.

There is no issue as to what was dedicated to the public. Patent Owner does do not request that the Terminal Disclaimers be nullified. There is no error in the reexamination certificate requiring correction.

Rather, Patent Owner requests, in effect, that the Terminal Disclaimers filed March 25, 2011 be replaced in the record with the Terminal Disclaimers filed October 3, 2011.

The Terminal Disclaimers filed March 25, 2011 were made of record and considered by the examiner in reexamination and issuance of the reexamination certificate. Removal of the Terminal Disclaimers filed March 25, 2011 from the record is inappropriate.

Placement of the Terminal Disclaimers filed October 3, 2011 (along with the petition and petition decision) in the record is sufficient to complete the record. No further action will be undertaken.

Receipt of the petition fee of $400 is acknowledged.

Telephone inquiries concerning this decision may be directed to Senior Petitions Attorney, Nancy Johnson at 571-272-3219.

Anthony Knight
Director
Office of Petitions

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,819	09/04/2010	6246247	P6D1-RX	8466

50905 7590 11/22/2010

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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
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EAST PALO ALTO, CA 94303-2248

Date: MAILED
NOV 22 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009819
PATENT NO. : 6246247
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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(Patent Owner)

Ronald L. Yin
DLA Piper LLP (US)
2000 University Avenue
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(Requestor)

MAILED
NOV 22 2010
CENTRAL REEXAMINATION UNIT

Inventor: Eldrigde, et al	: **DECISION ON**
Reexamination Proceeding	: **§ 1.181/1.182 PETITION**
90/009,819	:
Filed: September 4, 2010	:
For: U. S. Patent No. 6,246,247	:
Issued: June 12, 2001	:
Title: Probe Card Assembly and Kit,	:
and Method of Using Same	:

This is a decision on a November 5, 2010 § 1.181/1.182 petition by the Patent Owner seeking to strike and/or vacate the filing date of a September 4, 2010 request for reexamination. The petition is based on an alleged conflict of interest under §§ 10.56, 10.57, and 10.110 by the practitioner filing the reexamination request with the owner of the patent for which reexamination has been requested, U.S. Patent number 6,246,247 ('247 patent). The petition is now before the Office of Patent Legal Administration for decision.

The petition is Dismissed.

I. Background

1. An *ex parte* request for reexamination of patent number 6,246,247 was filed on September 4, 2010:

a. The party requesting reexamination is practitioner Ronald L. Yin. The patent owner is FormFactor, Inc. (FormFactor).

b. Copending litigation exists and is styled *FormFactor, Inc. v. Micro-Probe Incorporated and David Browne*, CV 10-03095 VRW, USDC NDCal.[1]

[1] Reqeust, page 2, para 16.

c. The request was accompanied by an 83 page attachment supporting the request, which attachment identifies 8 substantial new questions of patentability based solely on 4 U.S. patents applied under 35 U.S.C. §§ 102 and 103.[2]

2. A review of the prior art cited on the face of the '247 patent does not reveal any of the four U.S. patents upon which the request for reexamination is based.[3]

3. The instant petition and fee requesting the Office to strike and/or vacate the filing date of the instant reexamination request was filed on November 5, 2010:

a. The petition is supported by a Declaration by Merkadeau, a Senior Vice President and Secretary of FormFactor.

b. The petition is based on the practitioner requestor, Yin, having been privy to confidential information supplied by the patent owner in regard to the '247 patent, should not now be allowed to request reexamination of the '247 patent.

4. Status of the reexamination request:

a. No additional papers by the patent owner or the requestor have been filed.

b. An Office reply to the request for reexamination has not been issued.

II. Petitions Under § 1.181/182 to Strike and/or Vacate the Filing Date of the Reexamination Request

1. Petition under § 1.181: The petition under § 1.181 seeks to have the Office vacate the filing date of the instant reexamination request. Although separately stated, the § 1.181 petition is not separately argued. See the Petition under § 1.182 for the facts and legal basis presented to support the grant of the petitions.

2. Petition under § 1.182: The petition under § 1.182 seeks to have the Office strike the instant reexamination proceedings based on the following facts:

a. The reexamination request was filed by practitioner Yin of DLA Piper LLP (US) (DLA).

b. Previously, practitioner Yin worked at Gray Cary Ware & Freidenrich LLP (Gray).[4]

c. While at Gray, practitioner Yin headed the intellectual property side of a due diligence team that represented Morgan Stanley in an initial public offering by FormFactor.

d. As part of the due diligence work, the due diligence team had access to the prosecution file for the '247 patent, which file "included confidential communications in

[2] Attachment, pages 6 and 7.
[3] See also, Attachment to request for reexamination, page 2. An issue is also raised as to the appropriate priority [benefit] date patentee is entitled to notwithstanding the benefit claims on the face of the patent.
[4] Gray has since merged into DLA.

which FormFactor discussed strategies with respect to the prosecution of the '247 patent.[5]

e. Practitioner Yin is listed on a motion to dismiss a suit (presumably involving the '247 patent) filed by FormFactor.

f. Practitioner Yin has refused a request to withdraw from the patent suit.

Petitioner argues that having had access to the patent owner's prosecution file for the '247 patent and therefore been privy to confidential and secret information in that file, it is improper for practitioner Yin to turn against the owner of that patent. Reference is made to § 10.56 and § 10.57 identifying a practitioner's obligation to preserve the confidences and secrets of a client.

Petitioner speculates that practitioner Yin may try to argue that his representation was not with FormFactor directly but with underwriters. Such argument is thought to fail in that Yin is a member of the California bar and California courts have recognized that receipt by an attorney of confidential information from even a non-client leads to a duty of confidentiality where such information is obtained in a situation where the information will or may be useful in the attorney's representation of a client.[6] The confidential information obtained was useful in Yin's representation of the underwriters thereby causing the duty of confidentiality to attach.

Petitioner also speculates that practitioner Yin may try to argue that a few years have passed since his work on the due diligence so that the duty of confidentiality no longer applies. Such argument is also thought to fail in that the passage of time, except under limited circumstance that are not applicable here, does not eliminate prior substantial relationships.[7]

Finally, it is noted that the Office has a great interest in preserving the cornerstones of professional ethics and that vacating the filing date of the present reexamination request would preserve a balance, delicate though it may be, between an individual's right to his own freely chosen counsel and the need to maintain the highest ethical standards of professional responsibility.[8]

III. Standard for Disqualification of Opposing Counsel

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[9] Decisions on such

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[5] Petition, page 4, paragraph 8. A second access was had by the team to all FormFactor patent prosecution files, paragraph 10.
[6] Petition, page 6.
[7] *Id.*, page 8.
[8] *Id.*, bridge of pages 8 and 9.
[9] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." Petitions to disqualify a practitioner in *ex parte* or *inter partes* proceedings in the Office are not governed by Parts 10 and 11 and will be handled on a case-by-case basis under such conditions as the Director deems appropriate. The MPEP does not generally address Parts 10 and 11 of the rules of practice.

petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[10]

37 CFR 10.56 provides that a "practitioner should preserve the confidences and secrets of a client." 37 CFR 10.61 states that a "practitioner should exercise independent professional judgment on behalf of a client." More particularly, § 10.66(a) provides that proffered employment shall be declined "if it would be likely to involve the practitioner in representing different interests ...." 37 CFR 10.110 provides that a "practitioner should avoid even the appearance of impropriety."

The Office has utilized the following standard in regard to representations of patent matters:[11]

An attorney should be disqualified if a party can show that the:

(1) attorney was its former attorney,

(2) attorney now represents an adverse party, and

(3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The assumption will be made where the standard is met that confidences were disclosed and an inquiry will not be made into their nature and extent.[12] The Office has chosen a narrow interpretation of the expression "substantially related" to mean 'identical or essentially the same."[13]

IV. Decision on Petition Under 37 CFR 1.181

The petition under § 1.181 is dismissed as untimely,[14] and as an inappropriate basis to decide disqualification matters, which as noted above are handled under § 1.182.

V. Decision on Petition Under 37 CFR 1.182

37 CFR 1.182 provides relief for situations not specifically provided for in the regulations of Part 1 and is an appropriate basis for raising the issue of conflict of interest.

Preliminarily, it is noted that there is no evidence that the due diligence team specifically reviewed the prosecution file for the '247 patent or that, if such review was done, practitioner Yin either did the review, or became aware of the results of the review being the head of the team. The petition and supporting declaration by Merkadeau merely state that:

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[10] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.

[11] *SCM v. Aktieselskabet Niro Atomizer*, 212 USPQ 93 (Comm'r of Patents, December 16, 1980 and January 8, 19871).

[12] *Anderson v Eppstein.*

[13] *Id.*

[14] 37 CFR 1.181(f) provides that the petition be filed within two months from the action being complained of. The action being complained of is the September 4, 2010 request for reexamination. The petition was filed on November 5, 2010 (a Friday) as shown by an EFS receipt, one day past the two-month deadline. The Office sees no reason not to insist on the two-month period.

1. The due diligence involved review by the team of patents and patent applications.[15]
2. There was complete access by the team to patent prosecution files.[16]
3. Yin was exposed to FormFactor's formulation of policy and strategy.[17]
4. The due diligence team spent significant hours reviewing documents and files.[18]

The patent owner's § 1.182 petition to strike the reexamination proceedings is improper.

The gravamen of the § 1.182 petition is the alleged access of the practitioner filing the reexamination request to confidential information relating to the patent for which he requests reexamination. As access to the information was obtained under circumstances where a duty of confidentiality attached, the reexamination proceeding is to be struck. It is noted that there is not one instance where petitioner has identified the actual use of confidential information to support the request for reexamination. The reexamination request is entirely based on publicly available U.S. patents. It is not stated that Yin's knowledge of the materiality of these patents arose from information obtained from Yin's access to the patent owner's files. Instead, reliance is had on the availability of the patent owner's file relating to the '247 patent to the due diligence team of which Yin was the head.

The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts in a reexamination proceeding. The resulting delay of the substantive reexamination proceeding from any attempt to treat the instant conflict matter 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). For example, to address the conflict issue would require, as a matter of fairness, the opportunity for requestor Yin to present his position, a process that would not only extend the reexamination merits but also extend participation by the requestor beyond the bounds permitted by an *ex parte* requestor. On balance, the instant reexamination proceeding is not the forum for resolving this issue. Instead, petitioner should utilize an existing appropriate vehicle for addressing this issue. A request may be filed with the Director of the U.S. Patent & Trademark Office that practitioner Yin be disqualified from the instant reexamination proceedings for future submissions, and with identification of any remedial action to be taken to remedy any inappropriate submissions by Yin based on confidential information.[19]

The November 5, 2010 petition will be closed in the file record.

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[15] Petition, page 4, paragraph 4.
[16] *Id.*, paragraph 6.
[17] *Id.*, page 7.
[18] Markadeau Declaration, paragraph 9.
[19] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a register practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

VI. Contact

Telephone inquiries related to this decision (*e.g.*, only strictly procedure inquires from petitioner) should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707, or in his absence, to the undersigned at (571) 272-7735.

Robert A. Clarke

Robert A. Clarke
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

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(Third Party requester)

MAILED

JUN 22 2011

CENTRAL REEXAMINATION UNIT

In re Shimohigashi *et al.*
Reexamination Proceeding
Control No.: 90/009,821
Filed: September 10, 2010
For: U.S. Patent No.: 7,115,344

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the April 15, 2011 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, patent owner's 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 on April 15, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. On October 3, 2006, the Office issued U.S. Patent No. 7,115,344, to Hasegawa *et al.* (the '344 patent).

2. On September 10, 2010, a third party requester filed a request for *ex parte* reexamination of the '344 patent. The request was assigned reexamination proceeding control number 90/009,821 (the '9821 proceeding).

3. On October 19, 2010, the Office issued an order granting reexamination for the '9821 reexamination proceeding.

4. Prosecution progressed to the point where, on February 7, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '9821 proceeding.

5. On February 18, 2011, the '9821 proceeding entered the printing cycle and was designated a 452 status.

6. On April 15, 2011, patent owner filed the instant petition accompanied by an IDS, which patent owner requests the Office to consider.

7. On May 10, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8222nd), US 7,115,344 C1.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (8222nd), US 7,115,344 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '344 patent. Therefore, consideration of the submitted information by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

ADDITIONAL DISCUSSION

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on February 7, 2011, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (8222nd), thereby divesting the Office of jurisdiction over the '344 patent. However, even had the petition been addressed prior to issuance of the certificate, the April 15, 2011 IDS would not have had an entry right. While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied in an analogous manner to requests for withdrawal of reexamination proceedings from the printing cycle. Note that, for *ex parte* reexamination, 35 U.S.C. 305 mandates that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Given that 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, and such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.*

The conditions for entry of an IDS after NIRC are explicitly set forth in MPEP 2256 as follows:

> ... 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)

Even had the petition been addressed prior to issuance of the certificate, the fact situation did not satisfy the above-cited conditions, grounded on the statutory requirement for special dispatch.

The instant petition was filed very late in the examination of the reexamination. Specifically, patent owner filed the petition requesting consideration of April 15, 2011 IDS after issuance of a NIRC and after the '9821 proceeding had already entered the printing cycle for issuance of a reexamination certificate. Patent owner has failed to provide a statement as to why the submitted information (an art citation) makes at least one claim unpatentable. Accordingly, patent owner does not provide an amendment along with an explanation as to how the amendment renders the claims patentable in light of the submitted prior art as applicable to the confirmed claims in the '9821 reexamination proceeding. Therefore, the present petition does not satisfy the conditions for consideration of an IDS after the proceeding has entered the printing cycle, and would not have been granted in contravention of the statutory mandate for special dispatch. Accordingly, patent owner's request with regard to the April 15, 2011 IDS would have been dismissed, even if the Certificate had not been issued.

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, as the Office may not permit entry and consideration of these references in the '9821 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 concluded 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 to consider the IDS filed on April 15, 2011.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission has, however, been placed in the electronic file for the proceeding.

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

/Kenneth M. Schor/

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

6-21-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,824	09/16/2010	5191525	1484.22	7688

32233 7590 12/14/2010

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SMITH HOPEN, PA
180 PINE AVENUE NORTH
OLDSMAR, FL 34677

Date:
MAILED
DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009824
PATENT NO. : 5191525
ART UNIT : 3992

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,731	04/29/2010	5191525	1484.20	9139

32233 7590 12/14/2010

STORM LLP
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901 MAIN STREET, SUITE 7100
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009731
PATENT NO. : 5191525
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,756	06/04/2010	5191525	1484.21	6813

32233 7590 12/14/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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Date:
MAILED

DEC 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009756
PATENT NO. : 5191525
ART UNIT : 3992

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(For Third Party Requester)

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,824
Request Deposited: September 16, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,731
Request Deposited: May 29, 2010
For: U.S. Patent No. 5,191,525

In re LeBRUN *et alia*
Reexamination Proceeding
Control No. 90/009,756
Request Deposited: June 4, 2010
For: U.S. Patent No. 5,191,525

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,191,525 (hereinafter, the '525 patent), issued to LeBRUN *et alia*, on March 2, 2003.

2. On September 16, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,824 (hereinafter, the '9824 proceeding).

3. On May 29, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,731 (hereinafter, the '9731 proceeding).

4. On June 4, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '525 patent. The reexamination proceeding was assigned Control No. 90/009,756 (hereinafter, the '9756 proceeding).

5. The Reexamination Order is granted in the '9824 proceeding on concurrently herewith.

6. The Reexamination Order was granted in the '9731 proceeding on July 17, 2010.

7. The Reexamination Order was granted in the '9756 proceeding on August 2, 2010.

8. There are currently no amendments in any pending proceeding.

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 each of the above-identified reexamination proceedings. Accordingly, merger of the proceedings under § 1.565(c) is appropriate.

I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the '9824, '9731 and the '9756 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all files.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

CONCLUSION

1. Reexamination Control Nos. 90/009824, 90/009731 and 90/009756 are MERGED.

2. The reexamination files are being forwarded to the examiner for action.

3. **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.

4. 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.

/J Harrison/

Jessica Harrison
Supervisory Patent Examiner, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,826	09/17/2010	7607635	0644-102238	1670

27433 7590 03/28/2011

FOLEY & LARDNER LLP
321 NORTH CLARK STREET
SUITE 2800
CHICAGO, IL 60654-5313

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/28/2011

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

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Date:

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Paul M. Reznick
THE WEBB FIRM, P.C., 700 Koppers Bldg.
436 7th Avenue
Pittsburgh, PA 15219

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009826
PATENT NO. : 7607635
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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In re Application of 7607635
Appl. No.: 90/009,826
Filed: September 17, 2010
For: Fluid Valve Handle Assembly Providing Dual-Mode Operation

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed March 18, 2011, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that the documents entitled:

a) Drawings relating to U.S. Patent No. 3,279,742 ("Billeter"), Bates numbers SVC0317839-SVC0317841, Sloan Valve Co. v. Zurn Industries, Inc. et al., United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204;
b) "EX 500 Flush Valve Study," Bates numbers SVC0317842-SVC0317886, Sloan Valve Co. v. Zurn Industries, Inc. et al., United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204;
c) Confidential Exhibits to Deposition of Mathew Martin, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated August 11, 2010;
d) Confidential Exhibits to Deposition of Michael Rechtin, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated August 12, 2010;
e) Confidential Exhibits to Deposition of Joel Bock, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated August 13, 2010;
f) Confidential Exhibits to Deposition of Peter Jahrling, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated October 11, 2010;
g) Confidential Exhibits to Deposition of Mark Guttling-Kilzer, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated October 12, 2010;
h) Confidential Exhibits to Deposition of Daniel Carrol, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated October 13, 2010;

i) Confidential Exhibits to Deposition of John Wilson, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated October 14, 2010;
j) Confidential Exhibits to Deposition of Julie Shireman, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated October 15, 2010;
k) Deposition Transcript of Mr. Jim Allen, Sloan Valve Co. v. Zurn Industries, Inc. et al., United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated November 12, 2010; and
l) Confidential Exhibits to Deposition of Jim Allen, United States District Court for the Northern District of Illinois, Eastern Division, Case No. 1:10-cv-00204, Dated November 12, 2010,

filed March 7, 2011, 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 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.

Andres Kashnikow

Andres Kashnikow,
SPE, CRU 3993
(571) 272-4361

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,826	09/17/2010	7607635	0644-102238	1670

27433 7590 07/21/2011

FOLEY & LARDNER LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

THE WEBB LAW FIRM
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Pittsburgh, PA 15222

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009826
PATENT NO. : 7607635
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)).

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: **90/009,826**

1. The petitions under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed **March 18 (two); April 4; and April 12, 2011 are** 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)

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,834	10/12/2010	7,806,365	4871.REEXMS	5301

55749 7590 01/28/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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734 EAST 200 SOUTH
SALT LAKE CITY, UT 84102

Date: MAILED

JAN 28 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009834
PATENT NO. : 7806365
ART UNIT : 2900

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

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

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MAILED

JAN 28 2011

CENTRAL REEXAMINATION UNIT

Paul C. Oestreich (For Requester)
Morris O'Bryant Compagni, P.C.
734 East 200 South
Salt Lake City, UT 84102-2202

In re *Miller et al.*	:
Reexamination Proceeding	: DECISION ON
Control No. 90/009, 834	: PETITION UNDER
Filed: October 12, 2010	: 37 CFR 1.181
For: U.S. Patent No. 7,806,365	:

The paper filed by requester on December 17, 2010, styled as "Petition from Denial of Request for *Ex Parte* Reexamination of U.S. Patent No. 7,806,365," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated November 17, 2010. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,806,365 (hereinafter, the '365 patent) issued on October 5, 2010.

2. On October 12, 2010, a third party requester deposited a request for ex *partes* reexamination for claims 1-19 of the '365 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,834 (hereinafter, the '834 reexamination proceeding).

3. On November 17, 2010, an order denying the request for reexamination for claims 1-19 of the '365 patent was mailed.

4. On December 17, 2010, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

Petitioner's Grounds in Support of the Requested Relief

The following is a list of the prior art cited by requester:

1. Brewer, G. Daniel, *Hydrogen Aircraft Technology* (1991) (hereinafter "Brewer Book";
2. Sullivan, Roy M. et al., *Engineering Analysis Studies for Preliminary Design of Lightweight Cryogenic Tanks in UAV Applications*, May 2006 (hereinafter "Sullivan Paper");
3. U.S. Patent Application Publication No. 2004/0069897, filed January 28, 2003 to Corcoran (hereinafter "Corcoran");
4. Colozza, Anthony et al., *Overview of Innovative Aircraft Power and Propulsion Systems and Their Applications for Planetary Exploration*, July 2003 (hereinafter "Colozza Paper");
5. U.S. Patent No. 5,101,662 to Bond (hereinafter "Bond");
6. U.S. Patent No. 6,485,805 to Smith (hereinafter "Smith); and
7. Applicant's Admitted Prior Art (hereinafter "AAPA").

Petitioner (the third party requester) alleges that the examiner incorrectly denied the request for reexamination because the prior art, which is a combination of art previously considered and applied in the previous prosecution of the '365 patent (the Brewer Book and AAPA) taken in combination with newly cited prior art (Sullivan, Corcoran, the Colozza Paper, Bond and Smith), shows the features that were indicated as allowable (patentable) in the previous prosecution. Specifically, petitioner argues that he has established a substantial new question of patentability by presenting the previously considered Brewer Book reference in a new light by requesting its consideration in combination with the newly cited references. Petitioner also argues that the denial inaccurately characterized the prosecution history and inaccurately characterized the cited

art as relied on during prosecution, thus failing to appreciate the rationales to combine the new art with the old art.[1]

DECISION

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, the review will determine whether the examiner's refusal to order reexamination for claims 1-19 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-19 the '365 patent. As will be discussed in further detail in section III.B. below, consideration is limited as to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-19.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and

---

[1] It is also noted that petitioner argues that the request provides sufficient facts to at least provide a *prima facie* case of unpatentability, even though doing so is not required to present an SNQ (see pages 14-17 of the petition). However, this argument will not be addressed. As noted by petitioner at page 14 of the petition, there is a clear difference between the existence of an SNQ and a *prima facie* case of unpatentability (see also MPEP 2642). This decision does not seek to address issues of unpatentability, only issues relating to the existence or non-existence of an SNQ.

has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[2] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." [3],[4] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order,

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[2] Public Law 96-517, enacted on December 12, 1980.

[3] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

[4] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

> (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
>
> (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
>
> (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
>
> (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

A. As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated October 12, 2010. As will be discussed in further detail in section B. below, consideration is limited as to whether the cited references raise a substantial new question of patentability (SNQ) to patent claims 1-19.

The evidence and explanation, as set forth in the request dated October 12, 2010, simply does not support ordering a request for reexamination. The request does not present sufficient evidence that any of the previously cited and considered references are presented in a new light, or themselves otherwise provide any new technical teaching that was not previously discussed and considered on the record in a previous examination. As pointed out by the examiner at page 4 of the order denying reexamination, "[T]here is not a clear demonstration of "new light" being shed by the request on the teaching of the Brewer Book". The examiner also points to several instances in Office actions from the previous prosecution (including the reasons for allowance where the Brewer Book was applied against the claims (see pages 4-5 of the denial). The examiner also correctly notes that petitioner's argument that since the previous examiner did not cite *specifically* all of the same pages and Figures as the request, the examiner was thus not fully aware of the teachings of the Brewer Book is without merit. Also, as pointed out at pages 5-11 of the denial, inclusive, all of the other cited references are merely cumulative to the teachings relied upon by the examiner in the previous prosecution. MPEP 2247 is clear

that references that are cumulative to the teachings of the art cited in the earlier concluded examination of the patent cannot raise a SNQ.

Petitioner can still avail itself of an *ex parte* reexamination proceeding, provided that petitioner formulates and files a request for *ex parte* reexamination that brings forth some new technological information that was not considered in a previous examination. If a new request is filed, the new request should clearly set forth each SNQ, each proposed rejection that supports the SNQs, what claims each proposed rejection is applied to, and a clear, detailed explanation for how the references teach *every* claim limitation for *each* proposed rejection. The new request must not lump together the explanations of multiple, distinct proposed rejections. See MPEP 2214, 2216 and 2217.

As explained above, in accordance with MPEP 2242, "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications.

REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '365 patent, requester may wish to consider filing a new and complete request for *ex parte* reexamination (which new request includes the missing information identified above). This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

The requester can file a new request for *ex parte* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.510. Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

CONCLUSION

1. The PETITION is DENIED.

2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to this decision should be directed Supervisory Patent Examiner Andres Kashnikow, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAILED
FEB 25 2011
CENTRAL REEXAMINATION UNIT

In re Reissue Application of Justin P. Merkys et al. Application No.: 11/861,465 Filed: September 26, 2007 For: U.S. Patent No. 6,988,538	DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS
In re Justin P. Merkys et al. Reexamination Proceeding Control No.: 90/009,842 Filed: December 22, 2010 For: U.S. Patent No.: 6,988,538	

The above-captioned reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

Reissue application No. 11/861,465 and reexamination proceeding No. 90/009,842 **are merged** into a single proceeding.

Patent owner is directed to Section II below for detailed guidance on the required housekeeping amendment to be submitted within **ONE MONTH** of this decision, placing the same amendments in both files of the present merged proceeding.

REVIEW OF FACTS

1. On January 24, 2006, the Office issued U.S. Patent No. 6,988,538 ("the '538 patent") to Justin P. Merkys et al. with 28 claims.

2. On September 26, 2007, patent owner filed an application for broadening reissue of the '538 patent; the Office assigned the application serial No. 11/861,465 ("the '465 reissue application"). The September 26, 2007 filing included a paper titled "Preliminary Amendment Submitted Under 37 CFR § 1.173" which amended the specification and added new claims 29-56.

3. On February 19, 2008, the *Official Gazette* included an announcement of the filing of the '465 reissue application.

4. The Office issued a non-final rejection action on May 14, 2009, for the '465 reissue application.

5. On September 14, 2009, patent owner filed a response to the May 14, 2009 action in the '465 reissue application. The response included amendments to claims 4, 11, 20, 29, 32, 39, 48, and 52.

6. The Office issued a final rejection action on November 20, 2009, for the '465 reissue application.

7. On January 20, 2010, patent owner filed a response to the November 20, 2009 action in the '465 reissue application. The January 20, 2010 response sought to amend claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

8. The Office issued an advisory action on January 29, 2010, for the '465 reissue application. The January 29, 2010 action stated that the amendments proposed in patent owner's January 20, 2010 response will not be entered.

9. On February 19, 2010, patent owner filed a request for continued examination in the '465 reissue application. The February 19, 2010 filing included a paper titled "Amendment Accompanied By A Request For Continued Examination Under 37 CFR § 1.114" which amended the specification and claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

10. On December 22, 2010, third party requester filed a request for reexamination of the '538 patent; the Office assigned the request control No. 90/009,842 ("the '9842 reexamination proceeding").

11. On January 18, 2011, under the Office's pilot program for waiver of patent owner's statement, patent owner agreed to waive its right to file a patent owner's statement under 35 U.S.C. 304 in the event reexamination is ordered for the '538 patent.

12. On February 1, 2011, the Office ordered reexamination for the '9842 reexamination proceeding.

13. The Office has not issued an action on the merits in the '9842 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '465 reissue application and the '9842 reexamination proceeding are currently pending. The order to reexamine has been mailed in the '9842 reexamination proceeding, and notice of the '465 reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether to merge the two proceedings, consideration is given to the status of each proceeding. See MPEP § 2285.

In order to provide efficient and prompt handling of the reissue and *ex parte* reexamination proceedings, it is appropriate, in this instance, that the present reissue application and the present *ex parte* reexamination proceeding be merged, such that a joint examination will be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and multiple *ex parte* reexamination proceedings under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114,[1] the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that the severed reexamination proceeding would be an independent proceeding, and a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and reexamination proceeding are hereby merged. A joint examination will be conducted in accordance with the following guidelines and

[1] It is observed that one such RCE has already been filed for the '465 application.

requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the '465 reissue application file shows:

   (a) Original claims 1-28 of the '538 patent are present.

   (b) New claims 29-56 are added by the September 26, 2007 amendment.

   (c) Claims 4, 11, 20, 29, 32, 39, 48, and 52 are amended by the September 14, 2009 amendment.

   (d) Claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53 are amended by the February 19, 2010 amendment.

   (e) The specification is amended by the September 26, 2007 and February 19, 2010 amendments.

3. A review of the file of the '9842 reexamination proceeding shows that the specification is not amended and that original claims 1-28 of the '538 patent are present; in short, no amendments have been made.

4. Accordingly, the claims and specifications are not identical in both proceedings.

5. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to this requirement must be **strictly** limited to formally placing the same amendment in each **file so that the specification, claims, and drawings are identical in both cases**. The patent owner must **NOT** address any issue of patentability in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for both files (i.e., the reissue application number and the *ex parte* reexamination proceeding control number) and a signature. The housekeeping amendment must be filed in duplicate for entry into the reissue application file and the *ex parte* reexamination file.

   It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted under 37 CFR 1.173, in accordance with

reissue practice. The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).**

To avoid confusion as to the number of times a claim has been amended in the '465 reissue application and the '9842 reexamination proceeding in the present merged proceeding, it is preferred that patent owner use the status identifier "Amended" in the housekeeping amendment instead of "Twice Amended," etc. **No other amendments are permitted as part of this housekeeping amendment**.

See MPEP 1453 for a complete discussion of amendment practice in reissue applications

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time period for filing the amendment expires (see item 5 of Part II above), the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a proper housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) is to be rejected under the second paragraph of 35 U.S.C. 112 as being indefinite as to the content of the claim, and thus failing to particularly point out the invention. The disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in ex parte reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for all of the cases, i.e., the reissue application and the reexamination proceeding, and each action will be entered into the file history for both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with two

copies being filed for entry in the two files, with each of the two bearing a signature. Any such response must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application: "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

   Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are *always* underlined, and only words being deleted from the patent appear in brackets.

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

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the reexamination certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in statutes and rules relating to reexamination and reissue proceedings. Thus, 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 that 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).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/861,465 and reexamination control No. 90/009,842 **are merged** into a single proceeding.

2. Pursuant to Part II of this decision, a housekeeping amendment is required within **ONE MONTH** of this decision, placing the same amendments in all (both) cases of the present merged proceeding.

3. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed**. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the proceeding as per 37 CFR 1.550(d).

5. The merged reissue and reexamination proceeding will be examined in Technology Center 3700. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '538 patent (e.g., by preparing/signing an action). See MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in both cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

6. Patent owner is reminded to serve any communications directed to the now-merged

proceeding on the requester.

7. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

8. Telephone inquiries related to 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

February 22, 2011

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Maier & Maier, PLLC
1000 Duke Street
Alexandria, VA 22314

(For Third Party Requester)

In re Reissue Application of
Justin P. Merkys et al.
Application No.: 11/861,465
Filed: September 26, 2007
For: U.S. Patent No. 6,988,538

In re Justin P. Merkys et al.
Reexamination Proceeding
Control No.: 90/009,842
Filed: December 22, 2010
For: U.S. Patent No.: 6,988,538

In re Justin P. Merkys et al.
Reexamination Proceeding
Control No.: 90/009,892
Filed: April 14, 2011
For: U.S. Patent No.: 6,988,538

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

The above-captioned reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

Reissue application No. 11/861,465 and reexamination control numbers 90/009,842 and 90/009,9892 **are merged** into a single proceeding.

Patent owner is directed to Section II below for detailed guidance on the required housekeeping amendment to be submitted within **ONE MONTH** of this decision, placing the same amendments in all three files of the present merged proceeding.

REVIEW OF FACTS

1. On January 24, 2006, the Office issued U.S. Patent No. 6,988,538 ("the '538 patent") to Justin P. Merkys et al. with 28 claims.

2. On September 26, 2007, patent owner filed an application for broadening reissue of the '538 patent; the Office assigned the application serial No. 11/861,465 ("the '465 reissue application"). The September 26, 2007 filing included a paper titled "Preliminary Amendment Submitted Under 37 CFR § 1.173" which amended the specification and added new claims 29-56.

3. On February 19, 2008, the *Official Gazette* included an announcement of the filing of the '465 reissue application.

4. The Office issued a non-final rejection action on May 14, 2009, for the '465 reissue application.

5. On September 14, 2009, patent owner filed a response to the May 14, 2009 action in the '465 reissue application. The response included amendments to claims 4, 11, 20, 29, 32, 39, 48, and 52.

6. The Office issued a final rejection action on November 20, 2009, for the '465 reissue application.

7. On January 20, 2010, patent owner filed a response to the November 20, 2009 action in the '465 reissue application. The January 20, 2010 response sought to amend claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

8. The Office issued an advisory action on January 29, 2010, for the '465 reissue application. The January 29, 2010 action stated that the amendments proposed in patent owner's January 20, 2010 response would not be entered.

9. On February 19, 2010, patent owner filed a request for continued examination in the '465 reissue application. The February 19, 2010 filing included a paper titled "Amendment Accompanied By A Request For Continued Examination Under 37 CFR § 1.114" which amended the specification and claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

10. On December 22, 2010, third party requester filed a request for reexamination of the '538 patent; the Office assigned the request control No. 90/009,842 ("the '9842 reexamination proceeding").

11. On February 1, 2011, the Office ordered reexamination for the '9842 reexamination proceeding.[1]

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[1] On January 18, 2011, under the Office's pilot program for waiver of patent owner's statement, patent owner agreed to waive its right to file a patent owner's statement under 35 U.S.C. 304.

12. On February 25, 2011, the Office mailed a decision merging the '465 reissue application and the '9842 proceeding into a single proceeding.

13. On May 4, 2011, patent owner filed a housekeeping amendment in the merged proceeding, in response to the February 25, 2011 decision.[2] The May 4, 2011 amendment included amendments to both the specification and claims.[3]

14. On April 14, 2011, the same third party requester filed a second request for reexamination of the '538 patent; the Office assigned the April 14, 2011 request control No. 90/009,892 ("the '9892 reexamination proceeding").

15. On May 17, 2011, the Office ordered reexamination for the '9892 reexamination proceeding.[4]

16. The Office has not issued an action on the merits in the '9892 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '465 reissue application and the '9842 and '9892 reexamination proceedings are currently pending. The order to reexamine has been mailed in the reexamination proceedings, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of multiple proceedings. In making a decision on whether to merge multiple proceedings, consideration is given to the status of each proceeding. See MPEP § 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings, it is appropriate, in this instance, that the present reissue application and reexamination

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[2] Patent owner first filed a housekeeping amendment responsive to the February 25, 2011 decision on March 17, 2011. The March 17, 2011 housekeeping amendment was identified as being non-compliant in an April 19, 2011 Office communication, which set a one month period for patent owner to supply a corrective paper.
[3] In particular, patent owner amended claims 1, 4-5, 11-12, 20-21, and 24-25, and added new claims 29-56.
[4] On April 26, 2011, under the Office's pilot program for waiver of patent owner's statement, patent owner agreed to waive its right to file a patent owner's statement under 35 U.S.C. 304.

proceedings be merged, such that a joint examination will be conducted. Accordingly, the examination of the reissue application and the two *ex parte* reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and multiple *ex parte* reexamination proceedings under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114,[5] the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a RCE is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in All Three Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. As stated in the February 25, 2011 merger decision for the '465 reissue application and '9842 reexamination proceeding, the claims and specification were not identical in the '465 reissue application and '9842 reexamination proceeding at the time of the merger. Accordingly, the February 25, 2011 merger decision required an appropriate housekeeping amendment.

3. Patent owner's May 4, 2011 housekeeping amendment placed the same amendments in both the '465 reissue application and '9842 reexamination proceeding. Specifically, the May 4, 2011 housekeeping amendment amended the specification and claims 1, 4-5, 11-12, 20-21, and 24-25 of the '538 patent, and added new claims 29-56.

[5] It is observed that one such RCE has already been filed for the '465 application.

4. A review of the file of the '9892 reexamination proceeding shows that the specification is not amended and that original claims 1-28 of the '538 patent are present; in short, no amendments have been made.

5. Accordingly, the claims and specifications are not identical in all three proceedings.

6. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases, specifically, the above-captioned reissue and reexamination proceedings. The response to this requirement must be **strictly** limited to formally placing the same amendment in each **file so that the specification, claims, and drawings are identical in all three cases**. The patent owner must **NOT** address any issue of patentability in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for all three files (i.e., the reissue application number and the *ex parte* reexamination proceeding control numbers) and a signature. The housekeeping amendment must be filed in triplicate for entry into the reissue application file and the *ex parte* reexamination files.

   It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted <u>under 37 CFR 1.173</u>, in accordance with reissue practice. The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).**

   To avoid confusion as to the number of times a claim has been amended in the '465 reissue application and the '9842 and '9892 reexamination proceedings in the present merged proceeding, it is preferred that patent owner use the status identifier "Amended" in the housekeeping amendment instead of "Twice Amended," etc. **No other amendments are permitted as part of this housekeeping amendment.**

See MPEP 1453 for a complete discussion of amendment practice in reissue applications

III. <u>Conduct of the Merged Reissue Application Examination and Reexamination Proceedings</u>

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time period for filing the amendment expires (see item 6 of Part II above), the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a proper housekeeping amendment is not timely submitted, any claim which does not contain identical text in all three proceedings (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) is to be rejected under the second paragraph of 35 U.S.C. 112 as being indefinite as to the content of the claim, and thus failing to particularly point out the

invention. The disclosures in all three proceedings should be objected to as being inconsistent for the same underlying patent.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in ex parte reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data for all of the cases, i.e., the reissue application and the two reexamination proceedings, and each action will be entered into the file history for all three files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with three copies being filed for entry in the three files, with each of the three bearing a signature. Any such response must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application: "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

   Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are *always* underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claim

fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the reexamination certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved. The reexamination prosecutions 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 proceedings is clearly needed as a result of the difference in statutes and rules relating to reexamination and reissue proceedings. If further action in the reexamination proceedings is needed, 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 that 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).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/861,465 and reexamination control Nos. 90/009,842 and 90/009,892 **are merged** into a single proceeding.

2. Pursuant to Part II of this decision, a housekeeping amendment is required within **ONE MONTH** of this decision, placing the same amendments in all three files of the present merged proceeding.

3. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding**, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

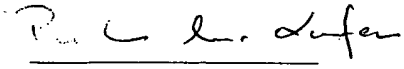
4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the proceeding as per 37 CFR 1.550(d).

5. The merged reissue and reexamination proceedings will be examined in Technology Center 3700. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '538 patent (e.g., by preparing/signing an action). See MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in all three cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

6. Patent owner is reminded to serve any communications directed to the now-merged proceeding on the requester.

7. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

8. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

September 6, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,860		6305849	AOSI01-00029	8022

26127 7590 04/19/2012

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EXAMINER

ART UNIT	PAPER NUMBER

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

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009860
PATENT NO. : 6305849
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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Dykema Gossett PLLC
39577 Woodward Avenue
Suite 300
Bloonfield Hills, Michigan 48304-5086

(For Patent Owner)

MAILED

APR 19 2012

CENTRAL REEXAMINATION UNIT

Munck Carter, LLP
P.O. DrawerR 800889
Dallas, Texas 75380

(For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No. 90/009,860
Filed: December 9, 2010
For: U.S. Patent No. 6,305,849

DECISION GRANTING PETITION

This is a decision on third party requester's February 22, 2011 petition entitled "PETITION TO THE DIRECTOR TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR UNDER 1.181 FOR QUESTIONS NOT SPECIFICALLY PROVIDED FOR IN THE REGULATIONS (37 CFR 1.182)" ("the petition under 37 CFR 1.181"), and third party requester's February 27, 2012 petition entitled "REQUEST TO WITHDRAW REQUESTER'S PETITION TO THE DIRECTOR FILED FEBRUARY 22, 2011" ("the petition to withdraw").

The petition under 37 CFR 1.181 and the petition to withdraw are before the Office of Patent Legal Administration.

In the petition under 37 CFR 1.181, requester requests supervisory review of the Office's January 24, 2011 *sua sponte* decision vacating the *ex parte* reexamination filing date. In the petition to withdraw, requester requests that the petition under 37 CFR 1.181 be withdrawn. To date, no decision on the petition under 37 CFR 1.181 has been mailed in the instant proceeding. Accordingly, the petition to withdraw is granted to the extent that it is being considered. As a result, the relief petitioned for in the February 22, 2011 paper is no longer being requested. Therefore, the requester's February 22, 2011 petition under 37 CFR 1.181 is hereby dismissed.

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

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

04-17-2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,870	01/11/2011	7349012	51020-056USC1RX	3070

42532 7590 02/09/2012

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/09/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date: MAILED

FEB 09 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009870 + 95001614
PATENT NO. : 7349012
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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FEB 09 2012

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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& Neustadt, L.L.P.
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(For the 90/009,870 Requester)

Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Avenue, NW
Washington, D.C. 20005

(For the 95/001,614 Requester)

In re Takezawa et al.
Ex Parte Reexamination Proceeding
Control No.: 90/009,870
Filed: January 11, 2011
For: U.S. Patent No. 7,349,012 B2

In re Takezawa et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,614
Filed: May 3, 2011
For: U.S. Patent No. 7,349,012 B2

DECISION
SUA SPONTE
TO MERGE
REEXAMINATION
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration on merging the above proceedings.

Ex parte reexamination proceeding No. 90/009,870 and *inter partes* reexamination proceeding No. 95/001,614 **are merged** into a single proceeding.

BACKGROUND

1. On March 25, 2008, United States Patent Number 7,349,012 B2 ("the '012 patent") issued to Takezawa et al. with 5 claims.

2. On January 11, 2011, a request for *ex parte* reexamination of claims 1-5 of the '012 patent was filed by a third party requester, Research in Motion Limited, and assigned Reexamination Control No. 90/009,870 ("the '9870 proceeding").

3. On March 24, 2011, *ex parte* reexamination of claims 1-5 of the '012 patent was granted in the '9870 reexamination proceeding. The order was accompanied by a non-final

Office action.

4. On May 3, 2011, a request for *inter partes* reexamination of claims 1-5 of the '012 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,614 ("the '1614 proceeding"). The request identified Apple Inc. and HTC Corporation ("the *inter partes* third party requester") as the real parties in interest.

5. On May 24, 2011, the patent owner filed a response to the non-final Office action in the '9870 proceeding. The response included an amendment in which claim 3 was amended and new claims 6-23 were added.

6. On August 1, 2011, *inter partes* reexamination of claims 1-5 of the '012 patent was granted in the '1614 proceeding.

7. To date, no Office action has been issued in the '1614 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '9870 proceeding) is an *ex parte* proceeding. The other proceeding (the '1614 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, during a telephonic interview with a USPTO official on February 4, 2011, the patent owner agreed to waive its right to file a statement under 37 CFR 1.530 in the *ex parte* proceeding. Therefore, consideration of merger is ripe at this point in time.

MPEP 2686.01 points out:

> 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."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/009,870 and 95/001,614 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. An amendment accompanied the patent owner's May 24, 2011 response in the '9870 *ex parte* reexamination proceeding. Claim 3 has been amended and new claims 6-23 have been added in the '9870 *ex parte* proceeding, while the claims in the '1614 *inter partes* proceeding have not been so amended. Thus, the claims are not currently the same in both proceeding files. An Office action requiring an amendment placing the claims of both proceedings in identical form is being issued concurrently with this decision. The patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requester will then have an opportunity to comment on the patent owner's response in accordance with the procedures in 37 CFR 1.947.

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* third party requester can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response. An *inter partes* requester does not have a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from the *ex parte* requester. The *inter partes* requester's comments must be submitted within the statutory time period of 30 days from date of service of the patent owner's response.

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[1] Each time that the patent owner files a response to an action on the merits from the United States Patent and Trademark Office ("Office"), the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683.[2] 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, the *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN as to the rejections the third party requester proposed in the *inter partes* reexamination request (not as to the rejections proposed in the *ex parte* reexamination request), and any that the *inter partes* 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, an appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the requester did not propose in the *inter partes* reexamination request, or during the merged proceeding) can be proposed by the *inter partes* third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

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

All papers filed by the patent owner and the *inter partes* third party requester should be directed:

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[2] As noted above, the rights of the *ex parte* requester are governed by 37 CFR 1.510 through 1.560. The active participation of the *ex parte* requester ends with the reply pursuant to 37 CFR 1.535, and no further submissions on behalf of the *ex parte* requester will be acknowledged or considered. *See* 37 CFR 1.550(g).

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://efs.uspto.gov/efile/myportal/efs-registered

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to 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 *inter partes third party requester* proposes to contest. In the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The *inter partes* third party requester must identify each rejection *that was previously proposed by the inter partes third party requester* that the *inter partes* third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the *inter partes* third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant *inter partes* requester) can be proposed by the *inter partes* third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that the *inter partes* third party requester can challenge in the appellant brief.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,870 and *inter partes* Reexamination Control No. 95/001,614 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. The examiner should not issue any further Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to the concurrently mailed Office action (see II above) to place the same amendment in all

proceedings and the *inter partes* requester's comments on that response, or (b) the expiration of the time for filing the required response and any comments the *inter partes* requester elects to file.

3. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

November 22, 2011

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.
90/009,876	02/15/2011	7037321	132.0007-02RX2	7593

22882 7590 02/22/2012

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Andrew J. Vance, Esq.
FINNEGAN HENDERSON FARABOW ET AL.
901 New York Ave., NW
Washington, DC 20001-4413

Date: MAILED
FEB 22 2012
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009876
PATENT NO. : 7037321
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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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

ARNOLD & PORTER LLP
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WASHINGTON, DC 20004-1206

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(For 90/009,876 Requester)

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(For 95/001,556 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,518
Filed: January 10, 2011
For: U.S. Patent No. 7,037,321 B2

Ex Parte Reexamination Proceeding
Control No. 90/009,876
Filed: February 15, 2011
For: U.S. Patent No. 7,037,321 B2

Inter Partes Reexamination Proceeding
Control No. 95/001,556
Filed: February 25, 2011
For: U.S. Patent No. 7,037,321 B2

DECISION ON PETITIONS AND MERGING REEXAMINATION PROCEEDINGS

This is a decision on the following patent owner petitions:

(1) Petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" filed on December 13, 2011 in reexamination proceeding 95/001,556;

(2) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 95/001,556; and

(3) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 90/009,876.

The patent owner petitions are before the Office of Patent Legal Administration.

SUMMARY

The patent owner's December 13, 2011 petition under 37 CFR 1.183 filed in the 95/001,556 proceeding requesting waiver of the requirement under 37 CFR 1.939(b) in order to permit consideration of the concurrently filed patent owner petition under 37 CFR 1.182 in the 95/001,556 proceeding is **granted**.

For the reasons set forth below, the patent owner's December 13, 2011 petitions filed in the 90/009,876 and 95/001,556 proceedings requesting (1) that the 90/009,876 and 95/001,556 proceedings be suspended until the conclusion of the 95/001,518 proceeding or (2) in the alternative, that the 90/009,876 and 95/001,556 proceedings not be merged with the 95/001,518 proceeding, are **dismissed**.

Ex parte reexamination proceeding 90/009,876 and *inter partes* reexamination proceedings 95/001,518 and 95/001,556 **are merged** into a single proceeding.

REVIEW OF THE RELEVANT FACTS

1. On May 2, 2006, United States Patent Number 7,037,321 B2 ("the '321 patent") issued to Sachdeva et al., with claims 1-9.

2. On January 10, 2011, a first request for *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,518 ("the '518 proceeding"). The request identified Boston Scientific Corporation as the real party in interest.

3. On February 15, 2011, a request for *ex parte* reexamination of claims 1-3, and 7 of the '321 patent was filed by a third party requester and was assigned control number 90/009,876 ("the '876 proceeding").

4. On February 25, 2011, a second request for *inter partes* reexamination of claims 1-9 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,556 ("the '556 proceeding"). The request identified MicroStrategy Incorporated as the real party in interest.

5. On March 2, 2011, *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was granted in the '518 proceeding. The order stated that the patent owner waived its right under 37 CFR 1.530 to file a patent owner statement. The order was also accompanied by a non-final Office action rejecting claims 1, 2, and 7.

6. On March 28, 2011, *inter partes* reexamination of claims 1-9 of the '321 patent was granted in the '556 proceeding.

7. On April 2, 2011, *ex parte* reexamination of claims 1-3 and 7 of the '321 patent was granted in the '876 proceeding. The patent owner did not amend or add any claims.
8. On May 2, 2011, the patent owner timely filed a response to the March 2, 2011 non-final Office action in the '518 proceeding.

9. On June 1, 2011, the third party requester timely filed comments after the patent owner's response in the '518 proceeding.

10. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" in the '876 proceeding.

11. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" in the '556 proceeding. The patent owner concurrently filed a petition in the '556 proceeding entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings."

12. On February 15, 2012, the patent owner filed a power of attorney and statement under 37 CFR 3.73(b) in the '518, '556, and '876 proceedings.

13. To date, no Office action has issued in either of the '556 and '876 proceedings.

DECISION

I. PATENT OWNER'S PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF 37 CFR 1.939(B)

In the December 13, 2011 petition under 37 CFR 1.183 filed in the '556 proceeding, the patent owner requests waiver of the requirements under 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office Action on the merits of an *inter partes* reexamination proceeding in order to permit consideration of the concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding. In support of its request for waiver of the rule, the patent owner argues that the Office recognizes situations where the requirements of 37 CFR 1.939(b) may be waived. The patent owner points out that such a situation is set forth in MPEP 2686.01(VI) where the Office will waive the requirements of 37 CFR 1.939(b) when deciding on a petition to merge multiple reexamination proceedings.

The December 13, 2011 patent owner petition under 37 CFR 1.183 is granted to the extent that the requirements of 37 CFR 1.939(b) are hereby waived to assure that the patent owner's concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding will be considered at the earliest possible stage.

II. PATENT OWNER'S PETITIONS UNDER 37 CFR 1.182 REQUESTING EITHER STAY OF THE '556 AND '876 PROCEEDINGS, OR NOT TO MERGE THESE PROCEEDINGS WITH THE '518 PROCEEDING

In the December 13, 2011 petitions under 37 CFR 1.182 filed in the '556 and '876 proceedings, the patent owner requests that these proceedings be stayed or not merged with the '518 proceeding. In support of its request to stay the '556 and '876 proceedings, the patent owner argues that the prosecution of the '518 proceeding is well under way and that proceeding with the prosecution of the '556 and '876 proceedings would delay the prosecution of the '518 proceeding. The patent owner contends that the delay would be due to the possibility that the concurrent prosecution of the same claims from each proceeding may lead to different results. Furthermore, the patent owner argues that staying the '556 and '876 proceedings would permit the '518 proceeding to conclude more quickly in accordance with special dispatch. In the alternative, the patent owner requests that the Office not merge the '556 and '876 proceedings with the '518 proceeding. In support of its requests for not merging these proceedings, the patent owner argues that merging these proceedings would also delay the prosecution of the '518 proceeding.

In response, the patent owner's arguments to stay or not merge the proceedings are found to be unpersuasive. Contrary to the patent owner's premise that the prosecution of the '518 proceeding is well under way, the prosecution of the '518 proceeding is still in the early stages of prosecution. Specifically, the Office issued a non-final Office action on March 2, 2011 in the '518 proceeding and the patent owner and the third party requester have respectively filed responses and comments on May 2, 2011 and June 1, 2011. No further action has been taken by the Office in the '518 proceeding. Therefore, merging the '556 and the '876 proceedings with the '518 proceeding at this point would not unduly delay the '518 reexamination proceeding. Furthermore, the Office does not have discretion to indefinitely suspend an *ex parte* reexamination proceeding pending conclusion of another reexamination proceeding. (*See*, *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).)

Reexamination has been ordered in the '556, '876, and '518 proceedings for overlapping claims of the same patent. All proceedings are still pending and have not been terminated. In addition, in the '876 proceeding, the patent owner has waived the right to file a patent owner statement under 37 CFR 1.530.[1] Therefore, consideration of merger is now ripe.

MPEP 2686.01 points out:

[1] See page 2 of the April 2, 2011 Order granting *ex parte* reexamination in the '876 proceeding.

> 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."

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

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the three proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the '518, '556, and '876 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

III. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

The 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.

IV. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the requester of the '876 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.[2] The examiner will conduct reexamination in the merged proceeding for claims 1-9 of the '321 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

[2] Active participation of the *ex parte* requester ends with the reply pursuant to 37 CFR 1.535 or the expiration of the time period for such reply. As such period has expired, further submissions on behalf of the *ex parte* requester will not be acknowledged or considered. *See* 37 CFR 1.550(g).

Upon merger of proceedings, all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[3] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

A discussion of an *inter partes* requester's appeal rights can be found in section G below.

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 *inter partes* 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 *inter partes* 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 the patent owner and the *inter partes* requesters should be directed:

by Mail to:	Attn: Mail Stop "*Inter Partes* Reexam" Central Reexamination Unit Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
by FAX to:	(571) 273-9900 Central Reexamination Unit
by Hand to:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314

[3] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* 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.

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at: https://efs.uspto.gov/efile/myportal/efs-registered

The patent owner and the *inter partes* requesters are reminded that every paper filed (including papers filed *via* facsimile transmission) 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 Rights and Procedures Reminders for *Inter Partes* Reexamination

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP §§ 2674 through 2675 and 2678 through 2683.

With respect to the patent owner's notice of appeal, the appeal must only be taken from the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the patent owner proposes to contest, and must identify each claim rejected by examiner that the patent owner intends to contest.

With respect to an *inter partes* requester's notice of appeal, the appeal must only be taken from the finding(s) of patentability of claims in the RAN that the *inter partes* requester proposes to contest. As set forth in MPEP § 2674, the *inter partes* requester must identify in the notice of appeal each rejection that was previously proposed by that *inter partes* requester that the *inter partes* requester intends to contest and each rejection made and later withdrawn by the examiner that the *inter partes* 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 *inter partes* requester must identify each previously proposed rejection to be contested.

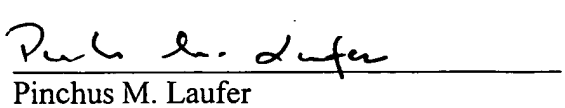
No new ground of rejection can be proposed by an *inter partes* requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* requester has not yet had an opportunity to propose it as an *inter partes* requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that an *inter partes* requester can challenge in the appellant brief.

It is to be noted that, because the '518 *inter partes* third party requester did not propose any rejections of claims 3-6, 8, and 9 in its request for reexamination, the '518 requester has no appeal rights as to those claims as they appear in the '321 patent.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,876 and *inter partes* Reexamination Control Nos. 95/001,518 and 95/001,556 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part IV of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



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

February 21, 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 NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,880	02/25/2011	7499716	Rex-7499716	4977

68468 7590 12/22/2011

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MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2011

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date: 12-22-11

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

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009880
PATENT NO. : 7449716
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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DEC 22 2011

CENTRAL REEXAMINATION UNIT

Jon E Kappes
Law Offices of Steven G. Lisa, LTD.
c/o Intellevate, LLC
P.O. Box 52050
Minneapolis, MN 55402

(For Patent Owner)

Covington & Burling, LLP
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For 3rd Party Requester)

In re Helferich
Reexamination Proceeding
Control No.: 90/009,880
Filed: February 25, 2011
For: U.S. Patent No.: 7,499,716

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

This is a decision on the November 2, 2011 patent owner petition under 37 C.F.R. § 1.182 to enter, and to have the examiner consider, an 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 November 2, 2011, has not been entered for consideration by the examiner.

BACKGROUND

1. Patent number 7,499,716 (the '716 patent) issued on March 3, 2009, having 68 claims.

2. On October March 25, 2011, the Office issued an order granting a February 25, 2011 request for reexamination of claims 1-18 and 21-69 of the '716 patent by a third party requester, which was accorded control number 90/009,880 (the '9880 proceeding).

3. The proceeding progressed until, on October 25, 2011, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '9880 proceeding.

4. On November 2, 2011, the present proceeding entered the publication cycle.

5. Also on November 2, 2011, patent owner filed the instant petition to enter an IDS filed together with the petition under § 1.555.

6. On December 13, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8758th), US 7,499,716 C1.

RELEVANT LAW AND PROCEDURE

35 U.S.C. 305 Conduct of reexamination proceedings.

. . . 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.

Once the reexamination has entered the Reexamination Certificate printing cycle (452 status), pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

"(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
(1) Unpatentability of one of more claims, **which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;**"

The printing cycle for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the printing cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for

withdrawal of a reexamination proceeding from its printing cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its 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 (see item (A) above)** factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the printing cycle for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

DECISION

The present reexamination proceeding has concluded with the issuance of *Ex Parte* Reexamination Certificate (8758th), US 7,499,716 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '716 patent. Therefore, consideration by the examiner of the proffered information is not authorized by statute. Accordingly, the petition is dismissed.

ADDITIONAL DISCUSSION

As pointed out above, the examiner terminated prosecution on the merits by issuing a NIRC on October 25, 2011, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (8758th), thereby divesting the Office of jurisdiction over the '716 patent. However, even had the petition been addressed prior to issuance of the certificate, the November 2, 2011 IDS would not have had an entry right. While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 C.F.R. § 1.313 has provided such a mechanism for an application. Accordingly, the requirements of 37 C.F.R. § 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. This policy is explicitly set forth in MPEP 2256, which requires that 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.

In the present instance, the submission fails to satisfy the criteria set forth in MPEP 2256. The instant petition was not filed until November 2, 2011, on the same date that the proceeding entered the printing cycle. Patent owner provides a statement as to why the references could not have been submitted earlier."[1] However, the statement merely alleges that the information was "very recently received . . . the information did not exist earlier."[2] Petitioner has failed to submit facts supporting this statement such that the statement can be evaluated as to whether there was justifiable cause to withdraw the proceeding from the printing cycle. The IDS contains a significant number of documents to be reviewed. The petition states that "[t]he information

[1] Petition at 1.
[2] *Id.*

could not have submitted earlier because, in the case of the *inter partes* request and Order denying one such requests), the information did not exist earlier, and in the case of the references received from the prospective licensee, the information was not previously known to Patentee." As to the *inter partes* reexamination proceedings containing the references submitted in the IDS, these proceedings were filed on September 6, 2011, more than a month prior to the issuance of the NIRC; Thus, the information did exist earlier at that point. And, it is not stated why the patent owner waited until the decision on the requests to file the present IDS. Next, the IDS provides "References received from a prospective licensee of the related patents" as well as "Documents relating to *ex parte* reexaminations of related cases." As to the former, the petition does not state when the references were received from the prospective licensee, and states nothing as to the latter. Based on this alone, the petition fails to meet one of the necessary requirements, set forth in the MPEP for entry of an IDS after NIRC, i.e., "(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier."

Furthermore, the petition fails to provide a statement as to why the submitted IDS items of information makes at least one claim unpatentable. As the proceeding entered the printing cycle on the same date as the petition was submitted, such a statement is required to justify withdrawal of the proceeding from the printing cycle. There is no statement by the patent owner that unequivocally states why any of the documents submitted make at least one claim unpatentable, nor is there an amendment accompanied by an explanation as to how the amendment causes such claim(s) 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 has been required that the withdrawal criteria of 37 C.F.R. § 1.313(c) be complied with for an application, in which there is no statutory provision requiring special dispatch, such criteria must certainly be complied with for a reexamination proceeding *where there is a statutory mandate for special dispatch.* This is the point of MPEP 2256, as reproduced above.

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on October 25, 2011, and the proceeding has now entered the final stages of the publication process. 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 and the failure to set forth a sufficient factual accounting and a statement of unpatentability as to at least one claim under reexamination, the present reexamination proceeding will <u>not</u> be reopened at this late date to consider the proffered IDS paper.

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), presenting the patent owner's position.

CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on November 2, 2011.

2. The IDS papers have not been considered by the examiner. A copy of the IDS submission will, however, be placed in the electronic image file wrapper (IFW) for the proceeding.

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

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

December 21, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 12 2011

CENTRAL REEXAMINATION UNIT

In re Reissue Application of
Justin P. Merkys et al.
Application No.: 11/861,465
Filed: September 26, 2007
For: U.S. Patent No. 6,988,538

In re Justin P. Merkys et al.
Reexamination Proceeding
Control No.: 90/009,842
Filed: December 22, 2010
For: U.S. Patent No.: 6,988,538

In re Justin P. Merkys et al.
Reexamination Proceeding
Control No.: 90/009,892
Filed: April 14, 2011
For: U.S. Patent No.: 6,988,538

DECISION, *SUA SPONTE*, TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

The above-captioned reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

Reissue application No. 11/861,465 and reexamination control numbers 90/009,842 and 90/009,9892 **are merged** into a single proceeding.

Patent owner is directed to Section II below for detailed guidance on the required housekeeping amendment to be submitted within **ONE MONTH** of this decision, placing the same amendments in all three files of the present merged proceeding.

REVIEW OF FACTS

1. On January 24, 2006, the Office issued U.S. Patent No. 6,988,538 ("the '538 patent") to Justin P. Merkys et al. with 28 claims.

2. On September 26, 2007, patent owner filed an application for broadening reissue of the '538 patent; the Office assigned the application serial No. 11/861,465 ("the '465 reissue application"). The September 26, 2007 filing included a paper titled "Preliminary Amendment Submitted Under 37 CFR § 1.173" which amended the specification and added new claims 29-56.

3. On February 19, 2008, the *Official Gazette* included an announcement of the filing of the '465 reissue application.

4. The Office issued a non-final rejection action on May 14, 2009, for the '465 reissue application.

5. On September 14, 2009, patent owner filed a response to the May 14, 2009 action in the '465 reissue application. The response included amendments to claims 4, 11, 20, 29, 32, 39, 48, and 52.

6. The Office issued a final rejection action on November 20, 2009, for the '465 reissue application.

7. On January 20, 2010, patent owner filed a response to the November 20, 2009 action in the '465 reissue application. The January 20, 2010 response sought to amend claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

8. The Office issued an advisory action on January 29, 2010, for the '465 reissue application. The January 29, 2010 action stated that the amendments proposed in patent owner's January 20, 2010 response would not be entered.

9. On February 19, 2010, patent owner filed a request for continued examination in the '465 reissue application. The February 19, 2010 filing included a paper titled "Amendment Accompanied By A Request For Continued Examination Under 37 CFR § 1.114" which amended the specification and claims 1, 4-5, 11-12, 20-21, 24-25, 29, 32-33, 39-40, 48-49, and 52-53.

10. On December 22, 2010, third party requester filed a request for reexamination of the '538 patent; the Office assigned the request control No. 90/009,842 ("the '9842 reexamination proceeding").

11. On February 1, 2011, the Office ordered reexamination for the '9842 reexamination proceeding.[1]

[1] On January 18, 2011, under the Office's pilot program for waiver of patent owner's statement, patent owner agreed to waive its right to file a patent owner's statement under 35 U.S.C. 304.

12. On February 25, 2011, the Office mailed a decision merging the '465 reissue application and the '9842 proceeding into a single proceeding.

13. On May 4, 2011, patent owner filed a housekeeping amendment in the merged proceeding, in response to the February 25, 2011 decision.[2] The May 4, 2011 amendment included amendments to both the specification and claims.[3]

14. On April 14, 2011, the same third party requester filed a second request for reexamination of the '538 patent; the Office assigned the April 14, 2011 request control No. 90/009,892 ("the '9892 reexamination proceeding").

15. On May 17, 2011, the Office ordered reexamination for the '9892 reexamination proceeding.[4]

16. The Office has not issued an action on the merits in the '9892 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

> "If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, the '465 reissue application and the '9842 and '9892 reexamination proceedings are currently pending. The order to reexamine has been mailed in the reexamination proceedings, and notice of the reissue application has been published in the *Official Gazette*. Accordingly, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of multiple proceedings. In making a decision on whether to merge multiple proceedings, consideration is given to the status of each proceeding. See MPEP § 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings, it is appropriate, in this instance, that the present reissue application and reexamination

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[2] Patent owner first filed a housekeeping amendment responsive to the February 25, 2011 decision on March 17, 2011. The March 17, 2011 housekeeping amendment was identified as being non-compliant in an April 19, 2011 Office communication, which set a one month period for patent owner to supply a corrective paper.
[3] In particular, patent owner amended claims 1, 4-5, 11-12, 20-21, and 24-25, and added new claims 29-56.
[4] On April 26, 2011, under the Office's pilot program for waiver of patent owner's statement, patent owner agreed to waive its right to file a patent owner's statement under 35 U.S.C. 304.

proceedings be merged, such that a joint examination will be conducted. Accordingly, the examination of the reissue application and the two *ex parte* reexamination proceedings will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and multiple *ex parte* reexamination proceedings under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, merger would be ordered. In addition, **if a request for continued examination (RCE) is filed under 37 CFR 1.114,[5] the merged proceeding will be automatically severed**, and the reissue application may then be suspended. Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a RCE is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to 37 CFR 1.550(d).

DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-identified reissue application and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in All Three Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in all three files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. As stated in the February 25, 2011 merger decision for the '465 reissue application and '9842 reexamination proceeding, the claims and specification were not identical in the '465 reissue application and '9842 reexamination proceeding at the time of the merger. Accordingly, the February 25, 2011 merger decision required an appropriate housekeeping amendment.

3. Patent owner's May 4, 2011 housekeeping amendment placed the same amendments in both the '465 reissue application and '9842 reexamination proceeding. Specifically, the May 4, 2011 housekeeping amendment amended the specification and claims 1, 4-5, 11-12, 20-21, and 24-25 of the '538 patent, and added new claims 29-56.

[5] It is observed that one such RCE has already been filed for the '465 application.

4. A review of the file of the '9892 reexamination proceeding shows that the specification is not amended and that original claims 1-28 of the '538 patent are present; in short, no amendments have been made.

5. Accordingly, the claims and specifications are not identical in all three proceedings.

6. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in all three cases, specifically, the above-captioned reissue and reexamination proceedings. The response to this requirement must be **strictly** limited to formally placing the same amendment in each **file so that the specification, claims, and drawings are identical in all three cases**. The patent owner must **NOT** address any issue of patentability in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper that includes the identifying data for all three files (i.e., the reissue application number and the *ex parte* reexamination proceeding control numbers) and a signature. The housekeeping amendment must be filed in triplicate for entry into the reissue application file and the *ex parte* reexamination files.

   It is to be noted that, pursuant to MPEP 2285, amendments in a merged reissue/reexamination proceeding are submitted under 37 CFR 1.173, in accordance with reissue practice. The patent owner is reminded that **any changes must be made relative to the patent pursuant to 37 CFR 1.173(d).**

   To avoid confusion as to the number of times a claim has been amended in the '465 reissue application and the '9842 and '9892 reexamination proceedings in the present merged proceeding, it is preferred that patent owner use the status identifier "Amended" in the housekeeping amendment instead of "Twice Amended," etc. **No other amendments are permitted as part of this housekeeping amendment**.

See MPEP 1453 for a complete discussion of amendment practice in reissue applications

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time period for filing the amendment expires (see item 6 of Part II above), the examiner should promptly prepare an Office action for the merged proceeding.

2. In the event that a proper housekeeping amendment is not timely submitted, any claim which does not contain identical text in all three proceedings (or would be construed differently based on a difference in the specifications in the reexamination and reissue proceedings) is to be rejected under the second paragraph of 35 U.S.C. 112 as being indefinite as to the content of the claim, and thus failing to particularly point out the

invention. The disclosures in all three proceedings should be objected to as being inconsistent for the same underlying patent.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in ex parte reexamination (35 U.S.C. 305). In addition, if a final rejection Office action should be issued in this merged proceeding, any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.**

4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the reexamination proceedings. Each action will contain identifying data for all of the cases, i.e., the reissue application and the two reexamination proceedings, and each action will be entered into the file history for all three files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, with three copies being filed for entry in the three files, with each of the three bearing a signature. Any such response must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285, for a merged proceeding containing a reexamination proceeding and a reissue application: "Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

   Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted.* Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

   Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are *always* underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, excess claim

fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.

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

9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the reexamination certificate under 37 CFR 1.570. See MPEP 2285.

10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved. The reexamination prosecutions 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 proceedings is clearly needed as a result of the difference in statutes and rules relating to reexamination and reissue proceedings. If further action in the reexamination proceedings is needed, 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 that 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).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceedings. Such examination would be conducted as set forth in the immediately preceding paragraph.

CONCLUSION

1. Reissue application No. 11/861,465 and reexamination control Nos. 90/009,842 and 90/009,892 **are merged** into a single proceeding.

2. Pursuant to Part II of this decision, a housekeeping amendment is required within **ONE MONTH** of this decision, placing the same amendments in all three files of the present merged proceeding.

3. Periods for response are to be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination. In addition, **if a final rejection Office action should be issued in this merged proceeding,** any request for extension for time must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any final rejection.

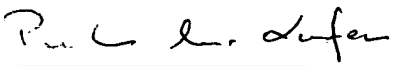
4. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the proceeding as per 37 CFR 1.550(d).

5. The merged reissue and reexamination proceedings will be examined in Technology Center 3700. The examiner assigned the merged proceeding is not to be one who was involved in any part of the examination of the '538 patent (e.g., by preparing/signing an action). See MPEP 2236. The examiner should not issue an Office action for the present merged proceeding of the reissue and reexamination proceedings until after the earlier of (a) the submission of the housekeeping amendment to place the same amendments in all three cases, or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

6. Patent owner is reminded to serve any communications directed to the now-merged proceeding on the requester.

7. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

8. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

September 6, 2011

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.
90/009,907 95/001635	05/04/2011	7779581	766P001-RX	4242

42754 7590 12/20/2011

Nields, Lemack & Frame, LLC
176 E. Main Street
Suite #5
Westborough, MA 01581

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/20/2011

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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CENTRAL REEXAMINATION UNIT

Nields, Lemack & Frame, LLC
176 E. Main Street
Suite #5
Westborough MA 01581

(For Patent Owner)

Foley Hoag, LLP
Patent Group, World Trade Center West
155 Seaport Blvd.
Boston, MA 02110

(For *Inter Partes* Requester)

Ex parte Reexamination Proceeding Control No. 90/009,907 Filed: May 4, 2011 For: U.S. Patent No. 7,779,581	**DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/001,635 Filing Date: May 26, 2011 For: U.S. Patent No. 7,779,581	

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

BACKGROUND

1. Patent number 7,779,581 (the '581 patent) issued to Flaherty *et al.* on August 24, 2010, with claims 1-47.

2. The '581 patent is the subject of concurrent proceedings styled *ADA Solutions v. Access Products*, *ADA Solutions v. Engineered Plastics*, and *ADA Solutions v. Cape Fear Systems*, Case Nos. 11-11757-NMG, 11-11758-NMG, and 11-11759-NMG (D.Mass.). The complaints were filed on October 4, 2011.[1]

3. On May 4, 2011, patent owner, ADA Solutions, filed a request for *ex parte* reexamination of claims 1 and 46 of the '581 patent; the request was assigned control no. 90/009,907 (the '9907 proceeding). Reexamination was ordered on June 6, 2011. A patent owner's statement was received on August 8, 2011.

[1] *See* Notice of Concurrent Proceedings, filed October 5, 2011 in Reexamination Control Number 95/001,635.

4. On May 26, 2011, a third party, Engineered Plastics, Inc., filed a request for *inter partes* reexamination of all claims of the '581 patent (claims 1-47); this request was assigned control no. 95/001,635 (the '1635 proceeding). Reexamination of claims 1-47 was ordered on August 12, 2011.

5. As of the date of this decision, no claim amendments have been made in either proceeding, and no Office action has been issued in either proceeding.

DECISION

I. MERGER OF PROCEEDINGS

As evidenced by the above review of facts, both the *inter partes* '1635 proceeding and the *ex parte* '9907 reexamination proceedings are currently pending. An order granting reexamination of claims 1 and 16 of the '581 patent has been mailed and a patent owner's statement has been filed in the '9907 *ex parte* reexamination proceeding. An order granting reexamination of claims 1-47 has been mailed in the '1635 *inter partes* reexamination proceeding. Therefore, consideration of merger pursuant to 37 CFR 1.989 is appropriate at this time.

MPEP 2686.01 points out:

> 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."

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/009,907 and 95/001,635 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the patent owner requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560. The examiner will conduct reexamination in the merged proceeding for claims 1-47 of the '581 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2). [2] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response. An *inter partes* requester does not have a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from the *ex parte* requester. The *inter partes* requester's comments must be submitted within the statutory time period of 30 days from date of service of the patent owner's response.

2. Appeal Rights:

A discussion of third party requester's appeal rights can be found in section G below.

C. Papers mailed/filed:

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

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[2] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* 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.

All papers filed by the patent owner and the third party requester(s) should be directed:

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

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

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

By EFS:

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

https:// efs.uspto.gov/efile/myportal/efs-registered.

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to 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 Rights and Procedures for *Inter Partes* Reexamination

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP §§ 2674 through 2675 and 2678 through 2683.

With respect to a patent owner's notice of appeal, the appeal must only be taken from the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the patent owner proposes to contest, and must identify each claim rejected by examiner that the patent owner intends to contest.

With respect to a third party requester's notice of appeal, the appeal must only be taken from the finding(s) of patentability of claims in the RAN that the third party requester proposes to contest. As set forth in MPEP § 2674, the third party requester must identify in the notice of appeal each rejection that was previously proposed by third party requester that the third party requester intends to contest and each rejection made and later withdrawn by the examiner that 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.

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. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that a requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,635 and *ex parte* Reexamination Control No. 90/009,907 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth in Part III of this decision.

2. Any questions concerning this communication should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

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McDermott Will & Emery LLP
600 13th Street NW
Washington, DC 20005-3096

For Patent Owner

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OCT 14 2011

CENTRAL REEXAMINATION UNIT

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

For 3rd Party Requester
90/011,697

Turner Boyd, LLP
2570 W. El Camino Real, #380
Mountain View, CA 94040

For 3rd Party Requester
90/009,912

Ex Parte Reexamination Proceeding
Control No. 90/011,697
Filed: May 18, 2011
For: U.S. Patent No. 7,835,927

Ex Parte Reexamination Proceeding
Control No. 90/009,912
Filed: June 6, 2011
For: U.S. Patent No. 7,835,927

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/011,697 and 90/009,912 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. 90/011,697 was ordered in a decision mailed August 5, 2011, granting reexamination of claims 1-20, all of the claims appearing in US Patent No. 7,835,927. Patent owner did not file a patent owner statement. No Office action has yet been rendered in this proceeding.

Reexamination in application control No. 90/009,912 was ordered in a decision mailed July 28, 2011 indicating that claims 1-20, all of the claims appearing in US Patent No. 7,835,927 would be reexamined. Patent owner did not file a patent owner statement. No Office action has yet been rendered in this proceeding

As evidenced by the above facts, reexamination control No. 90/011,697 and reexamination control No. 90/09,912 are currently pending. Since the order to reexamine has been mailed in each of the reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-20, all of the claims appearing in US Patent No. 7,835,927, are subject to reexamination. All papers mailed by the Office will take the form of a single action that jointly applies to each of the reexaminations. All papers issued by the Office will contain the identifying data each of the proceedings, and each paper will be entered into each of the 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 each of the third party requesters and requesters 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. 90/011,697 and 90/009,912 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be assigned to a single examiner in the Central Reexamination Unit and forwarded to that examiner for issuance of an Office action on the merits.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,074	12/07/2007	5,329,369	230.2-US-RX	1754

20872 7590 01/24/2011

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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

Copied from 90010074 on 01/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,021	09/06/2007	H. 5329369	4671-4672-001-02	8993

20872 7590 01/24/2011

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

HOVEY WILLIAMS LLP
10801 MASTIN BLVD, SUITE 1000
84 CORPORATE WOODS
OVERLAND PARK, KS 66210

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010021
PATENT NO. : 5329369
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)).

Copied from 90010074 on 01/27/2011

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

Date:

JASON S. FELDMAR
GATES & COOPER LLP
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010074
PATENT NO. : 5329369
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 90010074 on 01/27/2011

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,021 and 90/010,074

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 23, 2009 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 Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit

Eric Keasel
[*Signature*]

ERIC S. KEASEL
CRU SPE-AU 3992
(Title)

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

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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

Patent No. : 6335965 C1
Ser. No. : 90/010,045
Inventor(s) : KATZ
Issued : Nov. 29, 2011
Title : VOICE-DATA TELEPHONIC INTERFACE CONTROL SYSTEM
Docket No. : 6646-260
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 and/or 1.323.

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. 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.

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

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1. 17(i) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request 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

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Ennis Young
For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) **272-3435** or (703) 756-1814

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 No. : 4792968 C1
Ser. No. : 90/010,047
Inventor(s) : Katz
Issued : Dec. 20, 1988
Title : STATISTICAL ANALYSIS SYSTEM FOR USE WITH PUBLIC COMMUNICATION FACILITY
Docket No. : 6646-270
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 and/or 1.323.

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. 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.

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

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1. 17(i) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

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If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Ennis Young
For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) **272-3435** or (703) 756-1814

UNITED STATES PATENT AND TRADEMARK OFFICE

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

William S. Galliani
777 Sixth Street, NW
Suite 1100
Washington, DC 20001

In re Application of:
Chess, et al.
Application No. **90/010,050**
Filed: **November 8, 2007**
Title: **Apparatus and Method for Developing Secure Software**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

The Request To Withdraw from Representation filed December 6, 2010 meets all the requirements.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. §1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Patricia Martin

Patricia Martin
Paralegal Specialist
Central Reexamination Unit
(571) 272-5004

cc: Fortify Software, Inc.
2730 Sand Hill Road
Menlo Park, CA 94025

Robert W. Hahl
Neifeld IP Law, PC
4813-B Eisenhower Avenue
Alexandria, VA 22304

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.
90/010,053 + 95/000386	11/09/2007	7,223,236	7553.70003A / 07-0160	3387

EXAMINER

ART UNIT	PAPER NUMBER

60683 7590 05/07/2011

HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

DATE MAILED: 05/07/2011

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

Date: 5-7-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010053 - 95/000386
PATENT NO. : 7223236
ART UNIT : 3993

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

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

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MAY 07 2011

CENTRAL REEXAMINATION UNIT

Health Hero Network, Inc. (For Patent Owner)
2400 Geng Road
Suite 200
Palo Alto, CA 94303

Womble, Carlyle, Sandridge & Rice, PLLC (For *Inter Partes* Requester)
Attn.: IP Docketing
P.O. Box 7037
Atlanta, GA 30357-0037

Boziecevic, Field & Francis, LLP (For *Ex Parte* Requester)
1900 University Avenue
Suite 200
Palo Alto, CA 94303

In re Brown
Inter partes Reexamination Proceeding
Control No: 95/000,386
Filing Date: August 1, 2008
For: U.S. Patent No.: 7,223,236

In re Brown
Ex Parte Reexamination Proceeding
Control No. 90/010,053
Filing Date: November 9, 2007
For: U.S. Patent No. 7,223,236

DECISION DISMISSING PETITION TO TERMINATE MERGED PROCEEDINGS

This decision addresses the following papers:

- The patent owner's December 2, 2010 paper entitled "Notification of Conclusion of Prior or Concurrent Proceeding in *Inter Partes* Reexamination under 37 C.F.R. § 1.985 and Request for Termination of *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)", taken as a petition under 37 CFR 1.182 to terminate the present merged proceeding (the December 2, 2010 patent owner petition);

- The patent owner's January 13, 2011 petition entitled "Petition to Suspend and Transfer Jurisdiction", taken as a petition under 37 CFR 1.182 to suspend the present merged proceeding (the January 13, 2011 patent owner petition); and

- The requester's January 3, 2011 opposition to the December 2, 2010 petition, entitled "Inter partes Third Party Requester's Response to Patent Owner's 02-Dec-2010 Notification and Request for Termination of Inter Partes Reexamination" (the January 3, 2011 *inter partes* requester opposition).

The December 2, 2010 and January 13, 2011 patent owner petitions, the January 3, 2011 *inter partes* requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fees under 37 CFR 1.17(f) for patent owner's December 2, 2010 and January 13, 2011 petitions under 37 CFR 1.182, respectively, have been paid.

SUMMARY

The December 2, 2010 patent owner paper, which is taken as a petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding, is **dismissed**.

The January 13, 2011 patent owner petition, which is taken as a petition under 37 CFR 1.182 to suspend the present merged proceeding until the December 2, 2010 petition has been decided, and to transfer jurisdiction to the Office of Patent Legal Administration, is **dismissed as moot**.

DECISION

The December 2, 2010 Patent Owner Petition and the January 3, 2011 Inter Partes Requester Opposition

The patent owner argues that termination of the present merged 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 7,223,236 (the '236 patent), was the subject of a civil action in district court, i.e., *Health Hero Network, Inc. v. Alere Medical, Inc.*, Case No. 1:07-cv-05031, in the United States District Court for the Northern District of Illinois, Eastern Division. In support of its petition to terminate the present merged proceeding, the patent owner submits a copy of a "Notification of Docket Entry" by the

district court, which is a record of a stipulated order of dismissal by the court, and which states (emphasis added):

> MINUTE entry before Honorable Amy J. St. Eve: Pursuant to the parties' joint stipulation, all claims between the parties, *with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement)*, are dismissed with prejudice. All pending dates and deadlines are stricken. Civil case terminated. Mailed notice (kef,)

The patent owner provides evidence that the defendant in the civil action, Alere Medical, Inc., is a wholly owned subsidiary of Inverness Medical Innovations, Inc., who is the real party in interest in the *inter partes* reexamination proceeding control no. 95/000,386.[1] The requester in *ex parte* reexamination proceeding control no. 90/010,053 is Alere Medical, Inc., as stated in the "Request for Ex Parte Reexamination Transmittal Form", filed on November 9, 2007.

Thus, each requester in the merged proceeding was a party, or was in privy with a party, in the civil action, which satisfies item no.1.

Item nos. 2-4, however, have not been satisfied. The stipulated order of dismissal states that all claims are dismissed "*with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement"*. A copy of the parties' settlement agreement has *not* been provided for the record by the patent owner. The patent owner appears to provide a definition of "Field" on page 2 of the December 2, 2010 petition, and further states that "[t]he inclusion of the exception with respect to the "Field" *is believed* to provide for defense of allegations that might be made by an entity that was not a party to the civil action and, therefore, could not be bound by the settlement and/or dismissal with prejudice." Without a copy of the parties' settlement agreement, however, the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised, or could be raised, in the merged proceeding, or whether the court's stated exception refers to an entity that was not a party to the civil action, as argued by the patent owner. Furthermore, as argued by the *inter partes* requester,[2] the issue of invalidity can later be raised "in the defense of an assertion of patent infringement", as stated by the court's order. Therefore, the stipulated order of dismissal, on its face, does not appear to be "final" as to issues which could be raised in the merged proceeding.

For the reasons given above, the present petition fails to satisfy item no. 2.

Regarding item no. 3, the issue of invalidity does not appear to have been actually litigated in the present case. The present case appears to solely involve a dismissal with prejudice (with exceptions, as discussed *infra*). While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later

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[1] See Exhibit C, attached to the present petition. Exhibit C is a paper, entitled "Alere Medical Inc.'s Supplemental Notification of Affiliates Under Local Rule 3.2", filed by the defendant/requester in the litigation. See also page 2 of the requester's January 3, 2011 opposition, in which the requester states that the defendant in the litigation is a subsidiary of the *inter partes* requester.

[2] See the *inter partes* requester's January 3, 2011 opposition.

litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). Furthermore, the patent owner in the present case *points to no language in the court's dismissal or in the related settlement agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue.* Thus, as also argued by the *inter partes* requester in its January 3, 2011 opposition, there is nothing in the documents submitted by the patent owner that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met. Thus, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Health Hero Network* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination, as required by 35 U.S.C. 317(b).

For the reasons given above, the present petition fails to satisfy item no. 3.

Regarding item no. 4, the patent owner has the burden of showing that the prior art and any other issues raised in the merged proceeding were available to the requester/defendant and could have been placed in the litigation. If the joint stipulation reflected in the district court's order was entered at a sufficiently early stage in the litigation, such that the requester could have introduced the prior art and any other issues present in the merged proceeding into the litigation, had the litigation not been terminated by the district court's May 17, 2010 order, then the prior art and any other issues present in the instant merged proceeding "could have been raised" in the litigation proceeding. The patent owner, however, has not provided this showing, such as, for example, a copy of the district court's docket for the litigation.

For the reasons given above, the present petition fails to satisfy item no. 4.

Accordingly, patent owner's December 2, 2010 petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding is **dismissed**.

The Office notes that even if the *inter partes* reexamination proceeding, control no. 95/000,386, would be subsequently terminated, the *ex parte* reexamination proceeding would still continue, since it is not subject to the estoppel provisions of 35 U.S.C. 317.

The January 13, 2011 Patent Owner Petition

The patent owner requests that the Office suspend the present merged proceeding until the December 2, 2010 petition has been decided, and further requests that jurisdiction be transferred to the Office of Patent Legal Administration (OPLA).

In view of the present decision on the December 2, 2010 petition, patent owner's January 13, 2011 petition, which is taken as a petition under 37 CFR 1.182, is **dismissed as moot**.

CONCLUSION

- The December 2, 2010 patent owner petition under 37 CFR 1.182 to terminate the present merged proceeding is **dismissed**.
- The January 13, 2011 patent owner petition under 37 CFR 1.182 to suspend the present merged proceeding and to transfer jurisdiction to OPLA 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

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

5-05-2011
Kenpet8

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,053 + 95/000386	11/09/2007	7,223,236	7553.70003A / 07-0160	3387

60683 7590 09/08/2011

HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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

Date: 9-8-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO, CA 94303

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010053 - 95/000386
PATENT NO. : 7223236
ART UNIT : 3993

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

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

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CENTRAL REEXAMINATION UNIT

Health Hero Network, Inc. (For Patent Owner)
2400 Geng Road
Suite 200
Palo Alto, CA 94303

Womble, Carlyle, Sandridge & Rice, PLLC (For *Inter Partes* Requester)
Attn.: IP Docketing
P.O. Box 7037
Atlanta, GA 30357-0037

Boziecevic, Field & Francis, LLP (For *Ex Parte* Requester)
1900 University Avenue
Suite 200
Palo Alto, CA 94303

In re Brown
Inter partes Reexamination Proceeding
Control No: 95/000,386
Filing Date: August 1, 2008
For: U.S. Patent No.: 7,223,236

In re Brown
Ex Parte Reexamination Proceeding
Control No. 90/010,053
Filing Date: November 9, 2007
For: U.S. Patent No. 7,223,236

DECISION DISMISSING PETITION TO TERMINATE MERGED PROCEEDINGS

This decision addresses the following papers:

- The patent owner's July 7, 2011 petition entitled "Renewed Petition Under 37 CFR 1.182 for Termination of Merged Inter Partes and Ex Partes [sic] Reexaminations Pursuant to 35 U.S.C. §317(B) and 37 C.F.R. §1.907(B)" (patent owner's renewed petition to terminate);

- The requester's August 8, 2011 opposition to patent owner's July 7, 2011 petition, entitled "Inter partes Third Party Requester's Response to Patent Owner's 07-Jul-2011 Renewed Petition Under 37 CFR 1.182 for Termination of Merged Inter Partes and Ex Parte Reexaminations Pursuant to 35 U.S.C. §317(B) and 37 C.F.R. §1.907(B)" (the August 8, 2011 *inter partes* requester opposition); and

- The patent owner's September 1, 2011 petition entitled "Petition under 37 CFR 1.182 for an Order to Show Cause Why Documents Cannot Be Submitted" (patent owner's petition for an order to show cause).

The July 7, 2011 and September 1, 2011 patent owner petitions, the August 8, 2011 *inter partes* requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The July 7, 2011 renewed patent owner petition under 37 CFR 1.182 is **dismissed**.

The September 1, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

Inter partes reexamination proceeding control no. 95/000,386 is **not terminated**, and prosecution of the present merged proceeding **will continue**.

DECISION

Patent Owner's July 7, 2011 Renewed Petition under 37 CFR 1.182

In response to the Office's May 7, 2011 decision dismissing patent owner's December 2, 2010 petition to terminate the present merged proceeding, the patent owner renews its petition to terminate, arguing that termination of the present merged 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.

In the renewed petition, the patent owner points out that the Office determined, in its earlier decision of May 5, 2011, that element 1 was satisfied. This determination, which is not contested by the requester, is maintained.

Regarding elements 2-3, the Office determined, in its earlier decision of May 5, 2011, that these elements were not satisfied. Upon reconsideration, this determination is maintained.

Regarding element 2, the stipulated order of dismissal[1] in *Health Hero Network, Inc. v. Alere Medical, Inc.*, Case No. 1:07-cv-05031, in the United States District Court for the Northern District of Illinois, Eastern Division, states that all claims are dismissed "*with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement"*. A copy of the parties' settlement agreement has not been provided for the record by the patent owner. In its December 2, 2011 petition, the patent owner appears to have provided a definition of "Field", and further stated that "[t]he inclusion of the exception with respect to the "Field" *is believed* to provide for defense of allegations that might be made by an entity that was not a party to the civil action and, therefore, could not be bound by the settlement and/or dismissal with prejudice." Without a copy of the parties' settlement agreement, however, the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised, or could have been raised, in the merged proceeding, or whether the court's stated exception refers to an entity that was not a party to the civil action, as argued by the patent owner. Furthermore, as argued by the *inter partes* requester,[2] the issue of invalidity can later be raised "in the defense of an assertion of patent infringement", as stated by the court's order. Therefore, the stipulated order of dismissal, on its face, does not appear to be "final" as to issues which could have been raised in the merged proceeding.

Regarding element 3, the issue of invalidity does not appear to have been actually litigated in the present case. The present case appears to solely involve a dismissal with prejudice (with exceptions, as discussed *infra*). While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). Furthermore, the patent owner in the present case *points to no language in the court's dismissal or in the related settlement agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue*. Thus, as also argued by the *inter partes* requester in its January 3, 2011 opposition, there is nothing in the documents submitted by the patent owner that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met. Thus, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Health Hero Network* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination, as required by 35 U.S.C. 317(b).

---

[1] The stipulated order of dismissal, which is included in the court's "Notification of Docket Entry", states (emphasis added):

> MINUTE entry before Honorable Amy J. St. Eve: Pursuant to the parties' joint stipulation, all claims between the parties, *with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement)*, are dismissed with prejudice. All pending dates and deadlines are stricken. Civil case terminated. Mailed notice (kef)

[2] See the *inter partes* requester's January 3, 2011 and August 8, 2011 oppositions.

With respect to elements 2 and 3, the patent owner newly asserts, in its renewed petition, that it is unable to submit a copy of the parties' settlement agreement because the agreement is designated "confidential/attorney eyes only", and therefore cannot be disclosed without the consent of the requester. The patent owner newly requests the Office to issue a show cause order "setting a time period and specific information requests to facilitate an agreement between both the Patent Owner and the 3rd party requester with respect to which portions of the parties' settlement agreement may be submitted to Office [sic] to meet the information request".

However, where, as here, it is not clear whether the court's decision is final, the burden is on the patent owner, and not on the Office, to show that the court's stipulated order is a final decision, i.e., that all appeals have been exhausted. In this instance, the patent owner can submit its request to the court to facilitate the agreement between the parties with respect to which portions of the parties' settlement agreement may be submitted to the Office (see, *infra*, the discussion of patent owner's September 1, 2011 petition). The patent owner may then submit the court's decision, and any redacted settlement agreement permitted by the court, to the Office.

Furthermore, regarding element 3, even with a copy of the settlement agreement, there is nothing of record showing that the court's order amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met.

For the reasons given above, elements 2 and 3 have not been shown to be satisfied by the present renewed petition.

Regarding element 4, the Office determined, in its May 7, 2011 decision, that this element was not satisfied. However, the patent owner has now submitted, with its present renewed petition, a copy of the district court's docket, showing that the district court's order was entered at a sufficiently early stage in the litigation, such that the requester could have introduced the prior art and any other issues present in the merged proceeding into the litigation, had the litigation not been terminated by the district court's May 17, 2010 order. Furthermore, the requester, in its August 8, 2011 opposition, states that it does not dispute that this element has been satisfied. Thus, the patent owner has sufficiently shown that the prior art and any other issues present in the instant merged proceeding were either raised or could have been raised by the requester in the civil action.

For the reasons given above, element 4 has been shown to be satisfied by the present renewed petition.

In summary, elements 1 and 4 have been shown to be satisfied, and elements 2 and 3 have not been shown to be satisfied.

For the first time, in its July 7, 2011 renewed petition, the patent owner newly raised the issue of whether it is able to submit the parties' settlement agreement to the Office, and newly requested the Office to issue a show cause order. Patent owner's submission on September 1, 2011 of a separate petition under 37 CFR 1.182 for an order to show cause, which is addressed *infra*,

provides evidence that patent owner agrees that the request to issue a show cause order, and the issue of its ability to submit the parties' settlement agreement to the Office, is newly raised, requiring a separate petition. For this reason, patent owner's July 7, 2011 renewed petition is dismissed, rather than denied.

Accordingly, patent owner's July 7, 2011 renewed petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding is **dismissed**.

The patent owner also requests reconsideration of whether the *ex parte* reexamination proceeding would still continue even if the *inter partes* reexamination proceeding were to be terminated. In particular, the patent owner requests that the basis for the severance be fully explained. The patent owner points to 37 CFR 1.565(c), and specifically to 37 CFR 1.989(b), which states that the merged proceeding is governed by 37 CFR 1.902 through 1.997. The patent owner argues that the present merged proceeding is thus governed by 37 CFR 1.907, which provides for termination of the reexamination proceeding. The patent owner further argues that *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d (Fed. Cir. 1988) "does not appear to be dispositive, because the court in *Ethicon* does not appear to have been dealing with a merged proceeding as here".

However, the Office has determined, in the present decision, that the patent owner has not provided a sufficient showing that the provisions of 35 U.S.C. 317(b) have been met. For this reason, the present *inter partes* reexamination proceeding will not be terminated.

Regarding the requested explanation of the basis for the severance of the merged proceeding in the event that the *inter partes* reexamination proceeding were to be terminated, which is not the case here, note that an *ex parte* reexamination proceeding is not subject to the estoppel provisions of 35 U.S.C. 317, which specifically govern *inter partes* reexamination proceedings. 37 CFR 1.907, which tracks the statutory language, only applies to *inter partes* reexamination proceedings, including the present *inter partes* reexamination proceeding that is part of the present merged proceeding. Thus, if an *inter partes* reexamination proceeding, that is merged with an *ex parte* reexamination proceeding, were to be terminated, the merger would be severed, and the *ex parte* reexamination proceeding would continue. Furthermore, regarding the newly severed *ex parte* reexamination proceeding, *Ethicon* is dispositive. The court in *Ethicon* expressly held that the Office is not bound by a court's decision upholding a patent's validity:

> To the extent that [former] MPEP § 2286 states that the PTO is bound by a court's decision upholding a patent's validity, it is incorrect.

The *Ethicon* court noted that the district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by "clear and convincing" evidence, whereas in the Office, it is sufficient to show unpatentability by a "preponderance of the evidence." If sufficient reasons are present, claims held valid by the court may be rejected in an *ex parte* reexamination proceeding. See current MPEP 2286.

Thus, even if the present *inter partes* reexamination proceeding, control no. 95/000,386, were to be terminated, which is not the case here, the present *ex parte* reexamination proceeding, control

no. 90/010,053, would still continue. In any event, the present *inter partes* reexamination proceeding is **not terminated**, and prosecution of the present merged proceeding **will continue**.

Patent Owner's September 1, 2011 Petition Under 37 CFR 1.182

Patent owner requests that the Office issue an order to show cause, "setting a time period and specific information requests to facilitate an agreement between both the Patent Owner and the 3rd party requester with respect to which portions of the parties' settlement agreement may be submitted to the Office to meet the information request". However, as stated *supra*, the patent owner can easily submit its request to the court to facilitate the agreement between the parties with respect to which portions of the parties' settlement agreement may be submitted to the Office. The patent owner may then submit the court's decision, and any redacted settlement agreement permitted by the court, to the Office.

The patent owner has its remedy in court, and the Office will follow the court's decision. It is inappropriate to request that the Office resolve an issue that should properly be before the court.

Accordingly, patent owner's September 1, 2011 petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

- The July 7, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- The September 1, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- *Inter partes* reexamination proceeding control no. 95/000,386 is **not terminated**, and prosecution of the present merged proceeding **will continue**.
- Any further correspondence with respect to this matter should be addressed as follows:

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

By Mail: Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

- 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

9-06-2011

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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AUG 13 2010

CENTRAL REEXAMINATION UNIT

Perkins Coie LLP
Patent-SEA
P.O. Box 1247
Seattle, WA 98111-1247

(For Patent Owner)

Brian M. Berliner, Esq.
O'Melveny & Myers LLP
400 S. Hope Street
Los Angeles, CA 90071

(For Requester)

In re David M. Prokop
Ex Parte Reexamination Proceeding
Control No. 90/010,056
Filed: November 16, 2007
For: U.S. Patent No. 5,566,913

In re David M. Prokop
Ex Parte Reexamination Proceeding
Control No. 90/010,078
Filed: December 26, 2007
For: U.S. Patent No. 5,566,913

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

This is a decision on the May 7, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Notice of Appeal and revive the present terminated[1] merged reexamination prosecution ("the May 7, 2010 patent owner petition to revive").

The May 7, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 7, 2010 patent owner petition to revive is **granted**.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged 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 March 16, 2010.

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).

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 $270.00 on May 7, 2010, thereby satisfying item (1).[2] A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 7, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the May 7, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The May 7, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for further processing in view of the May 7, 2010 Notice of Appeal.

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 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, Aaron Lewis, of CRU Art Unit 3993, at (571) 272-4795.

---

[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

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

August 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,074	12/07/2007	5,329,369	230.2-US-RX	1754

20872 7590 01/24/2011

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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.
90/010,021	09/06/2007	H. 5329369	4671-4672-001-02	8993

20872 7590 01/24/2011

MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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

Date:

HOVEY WILLIAMS LLP
10801 MASTIN BLVD, SUITE 1000
84 CORPORATE WOODS
OVERLAND PARK, KS 66210

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010021
PATENT NO. : 5329369
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

JASON S. FELDMAR
GATES & COOPER LLP
6701 CENTER DRIVE WEST, SUITE 1050
LOS ANGELES, CA 90045

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010074
PATENT NO. : 5329369
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 Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,021 and 90/010,074

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 23, 2009 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 Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit

Eric Keasel
[*Signature*]

ERIC S. KEASEL
CRU SPE-AU 3992
(Title)

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AUG 13 2010

CENTRAL REEXAMINATION UNIT

Perkins Coie LLP
Patent-SEA
P.O. Box 1247
Seattle, WA 98111-1247

(For Patent Owner)

Brian M. Berliner, Esq.
O'Melveny & Myers LLP
400 S. Hope Street
Los Angeles, CA 90071

(For Requester)

In re David M. Prokop
Ex Parte Reexamination Proceeding
Control No. 90/010,056
Filed: November 16, 2007
For: U.S. Patent No. 5,566,913

In re David M. Prokop
Ex Parte Reexamination Proceeding
Control No. 90/010,078
Filed: December 26, 2007
For: U.S. Patent No. 5,566,913

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

This is a decision on the May 7, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Notice of Appeal and revive the present terminated[1] merged reexamination prosecution ("the May 7, 2010 patent owner petition to revive").

The May 7, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 7, 2010 patent owner petition to revive is **granted**.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the merged prosecution in this instance, the merged 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 March 16, 2010.

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).

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 $270.00 on May 7, 2010, thereby satisfying item (1).[2] A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 7, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the May 7, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The May 7, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3993, for further processing in view of the May 7, 2010 Notice of Appeal.

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 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, Aaron Lewis, of CRU Art Unit 3993, at (571) 272-4795.

---

[2] *See*: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).

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

August 12, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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PATTON BOGGS LLP
1801 CALFORNIA STREET
SUITE 4900
DENVER CO 80202

MAILED

JAN 14 2011

OFFICE OF PETITIONS

In re Original Application of	:	
Cohen et al.	:	
Patent Number: 6,253,504	:	DECISION ON REQUEST
Issue Date: 07/03/2001	:	FOR RECALCULATION OF
Reexamination Proceeding No. 90/010087	:	PATENT TERM ADJUSTMENT
Request Date: 01/08/2008	:	IN VIEW OF WYETH
Attorney Docket Number: 013226.0101X1US	:	

This is in response to the REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH, filed on March 11, 2010. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and is considered in light of the recent court decision in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

At the outset, the REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH* was filed using form PTO/SB/131. Petitioner is reminded that form PTO/SB/131 is only to be used to request recalculation of Patent Term Adjustment based upon the fact pattern described in Wyeth and no other issues will be addressed with this type of request.

Further to this, 37 CFR § 1.702, Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999, only applies to (f) *original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications*. (Emphasis supplied).

Accordingly, as the present file for which the request for recalculation of the patent term adjustment is filed is a reexamination proceeding of original U.S. Patent No. 6,253,504, issued July 3, 2001, for Application No. 08/970231, filed November 14, 1997, the request is deemed ineligible for consideration, and the request for recalculation of the patent term adjustment in view of Wyeth is **DENIED**.

The status is clear that a reexamination proceeding is not entitled to patent term adjustment since it is not the original patent. See, 35 U.S.C. § 154(b)(I)(A) "if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office...." (Underlining added). Since the reexamination is a proceeding and not an original application, no adjustment to the patent term will be made.

It is also noted that 37 CFR § 1.702 only applies to (f) original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications, and as such does not apply to the original U.S. Patent No. 6,253,504, issued July 3, 2001, which issued from Application No. 08/970231, filed November 14, 1997.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

Anthony Knight
Director
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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Dennis J. Dupray
SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

(For Patent Owner)

MAILED
MAR 12 2012
OFFICE OF PETITIONS

JULIE SAMUELS
Electronic Frontier Foundation
454 Shotwell Street
San Francisco, CA 94110

(For Requester)

In re Reissue Application of :
Goldberg et al. :
Application No. 12/138,357 : PETITION
Filed: June 12, 2008 :
For: U.S. Patent No. 6,264,560 :

In re Goldberg :
Reexamination Proceeding :
Control No. 90/010,093 :
Filed: January 31, 2008 :
For: U.S. Patent No. 6,264,560 :

This is a decision on the PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b), filed December 27, 2011.

The petition is GRANTED.

Copied from 12138357 on 03/20/2012

REVIEW OF FACTS

1. By decision mailed June 9, 2009, the above-captioned reissue and reexamination proceedings were merged. In accordance with that decision, a joint examination is being conducted.

2. Proceedings were terminated in the merged reissue and reexamination proceedings for failure to timely file a proper reply to the final Office action mailed September 6, 2011.

3. On December 27, 2011, the present petition was filed with a reply in the form of an amendment; payment of the petition fee; and the required statement of unintentional delay. Receipt of an accompanying reissue declaration is acknowledged.

DISCUSSION

37 CFR 1.137(b) provides that:

> *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.

The instant petition meets the requirements of 37 CFR 1.137(b). It has been determined that the reply submitted is sufficient for revival of this application after final Office action. The petition includes payment of the petition fee. The agent for the patent owner has made the required statement of unintentional delay. No terminal disclaimer is required for revival.

Copied from 12138357 on 03/20/2012

Technology Center AU 3700 has been advised of this decision. The application is, thereby, forwarded to the examiner for consideration of the reply filed December 27, 2011 and for action consistent with the action merging the applications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Copied from 12138357 on 03/20/2012

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,094	02/01/2008	6397189	8246.002.000000	9430

7590 01/06/2011

MCANDREWS HELD & MALLOY
NORTHWESTERN ATRIUM CENTER
500 WEST MADISON STREET
31ST FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SAN FRANCISCO OFFICE OF NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTION, TX 77002

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010094
PATENT NO. : 6397189
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)).

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,094

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 02/11/2009 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 Colleen Dunn at 571-272-1170. In his/her absence, calls may be directed to Mark Reinhart at (571) 272-1611 in the Central Reexamination Unit

   /Colleen P. Dunn/

   Colleen P. Dunn
   Supervisory Patent Examiner,
   Central Reexamination Unit
   571-272-1170

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.
90/010,094	02/01/2008	6397189	8246.002.000000	9430

7590 04/29/2011

MCANDREWS HELD & MALLOY
NORTHWESTERN ATRIUM CENTER
500 WEST MADISON STREET
31ST FLOOR
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2011

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

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SAN FRANCISCO OFFICE OF NOVAK, DRUCE & QUIGG LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTION, TX 77002

Date:

MAILED

APR 29 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010094
PATENT NO. : 6397189
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)).

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,094

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 11, 2009 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 Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit

   Eric Keasel
   [*Signature*]

   ERIC S. KEASEL
   CRU SPE-AU 3992
   (Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,095	02/01/2008	6970834	8246.002.000000	9579

7590 04/29/2011

McANDREWS, HELD & MALLOY, LTD
500 WEST MADISON STREET 34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEPHEN C. DURANT
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON TX. 77002

Date:

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APR 29 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010095
PATENT NO. : 6970834
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)).

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,095

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed December 15, 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 Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit

[*Signature*]

ERIC S. KEASEL
CRU SPE-AU 3992
(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 01/07/2011

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CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/07/2011

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1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON TX 77002

Date: MAILED
JAN 07 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010097
PATENT NO. : 6381575
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)).

MAILED

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,097

JAN 07 2011

CENTRAL REEXAMINATION UNIT

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 02/11/2009 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 Colleen Dunn at 571-272-1170. In his/her absence, calls may be directed to Mark Reinhart at (571) 272-1611 in the Central Reexamination Unit

   /Colleen P. Dunn/

   Colleen P. Dunn
   Supervisory Patent Examiner,
   Central Reexamination Unit
   571-272-1170

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,097	02/01/2008	6381575	8246.002.000000	9772

7590 04/29/2011

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CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/29/2011

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

Date:

MAILED

APR 29 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010097
PATENT NO. : 6381575
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 Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,097

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 11, 2009 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 Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit

Eric Keasel
[*Signature*]

ERIC S. KEASEL
CRU SPE-AU 3992
(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,128	03/31/2008	6615065	5180-0048	7046

24633 7590 11/05/2010
HOGAN LOVELLS US LLP
IP GROUP, COLUMBIA SQUARE
555 THIRTEENTH STREET, N.W.
WASHINGTON, DC 20004

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2010

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.
90/010,128	03/31/2008	6615065	5180-0048	7046

24633 7590 11/05/2010

O'SHEA, GETZ & KOSAKOWSKI, PC
1500 MAIN STREET SUITE 912
SPRINGFIELD, MA 01115

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/05/2010

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

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P.O. Box 1450
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Hogan Lovells US LLP
IP Group, Columbia Square
555 Thirteenth Street, NW
Washington DC 20004

(For Patent Owner)

MAILED

NOV 05 2010

CENTRAL REEXAMINATION UNIT

Richard D. Getz
O'Shea, Getz & Kosakowski, P.C.
1500 Main Street, Suite 912
Springfield, MA 01115

(For Third Party Requester)

In re Reissue Application of
Bruce J. Barrett *et al.*
Application No.: 11/219,298
Filed: September 2, 2005
For: U.S. Patent No. 6,615,065

In re Bruce J. Barrett *et al.*
Reexamination Proceeding
Control No.: 90/010,128
Filed: March 25, 2008
For: U.S. Patent No.: 6,615,065

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

This decision is supplemental to the Office's prior merger decision mailed July 30, 2008, which *sua sponte* merged reissue application No. 11/219,298 and reexamination control No. 90/010,128 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. 11/219,298 and reexamination control No. 90/010,128 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
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.
90/010,131; 90/010,905	03/31/2008	6,814,934	TB-ABI-1	6014

37509 7590 08/04/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JEFFREY B. OSTER
8339 SE 57th ST.
MERCER ISLAND, WA 98040

MAILED
AUG 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010131. 90/010,905
PATENT NO. : 6814934
ART UNIT : 3991

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,905	03/10/2010	6814934	6814934	1050

90/010,131

22896 7590 08/04/2010

LIFE TECHNOLOGIES CORPORATION
C/O INTELLEVATE
P.O. BOX 52050
MINNEAPOLIS, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Tracy W. Druce
NOVAK DRUCE DELUCA & QUIGG LLP
1300 Eye Street, NW, Suite 1000 West Tower
Washington, DC 20005

Date MAILED
AUG 04 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010905; 90/010,131
PATENT NO. : 6814934
ART UNIT : 3991

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

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

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Deckert LLP
P.O. Box 390460
Mountain View, CA 94039-0460 (For Patent Owner)

Jeffrey B. Oster
8339 SE 57th Street
Mercer Island, WA 98040 (For Third Party Requester)

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No.: 90/010,131
Filed: March 31, 2008
For: U.S. Patent 6,814,934

Novak Druce Deluca & Quigg LLP
1300 Eye Street, NW
Suite 1000 West Tower
Washington, DC 20005 (For Third Party Requester)

Ex Parte Reexamination Proceeding
Control No.: 90/010,905
Filed: March 10, 2010
For: U.S. Patent 6,814,934

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of merger of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,814,934 which issued November 9, 2004, is the subject of Reexamination Control Nos. 90/010,131 and 90/010,905.

2. A first request for reexamination, assigned Reexamination Control No. 90/010,131, was filed March 31, 2008. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed instrument and system or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/010,131 on June 12, 2008.

4. A non-final Office action was mailed on January 29, 2009.

5. A response was submitted on March 30, 2009 with no amendment to the claims.

6. A second non-final Office action was mailed on October 29, 2009.

7. A response was filed on January 29, 2010 without amendment to the claims.
8. A subsequent request for re-examination, assigned Reexamination Control No. 90/010,905, was filed March 10, 2010. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed instrument and system or are so close as to establish a case of obviousness.

9. Reexamination was ordered for 90/010,905 on May 14, 2010.

10. No Patent Owner statement has been received.

DISCUSSION

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* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under para 1.570.

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.5659 (c) is appropriate. MPEP 2283 further sets forth:

If the second request is based upon essentially the *same* patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the question raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/010,131 and 90/010,905 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."
Since there have been no amendments in either proceeding, the requirement for a "housekeeping" amendment is waived.

III. CONDUCT OF MERGED PROCEEDING

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 will contain the identifying data for <u>all</u> files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, **filed in triplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/001,131 and 90/010,905 as:

Deckert LLP
P.O. Box 390460
Mountain View, CA 94039-0460

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/010,131 as:

Jeffrey B. Oster
8339 SE 57th Street
Mercer Island, WA 98040

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/010,905 as:

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

CONCLUSION

Reexamination Control Nos. 90/010,131 and 90/010,905 are merged. **Since there has been no amendment in any of the files, the requirement to file a "housekeeping amendment" is waived.** An office action will issue in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at telephone No. (571) 272-1535.

/Deborah Jones/
Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/21/10

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction for Appl. No.: 90/010,144 Patent No.: C1 6018774

CofC mailroom date: 08/02/10

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: _____

Eric Kearl
SPE

3992
Art Unit

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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.
90/010,147	04/22/2008	5848398	8246.002.000004	1162

7590 01/07/2011

JOHN J. HELD
MCANDREWS HELD & MALLOY
500 W MADISON STREET
34TH FLOOR
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/07/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SAN FRANCISCO OFFICE OF NOVAK,
DRUCE & QUIGG LLP
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

JAN 07 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010147
PATENT NO. : 5848398
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)).

MAILED

JAN 07 2011

CENTRAL REEXAMINATION UNIT

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 90/010,147

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 02/11/2009 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 Colleen Dunn at 571-272-1170. In his/her absence, calls may be directed to Mark Reinhart at (571) 272-1611 in the Central Reexamination Unit

   /Colleen P. Dunn/

   Colleen P. Dunn
   Supervisory Patent Examiner,
   Central Reexamination Unit
   571-272-1170

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,150	05/13/2008	J. 6182649	RUS013USURX	5060

45180 7590 03/23/2011

Grimes & Battersby, LLP
488 Main Avenue
Suite 300
Norwalk, CT 06851-1008

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN C. MCNETT & QUENTIN G. CANTRELL
WOODARD, EMHARDT, MORIARTY, McNETT & HENRY ET AL.,
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204

Date:

MAILED
MAR 23 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010150
PATENT NO. : 6182649
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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GRIMES & BATTERSBY, LLP
488 MAIN AVENUE
SUITE 300
NORWALK, CT 06851-1008

(For Patent Owner)

MAILED
MAR 23 2011
CENTRAL REEXAMINATION UNIT

JOHN C. MCNETT & QUENTIN G. CANTRELL
WOODARD, EMHARDT, MORIARTY, McNETT
& HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204

(For Requester)

In re Battersby et al.
Control No.: 90/010,150
Filed: May 13, 2008
For: U.S. Patent No.: 6,182,649

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.181**
: **REQUESTING ENTRY**
: **OF DECLARATIONS**

This is a decision on the February 18, 2011, "Petition for Entry of Declaration Evidence into the Record," requesting that the evidentiary declarations of Michael Suba, dated July 14, 2010, (the "Suba Declaration") and Vincent D'Agostino, dated July 15, 2010, (the "D'Agostino Declaration") be entered into the record, or alternatively to reopen prosecution to allow entry of the Suba and D'Agostino Declarations. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition is dismissed as untimely for the reasons set forth below, without consideration of the merits.

REVIEW OF THE RELEVANT FACTS

1. On February 6, 2001, U.S. Patent 6,182,649 (the '649 patent) issued to Battersby et al.

2. On May 13, 2008, a request for *ex parte* reexamination of claims 1-32 of the '649 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,150 (the '10150 proceeding).

3. On August 8, 2008, the Office issued an order granting the '10150 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1-32 of the '649 patent would be subject to reexamination.

4. Prosecution continued and on June 18, 2010, a (second) final Office action was issued in the '10150 proceeding rejecting claims 1-37 as unpatentable.

5. On July 16, 2010, patent owner submitted an after-final response under 37 CFR 1.116. The Suba and D'Agostino Declarations were submitted as evidence in support of the remarks alleging patentability. Also, a declaration by inventor Gregory Battersby was submitted.

6. On August 23, 2010, patent owner filed a notice of appeal in the '10150 proceeding.

7. On September 29, 2010, the Office issued an advisory action responding to patent owner's after-final submissions. The advisory action stated that the Suba and D'Agostino Declarations, which were filed after a final action but before the filing of a notice of appeal, were not entered because patent owner failed to provide a showing of good and sufficient reasons why the declarations are necessary and were not earlier presented in accordance with 37 CFR 1.116(e). The advisory action stated that the declaration by Gregory Battersby was entered but did not overcome the current rejections.

8. On October 18, 2010, patent owner submitted an appeal brief.

9. On January 7, 2011, the Office mailed an Examiner's Answer.

10. On February 18, 2011, patent owner petitioned under 37 CFR 1.181 requesting entry of the Suba and D'Agostino Declarations, or alternatively the opening of prosecution to enter the declarations.

DISCUSSION

The Patent Owner requests entry of the Suba and D'Agostino Declarations, or alternatively the opening of prosecution to enter the declarations. The petitioner considers the examiner's decision to not enter the Suba and D'Agostino Declarations improper because the declarations are necessary, and there are good and sufficient reasons why the declarations were not earlier presented.

The request to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations, 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 patent owner brings before the Office a petition under 37 CFR § 1.181 to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations. The patent owner filed the petition on February 18, 2011. The action from which relief is requested is the advisory action, which was mailed on September 29, 2010. As stated above, the advisory action was the communication that informed the patent owner that the Suba and D'Agostino Declarations would not be entered into the record. Therefore, the petition was filed over **two** months from the mailing date of the action (September 29, 2010) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. The patent owner's February 18, 2011 petition under 37 CFR § 1.181 to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations, is hereby **dismissed**, as untimely, without consideration of the merits.

2. Telephone inquiries with regard to this decision should be directed to Supervisory Patent Examiner Andres Kashnikow at (571) 272-4361.

Irem Yücel, Director
Technology Center 1600

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GRIMES & BATTERSBY, LLP
488 MAIN AVENUE
SUITE 300
NORWALK, CT 06851-1008

(For Patent Owner)

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MAR 23 2011

CENTRAL REEXAMINATION UNIT

JOHN C. MCNETT & QUENTIN G. CANTRELL
WOODARD, EMHARDT, MORIARTY, McNETT
& HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204

(For Requester)

In re Battersby et al.
Control No.: 90/010,151
Filed: May 13, 2008
For: U.S. Patent No.: 6,546,924

: **DECISION ON PETITION**
: **UNDER 37 CFR 1.181**
: **REQUESTING ENTRY**
: **OF DECLARATIONS**

This is a decision on the February 18, 2011, "Petition for Entry of Declaration Evidence into the Record," requesting that the evidentiary declarations of Michael Suba, dated July 14, 2010, (the "Suba Declaration") and Vincent D'Agostino, dated July 15, 2010, (the "D'Agostino Declaration") be entered into the record, or alternatively to reopen prosecution to allow entry of the Suba and D'Agostino Declarations. The patent owner has petitioned under 37 CFR § 1.181(a)(3).

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petition is dismissed as untimely for the reasons set forth below, without consideration of the merits.

REVIEW OF THE RELEVANT FACTS

1. On April 15 2003, U.S. Patent 6,546,924 (the '924 patent) issued to Battersby et al.

2. On May 13, 2008, a request for *ex parte* reexamination of claims 1-6 of the '924 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,151 (the '10151 proceeding).

3. On August 8, 2008, the Office issued an order granting the'10151 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1-6 of the '924 patent would be subject to reexamination.

4. Prosecution continued and on June 18, 2010, a (second) final Office action was issued in the '10151 proceeding rejecting claims 1-10 as unpatentable.

5. On July 16, 2010, patent owner submitted an after-final response under 37 CFR 1.116. The Suba and D'Agostino Declarations were submitted as evidence in support of the remarks alleging patentability. Also, a declaration by inventor Gregory Battersby was submitted.

6. On August 23, 2010, patent owner filed a notice of appeal in the '10151 proceeding.

7. On September 29, 2010, the Office issued an advisory action responding to patent owner's after-final submissions. The advisory action stated that the Suba and D'Agostino Declarations, which were filed after a final action but before the filing of a notice of appeal, were not entered because patent owner failed to provide a showing of good and sufficient reasons why the declarations are necessary and were not earlier presented in accordance with 37 CFR 1.116(e). The advisory action stated that the declaration by Gregory Battersby was entered but did not overcome the current rejections.

8. On October 18, 2010, patent owner submitted an appeal brief.

9. On January 7, 2011, the Office mailed an Examiner's Answer.

10. On February 18, 2011, patent owner petitioned under 37 CFR 1.181 requesting entry of the Suba and D'Agostino Declarations, or alternatively the opening of prosecution to enter the declarations.

DISCUSSION

The Patent Owner requests entry of the Suba and D'Agostino Declarations, or alternatively the opening of prosecution to enter the declarations. The petitioner considers the examiner's decision to not enter the Suba and D'Agostino Declarations improper because the declarations are necessary, and there are good and sufficient reasons why the declarations were not earlier presented.

The request to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations, 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 patent owner brings before the Office a petition under 37 CFR § 1.181 to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations. The patent owner filed the petition on February 18, 2011. The action from which relief is requested is the advisory action, which was mailed on September 29, 2010. As stated above, the advisory action was the communication that informed the patent owner that the Suba and D'Agostino Declarations would not be entered into the record. Therefore, the petition was filed over **two** months from the mailing date of the action (September 29, 2010) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. The patent owner's February 18, 2011 petition under 37 CFR § 1.181 to enter the Suba and D'Agostino Declarations, or alternatively to open prosecution to enter the declarations, is hereby **dismissed** as untimely, without consideration of the merits.

2. 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

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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria VA 22314

(For Patent Owner)

Ying Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., # 215
Los Angeles, CA 90012

(For Requester)

In re Reexamination Proceeding
Jerome D. Johnson
Control No.: 90/010,185
Filed: June 3, 2008
For: U.S. Patent No.: 5,367,627

: **DECISION**
: **ON**
: **PETITION**

This is a decision on the January 29, 2010 patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(3) FOR SUPERVISORY REVIEW OF THE DECISION ON PETITION TO CONTINUE *EX PARTE* REEXAMINATION PROCEEDINGS".

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.181(a)(3) is **denied.**

REVIEW OF THE FACTS

1. On November 22, 1994, U.S. Patent 5,367,627 (the '627 patent) issued to Jerome D. Johnson.

2. On June 3, 2008, a request for *ex parte* reexamination of claims 1, 6-8 of the '627 patent was filed by a third party requester. The request was assigned reexamination control number 90/010,185 (the '10185 proceeding).

3. On July 22, 2008, the Office issued an order granting the '10185 *ex parte* reexamination request and setting a two month time period for a Patent Owner's Statement. The order stated that claims 1 and 6-8 of the '627 patent would be subject to reexamination.

4. On July 29, 2008, a notice of the filing of the '10185 *ex parte* reexamination was published in the *Official Gazette*.

5. On September 22, 2008, the time period for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10185 *ex parte* reexamination proceeding expired without the submission of a statement by the patent owner.

6. On November 26, 2008, a first Office action on the merits issued rejecting claims 1 and 6-8 as unpatentable over dBASE.

7. On December 3, 2008, the November 26, 2008 first Office action on the merits rejecting claims 1 and 6-8 as unpatentable over dBASE was remailed. The remailing of the Office action reset the time period for response.

8. On February 3, 2009, patent owner filed a response adding new claims 16-39 and only providing remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.

9. On March 11, 2009, patent owner conducted an interview with the examiner of record.

10. On March 13, 2009, patent owner submitted an information disclosure statement (IDS).

11. On March 19, 2009, patent owner *sua sponte* filed a supplemental response further adding new claim 40 and providing additional remarks asserting patentability over the prior art of record. Patent owner also submitted a notice of concurrent proceedings, namely five different co-pending patent infringement litigation proceedings directed to the '627 patent in the Federal District Court for the Eastern District of Texas.

12. On April 7, 2009, patent owner submitted a statement of the substance of the March 11, 2009 interview in accordance with 37 CFR 1.560(b).

13. On May 4, 2009, a final Office action was issued in the '10185 proceeding rejecting claims 1, 6-8 and 16-40 as unpatentable.

14. On July 2, 2009, patent owner submitted an after-final response under 37 CFR 1.116 consisting entirely of remarks asserting patentability over the prior art of record. No evidence was provided in support of the remarks alleging patentability.

15. On July 29, 2009, patent owner submitted a supplemental after-final response consisting of a declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne.

16. On September 4, 2009, patent owner, with Dr. V. Thomas Rhyne, conducted an interview with the examiner of record.

17. On September 10, 2009, the Office issued an advisory action responding to patent owner's after final submissions. The Rhyne declaration, which was filed after a final action, but before the filing of a notice of appeal, was not entered because patent owner failed to provide a showing of good and sufficient reasons why the declaration is necessary and was not earlier presented in accordance with 37 CFR 1.116(e).

18. On October 5, 2009, patent owner filed a notice of appeal in the '10185 proceeding.

19. Also on October 5, 2009, patent owner filed another declaration under 37 CFR 1.132 by Dr. V. Thomas Rhyne, a statement of the substance of the September 10, 2009 interview in accordance with 37 CFR 1.560(b), a third response after final under 37 CFR 1.116 and two petitions under 37 CFR 1.181 requesting supervisory review.

20. Finally, on October 5, 2009, patent owner filed a petition under 37 CFR 1.182 requesting entry of all after final submissions, to include all after-final responses and declarations in the '10185 proceeding.

21. On November 23, 2009, patent owner filed a status inquiry regarding the petitions submitted on October 5, 2009.

22. On December 4, 2009, patent owner filed an appeal brief.

23. On January 29, 2010, the Office dismissed patent owner's October 5, 2009 petition under 37 CFR 1.182 requesting entry of all after final submissions.

24. On March 2, 2010, the Office issued a notice of defective appeal brief.

25. On March 26, 2010, patent owner filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(3) FOR SUPERVISORY REVIEW OF THE DECISION ON PETITION TO CONTINUE *EX PARTE* REEXAMINATION PROCEEDINGS".

26. On March 31, 2010, patent owner filed a corrected appeal brief in response to the March 2, 2010 notice of defective appeal brief.

27. On June 29, 2010, the Office issues two decisions dismissing patent owner's two October 5, 2009 petitions under 37 CFR 1.181 requesting supervisory review.

28. This decision addresses patent owner's March 26, 2010 petition under 37 CFR 1.181 requesting supervisory review of the Office decision issued on January 29, 2010.

RELEVANT AUTORITY AND GUIDANCE

35 U.S.C. § 305 provides:

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

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.

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.

MPEP 2272 states (in part):

Since patents undergoing reexamination cannot become abandoned and cannot be refiled, and since the holding of claims unpatentable and canceled in a certificate is absolutely final, it is appropriate that the examiner consider the feasibility of entering amendments touching the merits after final rejection or after appeal has been taken, where there is a **showing** why the amendments are necessary and a ***suitable*** *reason is given why they were not earlier presented.* [Emphasis added]

DECISION ON PETITION UNDER 37 CFR 1.181

I. Issues Raised and Relief Requested

Patent owner states that the January 29, 2010 decision dismissing the October 5, 2009 request for continued reexamination was improper, asserting the Office decision failed to: (1) Appreciate that the patent owner's declarations and after final responses should be entered in order to address new issues raised by the examiner after a final Office action; (2) Recognize that treatment of the declaration and after final responses would further the special dispatch requirement of the Office by helping to resolve remaining issues; (3) Recognize, that by filing the declarations and after final responses, patent owner demonstrated that it was making a *bona fide* attempt to define the issues for appeal or issuance of a reexamination certificate; and (4) Render a decision consistent with other proceedings under similar circumstances resulting in an arbitrary and capricious determination.

Patent owner requests as remedies: (1) Vacatur of the January 29, 2010 decision dismissing patent owner's October 5, 2009 petition for continued reexamination; and (2) Entry of all after final declarations and submissions filed in this reexamination proceeding.[1]

II. Discussion of Previous Petition and Decision

In the original petition requesting reopening prosecution and entry of papers to continue reexamination, patent owner asserted that: (1) The July 29, 2009 37 CFR 1.132 declaration does not raise new issues and should be entered because it addresses the same issues argued of record by providing additional evidence in support of patent owner's position; and (2) the July 29, 2009 37 CFR 1.132 declaration is essential to understand Dr. Rhyne's September 4, 2009 interview comments; (3) The October 5, 2009 37 CFR 1.132 declaration and second after-final response address the new issue of "overlap" raised by the examiner in the September 4, 2009 interview, (4) and the May 4, 2009 final Office action presented a new grounds of rejection based upon the "overlap" issue (as evidenced by the Interview Summary and Advisory Action) and therefore constitutes a newly raised issue patent owner has not had an opportunity to respond to, thus justifying continued reexamination.

The Office issued a decision dismissing patent owner's original petition. Regarding the July 29, 2009 declaration, the decision pointed out that patent owner's arguments to justify continued examination and entry of the July 29, 2009 after final declaration were not persuasive. Patent owner stated on the record that the declaration was "addressing the same issues" that arose during open prosecution, i.e. a cumulative submission.[2] Patent owner provided no explanation as to why the cumulative July 29, 2009 declaration was not submitted before prosecution was closed, nor why there was a three month delay in the submission of the merely cumulative declaration after prosecution had closed.

Regarding the October 5, 2009 declaration, the decision pointed out that patent owner's arguments to justify continued examination and entry of the October 5, 2009 after final declaration were not persuasive. Patent owner argued that, in an after-final interview, the examiner's question to the declarant as to text and graphics overlap somehow altered the previously issued final Office action, causing the previously issued final action to *nunc pro tunc* raise a "new issue" justifying re-opening of prosecution and entry of all after final submissions. The decision found the *nunc pro tunc* argument unpersuasive, noting that the issue of text being equated to and overlapping with graphics was established on the record and consistently maintained for the entire duration of the proceeding's prosecution and clearly communicated to patent owner. Finally, the decision noted that patent owner requested that the declarant's resume, which accompanied the declarations, be admitted as the declarant was also a participant in two interviews conducted during prosecution of the '10185 proceeding. Patent owner argued that entry of the resume was necessary to better evaluate the credibility of the declarant's statements made in the interview in terms of his expertise. The Office concurred with patent owner as to this, and the declarant's resume was entered into the record. Accordingly, the

[1] Petition at page 11. It is understood by the Office that patent owner is referring to only the after final submissions which have been denied entry by the examiner.
[2] Petition at page 6.

decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

III. Findings and Analysis

A. The Issue Asserted by Patent Owner was Initiated by the Examiner Prior to Final

Patent owner alleges that the examiner raised new issues in the May 4, 2009 final Office action, by dint of comments made by the examiner in an after-final interview held five months after issuance of the final Office action (on September 4, 2008). This allegation is not borne out by the record. In the order issued by the Office on July 22, 2008, the Office cited the prior art reference of "dBase" as evidence of a substantial new question of patentability regarding the '627 patent as to claims 1 and 6-8 by itself and in combination with other references. Claim 8 of the '627 patent contained the "graphical information" limitation. On December 3, 2008, the Office issued a first Office action using the dBase reference to reject the graphical information limitation of claim 8, stating "the text in Fig 8-15 is graphical information." [3] On May 4, 2009, the Office issued a final Office action maintaining the same position as the December 3, 2008 Office action using the dBase reference to reject the graphical information limitation of claim 8, stating "the text in Fig 8-15 is graphical information." [4] Therefore, the statement regarding text being graphical information in the final Office action is not newly made. Accordingly, finality of the May 4, 2009 Office action was in accord with Office procedure,[5] and the patent owner was in possession of the Office's position after first action (as far as addressing the issue).

During the after-final interview of September 4, 2008, the claim and art interpretation of text being equated to and/or overlapping with graphical information was discussed. Based upon this *ex post* interview discussion, patent owner has come forward to assert that the *ex post* discussion has *nunc pro tunc* created a new issue in the final action that justifies granting of a request for continued reexamination and entry of all after-final submissions. However, as stated in the Office's January 29, 2010 decision, patent owner's contention is an insufficient showing to justify continued reexamination and reopening of prosecution of a reexamination proceeding.[6] There is no showing that these asserted "overlap" issues could not have been addressed during open prosecution as the matter was brought to patent owner's attention in the first action; instead petitioner choose to do so only after receiving a final rejection and submitting an after-final affidavit. It is to be noted that an examiner will address patent owner arguments at an interview and may expound on them to clarify, where appropriate to deal with the arguments; this is not, however a license to reopen prosecution. A patent owner is expected to deal with issues that are raised prior to final rejection – before the final rejection is issued, not five months after the final Office action is issued. Further, interview summary comments do not serve as grounds of rejection, nor do they alter a grounds of rejection previously made of record. Therefore, the comments made regarding "overlap" did not raise a new rejection of the claims, nor modify the stated rejection of record. The interview comments, at best, are simply a statement of after-final interview discussion between patent owner's expert and the examiner of record, where issues of claim interpretation were discussed.

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[3] Page 8 of the December 3, 2008 Office action.
[4] Page 6 of the May 4, 2009 final Office action.
[5] See MPEP 2271
[6] Office decision dated January 29, 2010 at pages 5-6

B. Patent Owner's After-Final Declaration Submissions were not a *bona fide* response

Patent owner alleges the after final submissions are "*bona fide*" responses that should support the granting of petition requesting continued reexamination. Patent owner is in error. The January 29, 2010 decision discussed the standards for what constitutes a *bona fide* response in the context of the equitable relief of a request for continued reexamination.

> 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 which mandates that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, because this is a key factor in reducing pendency of a reexamination proceeding. Further, the § 1.182 petition practice includes a requirement that the filing of the § 1.182 petition be accompanied by a showing that that patent owner has made a *bona fide* effort during the proceeding to advance the prosecution toward appeal, or toward the issuance of a reexamination certificate. 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 newly made statement in the final Office action. Thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of (did not anticipate) the need for the new amendment or evidence earlier in the prosecution. And, the grant or dismissal of a § 1.182 petition depends on the equities of the fact situation, taking into account the statutory mandate for special dispatch in resolving the substantial new question of patentability raised by the request.[7] [Emphasis added.]

In the prior Office decision, the Office weighed the entry of the July 2, 2009 after-final response against the delay of the statutorily mandated "special dispatch" (in the Office) that reopening prosecution to consider the July 29, 2009 after-final affidavit would create. The affidavit consists solely of argument, which patent owner admitted on the record as addressing issues previously addressed in the proceeding. Patent owner has not provided a satisfactory justification for submitting cumulative arguments in the July 29, 2009 affidavit, three months after issuance of the final rejection. Nor has patent owner explain why the need for the patent owner's response and declaration could not have been anticipated earlier, and only became apparent as a result of newly made statements in the final Office action.

Regarding patent owner's October 5, 2009 after-final affidavit, as noted *supra* in section III.A of this decision, the examiner maintained a consistent position regarding the interpretation of the prior art in regards to text reading upon the graphical information claim limitation and did not alter this position in the final Office action. Patent owner's *nunc pro tunc* argument that the usage of the term "overlap" in the September 4, 2009 after-final interview altered the May 4, 2009 final Office action, with regard to the text equals graphical information examiner position, is unpersuasive for the reasons stated in section III.A of this decision. Therefore, patent owner does not provide a satisfactory justification for submitting the October 5, 2009 affidavit five months after issuance of the final rejection.

C. Entry of After Final Declarations does not further Special Dispatch

Patent owner asserts that the January 29, 2010 Office decision dismissing the request for

[7] Office decision dated January 29, 2010, pages 3-4.

reexamination failed to recognize that entry of the after final submissions would advance prosecution and support special dispatch. Such assertion is not agreed with. The January 29, 2010 decision dismissing patent owner's petition requesting continued reexamination properly determined that no new issues were raised in the May 4, 2009 final Office action and that the after-final submissions at issue were not entitled to consideration in a reopened prosecution, as discussed *supra* in sections III.A and III.B respectively. The January 29, 2010 decision then noted the proceeding was at the very mature appeal stage and weighed the delay that would be caused granting patent owner's request for continued reexamination against the statutory mandate of special dispatch. The decision employed these standards for evaluating the merits of the request for continued reexamination under 37 CFR 1.182 and did not employ the standards of 37 CFR 1.116. In fact, the decision never cited nor mentioned 37 CFR 1.116. The examiner properly followed Office procedure in rendering a final action,[8] and patent owner did not provide an adequate showing that a new issue was raised for the first time in the final Office action (or after it) to which the after-final submissions at issue are limited; accordingly, the conclusion that special dispatch was best served by dismissal of patent owner's petition was proper and is being maintained.

D. Denial of Entry was not Arbitrary and Capricious

Patent owner alleges the Office has acted in an "arbitrary and capricious" manner in dismissing patent owner's October 5, 2009 request for continued examination. In support of the assertion, patent owner cites a series of reexamination proceedings, stating that the Office's dismissal of the October 5, 2009 request for continued reexamination is inconsistent with the cited reexamination proceedings. Patent owner has provided no recitation of the relevant facts and circumstances of the cited proceedings, outside of a blanket generalization about each cited reexamination proceeding. Patent owner did not provide (or cite to) relevant papers and portions of relevant papers in the asserted proceedings, except for one proceeding where the petition and Office decisions were cited. Finally, patent owner has made no effort to analyze the present proceeding's substantive and procedural facts and circumstances relative to the cited reexamination proceedings. Regarding, patent owner's usage of "arbitrary and capricious" is a characterization that the January 29, 2010 Office decision was an unreasonable action with disregard of the facts of the case and/or inconsistent with previous Office decisions.[9] Patent owner's position is not persuasive. All matters in a proceeding are addressed and resolved on a case-by-case basis based on the given facts and circumstances. In the present proceeding, the examiner consistently applied the same art throughout the proceeding, no new rejection was leveled against patent owner for the first time in the May 4, 2009 final Office action, and patent owner had fair and full opportunity to address the matter at issue before final action. None of the cited proceedings support the granting of a request for continued reexamination where a patent owner has had fair and full opportunity to address a properly presented issue before final action, but chooses not to do so until after a proper final action issued.

In regard to the merged reexamination proceeding Nos. 90/007,859 and 90/007,542, the patent owner not only argued the presence of new rejections existing in the final Office action of

[8] See MPEP 2271

[9] Black's Law Dictionary 105 (6th ed. 1990).

February 16, 2007, but cited to the rejections of record and citing to the relevant facts of the proceeding articulated how the rejections were empirically new.[10]

In regard to reexamination proceeding No. 95/000,071, a request for continued reexamination was never filed; therefore the proceeding is not relevant in regards to the consistent or inconsistent treatment of requests for continued reexamination petitions. However, it is noted that in the Office's June 5, 2007 dismissal of patent owner's July 7, 2006 petition, in addition to suggesting that patent owner consider submission of a request for continued reexamination, stated that an amendment defining over the prior art and cancelling the rejected claims was an exemplary *bona fide* response, which would support a granting of the suggested petition.[11]

In regards to reexamination proceeding No. 95/000,043, in which the Office granted patent owner's February 13, 2006 request for continued reexamination, the patent owner asserted that new issues were raised[12] and patent owner provided a *bona fide* response advancing prosecution by presenting a proposed amendment cancelling independent claim 1 and further amending 18 of the remaining 19 claims.[13] Patent owner subsequently filed another request for continued reexamination in the '043 proceeding on March 12, 2008. The second request for continued reexamination was dismissed by the Office, due to the undue delay that granting such a request would cause.[14] The amendment patent owner attempted to enter in the dismissed second request for continued reexamination included the addition of a new claim and attempted to re-argue claims previously established as unpatentable.[15]

In regards to reexamination proceeding No. 95/000,134, the Office granted patent owner's December 28, 2007 request for continued reexamination, as the examiner had issued a final Office action using new references provided by requester. Patent owner had previously responded to the non-final first Office and overcame all known grounds of rejection. Patent owner had submitted a response to the new grounds of rejection set forth in the final Office action responding to all new grounds of rejection and advancing prosecution.[16]

In regards to reexamination proceeding No. 95/000,149, the Office granted patent owner's September 29, 2008 request for continued reexamination, as the examiner issued a final Office action presenting new rejections and applying new references. Patent owner had submitted a response to the new grounds of rejection set forth in the final Office action cancelling several claims and further amending other pending claims in response to the new grounds of rejection and advancing prosecution.[17]

None of the proceedings cited by patent owner contained the same substantive and procedural facts as the present proceeding. Therefore the cited decisions are not inconsistent with the

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[10] *Ex parte* merged Reexamination Control. Nos. 90/007,542 and 90/007,859 patent owner petition dated March 6, 2007, page 5.
[11] *Inter partes* Reexamination Control. No. 95/000,071 Office decision dated June 5, 2007, page 6.
[12] *Inter partes* Reexamination Control. No. 95/000,043 patent owner petition dated February 13, 2006, page 3.
[13] *Inter partes* Reexamination Control. No. 95/000,043 Office decision dated December 13, 2006, page 4.
[14] *Inter partes* Reexamination Control. No. 95/000,043 Office decision dated July 21, 2008.
[15] *Inter partes* Reexamination Control. No. 95/000,043 patent owner petition under 37 CFR 1.181 dated March 12, 2008, pages 10-11.
[16] *Inter partes* Reexamination Control. No. 95/000,134 Office decision dated February 11, 2008, page 3.
[17] *Inter partes* Reexamination Control. No. 95/000,149 Office decision dated October 14, 2008, page 3.

January 29, 2010 decision issued in this proceeding, dismissing patent owner's petition requesting continued reexamination. Accordingly, the Office is not acting in an arbitrary and capricious manner in refusing to grant patent owner's petition.

For all the reasons noted above, the petition under 37 CFR 1.181(a)(3) is **denied.**

CONCLUSION

1. The petition under 37 CFR 1.181 is denied.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

3. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

7-19-10
Kenpet8/
Keninterview

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MAR 27 2012

CENTRAL REEXAMINATION UNIT

Accenture Chicago 28164
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

For Patent Owner

Daniel M. DeVos
Blakeley, Sokoloff, Taylor & Zafman, LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

For 3rd Party Requester
(all three requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,201
Filed: June 19, 2008
For: U.S. Patent No. 7,013,284

Ex Parte Reexamination Proceeding
Control No. 90/010,713
Filed: October, 9, 2009
For: U.S. Patent No. 7,013,284

Ex Parte Reexamination Proceeding
Control No. 90/011,484
Filed: February 10, 2011
For: U.S. Patent No. 7,013,284

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Reexamination Specialist 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 proceeding control No. 90/010,201 was ordered in a decision mailed October 1, 2008. The decision granted reexamination for claims 1-22, all of the claims in U.S. Patent No. 7,013,284. On July 17, 2009, a non-final Office action was mailed rejecting all of the claims (i.e., claims 1-22). On September 17, 2009, patent owner filed a response to the Office action. The response presented arguments in favor of confirmation of claims 1-22 and added new claims 23-40. Reexamination in proceeding Control No. 90/010,713 was ordered in a decision mailed December 17, 2009. The decision indicating that claims 1-22, all of the claims in U.S. Patent No. 7,013,284, would be reexamined. A decision merging reexamination proceedings 90/010,201 and 90/010,713 was mailed February 26, 2010. The decision required a "housekeeping amendment" to place the two proceedings in identical conditions. An amendment was filed by patent owner on March 26, 2010 adding new claims 23-40 to reexamination proceeding 90/010,713, thereby placing both of these proceedings in identical condition as to claims, specification, and drawings. A non-final Office action was mailed in these merged proceedings on October 1, 2010 rejecting claims 1-40, all of the claims. Patent owner filed a timely response on January 3, 2011. This response did not include any amendments to the claims, specification, or drawings. No further action has been issued by the Office in this merged proceeding.

Reexamination in proceeding control No. 90/011,484 was ordered in a decision mailed February 10, 2011. The decision granted reexamination for claims 1-22, all of the claims in U.S. patent No. 7,013,284. Patent owner did not file a patent owner statement under 37 CFR 1.530. On May 4, 2011, patent owner filed a petition requesting that this newly filed reexamination request be expunged and the filing date of the request as well as the order granting reexamination be vacated. On May18, 2011, third party requester filed a petition in opposition to patent owner's petition of May 4, 2011. In a decision mailed January 10, 2012, patent owner's petition of May 4, 2011 requesting that the filing date of the instant reexamination proceeding be vacated was dismissed. In that same decision, third party requester was given a period of fifteen days from the mailing date of the decision as an opportunity to submit a redacted replacement copy of the 90/011,484 request for reexamination, which copy would be identical to the February 10, 2011 request except for redacting the text of the section titled "Maintaining Certain Existing Rejections". As third party requester did not file such a redacted copy of the original request within the set time period for response, the Office has redacted the original copy of the request consistent with the guidelines set forth in the decision – see "Letter Redacting Request for Reexamination" mailed March 27, 2012 in reexamination proceeding 90/011,484.. This proceeding is otherwise ready for an Office action.

As evidenced by the above facts, reexamination Control Nos. 90/010,201; 90/010,713; and 90/011,484 are currently pending. Since the order to reexamine has been mailed in each of the three reexamination proceedings and all proceedings are pending, a decision under 37 CFR 1.565(c) is timely. Accordingly, the proceedings are hereby merged. A joint examination as to claims 1-40 will be conducted in accordance with the following guidelines and requirements.

Requirement for Same Claims, Drawings, and Specification in all Proceedings

As noted above, new claims 23-40 were added in reexamination proceeding 90/010,201 by the response filed September 17, 2009. Further, by virtue of a "housekeeping amendment" filed March 26, 2010 pursuant to the requirement made in the decision merging reexamination proceedings control Nos. 90/011,201 and 90/010,703, new claims 23-40 were added to reexamination control No 90/011,713. No amendment has been filed in reexamination control No. 90/011,484. As patent owner is required to maintain identical claims, drawings, and specification in both files, and to expedite the proceedings, attached as an appendix are claims 23-40, which claims are hereby being incorporated into reexamination proceeding 90/011,484.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. All papers mailed by the Office will take the form of a single action that jointly applies to each of the three reexamination proceedings. All papers issued by the Office will contain the identifying data for each case, and each paper will be entered into each of the three files (which will be maintained as separate files). Any paper filed by the patent owner must consist of a single response, filed in triplicate, 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. 90/010,201; 90/010,713; and 90/011,484 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.

Any inquiry concerning this decision should be directed to Andres Kashnikow, Supervisory Patent Reexamination Specialist, at telephone No. (571) 272-4361.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993

Enclosure: Appendix – Copy of new claims 23-40.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100924

DATE : September 24, 2010

TO SPE OF : ART UNIT 2917

SUBJECT : Request for Certificate of Correction on Patent No.: D552,440 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,279	09/16/2008	5157391	347238US	8706

22850 7590 08/04/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010279
PATENT NO. : 5157391
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MOTOROLA, INC., PATENT DEPT.
1500 NW 22 AVE.,
BOYNTON BEACH, FL 33426-8753

Date:
MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010279
PATENT NO. : 5157391
ART UNIT : 3992

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(For Patent Owner) **MAILED**

MOTOROLA, INC., PATENT DEPT.
1500 NW 22 AVE.,
BOYNTON BEACH FL 33426-8753

AUG 04 2010

CENTRAL REEXAMINATION UNIT

(Courtesy Copy)

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1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Requester)

WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

In re Weitzen	: DECISION DISMISSING
Reexamination Proceeding	: PETITION TO MERGE
Control No. 90/010,279	: REEXAMINATION
For: U.S. Patent No. 5,157,391	: PROCEEDINGS

The above *ex parte* reexamination is before the Director of the Central Reexamination Unit for consideration of a petition filed December 23, 2009 to merge reexamination proceedings. Although the petition is styled as a petition under 37 CFR 1.182, the petition is considered pursuant to 37 CFR 1.181. No fee is required.

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,157,391 (hereinafter, the '391 patent), issued to Weitzen, on October 20, 1992.

2. On September 16, 2008, a third party deposited a request for *ex parte* reexamination of the '391 patent requesting claims 1, 5, 8, and 9 be reexamined. The reexamination proceeding was assigned Control No. 90/010,279 (hereinafter, the '10279 proceeding).

3. On April 11, 2008, the order granting the request for reexamination of claims 1, 5, 8, and 9 was mailed.

4. During prosecution, claims 8 and 9 were cancelled. Claims 1 and 5 stand finally rejected. Patent owner has appealed the final rejection and filed an appeal brief. The examiner's answer has been mailed. A reply brief has been filed and the '10279 proceeding is ready to be forwarded to the Board of Patent Appeals and Interferences (BPAI) for docketing.

5. On July 1, 2009, a third party deposited a request for *ex parte* reexamination of the '391 patent requesting claims 2 and 6 be reexamined. The reexamination proceeding was assigned Control No. 90/009,509 (hereinafter, the '9509 proceeding). Claims 2 and 6 stand finally rejected.

DECISION

MPEP 2283 states, in part:

Pursuant to 35 U.S.C. 305, "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 305 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

In the instant proceeding, one factor weighing against merger is that the '10279 proceeding is ready to be forwarded to the BPAI, whereas the '9509 proceeding is many months further behind

in prosecution. It is unclear, how delaying the '10279 proceeding is consistent with the requirement for "special dispatch". Also, the claims that are subject to reexamination are different in each of the proceedings. So the possibility exists that the rejections could be affirmed in one proceeding and reversed in the other. In that situation, if the proceedings are not merged, then one proceeding could be appealed while the other is resolved and can result in the reexamination certificate. However, if the proceedings are merged, the proceeding with only confirmed claims would be subject to further delay.

Petitioner notes that some claim limitations are common between the claims in the proceedings and expresses concern that separate appeals may result in inconsistent results. Patent owner can reduce those concerns by bringing the other proceeding to the attention of the BPAI if an appeal brief is filed in the second proceeding.

After weighing the factors for and against merger in this case, the office decides that any benefit from merging is outweighed by the delay associated with merging. Accordingly, the petition is **dismissed**.

CONCLUSION

1. The petition to merge the '10279 proceeding with control number 90/009,509 is **dismissed**.

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

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,279	09/16/2008	5157391	347238US	8706

22850 7590 02/01/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2011

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.
90/009,509	07/01/2009	5157391	347235US	9691

22850 7590 02/01/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/01/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED
FEB 01 2011
CENTRAL REEXAMINATION UNIT

Date:

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE / DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009509
PATENT NO. : 5157391
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHAL/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

Date:

MAILED
FEB 01 2011
CENTRAL REEXAMINATION UN

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010279
PATENT NO. : 5157391
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
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Alexandria, VA 22313-1450
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MAILED
FEB 01 2011
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

MOTOROLA, INC., PATENT DEPT.
1500 NW 22 AVE.,
BOYNTON BEACH FL 33426-8753

(For Requester)

WILMERHALE/NEW YORK
399 PARK AVENUE
NEW YORK, NY 10022

(For Requester)

WILMERHALE/DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

(Courtesy Copy)

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Weitzen	:
Reexamination Proceeding	: DECISION
Control No. 90/010,279	: MERGING
Filed: September 16, 2008	: REEXAMINATION
For: U.S. Patent No. 5,157,391	: PROCEEDINGS

In re Weitzen	:
Reexamination Proceeding	:
Control No. 90/009,509	:
Filed: July 1, 2009	:
For: U.S. Patent No. 5,157,391	:

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. 5,157,391 (hereinafter, the '391 patent), issued to Weitzen, on October 20, 1992.

2. On September 16, 2008, a third party deposited a request for *ex parte* reexamination of the '391 patent. The reexamination proceeding was assigned Control No. 90/010,279 (hereinafter, the '10279 proceeding).

3. The Reexamination Order was granted in the '10279 proceeding on November 10, 2008 finding a substantial new question of patentability (SNQP) as to claims 1, 5, 8, and 9.

4. During prosecution of the '10279 proceeding, claims 8 and 9 were cancelled. Also, a rejection of claims 1 and 5 was reversed by the Board of Patent Appeals and Interferences (BPAI).

5. On July 1, 2009, a third party requester deposited a Request for *ex parte* Reexamination of the '391 patent. The reexamination proceeding was assigned Control No. 90/009,509 (hereinafter, the '9509 proceeding).

6. The Reexamination Order was granted in the '9509 proceeding on August 19, 2009 finding a substantial new question of patentability (SNQP) as to claims 2 and 6.

7. During prosecution of the '9509 proceeding, a rejection of claims 2 and 6 was reversed by the BPAI.

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 usually be merged and result in the issuance of a single certificate of a single certificate under § 1.570.

In accordance with 37 C.F.R. § 1.565(c), the '10279 and '9509 reexamination proceedings are merged. The cancelled claims 8 and 9 are considered cancelled in the merged proceeding. Since the standing rejections of claims 1, 2, 5, and 6 have been reversed, the proceeding is being

forwarded to the examiner for action not inconsistent with this decision or the decisions of the BPAI.

CONCLUSION

1. Reexamination Control Nos. 90/010,279 and 90/009,509 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

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

Calfee Halter & Griswold, LLP (For patent owner)
800 Superior Avenue
Suite 1400
Cleveland, OH 44114

MAILED

SEP 21 2010

CENTRAL REEXAMINATION UNIT

Jenkins, Wilson, Taylor & Hunt, P.A. (For requester)
Suite 1200
University Tower
3100 Tower Blvd.
Durham, NC 27707

In re Kenneth H. Kowalski et al. :
Ex Parte Reexamination Proceeding : **DECISION**
Control No. 90/010,331 : **GRANTING**
Filed: November 10, 2008 : **PETITION UNDER**
For: U.S. Patent No. 7,047,806 : **37 CFR 1.137(b)**

This is a decision on the August 3, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination[1] ("the August 3, 2010 patent owner petition to revive").

The August 3, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 3, 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 response under 37 CFR 1.550(b) to the April 16, 2010 Office action.

35 U.S.C. 133 provides:

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

35 U.S.C. 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:

(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 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.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the August 3, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the April 16, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The April 16, 2010 Office action set a two-month period for response. In addition, a one-month extension of time to respond to the April 16, 2010 Office action was granted by the June 23, 2010 Decision Granting Petition for Extension of Time. However, a proper response to the April 16, 2010 Office action was not filed until August 3, 2010, which was untimely. Nevertheless, for the purpose of evaluating whether the August 3, 2010 patent owner petition to revive is a grantable petition, the submission of the August 3, 2010 Amendment and Declaration Under 37 CFR 1.131 satisfies item (1).[2]

Accordingly, the August 3, 2010 patent owner petition to revive is **granted**.

CONCLUSION

1. The August 3, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for treatment of the August 3, 2010 Amendment and Declaration Under 37 CFR 1.131.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Anjan Deb, of CRU Art Unit 3992, at (571) 272-2228.

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

09/20/2010

[2] This decision is not directed to the persuasiveness and propriety of the arguments presented in the August 3, 2010 Amendment and Declaration Under 37 CFR 1.131 as to each of the rejections set forth in the April 16, 2010 Office action; such is the examiner's province.

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 11/19/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date: **MAILED**

NOV 1 9 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290

21906 7590 11/19/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:
MAILED
NOV 1 9 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910

21906 7590 11/19/2010

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/19/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

NOV 19 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

Commissioner for Patent
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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NOV 19 2010

CENTRAL REEXAMINATION UNIT

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

(For first *Inter Partes* Requester)

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

(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION GRANTING-IN-PART PETITION

This is a decision on the September 14, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 141 pages in order to fully address the June 14, 2010 non-final Office action. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

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

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is granted to the extent that the page limit for patent owner's response is extended to not exceed 81 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

REVIEW OF RELEVANT FACTS

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*

2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '10333 proceeding.

4. On August 5, 2009, a non-final Office action was mailed in the '10333 proceeding, rejecting all the claims of the '833 patent.

5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc. The request was assigned control number 95/001,223 (the '1223 proceeding).

6. On October 2, 2009, patent owner timely filed, in the '10333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.

7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. The request was assigned control number 95/001,264 (the '1264 proceeding).

9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.

10. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date.

11. On July 15, 2010, patent owner filed a request for a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the June 14, 2010 non-final Office action.

12. On July 21, 2010, the Office mailed a decision granting the requested one-month extension, setting the response due date to September 14, 2010.

13. On September 14, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, patent owner timely filed a response to the June 14, 2010 non-final Office action.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

*****

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit

requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on September 14, 2010 to address the June 14, 2010 non-final Office action, and requests that the page limit be extended to 141 pages.[1] In support of its request for waiver of the rule, patent owner argues that large portions of the request were incorporated by reference into the 46 page Office action and that patent owner's 141 page submission is much smaller than the more than 800 pages constituting the three different Requests for reexamination and accompanying exhibits.[2] Patent owner asserts that "this waiver is in keeping with the substantial interest of justice, in that the Patent Owner should have the opportunity to adequately respond and amend the claims in view of the pending claim rejections" and that "[e]nforcing the page limit would prevent the Patent Owner from making a full and complete response to the Office Action as required by the patent statute and the rules."[3]

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of the resulting comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such a comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments submission: (1) for justification that more pages are needed to complete the comments submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the comments submission.

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[1] Petition at page 2.
[2] *Id.*
[3] *Id.*

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's September 14, 2010 response includes 37 pages of remarks, which are subject to the 50 page limit. The following sections of the response are not included in the page limit: the cover page, the five page listing of claims, the signature page, and the two pages of certificate of service.

The patent owner response is also accompanied by Appendix A, Appendix B, declarations of Paul Polansky under 37 CFR 1.132 and of Russell White under 37 CFR 1.132, and four pages of certificate of service for these two declarations.

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Appendix A is a 4-page claim chart showing support for the new claims, and is counted toward the page limit. Appendix B consists of Office actions, applicant's responses to those Office actions, and an interview summary, all of which are from the original prosecution of the instant patent under reexamination. The copies of these documents, which are of record for the patented file, do not count toward the page limit.

The declaration of Polansky and the accompanying Appendices A-Y do not contain any legal arguments and therefore do not count toward the page limit.

The declaration of White is accompanied by Exhibits A-M and contain legal arguments as follows: On page 2, declarant White states: "The following facts establish that the claims of the '833 patent are not obvious..." On page 8, declarant White states: "For at least these reasons, the claims of the '833 patent are not obvious." The remaining pages of the White declaration are strictly drawn to evidence of commercial success and/or copying, which do not count toward the page limit. Attached Exhibit C is a 31-page Claim Construction order that is replete with legal arguments and relied upon by patent owner in its remarks; therefore, the claim construction order is counted toward the page limit. Exhibit D is patent owner's infringement contentions and contain legal arguments regarding the priority date of the patent claims on pages 3-5, 7-9, and 11, which count toward the page limit.

Accordingly, the September 14, 2010 patent owner response *in toto* is 81 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 31 pages of arguments in excess of 50 required to complete the patent owner's response are not unreasonable in this instance, in view of the present facts and circumstances. The June 14, 2010 non-final Office action is 46 pages in length (excluding 6 cover sheets) and incorporates by reference 36 pages of the Request and more than 57 pages of the claim charts accompanying the Request. The June 14, 2010 non-final Office is effectively more than 139 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 81 pages in length is appropriate in the interest of justice.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **31 pages** of the arguments portion of patent owner's September 14, 2010 response that exceed the 50-page limit.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's response to the June 14, 2010 Office action not exceed 81 pages in length, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the September 14, 2010 patent owner response page-length compliant.

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

Cynthia L. Nessler

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

11-18-10
Cindypet/

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 01/06/2011
TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:
MAILED
JAN 06 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,223	09/22/2009	7324833	AFF.0004B2US	1290

21906 7590 01/06/2011

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001223
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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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.
95/001,264	11/13/2009	7324833	AFF.0004B5US	6910

21906 7590 01/06/2011

TROP, PRUNER & HU, P.C.
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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

Date:
MAILED
JAN 06 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001264
PATENT NO. : 7324833
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

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JAN 06 2011

CENTRAL REEXAMINATION UNIT

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

(For Patent Owner)

KENYON & KENYON LLP
ONE BROADWAY
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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA AVENUE
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HOUSTON, TX 77002

(For second *Inter Partes* Requester)

KNOBBE, MARTENS OLSON & BEAR, LLP
2040 MAIN ST. 14TH FLOOR
IRVINE, CA 92614

(For *Ex Parte* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION DISMISSING PETITION

This is a decision on the October 20, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the 37 CFR 1.98 copy requirement and the 37 CFR 1.903 service requirement with respect to "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature) cited in patent owner's concurrently filed information disclosure statement (IDS) submissions.

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

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for patent owner's petition under 37 CFR 1.183 has been paid.

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

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.*

2. On November 7, 2008, a request for *ex parte* reexamination of the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '10333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered for the '10333 proceeding.

4. On September 22, 2009, a first request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Volkswagen Group of Americas, Inc.. The request was assigned control number 95/001,223 (the '1223 proceeding).

5. On November 9, 2009, *inter partes* reexamination was ordered for the '1223 proceeding.

6. On November 13, 2009, a second request for *inter partes* reexamination of the '833 patent was filed by a third party requester and real party in interest, Apple, Inc.. The request was assigned control number 95/001,264 (the '1264 proceeding).

7. On February 5, 2010, *inter partes* reexamination was ordered for the '1264 proceeding.

8. On June 14, 2010, the '10333, '1223, and '1264 proceedings were merged (the merged proceeding). A non-final Office action was mailed on even date.

9. On September 14, 2010, patent owner timely filed a response to the June 14, 2010 non-final Office action.[1]

10. On October 20, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with IDS submissions.

[1] On July 21, 2010, the Office mailed a decision granting patent owner's July 15, 2010 request for a one-month extension of time, setting the response due date to September 14, 2010.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.98(a)(2) provides that any IDS filed under § 1.97 shall include:

> A legible copy of:
> (i) Each foreign patent;
> (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
> (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
> (iv) All other information or that portion which caused it to be listed.

37 CFR 1.555(a) provides in-part (emphasis added):

> ****
>
> The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. <u>Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding</u>, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

> The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must

reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

II. Patent Owner's Petition

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.98 that patent owner submit copies of "non-U.S. references" (i.e., non-U.S. patent documents and non-patent literature; subsequently referred to herein as "references") cited on patent owner's IDS submissions filed concurrently with the instant petition on October 20, 2010.[2] In support of its request for waiver of the rule, patent owner states that it has recently filed (in four boxes) copies of the same references in connection with IDS submissions filed in co-pending reexamination proceeding control no. 95/001,262 (the '1262 proceeding) and that "[t]o avoid the need to re-send these duplicative documents, Patent Owner respectfully requests this petition be granted."[3] Patent owner also requests waiver of the requirement under 37 CFR 1.903 that patent owner serve copies of these same references on second *inter partes* requester (Apple Inc.), as patent owner has already served these same documents on Apple Inc. in the co-pending '1262 proceeding.[4] Patent owner states that it "makes this petition to avoid the expense and burden on the Patent Owner, Patent Office and Requester that the preparation, filing, uploading to PAIR, and so forth would require of all of these parties" and that "[t]his burden is especially unwarranted, as all of the documents that would be avoided by the granting of this petition have already been provided both to the Patent Office and to Requester Apple."[5]

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Waiver of the copy requirement of 37 CFR 1.98(a)(2)

As a general rule, waiver of a rule in the interest of justice is not available when there is recourse within the rules of practice. In this instance, petitioner requests waiver of the rules governing submission of documents to the Office based on the alleged burden of submitting to the Office physical copies of numerous references in multiple reexamination proceedings. In lieu of submitting to the Office physical copies of the references, however, petitioner patent owner may use the Office's Web-based electronic filing system (EFS-Web) to submit electronic copies of the references to the Office. In this way, petitioner need only scan the references into an acceptable electronic format (e.g., Adobe Portable Document Format (PDF)) once, and petitioner can then submit the scanned references to the Office via EFS-Web in any number of reexamination proceedings.

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[2] Petition at pages 1-2.
[3] *Id.* at page 2.
[4] *Id.*
[5] *Id.*

Additionally, Office systems, as currently configured, do not have the capability of copying, in bulk, references from the IFW of one reexamination proceeding into the IFWs of other reexamination proceedings. Any such copying by the Office would be on an individual citation basis and would be lengthy and tedious. Thus, if the Office were to grant petitioner's request, the logistics of insuring that each of the references is properly included in the IFW of the instant merged proceeding would be shifted to the Office. Accuracy of the reexamination file should be paramount when determining who is better positioned to provide the required copies of references cited in an IDS submission. Patent owner has greater knowledge of the references cited in the IDS and is better able to address issues that may arise during introduction of the copies of the references into the instant merged proceeding. For these reasons, patent owner is better positioned to supply the required copies of the IDS references in question, and therefore must comply with 37 CFR 1.98(a)(2).

Accordingly, for all of the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.98(a)(2), and the petition is dismissed.

Waiver of the service requirement of 37 CFR 1.903

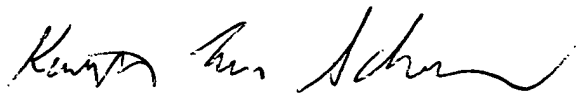
35 U.S.C. 314(b)(1) provides: "With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party." 37 CFR 1.183 is clear that it applies only to a "requirement of the regulations in this part which is not a requirement of the statutes" (emphasis added), and it should be equally clear that a requirement of the statute cannot be waived.

Accordingly, patent owner's petition under 37 CFR 1.183 as to waiver of the service requirement of 37 CFR 1.903 is dismissed.

CONCLUSION

1. Patent owner's October 20, 2010 petition under 37 CFR 1.183 is dismissed.

2. Telephone inquiries related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.



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

January 5, 2011
Ken pet 8/

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90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 04/18/2011
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HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

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2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Date:

MAILED

APR 18 2011

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

United States Patent and Trademark Office

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APR 1 8 2011

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Inter Partes Reexamination Proceeding
Control No. 95/001,223
Filed: September 22, 2009
For: U.S. Patent No. 7,324,833

Inter Partes Reexamination Proceeding
Control No. 95/001,264
Filed: November 13, 2009
For: U.S. Patent No. 7,324,833

Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION GRANTING-IN-PART PETITION AND EXPUNGING IMPROPER PAPER

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on December 20, 2010.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester VWGoA not exceed fifty (50) pages in length, and requests that the page limit be extended to 138 pages. Third party requester VWGoA timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

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

Third party requester VWGoA's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester VWGoA is granted to the extent that the page limit for written comments by third party requester is VWGoA extended to not exceed 92 pages in length.

For the reasons set forth below, third party requester VWGoA's comments submission is an improper paper and is being expunged without consideration. Since the third party requester VWGoA's paper has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, the December 20, 2010 third party requester comments submission by VWGoA is being expunged from the record by closing it and marking it "not public".

DECISION

I. DECISION GRANTING-IN-PART PETITION TO WAIVE THE REQUIREMENTS OF 37 CFR 1.943(b)

In the instant petition, third party requester VWGoA requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and request that the page limit be extended to138 pages.[1] In support of its request for waiver of the rule, third party requester VWGoA argues that additional pages are needed to present new proposed grounds of rejection, which are either necessitated by patent owner's addition of 14 new claims in its response or by VWGoA's recent discovery of new prior art based on depositions that were conducted by patent owner in the concurrent litigation involving the '833 patent in April and May 2010, after the date of VWGoA's request for *inter partes* rexamination.[2] VWGoA also asserts that the new claims add subject matter that was not previously claimed in any of the original claims of the '833 patent.[3] Finally, VWGoA argues that MPEP § 2617 requires a detailed explanation for the newly proposed rejections.[4]

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester VGWoA's December 20, 2010 written comments include **42** pages of remarks, which are subject to the 50 page limit. The third party requester's written comments

[1] Petition at page 8.
[2] *Id.* at 8-9.
[3] *Id.* at 8.
[4] *Id.* at 9.

are also accompanied by 80 pages of claim charts for the new proposed grounds of rejection, Exhibits 1-12, and a declaration of Scott Andrews under 37 CFR 1.132.[5]

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 80-page claim chart for the new proposed grounds of rejection is counted toward the page limit.

Exhibit 2 is VWGoA's 27-page post-trial brief filed in the concurrent litigation containing legal arguments regarding the '833 patent claims and is counted toward the page limit.

Exhibit 3 is a 27-page comparison of the parent '812 application as filed and the '833 patent as filed to support VWGoA's arguments regarding priority of the '833 patent claims and is counted toward the page limit.

The 12-page declaration of Andrews contains 8 pages of legal arguments. Examples of legal arguments in the Andrews declaration, which are not exhaustive are:

> On page 2, paragraph 10, declarant Andrews states: "In my opinion, claims 1 to 35 of the '833 patent include subject matter not disclosed in the '812 application."

[5] This decision would normally be limited to the page-limit issue and the propriety of third party requester's written comments would be reviewed by the Central Reexamination Unit (CRU). However, in response to VWGoA's statement on page 8 of the instant petition that it is presenting new proposed grounds of rejection based on new prior art, this decision notifies the requester that its comments submission facially fails to comply with 35 U.S.C. 314(b)(2) and 37 CFR 1.947.

On page 3, paragraph 12, declarant Andrews states: "In my opinion, the '812 application does not describe the following features included in claim 17 of the '833 patent."

On page 5, paragraph 20, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) portable radio 500..."

On page 6, paragraph 22, declarant Andrews states: "Nor does the '812 application describe or suggest even such a hypothetical (and not described) vehicle system..."

On page 7, paragraph 24, declarant Andrews states: In contrast to these systems described in the '812 application, the claims of the '833 patent require two devices..."

On page 9, paragraph 28, declarant Andrews states: "Therefore, conventional audio systems, at the time of filing the '812 application...were incapable of presenting graphical user interfaces or graphical menus of the type described in the claims of the '833 patent."

On page 10, paragraph 33, declarant Andrews states: "Based on the foregoing, it is my opinion that the '812 application does not describe the audio system described claim 1 of the '833 patent."

On page 11, paragraph 34, declarant Andrews states: "Furthermore, it is my opinion that the '812 application does not describe the audio system described in claim 17 of the '833 patent."

In addition, the Andrews declaration is accompanied by Exhibits A-C.

Exhibit B is a copy of application 09/537,812, which is the parent application of the '833 patent. This copy is not counted toward the page limit because it is presumed to have been reviewed by the examiner of the present merged proceeding.

Accordingly, the December 20, 2010 third party requester VWGoA's comments submission *in toto* is 184 pages in length, as to the pages counted toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 134 pages of arguments in excess of 50 required to complete third party requester VGWoA's comments are unreasonable in this instance, in view of the present facts and circumstances. The patent owner added only 14 new claims, and amended three original claims. As an initial matter, the submission of 134 additional pages of arguments to address the limited number of newly added claim limitations is deemed to be unreasonable.

In the decision addressing third party requester Apple's December 20, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b), which is being mailed on even date, the third party requester Apple's written comments submission was determined to be 92 pages in length, and was deemed page length compliant in view of the waiver granted therein.

In a balancing of the equities, and after a review of the comments submission, the third party requester VWGoA's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **42 pages** of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit (assuming that requester revises the comments submission to properly limit it by deleting the comments that are directed to improperly proposed new prior art rejections, as discussed below).

Third party requester VWGoA's written comments submission does not comply with the page limit of ninety-two (92) pages in length granted in this decision by waiver, and thus lacks an entry right in the present merged proceeding. The written comments submission was entered (scanned) into the Office's IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present merged reexamination proceeding.

II. THIRD PARTY REQUESTER VWGoA'S DECEMBER 20, 2010 COMMENTS SUBMISSION IS FACIALLY IMPROPER

The Office notes that third party requester VGWoA's comments submission improperly proposes rejections based on newly submitted prior art. For example, a brief review of VGWoA's comments submission reveals that the requester newly proposes rejections, based on newly submitted prior art, of unamended (original) claims.[6] Such rejections are based on, for example, the Simon et al. and Empeg Car User Guide (hereinafter "Empeg") references.[7] Third party requester VWGoA justifies these newly proposed prior art rejections as follows: With respect to the Simon et al. reference, third party requester VGWoA asserts that the reference, "first became known to VWGoA not earlier than April 27, 2010," the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.[8] With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner's response, that is to address the new claims presented in patent owner' response.[9] In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary to apply the reference against the independent claims as well.[10]

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[6] See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.
[7] *Id.*
[8] See page 32 of the December 20, 2010 VWGoA's written comments.
[9] *Id.*
[10] *Id.*

The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitation on what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled "information disclosure statement," which is filed with requester's comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement." To newly propose a rejection based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by patent owner's amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner's amendment. See 37 CFR 1.947 and MPEP 2666.05.

35 U.S.C. § 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." Even if the requester shows that the new prior art is submitted in compliance with 37 CFR 1.948, this does not necessarily permit requester to propose a new ground of rejection based on additional art, as (1) 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection, and (2) 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. § 314(b)(2). If the requester were permitted to newly propose rejections based on newly cited prior art, without showing how these rejections were necessitated by amendment, then the provisions of 35 U.S.C. § 314(b)(2) and 37 CFR 1.947 would essentially be a nullity. For example, an entirely new proposed ground of rejection, and one which is based on 37 CFR 1.948(a)(3) art, is not permitted by 35 U.S.C. 314(b)(2) because it would not address "issues raised by the action of the Office or the patent owner's response."

Therefore, the December 20, 2010 requester VWGoA comments do not have a right of entry under 37 CFR 1.947 and 1.948 and 35 U.S.C. § 314(b)(2). There is simply no statutory or regulatory authority for entry of the newly proposed prior art rejections not necessitated by an amendment to the patent claims. As pointed out above, the written comments paper was entered (scanned) into the Office's IFW system before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW system. Therefore, the written comments submission is being expunged from the record by closing it and by marking it "not public".

In view of the above discussion as to the VWGoA comments filed on December 20, 2010 being improper, the comments are expunged from the record in the manner described above.

This decision primarily addresses requester's petition under 37 CFR 1.183 for waiver of the page length requirements under 37 CFR 1.943(b), and does not include a complete analysis of the propriety, or lack thereof, of requester's comments submission, pursuant to, for example, 37 CFR §§ 1.947 or 1.948, or MPEP 2666.05. As to the compliance of requester's comments submission with any regulation other than 37 CFR 1.943(b), or any applicable statute or published procedure, this decision only notifies the requester that requester's comments submission ***facially*** fails to comply with 35 U.S.C. 314(b)(2), 37 CFR 1.947, and MPEP 2666.05.

Any replacement comments submission filed in response to this decision will be reviewed by the examiner for compliance with all of the applicable statutes, regulations, and procedures.

THIRD PARTY REQUESTER OPTIONS

For the above reasons, the December 20, 2010 comments submission submitted by the third party requester VWGoA is improper.

Third party requester is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission, which must be limited to 92 pages pursuant to the page limit waiver granted-in-part in this decision. The requester should review the entire replacement written comments submission, prior to its filing, for compliance with all applicable statutes, regulations, and published Office procedures, particularly 37 CFR §§ 1.943(b), 1.947, and 1.948, and MPEP 2666.05.

Any replacement comments submission filed in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submission. No comments that add to those in the expunged paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

If no replacement comments submission from the third party requester is timely received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments by the third party requester.

CONCLUSION

1. Third party requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester VWGoA's 37 CFR 1.947 comments submission after the September 14, 2010 patent owner response is not to exceed 92 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.**

2. Third party requester VWGoA's written comments submission, filed on December 20, 2010, is improper, and will NOT be made a part of the record of the present merged proceeding.

3. Since third party requester VWGoA's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the present merged proceeding, these papers are expunged by closing them in the present merged reexamination proceeding's IFW files and marking them as "non-public."

4. Third party requester VWGoA is given fifteen (15) days from the mailing date of this decision to file a replacement comments submission. Any replacement comments submission filed in

response to the notification **must be strictly limited to (i.e., must not go beyond) the comments in the original (now expunged) comments submission**. No comments that add to those in the original paper will be considered for entry, other than what is strictly necessary to conform to the guidelines set forth in this decision.

5, No copy of the third party requester VWGoA's December 20, 2010 written comments submission will be maintained in the record, or elsewhere in the Office.

6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

4/15/11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,333	11/07/2008	7324833	AFF.0004B1US	6333

21906 7590 04/18/2011
TROP, PRUNER & HU, P.C.
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 18 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010333
PATENT NO. : 7324833
ART UNIT : 3992

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

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

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Inter Partes Reexamination Proceeding :
Control No. 95/001,223 :
Filed: September 22, 2009 :
For: U.S. Patent No. 7,324,833 :
:
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,264 : **GRANTING**
Filed: November 13, 2009 : **PETITION**
For: U.S. Patent No. 7,324,833 :
:
Ex Parte Reexamination Proceeding :
Control No. 90/010,333 :
Filed: November 7, 2008 :
For: U.S. Patent No. 7,324,833 :

This is a decision on the 95/001,264 third party requester (Apple, Inc., hereinafter "Apple") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37

C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION," filed on December 20, 2010. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 91 pages. Third party requester Apple timely filed its comments pursuant to 37 CFR 1.947 concurrently with the petition.

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

Third party requester Apple's petition under 37 CFR 1.183 is granted.

DECISION

In the instant petition, third party requester Apple requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its comments filed on December 20, 2010, and requests that the page limit be extended to 91 pages.[1] In support of its request for waiver of the rule, third party requester Apple argues that additional pages are needed to "provide detailed discussion of the grounds of rejection proposed for the amended and newly added claims that would satisfy the requirements of MPEP § 2617" and to "fully address the patentability of the amended and new claims."[2] Third party requester Apple further argues that it must provide detailed arguments under the Office's rules in responding "to the Patent Owner's Reply of September 14, 2010, the amended and new claims, the declaration of Russell W. White and Paul J. Polansky, and the Office Action mailed June 14, 2010."[3]

The third party requester Apple's instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester Apple's December 20, 2010 written comments include 66 pages of remarks, which are subject to the 50 page limit.

The third party requester Apple's written comments are also accompanied by Exhibits A-E.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that

[1] Petition at page 9.
[2] *Id.* at page 8.
[3] *Id.*

provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

After brief review, Exhibit A includes a 26-page declaration of Dr. Bruce Maggs, which is replete with legal arguments. For this reason, the entirety of the declaration is counted toward the page limit. Examples of legal arguments in the Maggs declaration, which are not exhaustive, that count toward the page limit are: In paragraph 9, on page 2, declarant Maggs states: "In my opinion, *the claims* of the '833 patent were all well known in the art before the filing date of the patent." In paragraph 11 on page 3, declarant Maggs states: "One of ordinary skill in the art would have been motivated to combine the references as presented in the *inter partes* request..." (also see, at a minimum, paragraphs 17, 18, 20-22, 26-39, 43-44, 47, 48, 50-52, 54-59, 61-67).

Accordingly, the December 20, 2010 third party requester Apple's comments *in toto* is 92 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 42 pages of arguments in excess of 50 required to complete the third party requester Apple's comments are not unreasonable in this instance, in view of the present facts and circumstances. The September 14, 2010 patent owner response amends claims 1, 17, and 19 and adds 14 new claims. In addition, the examiner, in the June 14, 2010 non-final Office action, did not adopt at least 30 of Apple's proposed rejections.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the third party requester Apple's instant petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester Apple's comments to run 92 pages in length is appropriate in the interest of justice.

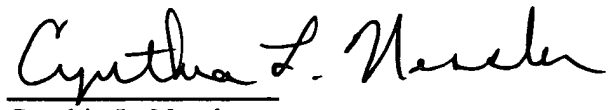
Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester Apple's comments submission to exceed the page limit by up to **42 pages**. This waiver makes requester Apple's December 20, 2010 comments submission page-length compliant.

CONCLUSION

1. Third party requester Apple's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester Apple's comments filed on December 20, 2010 may exceed the page limit by up to 42 pages. This waiver makes the

December 20, 2010 third party requester Apple's comments submission page-length compliant.

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



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Ex Parte Reexamination Proceeding
Control No. 90/010,333
Filed: November 7, 2008
For: U.S. Patent No. 7,324,833

DECISION DENYING PETITION AND EXPUNGING IMPROPER PAPERS

This is a decision on the 95/001,223 third party requester (Volkswagen Group of America, Inc., hereinafter "VWGoA") petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION," filed on May 3, 2011.

The present petition for reconsideration requests that:

(1) The April 18, 2011 Office decision granting-in-part the requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be vacated;

(2) The requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) be granted in its entirety; and

(3) The requester VWGoA's expunged December 20, 2010 comments submission be entered into the record and considered.

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

SUMMARY

The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is denied as to the underlying relief requested.

The April 18, 2011 Office decision **properly granted-in-part** requester VWGoA's December 20, 2010 petition requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission, and **properly expunged** VWGoA's December 20, 2010 comments submission that newly proposed rejections of unamended (original) claims that were based on newly cited prior art.

Exhibit 2, which is a copy of requester VWGoA's December 20, 2010 comments submission attached to the present petition, and the replacement comments filed concurrently with the present petition **are improper papers** and **are being expunged** without consideration. Since these papers have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the above-captioned merged reexamination proceeding, they are being expunged from the record by closing them and marking them "not public." .

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. On January 29, 2008, the Office issued U.S. Patent No. 7,324,833 (the '833 patent) to White *et al.,* with claims 1-35.

2. On November 7, 2008, a request for *ex parte* reexamination of all the claims in the '833 patent was filed by a third party requester. The request was assigned control number 90/010,333 (the '333 proceeding).

3. On December 19, 2008, *ex parte* reexamination was ordered on all the claims of the '833 patent in the '333 proceeding.

4. On August 5, 2009, a non-final Office action was mailed in the '333 proceeding, rejecting all the claims of the '833 patent.

5. On September 22, 2009, a first request for *inter partes* reexamination of all the claims in the '833 patent was filed by a third party requester and real party in interest, VWGoA. The request was assigned control number 95/001,223 (the '1223 proceeding).

6. On October 2, 2009, patent owner timely filed, in the '333 proceeding, an amendment and response to the August 5, 2009 Office action, amending claims 1 and 17. No claims were added or canceled.

7. On November 9, 2009, *inter partes* reexamination was ordered in the '1223 proceeding.

8. On November 13, 2009, a second request for *inter partes* reexamination of all the claims in the '833 patent, was filed by a third party requester and real party in interest, Apple, Inc. (hereinafter "Apple"). The request was assigned control number 95/001,264 (the '1264 proceeding).

9. On February 5, 2010, *inter partes* reexamination was ordered in the '1264 proceeding.

10. On June 14, 2010, the '333, '1223, and '1264 proceedings were merged. A non-final Office action was mailed on even date. Before the merger, no Office action was issued in the '1223 *inter partes* proceeding, nor in the '1264 *inter partes* proceeding, and no further Office action was issued in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action incorrectly stated on page 2 that claims 1, 17, and 19 were amended in the '333 proceeding. Only claims 1 and 17 were amended in the October 2, 2009 patent owner response filed in the '333 *ex parte* proceeding. The June 14, 2010 non-final Office action also stated on page 2 that claims 1-27 are not the same in all three proceedings and stated on page 3 that for examination purposes, the set of claims in the '333 proceeding would be utilized – i.e., the current set of claims in the '333 proceeding would be tentatively in effect for all three proceedings.[1]

[1] It is noted that in the June 14, 2010 non-final Office action that was mailed concurrently with the June 14, 2010 decision merging the '333, '1223, and the '1264 proceedings, the examiner's use of the amended claim set from the *ex parte* proceeding, where claims 1 and 17 were amended, as the claim set in effect for the merged proceeding, is a harmless procedural error. The examiner should have waited for the patent owner to file a housekeeping amendment that placed the same amendment in each of the three proceedings before issuing the June 14, 2010 non-final Office action. In its September 14, 2010 patent owner response, the amendment shows claims 1, 17, and 19 in their original form and adds new claims 36-49. Claims 1-35 are original patent claims as is confirmed by patent owner's remarks on page 7 of patent owner's September 14, 2010 response. The patent owner's September 14, 2010 amendment returning claims 1 and 17 to their original form remedied the procedural error to the extent that the scope of the original claims that was in front of the requesters at the critical time had not been changed by the patent owner's response to the June 14, 2010 non-final Office action. Thus, the proposed rejections for the original claims as set forth in the requests by both *inter partes* requesters are still before the examiner for his consideration.

11. On December 20, 2010, third party requester Apple filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PROVISIONS OF 37 C.F.R. § 1.943(B) TO INCREASE THE NUMBER OF PAGES PERMITTED FOR REQUESTER'S WRITTEN COMMENTS BEYOND THE 50-PAGE LIMITATION." Concurrently with the petition, third party requester Apple timely filed comments pursuant to 37 CFR 1.947.

12. On December 20, 2010, third party requester VWGoA filed a petition entitled " PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)." Concurrently with the petition, third party requester VWGoA timely filed comments pursuant to 37 CFR 1.947.

13. On April 18, 2011, the Office mailed a decision granting third party requester Apple's December 20, 2010 petition. The page limit waiver granted in the decision rendered requester Apple's December 20, 2010 comments submission page-length compliant.

14. On April 18, 2011, the Office mailed a decision granting-in-part requester VWGoA's December 20, 2010 petition (hereinafter "the April 18, 2011 decision"). The decision waived the page limit requirement of 37 CFR 1.943(b) to the extent that the page limit for requester VWGoA's written comments was extended not to exceed 92 pages in length. The requester's VWGoA's December 20, 2010 written comments submission, having a effective page length of 184 pages, did not comply with the page limit of 92 pages that was granted in the decision by waiver and thus lacked an entry right in the merged proceeding. Furthermore, the requester's VWGoA's December 20, 2010 written comments submission was found to be facially improper for proposing rejections based on newly submitted prior art for unamended (original) claims. Accordingly, the April 18, 2011 decision expunged requester's VWGoA's December 20, 2010 written comments submission from the record.

15. On May 3, 2011, third party requester VWGoA filed the instant petition entitled " PETITION UNDER 37 C.F.R. § 1.181 FOR RECONSIDERATION." Concurrently with the petition, third party requester VWGoA filed its replacement comments submission.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states (emphasis added):

> **Each time that the patent owner files a response to an action on the merits** from the Patent and Trademark Office, the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto**, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 states (emphasis added):

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may **once file written comments** within a period of 30 days from the date of service of the patent owner's response. These comments **shall be limited to issues**

raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.948(a) states (emphasis added):

After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include **a discussion of the pertinency of each reference** to the patentability of at least one claim.

The Manual of Patent Examining Procedure (MPEP), Section 2666.05 (II) states in pertinent part (emphasis added):

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

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Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. **However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record.** Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

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Where the **third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response**, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, **the written comments are improper**. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity **to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules**; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification **must be strictly limited to (i.e., must not go beyond)** the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

DECISION ON PETITION UNDER 37 CFR 1.181

Requester VWGoA urges that the following points be reviewed:

A. Whether the Office erred by (1) refusing to enter and consider requester VWGoA's original comments submission, filed on December 20, 2010, and (2) expunging the original comments submission from the record;[2] and

B. Whether the April 18, 2011 decision properly limited requester VWGoA's comments to only 92 of the requested 184 pages.[3]

The present decision addresses both requester points.

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[2] Petition for reconsideration at pages 7 and 13.

[3] *Id.* at page 7. It is noted that requester VWGoA's December 20, 2010 petition requested 138 pages for its comments, not the 184 pages that it is requesting in the present petition for reconsideration. In the April 18, 2011 decision, the Office determined that requester VWGoA's comments submission was 184 pages in length, as to the pages counted toward the regulatory page limit.

A. The April 18, 2011 Decision Properly Denied Entry of, and Expunged, the Requester VWGoA Original Comments Submission Filed on December 20, 2010:

1. The Statute Does Not Permit Requester to Newly Propose Rejections For Unamended (Original) Claims Based on Newly Cited Prior Art

The April 18, 2011 Office decision held that requester VWGoA's newly proposed rejections in its December 20, 2010 submission, which applied newly cited prior art against unamended (original) claims of the '833 patent, were not permitted by 35 U.S.C. § 314(b)(2).[4] Such newly proposed rejections were based on the Simon et al. and the Empeg Car User Guide (hereinafter "Empeg") references.[5] Requester VWGoA argues that this holding is improper. To support its argument, requester VWGoA contends that the language in 35 U.S.C. § 314 (b)(2) "is permissive and open-ended, rather than limiting."[6] Requester VWGoA argues that the language in 35 U.S.C. § 314 explains that the requester "shall have" certain rights, and that "the statute requires that the third-party requester be given **at least** 'one opportunity to file written comments' whenever the patent owner files as [sic] response, and that those comments be permitted to address **at least** 'issues raised by the action of the Office or the patent owner's response thereto.'"[7] Based on its interpretation of the statute, requester VWGoA contends that the Office's rules implementing this statutory provision are improperly closed-ended, and limiting.[8]

Requester VWGoA's interpretation of 35 U.S.C. § 314(b)(2) is not found to be correct. The relevant language of the statute is that "the third-party requester shall have **one opportunity** to file written comments **addressing issues raised by the action of the Office or the patent owner's response thereto.**" (Emphasis added) Based on the plain meaning of the language in the statute, the statute is not construed to provide third party-requester with an extra opportunity to submit written comments or the right to comment on issues that are not limited to those raised by patent owner's response or the Office action, and there is no legislative history to the contrary.

In December 2000, the Office issued final rules to implement *inter partes* reexamination, which was newly enacted by the America Inventors Protection Act (AIPA) of 1999 (Public Law No. 106-113. *See Rules to Implement Optional Inter Partes Reexamination Proceedings; Final Rule*, 65 Fed. Reg. 76756 (December 7, 2000), effective date of February 5, 2001. In this rule making the Office did not construe the language in 35 U.S.C. § 314(b) contrary to its plain language when implementing the statute through 37 CFR 1.947.[9]

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[4] *Id.* at page 18.
[5] See for example, pages 1-39 of the 80-page claim chart attached to the December 20, 2010 VWGoA's comments, which contain newly proposed prior art rejections for unamended (original) claims.
[6] Petition for reconsideration at page 17.
[7] *Id.*
[8] *Id.* at pages 17-18.
[9] One comment on the notice of proposed rule making suggested that the patent owner should have the right of the last comment, which the Office did not adopt. The Office's response, which is provided in the notice, explains that providing the patent owner with an opportunity to reply to third party comments would unduly prolong the pendency of the proceeding, contrary to the special dispatch requirement set forth in 35 U.S.C. § 314(c). The Office also noted that a patent owner response to the third party comments could be considered a (supplemental) patent owner

In the Office's implementation of *inter partes* reexamination, the rules which limit requester's written comments to issues raised in the patent owner response or in the Office action, and which provide only one opportunity to file comments after a patent owner response, were established through notice and comment. The final rule making notice points out that only three comments directed to proposed 37 CFR 1.947 were received. None of these comments challenged the Office's interpretation of the statute that is set forth in 37 CFR 1.947. To date, the text of 37 CFR 1.947 has not been amended since the rule first became effective on February 5, 2001.

It is to be noted that since the inception of optional *inter partes* reexamination, the Office has construed the statute to: 1) limit requester's comments to issues raised in the patent owner response or in the Office action, and 2) provide only one opportunity to file written comments, each time that a patent owner files a response to an Office action. If the Office were to adopt the petitioner's reading of the statute, the Office would be changing a well-established Office procedure, which would be contrary to *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 87 USPQ 2d 1705 (Fed. Cir. 2008). In *Cooper*, the Federal Circuit stated:[10]

> In this case, the Patent Office expressly interpreted "original application" as used in the AIPA, shortly after the AIPA was enacted. *See 65 Fed. Reg. at 76,757.* "[T]he Supreme Court has instructed that **'an administrative practice has particular weight when it involves a contemporaneous construction of a statute by the [persons] charged with the responsibility of setting its machinery in motion, of making the parts work efficiently and smoothly while they are yet untried** and new.'" *Daewoo Elecs. Co. v. Int'l Union of Elec., Elec., Technical, Salaried & Machine Workers, AFL-CIO, 6 F.3d 1511, 1522 (Fed. Cir. 1993)* (quoting *Zenith Radio Corp. v. United States, 437 U.S. 443, 450, 98 S. Ct. 2441, 57 L. Ed. 2d 337 (1978)* (second alteration in the original)). We therefore must give the Patent Office's construction "particular weight" in our analysis. [Emphasis added]

Pursuant to the Office's "contemporaneous construction" of 35 U.S.C. § 314(b), each time a patent owner files a response to an Office action, a requester may file comments only once, and such comments are limited to issues raised by the Office action or by the patent owner's response.

As a further point, had Congress intended to provide the requester with "at least one" opportunity to file comments, and to permit the requester to address "at least" the issues raised by the Office action or by the patent owner's response, the statute or legislative history would have explicitly stated so. The phrase "at least" does not appear in the text of 35 U.S.C. § 314(b) or in the legislative history. Further, the plain meaning of the language of the statute does not compel such a reading, as advocated by the requester.

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response to the Office action, which would trigger a further right to third party comment under 35 U.S.C. § 314(b)(2), and thus create an endless cycle. Similarly, to provide requester with more than one opportunity to file comments is not only contrary to 35 U.S.C. § 314(b)(2), but also contrary to the statutory mandate for special dispatch.

[10] *Cooper Techs. Co. v. Dudas*, 536 F.3d at 1341.

Requester has referred to MPEP 2666.05, entitled "Third Party Comments after Patent Owner Response" to support its argument that the actions of the third party requester are limited by the rules of the Office, and not by the statute. Specifically, requester argues that this section of the MPEP waives the provision of the "may once" file written comments under 37 CFR 1.947 to permit requester to rectify improper comments by filing replacement comments.[11] Requester argues that this waiver in the MPEP would not be possible if the language of the statute (rather than the Office rules) limited the requester to one opportunity to file comments.[12] However, the first **improper comments submission** does not have an entry right and, for this reason, it was never officially "filed." It is the corrected comments, the content of which is strictly limited to (i.e., must not go beyond) that of the original comments, that serves the function of the **one filing** of a comments submission under 37 CFR 1.947.

For all of the reasons given above, the April 18, 2011 decision properly expunged requester VWGoA's December 20, 2010 comments submission. The statute simply does not permit a requester to newly propose rejections of unamended (original) claims over newly cited prior art as part of its comments submission, which is filed pursuant to 37 CFR 1.947.

2. <u>The Provisions of 37 CFR 1.947 Do Not Conflict With Those of 37 CFR 1.948 That Permit Requester to Newly Cite the Simon et al. and the Empeg references</u>

Requester contends that "the restrictive and limiting language of 37 C.F.R. § 1.947 cannot be used to impose the requirement that the newly cited prior art be applied only to new and amended claims as the Expungement Decision held," since "[t]his interpretation of the rules would conflict with the other provisions of 37 C.F.R. and the M.P.E.P".[13] Specifically, requester argues that the April 18, 2011 decision, which explained that any newly proposed rejections over newly cited prior art may only be applied to claims which have been newly amended, limits the requester to applying prior art that may only be submitted under 37 CFR 1.948(a)(2). The requester further asserts that MPEP 2666.05(II) requires requester to include a discussion of any prior art submitted under 37 CFR 1.948(a)(3), regardless of whether that art also qualifies under 37 CFR 1.948(a)(2).[14]

As an initial matter, in the present petition for reconsideration, requester VWGoA's statements regarding which specific subsections of 37 CFR 1.948(a) apply to the Simon et al. and the Empeg references appear to be inconsistent with those in its December 20, 2010 comments submission. In the present petition, requester VWGoA states that "[a]s VWGoA explained it its December Comments, the new citations to the Simon et al. and the Empeg references in that submission were proper under 37 C.F.R. §§ 1.948(a)(2) and (3), because those references were 'necessary to rebut a response of the patent owner' and 'for the first time became known or available to [VWGoA] after the filing of the request for *inter partes* reexamination proceeding.'"[15] This statement suggests that both references were cited under 37 CFR 1.948(a)(2) and (a)(3).

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[11] *Id.* at page 18.
[12] *Id.* at page 18
[13] *Id.* at page 19.
[14] *Id.* at page 19.
[15] Petition for reconsideration at page 16.

In contrast, in its December 20, 2010 comments paper, requester VWGoA justified its proposed rejections over these newly cited prior art references as follows: With respect to the Simon et al. reference, third party requester VWGoA asserts that the reference, "first became known to VWGoA not earlier than April 27, 2010," the date on which patent owner held a deposition of the first named inventor Simon in connection with the concurrent litigation.[16] With respect to the Empeg reference, VWGoA asserts that it is permissible under 37 CFR 1.948(a)(2) to cite this reference to rebut patent owner's response, that is, to address the new claims presented in patent owner's response.[17] In addition, VWGoA asserts that since the Empeg reference is applied to the new claims that are dependent claims, it is necessary for VWGoA to apply the reference against the respective independent claims as well.[18] In view of requester's VWGoA's December 20, 2010 comments, the Simon et al. reference was submitted under 37 CFR 1.948(a)(3) and the Empeg reference was submitted under 37 CFR 1.948(a)(2).

Regardless of which subsections of 37 CFR 1.948(a) apply to the newly cited Simon et al. and Empeg references, requester's principal argument regarding the provisions of 37 CFR 1.948(a) is that "the limitations imposed by Section 1.947 do not apply to the discussion of new prior art that is properly cited under Section 1.948."[19] Requester argues that the guidance in MPEP 2666.05(II) together with the statement in MPEP 2648 that claims "will be reexamined in view of all **prior art** during the reexamination under 37 CFR 1.937" permits requester to apply the Simon et al. and the Empeg references to unamended (original) claims in a newly proposed rejection, as part of its comments submission submitted under 37 CFR 1.947.[20]

However, there is nothing in MPEP 2666.05(II) that would permit prior art properly cited, i.e., made of record under 37 CFR 1.948(a)(1) and (a)(3) to be applied in a new rejection as to unamended (original) claims.

As to the statement in MPEP 2648 that claims "will be reexamined in view of all **prior art** during the reexamination under 37 CFR 1.937," MPEP 2648 points out that the examiner will reexamine the claims in view of all of the prior art that is properly of record, in accordance with 37 CFR 1.937; accordingly, the examiner will apply any of that art which the examiner believes to have a bearing on patentability. While prior art properly made of record under 37 CFR 1.948(a)(1) and (a)(3) is available to the examiner for consideration, if such art does not have a bearing on patentability, the examiner is clearly not required to apply it. The statement in MPEP 2648 does not support requester's argument that requester is permitted to newly propose art rejections for any unamended claim, simply by virtue of having made that art of record under 37 CFR 1.948(a)(1) and (a)(3). The MPEP would not make such a permissive statement, because the 37 CFR 1.947 provision that requester's comments are limited to issues raised by the patent owner response, or by the Office action, is a statutory requirement (as discussed in detail above) that cannot be waived. Furthermore, the first line of section 2666.05(II) of the MPEP reiterates

[16] See page 32 of the December 20, 2010 VWGoA's written comments.
[17] *Id.*
[18] *Id.*
[19] *Id.* at page 20.
[20] *Id.*

this statutory requirement as follows: "The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response."

In the present petition, the requester appears to be confusing a prior art citation submitted under 37 CFR 1.948 with the requirement for properly setting forth a proposed prior art rejection, as detailed in MPEP 2617. The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) are directed only as to what newly cited prior art the requester may *file* in an *inter partes* reexamination, as part of, for example, a document entitled "information disclosure statement," which is filed with requester's comments under 37 CFR 1.947. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record and considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement." 37 CFR 1.948(a), however, does not authorize the requester to newly propose a *rejection* of unamended (original) claims based on prior art newly submitted under the rule. To newly propose a rejection based on such new prior art, the requester must also show how the newly proposed rejection is necessitated by patent owner's amendment of the claims, i.e., how the presence of a teaching, in each reference cited alone, or, if the reference is cited in a combination, in at least one of the references of the reference combination, corresponds to at least one claim limitation newly added by patent owner's amendment. See 37 CFR 1.947 and MPEP 2666.05.[21]

Finally, the requester argues that the limitations imposed by 37 CFR 1.947 do not apply to the discussion of new prior art that is properly cited under 37 CFR 1.948.[22] 37 CFR 1.948(a)(3) requires that any prior art submitted under this provision must be accompanied by a statement that includes a discussion of the pertinency of each reference to the patentability of at least one claim. However, the provisions of 37 CFR 1.948(a)(3) do not require, nor permit, requester to propose a rejection of the claims based on the newly cited prior art. They only require a discussion of the *pertinence* of the newly cited prior art to the claims.

For all of the reasons given above, the provisions of 37 CFR 1.947 are not deemed to conflict with the provisions of 37 CFR 1.948(a), contrary to requester's arguments.

3. Requester's December 20, 2010 Comments Submission and the May 3, 2011 Replacement Comments Submission Are Improper

[21] It is understood that new art may be added to an existing proposed rejection in order to rebut a point newly made in the Office action or a patent owner response if the point being rebutted is identified in requester comments, but that is not the same as making a new proposed rejection as is the case here. In this regard, MPEP 2666.05(II), reproduced above, explicitly prohibits the use of prior art cited under 37 CFR 1.948(a)(1) to replace the art originally advanced by the requester, where the Office action which the requester is addressing includes a statement that a particular claimed feature is not shown by the prior art originally cited against that claim. The relevant portion of MPEP 2666.05(II) states:

> "However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record."

[22] *Id.* at page 20.

In view of the above discussion, requester VWGoA's argument that it was permitted to propose new rejections over the Simon et al. and Empeg references (that were cited under 37 CFR 1.948(a) and MPEP 2666.05(II)) for unamended claims in its December 2010 comments submission under 37 CFR 1.947[23] is not persuasive. 35 U.S.C. § 314(b)(2) limits the content of requester's comments to "addressing issues raised by the action of the Office or the patent owner's response thereto." Requester is not permitted to propose rejections based on the newly cited prior art submitted under 37 CFR 1.948(a)(2) or (a)(3) for unamended (original) claims since neither the Office action, nor the patent owner's response, raised an issue with regard to these claims.

Thus, the Office properly expunged the original December 20, 2010 comments submission, because it included newly proposed rejections which do not have a right of entry under 35 U.S. C. § 314(b)(2) and 37 CFR 1.947, i.e., the newly proposed rejections of the unamended (original) claims based on the newly cited Simon et al. and Empeg references. As explained in the April 18, 2011 decision, there is no statutory or regulatory authority for entry of newly proposed rejections that are not necessitated by an amendment to the patent claims.[24]

Requester has attached Exhibits 1-3 to the present petition for reconsideration. Exhibit 1 is a copy of the April 18, 2011 Office decision, which granted-in-part requester VWGoA's December 20, 2010 petition under 37 CFR 1.183, and expunged requester VWGoA's December 20, 2010 comments submission. Exhibit 2 is a copy of the original December 20, 2010 comments submission by requester VWGoA. Exhibit 3 is a copy of requester VWGoA's December 20, 2010 petition under 37 CFR 1.183. However, the original comments submission is improper for reasons discussed above, as well as in the April 18, 2011 decision on requester's VWGoA's December 20, 2010 petition. Accordingly, Exhibit 2, which is attached to the present petition, is improper and is being expunged from the record.

Requester has also filed replacement comments concurrently with the present petition for reconsideration. Contrary to requester's assertion,[25] the replacement comments do not comply with the restrictions imposed by the Office's April 18, 2011 decision. In its May 3, 2011 transmittal letter for the replacement comments, requester VWGoA asserts "[s]ince claims 36 to 49 are all dependent claims, the Replacement Comments include claim charts applying the newly-cited prior [art] against the respective independent and intervening claims solely for the purpose of fully supporting the new proposed grounds of rejection applied against the newly-added dependent claims."[26]

The replacement claim charts apply newly cited prior art against the original, independent claims,[27] which is prohibited by 35 U.S.C. § 314(b)(2) and 37 CFR 1.947, as extensively

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[23] *Id.*

[24] See April 18, 2011 decision on VWGoA's December 20, 2010 petition at page 6.

[25] See Footnote 1 on page 2 of the petition for reconsideration.

[26] See page 2 of the May 3, 2011 transmittal letter for the replacement comments.

[27] Claims 1-35 are unamended (original) claims. The replacement charts apply newly cited prior art against some of the unamended (original) claims. See for example, pages 12-26, 42 and 43 of the replacement claim charts where the Empeg reference is applied against original claims 1, 3, 12, 17, 20, 28, 34, and 35, and pages 29-39 of the replacement claim charts where the Simon reference is applied against original claims 1, 17, 20, 28, 34, and 35.

discussed *supra*. In the May 3, 2011 transmittal letter for its replacement comments, requester VWGoA justifies applying the newly cited art to the unamended (original) claims in order to support the rejections of the dependent new claims. This argument is unpersuasive as the requester need only address the limitations of the dependent claims and how the newly cited art is needed to modify the rejections of record for the new dependent claims. The newly cited prior art must address the features of the new dependent claims; however, it is unnecessary and impermissible to apply the newly cited prior art to the unamended (original) claims from which these new claims depend (which unamended (original) claims do not contain the features of the new dependent claims).

Accordingly, the replacement comments submission is an improper paper, and it is being expunged.

Since Exhibit 2, which is attached to the present petition, and the replacement comments submission filed concurrently with the present petition have been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the present merged reexamination proceeding, these papers are being expunged from the record by closing them and by marking them "not public."

B. The April 18, 2011 Decision Properly Granted-in-Part Requester VWGoA's December 20, 2010 Petition to Waive the Requirements of 37 CFR 1.943(b):

The present petition for reconsideration requests that requester VWGoA's December 20, 2010 petition under 37 CFR 1.183 for additional pages be granted in its entirety.[28] Requester VWGoA alleges that "the Office appears to have awarded VWGoA only 42 additional pages for its replacement comments solely on the length of Apple's comments submission."[29] Requester argues that it is unreasonable for the Office to base any decision on its request for additional pages on the unrelated comments filed by Apple.[30] Requester explains that the difference between Apple's request for 42 additional pages and VWGoA's request for 134 additional pages is that VWGoA submitted 80 pages of claim charts to support its new rejections proposed in its December 20, 2010 comments.[31] Requester also argues that the Office also appeared to base its decision on the page limit issue on the incorrect interpretation of the rules which would limit VWGoA to asserting any new prior art against only new and amended claims of the '833 patent.[32]

However, the Office pointed out in the April 18, 2011 decision that a substantial portion of the original claim charts was devoted to applying the newly cited Simon et al. and Empeg references against unamended (original) claims.[33] Since these newly proposed rejections for unamended (original) claims are improper for the reasons discussed in the April 18, 2011 decision and reiterated above, it is reasonable for the Office not to grant the 134 additional pages that are

[28] Petition for reconsideration at page 22.
[29] *Id.* at page 21.
[30] *Id.*
[31] *Id.*
[32] *Id.* at page 20.
[33] See footnote 6 on page 5 of the April 18, 2011 Office decision.

presently requested for the improper purpose of providing an explanation of how the newly cited references are applied to the unamended (original) claims.

Accordingly, requester's VWGoA's request that the December 20, 2010 petition under 37 CFR 1.183 to be granted in its entirety is denied.

For all the reasons given above, the requester VWGoA's petition under 37 CFR 1.181(a)(3) is denied.

CONCLUSION

1. The petition for reconsideration is granted only to the extent that the April 18, 2011 Office decision has been reconsidered, but is **denied as to the underlying relief requested**.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

3. The proceeding is being referred to the CRU for issuance of an Office action in due course addressing patent owner's September 14, 2010 response and requester Apple's December 20, 2010 written comments.

4. Further correspondence with respect to this matter should be addressed as follows:

   By mail: Mail Stop
   Commissioner for Patents
   Post Office Box 1450
   Alexandria, VA 22313-1450

5. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to the undersigned at (571) 272-7710.

/Kenneth M. Schor/

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

9-15-11
Kenpet8/

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.
90/010,346	11/21/2008	5778178	WEBX001RE	2861

23122 7590 04/14/2011

RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michelle E. O'Brien
O'BRIEN JONES, PLLC
8200 Greensboro Dr, Suite 1020A
McLean, VA 22102

Date:
MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010346
PATENT NO. : 5778178
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.: 90/010,346

1. THIS IS A DECISION ON THE PETITION FILED 28 January 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 Notice of Appeal dated on 01 April 2011, which sets a two (2) month period for filing a response thereto, 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 _ _____, 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 other).
      v. ☐ The petition is moot.
      vi. ☒ Other/comment: see attached.

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 Art Unit 3992
[*Signature*]	(Title)

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative is newly appointed representation of patent owner. There is provided no accounting as to the time prior to the change in representation by the patent owner.

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need additional time. The patent owner has not shown what action was taken in the time preceding the request for extension of time and change of power of attorney. This is especially germane given that the patent owner states that they were acting as *pro se*, when in fact the patent owner sought counsel which later withdrew. See papers dated 09 November 2011 and 30 November 2011.

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. This is the second request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in an *ex parte* reexamination proceeding. Yet it is Patent owner who must exercise diligence in preparation for Appeal. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council very late in prosecution, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. The Patent Owner's submission of multiple after final amendments does not guarantee that prosecution will continue indefinitely. The Patent Owner should consider that issues to have been resolved for Appeal in the interview. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration the late stage of prosecution. The petition was submitted after the filing for the Notice of Appeal. At this late stage the issues are now ready for Appeal.

In consideration of the factual accounting provided by patent owner in the petition balanced with the statutory mandate of conducting reexamination proceedings with special dispatch, it is considered that the petition lacks "sufficient cause" to grant any additional time.

The petition for extension of time is hereby dismissed

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CENTRAL REEXAMINATION UNIT

RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

(For Patent Owner)

MICHELLE E. O'BRIEN
O'BRIEN JONES, PLLC
8200 GREENSBORO DR, SUITE 1020A
MCLEAN, VA 22102

(For Third-Party Requester)

In re ARUNACHALAM
Reexamination Proceeding
Control No. 90 / 010,346
Request Deposited: November 21, 2008
For: U.S. Patent No. 5,778,178

: **DECISION ON**
: **PETITION FILED UNDER**
: **37 CFR 1.181 IN**
: **REEXAMINATION**
:

This is a decision on the January 31, 2011 petition entitled "Patent Owner's Petition to Director under 37 CFR 1.181 for request for Withdrawal of the Final Office Action mailed October 4, 2010". The petition is before the Director of the Central Reexamination Unit for consideration. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,778,178 (hereinafter, the '178 patent), issued to Arunachalam on July 7, 1998.

2. On November 21, 2008, a third party deposited a Request for Ex Parte Reexamination of the '178 patent. The reexamination proceeding was assigned Control No. 90/010,346 (hereinafter, the '10346 proceeding).

3. The reexamination order was granted in the '10346 proceeding on January 23, 2009.

4. A final rejection was mailed by the Office on October 4, 2010.
5. The instant petition was received January 31, 2011.

Applicable Statute or Regulation

37 CFR 1.181 states in part:

> § 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;
> .
> .
> .
> (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.

DECISION

The instant petition is untimely as it was not filed within two months of the mailing date of the action or notice from which relief is requested. This two month period is not extendable, and relief was not granted via prior petition under 37 CFR 1.183. Accordingly, the requested relief is not considered or granted.

CONCLUSION

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

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, Mark Reinhart, at (571) 272-1611 or Jessica Harrison at (571) 272-4449.

/Jessica J. Harrison/

Jessica J. Harrison
SPE, AU 3992 Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

Ratner Prestia
P. O. Box 980
Valley Forge, PA 19482

(For Patent Owner)

Michelle E. O'Brien
O'Brien, Jones, PLLC
8200 Greensboro Dr., Suite 1020A
McLean, VA 22102

(For Requester)

In re Arunachalam
Ex Parte Reexamination Proceeding
Control No. 90/010,346
Filed: November 21, 2008
For: U.S. Patent No. 5,778,178

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

This is a decision on the January 31, 2011 patent owner petition entitled "Patent Owner's Petition under 37 C.F.R. 1.183 For Waiver of Time Limit for Filing 37 CFR 1.81 [sic]" (the January 31, 2011 petition under 37 CFR 1.183).

The January 31, 2011 petition under 37 CFR 1.183, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the January 31, 2011 petition under 37 CFR 1.183 has been received.

The January 31, 2011 petition under 37 CFR 1.183 is **dismissed**.

BACKGROUND

- On July 7, 1998, U.S. Patent 5,778,178 (the '178 patent) issued to Arunachalam.
- On November 21, 2008, the third party requester filed a request for *ex parte* reexamination. The reexamination proceeding was assigned control no. 90/010,346 (the '10346 proceeding).
- On January 23, 2009, the Office mailed an order granting reexamination.
- Prosecution progressed until October 4, 2010, when the Office mailed a final Office action.
- On November 1, 2010, the patent owner filed a request for a six-week extension of time.
- On November 12, 2010, the Office mailed a decision granting-in-part patent owner's November 1, 2010 request, and giving the patent owner a one-month extension of time.

- On January 4, 2011, the patent owner timely filed a 211-page amendment and response after final Office action.

- On January 26, 2011, the patent owner filed a supplemental response after final Office action.

- On January 31, 2011, the patent owner filed a petition entitled "Patent Owner's Petition to Director under 37 CFR 1.181 for Request for Withdrawal of the Final Office Action Mailed October 4, 2010".

- Also on January 31, 2011, the patent owner filed the present petition, entitled "Patent Owner's Petition under 37 C.F.R. 1.183 For Waiver of Time Limit for Filing 37 CFR 1.81 [sic]" (the January 31, 2011 petition under 37 CFR 1.183).

- On February 22, 2011, the patent owner fled a second supplemental response after final Office action.

- On April 1, 2011, the patent owner filed a notice of appeal.

- On April 13, 2011, the patent owner filed a second request for an extension of time, in order to file an appeal brief.

- On April 14, 2011, the Office mailed a decision dismissing patent owner's April 13, 2011 second request for an extension of time.

DECISION

The patent owner's petition under 37 CFR 1.183 requests waiver of the provisions of 37 CFR 1.181(f) to permit the entry of a concurrently-filed petition under 37 CFR 1.181. 37 CFR 1.181(f) provides, in pertinent 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.

The patent owner, in its January 31, 2011 petition under 37 CFR 1.181, requests relief from the final Office action mailed on October 4, 2010. Thus, the concurrently-filed petition was filed more than two months from the mail date of the action from which relief is requested, and is untimely pursuant to 37 CFR 1.181(f). To obtain a waiver of the rule pursuant to 37 CFR 1.183, the patent owner must show an extraordinary situation such that justice requires such a waiver.

To show extraordinary circumstances as required by 37 CFR 1.183, the patent owner argues that the present petition could not be timely filed because of the time taken to retain new counsel, including interviewing law firms, engaging the services of new counsel, and then terminating the services of the new counsel. The patent owner further argues that due to her termination of the

services of the new counsel, the patent owner was required to prepare, *pro se*, for interviews with the Office, which were scheduled for her by her former attorney, for several reexamination proceedings in which the patent owner is a party. This preparation, as argued by the patent owner, included the drafting of new claims. The patent owner argues that for this reason, "[t]here was very limited time between November 30, 2010, the day on which the Patentee assumed the work *pro se* and December 4, when the 2-month period for filing the 37 CFR 1.181 would be over, to be able to file the 37 CFR 1.181 regarding the Examiner's FINAL OFFICE ACTION mailed October 4, 2010 being premature, incomplete and improper."

The amount of time needed to prepare a response, and the considerations undertaken to retain new counsel in preparing a response is understood. However, these are the same considerations that any patent owner in any reexamination proceeding encounters. Furthermore, it was the patent owner who chose to retain new counsel very late in the reexamination proceeding, and then chose to terminate the services of that counsel and prosecute the present proceeding *pro se*. While the patent owner has a right to do so, the patent owner must also take responsibility for choosing to do so one week prior to the last day for timely filing any paper, including a petition under 37 CFR 1.181 to withdraw a final Office action. Furthermore, the patent owner chose the original and the new (now former) counsel, and must take the responsibility for making those choices, even if the patent owner now believes that their performance was unsatisfactory. See *Huston v. Ladner*, 973 F.2d 1564, 23 USPQ2d 1910 (Fed. Cir. 1992), in which the Federal Circuit held that it was not an abuse of discretion for the Office to hold that the *alleged* negligence of applicant's counsel was not good cause to justify submitting additional evidence.

> 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. . .
>
> If we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.
>
> *Id* at F.2d 1566-67.

The patent owner further argues that, after the two-month time period for filing a petition under 37 CFR 1.181 to withdraw the final Office action had passed, the patent owner was occupied with reviewing the file and preparing a response to the final Office action, which, given the one-month extension of time, was due on January 4, 2011, and that time was also needed to file a supplemental response after final Office action in this proceeding. In addition, the patent owner argues that she was preparing a petition as well as interview summaries which were filed in other reexamination proceedings in which the patent owner is a party.

Again, while the time needed to prepare responses to Office actions is understood, the fact that such time was needed does not present an extraordinary situation. These are the same considerations that any patent owner in any reexamination proceeding encounters. In this instance, the concurrently-filed petition under 37 CFR 1.181, could have been prepared and filed

concurrently with patent owner's response to the final Office action, particularly where, as here, the patent owner argues that the response to the final Office action "distinctly and specifically pointed out the supposed errors in the examiner's action".[1] Stated another way, patent owner could have concurrently filed a petition under 37 CFR 1.181 to withdraw the final Office action, as premature together with her response to the final Office action, since both the petition under 37 CFR 1.181 and the response to the final Office action would necessarily include similar arguments regarding the supposed errors in the examiner's action.

Finally, the patent owner argues that it would be unjust and unfair to prevent the patent owner from "fil[ing] new claims or 37 CFR 1.132 declarations in addition to the originally granted claims 1-16, in accordance with 35 U.S.C. 314(a) [sic] to exercise her right to present these additional, narrower claims" and that the patent owner "has diligently made *bona fide* attempts to place the claims in condition for allowance and to advance the reexamination proceeding toward confirming the allowance of all of the claims 1-143".[2]

The Office, however, is specifically required by statute to conduct reexamination proceedings with special dispatch. See 35 U.S.C. 305. For this reason, the Office cannot permit the prosecution of a reexamination proceeding to continue indefinitely. The periods for response for the patent owner in the present proceeding are standard periods for response for all reexamination proceedings, set by Office regulations. It was the patent owner's choice, and not a requirement of the Office, to file numerous additional claims, to conduct multiple interviews (either by phone or in person), and to file a response after final rejection, in which the remarks section is 187 pages in length, all of which contributed to the time constraints experienced by the patent owner.

In summary, the patent owner has simply not shown extraordinary circumstances, such that justice requires waiver of 37 CFR 1.181(f).

Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

---

[1] See page 6 of the present petition.

[2] New claims 17-143 were added by the patent owner in the October 20, 2009 response to the August 20, 2009 non-final Office action. These new claims were entered and treated on the merits in the October 4, 2010 final Office action.

CONCLUSION

- The January 31, 2011 patent owner petition under 37 CFR 1.183 is **dismissed**.
- Any inquiry concerning this communication should be directed to the Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

05/10/2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,346	11/21/2008	5778178	WEBX001RE	2861

23122 7590 09/27/2011
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CABRERA, ZOILA E

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
09/27/2011	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.

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In re Application of	:	
Lakshmi ARUNACHALAM	:	
Control No. 90/010,346 (U.S. Patent 5,778,178)	:	DECISION ON PETITION
Filed: November 21, 2008	:	TO WITHDRAW
Attorney Docket No. WEBX-100REX	:	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 August 8, 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. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Stepehn J. Weed on behalf of all attorneys of record who are associated with Customer No. 23122. All attorneys/agents associated with the Customer No. 23122 have been withdrawn.

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

The request to change the correspondence of record is acceptable as the requested correspondence address is that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Eric Keasel
Supervisory Patent Examiner
CRU 3992

cc: LAKSHMI ARUNACHALAM
222 STANFORD AVENUE
MENLO PARK, CA 94025

cc: MICHELLE E. O'BRIEN (Third Party Requester)
O'BRIEN JONES PLLC
8200 GREENSBORO DRIVE
SUITE 1020A
MCLEAN, VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

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

26111 7590 09/07/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

William H. Wright
Orrick, Herrington & Sutcliffe, LLP
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,365. T95/001,189

PATENT NO. 7287119.

ART UNIT 3992.

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

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

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. :(For Patent Owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP : (For Requester)
ATTN: WILLIAM H. WRIGHT
IP PROSECUTION DEPARTMENT
4 PARK PLAZA, SUITE 1600
IRVINE, CA 92614

In re Barth *et al.* : DECISION DISMISSING
Reexamination Proceeding : PETITION FOR
Control No. 90/010,365 : EXTENSTION OF TIME
Request Deposited: December 18, 2008 : [37 CFR 1.550(c)]
For: U.S. Patent No. 7,287,119 :

This is a decision on the August 27, 2010, "PETITION AND REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R §1.550(c)" requesting that the time to submit a Patent Owner response be extended "for a one-month extension of time to reply to the final Office action which issued on August 9, 2010".

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

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

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

3. The reexamination order was granted in the '10365 proceeding on February 20, 2009.

4. The '119 patent is subject to litigation in the United States 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 1-23 against the requester in litigation.

5. A first office action on the merits was issued on April 29, 2009 setting a two month period for response.

6. Patent owner requested a two month extension of time on June 5, 2009 to respond to the first office action. A one month extension was granted on June 11, 2009.

7. An interview was held on July 22, 2009 followed by a response from owner on July 29, 2009 and a supplemental response from owner filed August 23, 2009.

8. An *inter partes* request for reexamination of the '119 patent was filed and granted in the order mailed August 3, 2009. The *inter partes* proceeding is denominated 95/001,189 ('1189). On October 2, 2009, the Office, *sua sponte*, issued a decision merging the ' 1189 *inter partes* reexamination proceeding with the '10365 *ex parte* reexamination proceeding (the merged proceeding).

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

10. On November 14, 2009, the Office issued a first Office action on the merits in the merged proceeding, setting a two month period for response.

11. Patent owner requested a two month extension of time on December 7, 2009 to respond to the merged office action on the merits. A one month extension was granted on December 11, 2009.

12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 21, 2009 petition requesting reconsideration of the October 2, 2009 decision to merge the ' 1189 *inter partes* and ' 10365 *ex parte* reexamination proceedings.

13. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

14. On February 16, 2010, patent owner timely filed responsive comments to the November 14, 2009 Office action, to include an amendment to some of the claims.

15. On March 17, 2010, third party requester timely filed responsive comments.

16. On June 23, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

17. On June 28, 2010 the Office granted owners requested relief and dissolved the merger of the '1189 *inter partes* proceeding and the '10365 *ex parte* proceeding.

18. On August 9, 2010 the Office issued a final rejection in the '10365 proceeding. The office action set a one month period for response.

19. On August 27, 2010 owner filed the instant petition requesting a one month extension of time in the '10365 proceeding in order to file a response and conduct an interview with the examiner.

DECISION

The Patent Owner requests an extension of time in which to file a Patent Owner response. The request for extension is the second *ex parte* request for an extension of time. The present petition for extension of time was timely filed on August 27, 2010, together with the petition fee 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. 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 of the request for extension is submitted, an (B) why, in spite of the actions taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period...

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

Analysis and Findings

In the petition patent owner's representative requests a one-month extension of time to (i) perfect the patent owner's declaration under 37 CFR 1.131, (ii) request and conduct an after –final interview, (iii) because patent owner believes these two actions will resolve the issues of the case and (iv) because patent owner has three other responses to office actions in other related cases due on the same day which may benefit from the resolution of the issues in the instant case. In further support of the request for additional time, patent owner's representative submits 1) that the final office action notes an number (three) of alleged deficiencies with the Rule 131 declaration which the patent owner wishes to fully address and resolve, 2) that allowing this modest extension of time will not impact the statutory requirement for special dispatch and 3) as 37 CFR 11.18 requires reasonable inquiry into any allegations or factual contentions made in any paper filed with the Office the patent owner needs additional time to investigate the factual details or to seek additional Rule 132 declaratory evidence, 4) that patent owner intends to seek an after Final interview to ensure a complete response will be filed and 5) additional responses in related proceedings will benefit from the interview.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative has conducted various 'reviews' as outlined on page 7 of the petition.

With respect to point 1), review of the file history reveals that the alleged deficiencies in the Rule 131 declaration were first noticed to patent owner in the merged office action of November 14, 2009. It also appears that the response filed February 16, 2010 overcame the alleged deficiencies as outlined in the Action Closing Prosecution of the merged proceeding mailed June 23, 2010. As the petition decision dissolving the merged proceeding mailed June 28, 2010 noted, the actions issued and responses submitted by the parties during the merged proceeding were vacated by the decision. Further, the final Office action of August 9, 2010 noted the evidence must be resubmitted to be considered in the *ex parte* proceeding post dissolution of merger. It would seem patent owner has been fairly noticed of what steps need to be taken in order to resolve the outstanding issues regarding the sufficiency of the Rule 131 showing.

As to point 2), prosecution of the instant reexamination proceeding has been pending close to 21 months which is above average pendency time. Even a modest extension of one month at this point in the proceeding, absent sufficient cause, would impact the mandate for special dispatch.

Petitioners point 3) is not well taken in as much as it appears the record reflects little need for additional inquiry or declaratory evidence given the prior submitted evidence need only be resubmitted as noted by the Examiner in the final Office action.

Regarding the desire to have an interview with the examiner as expressed in 4), the instant proceeding was unmerged in late June. Patent owner has had ample opportunity to request an

interview from that date to the present. No such request has been received and no extenuating circumstance such as the unavailability of the examiner has been asserted. Further, nothing prevents patent owner from filing a timely response to the outstanding final Office action and requesting an interview therewith or shortly thereafter as any unsuccessful submission after final rejection would necessarily result in an automatic one month extension of time (MPEP 2272) so that patent owner would be afforded sufficient time to consider options. This logic extends as a counter to petitioner's point 5).

On balance, it does not appear patent owners reasoning as to why additional time is needed, in light of the review actions taken thus far outweigh the need for special dispatch given the prolonged prosecution in the instant proceeding. Sufficient cause has not been shown. Therefore, the request fails to meet the requirements as outlined in MPEP 2265 for granting of a request for extension of time under 37 CFR 1.550(c).

CONCLUSION

1. Petitioner's request is **dismissed**. The period during which Patent Owner may file a response to the final rejection remains running one month from the date of the outstanding Office action.

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, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272- 4449.

/J. Harrison/

Jessica Harrison
Supervisory Primary Examiner
AU 3992 Central Reexamination Unit

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

26111 7590 01/06/2011

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

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

26111 7590 01/06/2011

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

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DATE MAILED: 01/06/2011

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

Date: MAILED
JAN 0 6 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001189
PATENT NO. : 7287119
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ORRICK, HERRINGTON, & SUTCLIFFE, LLP
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

Date:

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JAN 0 6 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010365
PATENT NO. : 7287119
ART UNIT : 3992

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

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

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)
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JAN 06 2011
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ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)
Attn: William H. Wright
IP Prosecution Department
4 Park Plaza, Suite 1600
Irvine, CA 92614

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

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

DECISION ON PETITION

This is a decision on third party requester's July 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 July 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 June 28, 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 October 23, 2007, the Office issued U.S. Patent No. 7,287,119 (the '119 patent) to Barth *et al.*

2. The '119 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-23 against the requester in the litigation.

3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

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

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

6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10365 *ex parte* reexamination proceeding expired on April 20, 2009.[2]

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

8. On May 18, 2009, a request for *inter partes* reexamination of all the claims (claims 1-23) of the '119 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,189 (the '1189 proceeding).[3]

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

10. On July 29, 2009, patent owner filed a response in the '10365 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.[4]

11. On August 3, 2009, the Office issued an order granting the '1189 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '119 patent, claims 1-23, would be subject to reexamination.

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

13. On October 2, 2009, the Office, *sua sponte,* issued a decision merging the '1189 *inter*

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[1] The request cited and used a single reference to Gillingham as a basis for requesting reexamination on two claims, the Gillingham reference claimed benefit to U.S. provisional applications to Gillingham, Ryan et al. and Gustavson et al. under 35 U.S.C. 119(e). Requester cited these U.S. provisional applications in the request.

[2] 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 request).

[3] The *inter partes* reexamination request used the same Gillingham reference as in the '10365 proceeding, but in a more expansive manner against more of the claims in the '119 patent as a basis for requesting reexamination.

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

partes reexamination proceeding with the '10365 *ex parte* reexamination proceeding (the merged proceeding).

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

15. On November 14, 2009, the Office issued a first Office action on the merits in the merged proceeding.

16. On December 16, 2009 the Office issued a decision dismissing patent owner's October 21, 2009 petition requesting reconsideration of the October 2, 2009 decision to merge the '1189 *inter partes* and '10365 *ex parte* reexamination proceedings.

17. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

18. On February 16, 2010, patent owner timely filed a response to the November 14, 2009 Office action, including amendments to the claims.[5]

19. On March 17, 2010, third party requester timely filed comments after the patent owner response.

20. On June 23, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

21. On June 28, 2010, the Office issued a decision dissolving the merger of the '1189 and the '10365 proceedings.

22. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.

23. On August 9, 2010, the Office issued a non-final Office Action in the '1189 proceeding.

24. Also on August 9, 2010, the Office issued a final Office Action in the '10365 proceeding.

25. On September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '1189 proceeding.

---

[5] Patent Owner petitioned for a two month extension of time and was granted a one month extension of time to respond to the November 14, 2009 Office action. The due date of February 14, 2010 was a Sunday and February 15, 2010 was a federal holiday, giving patent owner until February 16, 2010 to file a response. See 37 CFR 1.7(a).

26. Also on September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '10365 proceeding.

27. On October 8, 2010, third party requester timely filed its comments in the '1189 proceeding.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 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 June 28, 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 21, 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 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 February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 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 February 5, 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 June 28, 2010, the Office issued a decision granting patent owner's February 5, 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 June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment[6] and argues that the June 28, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

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[6] Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

In response:

The June 28, 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.[7] The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '119 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 July 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.[8]

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '119 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '119 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

[7] Id.
[8] See MPEP 2686.01 IV.

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),[9] 37 CFR 1.989(a),[10] MPEP 2686.01 I,[11] MPEP 2686.01 IV,[12] MPEP 2283,[13] and MPEP 2286.[14] 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 (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 June 28, 2010 Office decision is not a violation of Requester's Rights

The requester asserts that the June 28, 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

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[9] "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).

[10] "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).

[11] "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.'"

[12] "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."

[13] "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.'"

[14] "[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.'"

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 June 28, 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.[15]

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 June 28, 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 June 28, 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 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.[16] In the present instance, as noted in

[15] 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.
[16] See MPEP 2686.01 IV.

the June 28, 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 June 28, 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 June 28, 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 June 28, 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 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 June 28, 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.[17] 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 June 28, 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.[18] 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 June 28, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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

1/5/11

[17] See the June 22, 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.
[18] See Petition at page 9, section E.

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CENTRAL REEXAMINATION UNIT

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(for Third Party Requester)

In re Bloomer
Reexamination Proceeding
Control No.: 90/010,381
Filed: January 23, 2009
For: U.S. Patent 6,080,330

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In re Bloomer
Reexamination Proceeding
Control No.: 90/011,454
Filed: January 21, 2011
For: U.S. Patent 6,080,330

DECISION MERGING
REEXAMINATION
PROCEEDINGS

The above noted reexamination files are before the Supervisor of Art Unit 3991 of the Central Reexamination Unit for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,080,330, issued June 27, 2000, is the subject of Reexamination Control Nos. 90/010,381 and 90/011,454.

2. A first request for reexamination, assigned Reexamination Control No. 90/010,381, was filed January 23, 2009. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed composition and processes or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/010,381 on March 18, 2009.

4. A first non-final office action on the merits was issued on September 18, 2009.

5. The Office action of September 18, 2009 was re-issued on October 21, 2009 to clarify the response period.

6. Patent Owner filed a response on December 21, 2009 that included amendments and additional claims 11-37.

7. A non-final Office action was issued on October 6, 2009.

8. Patent Owner filed a response on December 12, 2010.

9. A subsequent request for re-examination, assigned Reexamination Control No. 90,011,454, was filed January 2,1 2011. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed either disclose the claimed composition and processes or are so close as to establish a case of obviousness..

10. Reexamination was ordered for 90,011,454 on March 11, 2011.

11. No Office action has been issued in the later reexamination.

DISCUSSION

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* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under para 1.570.

As noted in the above review of facts, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.5659 (c) is appropriate. MPEP 2283 further sets forth:

> If the second request is based upon essentially the *same* patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as those raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the question raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/010,381 and 90/011,454 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations."

III. CONDUCT OF MERGED PROCEEDING

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 of 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 duplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the patent owner's representative address listed in Reexamination Control Nos. 90/010,381 and 90/011,454 as:

KING & SCHICKLI, PLLC
247 North Broadway
Lexington, KY 40507

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/010,381 as:

CHRISTENSEN, O'CONNER, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control No. 90/011,454 as:

CHRISTENSEN, O'CONNER, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

CONCLUSION

Reexamination Control Nos. 90/010,381 and 90/011,454 are merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping amendment" placing the same claims in both files and to name but a single representative.** Upon receipt of the response, as Office action will issue in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at telephone No. (571) 272-1535.

Deborah Jones

Deborah Jones,
SPE, Art Unit 3991
Central Reexamination Unit

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In re Bloomer
Reexamination Proceeding
Control No.: 90/010,381
Filed: January 23, 2009
For: U.S. Patent 6,080,330

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In re Bloomer
Reexamination Proceeding
Control No.: 90/011,454
Filed: January 21, 2011
For: U.S. Patent 6,080,330

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(for Third Party Requester)

In re Bloomer
Reexamination Proceeding
Control No.: 90/011,713
Filed: May 26, 2011
For: U.S. Patent 6,080,330

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of the proceedings under 37 C.F.R. 1.565(c).

BACKGROUND

1. United States Patent 6,080,330, issued June 27, 2000, is the subject of Reexamination Control Nos. 90/010,381, 90/011,454 and 90/011,713.

2. A first request for reexamination, assigned Reexamination Control No. 90/010,381, was filed January 23, 2009. The request urged that a substantial new question of patentability was raised by the newly cited references that either disclose the claimed composition and processes or are so close as to establish a case of obviousness.

3. Reexamination was ordered for 90/010,381 on March 18, 2009.

4. A first non-final office action on the merits was issued on September 18, 2009. 5. The Office action of September 18, 2009 was re-issued on October 21, 2009 to clarify the response period.

6. Patent Owner filed a response on December 21, 2009 that included amendments and ad.ditional claims 11-37.

7. A non-final Office action was issued on October 6, 2009.

8. Patent Owner filed a response on December 12, 2010.

9. A second request for re-examination, assigned Reexamination Control No. 90,011,454, was filed January 21, 2011. The request urged that a substantial new question of patentability was raised by the newly cited references that either discloses the claimed composition and processes or are so close as to establish a case of obviousness.

10. Reexamination was ordered for 90/011,454 on March 1, 2011.

11. Patent Owner filed a housekeeping amendment on May 2, 2011.

12. No Office action has been issued in the 90/11,454 reexamination proceeding.

13. A third request for re-examination, assigned Reexamination Control No. 90,011,713, was filed May 26, 2011. The third request urged that a substantial new question of patentability was raised by the newly cited references that either discloses the claimed composition and processes or are so close as to establish a case of obviousness.

14. Reexamination was ordered for 90/011,713 on August 3, 2011.

15. No Office action has been issued in the 90/11,713 reexamination proceeding.

DISCUSSION

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* proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under paragraph 1.570.

As noted in the above REVIEW OF SALIENT FACTS, reexamination has been ordered in each of the above reexamination proceedings. Accordingly, merger of the proceedings under 37 C.F.R. 1.565(c) is appropriate. MPEP 2283 further sets forth:

If the second request is based upon essentially the same patents or publications as in the first request or on patents or printed publications which raise essentially the same issues as raised in the first request, and if reexamination is ordered, the examination of the merged proceeding will continue at the point reached in the first reexamination proceeding. If, however, *new* patents or printed publications are presented in the second request which raise different questions than those raised in the first request, then prosecution in the merged reexamination proceeding will be reopened, if applicable, to the extent necessary to fully treat the question raised.

DECISION

I. MERGER OF PROCEEDINGS

In accordance with 37 C.F.R. 1.565(c), the 90/010,381, 90/011,454 and 90/011,713 proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding: **Accordingly, Patent Owner is hereby required to submit a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in both files.** The paper should be strictly limited to the bare presentation of the amendments. Any discussion of the merits or issues of the proceedings would be improper under 37 CFR 1.540 and would result in the return of the paper as an improper submission. See MPEP 2283, "Merger of Reexaminations".

III. CONDUCT OF MERGED PROCEEDING

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 will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the Patent Owner must consist of a single response, **filed in triplicate**, each bearing a signature and identifying data for **all** files, for entry into each file.

All correspondence from the USPTO will be addressed to the Patent Owner's representative address listed in Reexamination Control Nos. 90/010,381, 90/011,454 and 90/011,713 as:

KING & SCHICKLI, PLLC
247 North Broadway
Lexington, KY 40507

A copy of all correspondence from the USPTO will be served on the Third Party Requester at the address listed in Reexamination Control Nos. 90/010,381, 90/011,454 and 90/011,713 as:

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

CONCLUSION

Reexamination Control Nos. 90/010,381, 90/011,454 and 90/011,713 are merged. **As stated above, Patent Owner has one month from the mailing date of this decision within which to submit a "housekeeping**

amendment" placing the same claims in all files and to name but a single representative. Upon receipt of the response, as Office action will issue in due course.

Any inquiry concerning this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at telephone No. (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.
90/010,389	01/21/2009	RE36847	03871.00100	9925

22242 7590 10/04/2010

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/04/2010

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Application of RE36847 ET AL.
Appl. No.: 90/010,389
Filed: January 21, 2009
For: Automated Self-Cleaning Litter Box for Cats

RESPONSE TO PETITION UNDER 37 CFR 1.59

MAILED

OCT 04 2010

CENTRAL REEXAMINATION UNIT

This is a response to the renewed petition under 37 CFR 1.59(b), filed August 17, 2010, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until shortly or after the mailing a Notice of Intent to Issue *Ex Parte* Reexamination Certificate, at which time the petition will be decided.

Petitioner requests that documents entitled:

"Rebuttal Experts Report (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit A", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit B", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit C", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Motion for Summary Determination on the Anticipation Defense (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Response to Respondent Motion for Summary Determination on Obviousness Claims 27, 33, 41, 42 – Appendix A Claim Construction (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Prehearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Applica Post Hearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Waters Post Hearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);

"Complainant Applica Post Hearing Reply Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainant Waters Post Hearing Response Brief (Excerpted and Redacted)". In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainant Applica's Response to Both Petitions for Review (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Commission Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Commission Response Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC); and
"Direct Witness Statement of Michael A. Waters (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC),

filed July 26, 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 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.

Andres Kashnikow, SPE
Central Reexamination Unit 3993
(571) 272-4361

cc: Steven E. Warner
Fitzpatrick, Cella, Harper, & Scinto
1290 Avenue of the Americas
New York, NY 10104-3800

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,389	01/21/2009	RE36847	03871.00100	9925

EXAMINER

ART UNIT	PAPER NUMBER

22242 7590 01/31/2011
FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

DATE MAILED: 01/31/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Application of RE36847 ET AL.
Appl. No.: 90/010,389
Filed: January 21, 2009
For: Automated Self-Cleaning Litter Box for Cats

DECISION ON PETITION UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed August 17, 2010, to expunge information from the above identified reexamination proceeding.

As the proceeding is in condition for the Issuance of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC), renewed consideration of the aforementioned petition is in order. The petition is granted.

Petitioner requests that documents entitled:

"Rebuttal Experts Report (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit A", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit B", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Rebuttal Expert Report – Exhibit C", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Motion for Summary Determination on the Anticipation Defense (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Response to Respondent Motion for Summary Determination on Obviousness Claims 27, 33, 41, 42 – Appendix A Claim Construction (Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Prehearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Applica Post Hearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Waters Post Hearing Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);

"Complainant Applica Post Hearing Reply Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainant Waters Post Hearing Response Brief (Excerpted and Redacted)". In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainant Applica's Response to Both Petitions for Review (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Commission Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC);
"Complainants Commission Response Brief (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC); and
"Direct Witness Statement of Michael A. Waters (Excerpted and Redacted)", In re Certain Self-Cleaning Litter Boxes and Components Thereof, Inv. No. 337-TA-625 (ITC),

filed June 1, 2010, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant reexamination proceeding.

Patent Owner is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been removed from the official file.

Andres Kashnikow

Andres Kashnikow, SPE
Central Reexamination Unit 3993
(571) 272-4361

Cc: Steven E. Warner
Fitzpatrick, Cella, Harper, & Scinto
1290 Avenue of the Americas
New York, NY 10104-3800

Enclosure: Above-identified documents

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Fish & Richardson P.C. (For Patent Owner)
P.O. Box 1022
Minneapolis, MN 55440-1022

MAILED

AUG 25 2010

CENTRAL REEXAMINATION UNIT

Gene S. Winter (For Requester)
St. Onge Steward Johnston & Reens, LLC
986 Bedford Street
Stamford, CT 06905-5619

In re Steven E. Robbins	:	
Ex Parte Reexamination Proceeding	:	**DECISION GRANTING**
Control No. 90/010,402	:	**PETITION UNDER**
Filed: February 25, 2009	:	**37 CFR 1.137(b)**
For: U.S. Patent No. 6,343,426	:	

This is a decision on the July 30, 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 July 30, 2010 petition to revive").[1]

The July 30, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 30, 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 June 17, 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 June 17, 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 July 30, 2010, which was untimely. However, for the purpose of evaluating whether the July 30, 2010 petition to revive is a grantable petition, the July 30, 2010 Interview Summary satisfies item (1).

The appropriate petition fee of $810.00 set forth in 37 CFR 1.17(m) for the July 30, 2010 petition to revive has been paid, which satisfies item (2).

Regarding item (3), the statement provided in the July 30, 2010 petition to revive ("the entire period of 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 July 30, 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 July 30, 2010 petition to revive.

Accordingly, the July 30, 2010 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

CONCLUSION

1. The July 30, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Jurisdiction over this reexamination proceeding is being returned to Art Unit 3993 for processing of the July 30, 2010 Interview Summary.

3. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Glenn Dawson, of Art Unit 3993, at (571) 272-4694.

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

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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AUG 13 2010

CENTRAL REEXAMINATION UNIT

Charles W. Shifley
BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago IL 60606

(Patent Owner)

Rod S. Berman, Esq.
JEFFER, MANGELS, BULTER
& MARMARO, LLP
1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067

(Third Party Requester)

In re Richard L. Weiner
Reexamination Proceeding
Control No.: 90/010,415
Filed: March 6, 2009
For: U.S. Patent No.: 6,505,075

DECISION ON PETITION UNDER 37 CFR 1.182

This is a decision on the May 28, 2010 patent owner petition under 37 CFR 1.182, requesting the Office to enter and consider an information disclosure statement (IDS) after the termination of the prosecution in the above captioned 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 May 28, 2010, has not been entered for consideration by the examiner.

BACKGROUND

1. On January 7, 2003, the Office issued U. S. patent number 6,505,075 (the '075 patent).
2. On February 17, 2009, a request for *ex parte* reexamination of the '075 patent was deposited by a third party requester and assigned reexamination control no. 90/010,415 (the '10,415 proceeding). On March 6, 2009, a corrected request was subsequently filed, for which the '10,415 proceeding received a filing date.
3. On April 8, 2009, the Office ordered reexamination of the '075 patent in the '10,415 reexamination proceeding.
4. On May 12, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) in the '10,415 reexamination proceeding.
5. On May 14, 2010, the '10,415 proceeding entered the printing cycle, for printing of a reexamination certificate.

6. On May 28, 2010, patent owner filed the instant petition, accompanied with an information disclosure statement (IDS) with a six page list of citations, requesting entry and consideration of the post NIRC IDS submission.
7. On July 27, 2010, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (7641st), US 6,505,075 C1.

DECISION

The present reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7641st), US 6,505,075 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '075 patent. Therefore, the submission of information for consideration by the examiner is not authorized by statute. Accordingly, the petition is **dismissed.**

ADDITIONAL DISCUSSION

A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on May 12, 2010, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (7641st), thereby divesting the Office of jurisdiction over the '075 patent. However, even had the petition been addressed prior to issuance of the certificate, the May 28, 2010 IDS would not have had an entry right. While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 37 CFR 1.313 provides such a mechanism for an application. Accordingly, the requirements of 37 CFR 1.313 for withdrawal of an application from the printing cycle (after the issue fee has been paid) have historically been applied, in an analogous manner, to requests for withdrawal of reexamination proceedings from the printing cycle. Note that, for *ex parte* reexamination, 35 U.S.C. 305 mandates that all *ex parte* reexamination proceedings "will be conducted with special dispatch within the Office." Given that 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.*

The conditions for entry of an IDS after NIRC are explicitly set forth in MPEP 2256 as follows:

> ... The printing cycle for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the printing cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its printing cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its printing cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition to** the above-discussed (see item (A) above) 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 printing 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)

Patent owner has attempted to provide a showing to satisfy the requirement for entry of an IDS after NIRC, but before the proceeding has entered the print cycle. Specifically, patent owner filed the IDS and the petition requesting consideration on May 28, 2010, after issuance of a NIRC and after the proceeding had already entered the printing cycle for issuance of a reexamination certificate on May 14, 2010. Therefore, even had the petition been addressed

prior to issuance of the certificate, the petition did not provide a sufficient showing for entry of an IDS after a reexamination proceeding has entered the print cycle.

Patent owner has not provided a statement as to why the submitted information (multiple non-patent literature references and papers from a related continuation application) makes at least one claim unpatentable. The petition merely states that the examiner may find the information relevant, which statement falls far below the standard of unpatentability. Moreover, patent owner does not provide an amendment along with an explanation as to how the amendment renders the claims patentable in light of the submitted prior art as applicable to the confirmed claims in the '10,415 reexamination proceeding. Therefore, the present petition does not satisfy the conditions for consideration of an IDS after the proceeding had entered the print cycle, and would not have been granted in contravention of the statutory mandate for special dispatch. Accordingly, patent owner's request with regard to the May 28, 2010 IDS is dismissed.

If, however, the patent owner or any other party in fact believes that the references submitted raise a substantial question of patentability as to at least one claim of the patent *different* than raised in the present proceeding, any member of the public can always file a new request for reexamination for consideration of such reference(s).

Although the IDS submitted by patent owner is not being entered of record in the reexamination proceeding, it will remain in the file. However, because the proceeding has concluded by issuance of the *Ex Parte* Reexamination Certificate, the IDS will not, and cannot, be considered.

CONCLUSION

1. The petition is **dismissed** as to the request for consideration of the IDS filed on May 28, 2010.

2. The IDS papers have not been entered for consideration by the examiner. A copy of the IDS submission will, however, be placed in the electronic file for the proceeding.

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

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

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.
90/010,417	02/23/2009	6212556	WEBX002RE	1434

7590 12/01/2010

WEBXCHANGE, INC.
222 STANFORD AVENUE
MENLO PARK, CA 94025

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 Patent and Trademark Office
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JOHN TEMPLE KELLER
HULSEY IP LAWYERS, PC.
919 CONGRESS AVENUE,
SUITE 919
AUSTIN, TX 78701

In re Application of	:	
LAKSHMI ARUNACHALAM	:	
Control No. 90/010,417 (U.S. 6,212,556)	:	DECISION ON PETITION
Filed: February 23, 2009	:	TO WITHDRAW
Attorney Docket No. WEBX002RE	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 10.40(b)(4), filed November 30, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by John. T. Keller on behalf of all attorneys of record. Applicant is reminded that there is no attorney of record at this time. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Manuel Saldana at 571-272-7740.

Manuel Saldana for

Jessica Harrison
Supervisory Patent Examiner
CRU 3992

cc: JOHN D. VANDENBERG (Third Party Requester)
ONE WORLD TRADE CENTER
121 S.W. SALMON STREET, SUITE 1600
PORTLAND, OR, 97204

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 30, 2010. There is no indication it was served on 3rd Party Requester.

Doc Code: PET.AUTO **Document Description: Petition automatically granted by EFS-Web**	PTO/SB/83 U.S. Patent and Trademark Office Department of Commerce

Electronic Petition Request	**REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS**
Application Number	90010417
Filing Date	23-Feb-2009
First Named Inventor	6212556
Art Unit	3992
Examiner Name	ZOILA CABRERA
Attorney Docket Number	WEBX-101REX
Title	CONFIGURABLE VALUE-ADDED NETWORK (VAN) SWITCHING

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 23122

The reason(s) for this request are those described in 37 CFR:

10.40(c)(1)(iv)

Certifications

☒ 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

☒ 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

☒ I/We have notified the client of any responses that may be due and the time frame within which the client must respond

Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:

Name	Lakshmi Arunachalam
Address	222 Stanford Avenue
City	Menlo Park
State	CA
Postal Code	94025
Country	US

I am authorized to sign on behalf of myself and all withdrawing practitioners.	
Signature	/Stephen J. Weed/
Name	Stephen J. Weed
Registration Number	45202

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

Decision Date : July 1,2011

In re Application of :

6212556

Application No : 90010417

Filed : 23-Feb-2009

Attorney Docket No : WEBX-101REX

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY/AGENTOF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed July 1,2011

The request is **APPROVED.**

The request was signed by Stephen J. Weed (registration no. 45202) on behalf of all attorneys/agents associated with Customer Number 23122 . All attorneys/agents associated with Cusotmer Number 23122 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name	Lakshmi Arunachalam
Name2	
Address 1	222 Stanford Avenue
Address 2	
City	Menlo Park
State	CA
Postal Code	94025
Country	US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

MAILED
JAN 25 2011
CENTRAL REEXAMINATION UNIT

In re Stephen R. Haddock et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,432
Filed: March 3, 2009
For: U.S. Patent No. 6,678,248

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the November 10, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the November 10, 2010 petition to revive").

The November 10, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 10, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,678,248 issued November 2, 2010, for the present proceeding, and the July 9, 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 1.137 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 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.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the November 10, 2010 petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the April 6, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The April 6, 2010 Office action set a two-month period for response. A response to the April 6, 2010 Office action was not filed until November 8, 2010, which was untimely. However, for the purpose of evaluating whether the November 10, 2010 petition to revive is a grantable petition, the submission of the November 8, 2010 response satisfies item (1).[1]

Accordingly, the November 10, 2010 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,678,248 issued for the present proceeding on November 2, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on July 9, 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 6,678,248 to Stephen R. Haddock et al. of Los Gatos, CA (US) for POLICY BASED QUALITY OF SERVICE, appearing in the *Official Gazette* of November 2, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The November 10, 2010 petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the July 9, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued November 2, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 6,678,248 patent consistent with this decision.

---

[1] This decision is not directed to the persuasiveness and propriety of the information presented in the November 8, 2010 response as to each of the rejections set forth in the April 6, 2010 Office action; such is the examiner's province.

5. Art Unit 3992 of the Central Reexamination Unit will process the November 8, 2010 response to Office action in the 90/010,432 reexamination proceeding, after which the examiner will proceed to take appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Scott Weaver, of Art Unit 3992, at (571) 272-7548.

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

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

01/19/11
Kenwd+vacate

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,433	03/03/2009	6859438	E2003-701650	7619

8791 7590 01/24/2011

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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
LANDO & ANASTASI, LLP
ONE MAIN STREET
SUITE 1100
CAMBRIDGE, MA 02142

Date: MAILED

JAN 24 2011

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010433
PATENT NO. : 6859438
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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Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

MAILED

JAN 24 2011

CENTRAL REEXAMINATION UNIT

In re Stephen R. Haddock et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,433
Filed: March 3, 2009
For: U.S. Patent No. 6,859,438

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the November 8, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the November 8, 2010 petition to revive").

The November 8, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 8, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,859,438 issued November 2, 2010, for the present proceeding, and the July 9, 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 1.137 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 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.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the November 8, 2010 petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the April 6, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The April 6, 2010 Office action set a two-month period for response. A response to the April 6, 2010 Office action was not filed until November 8, 2010, which was untimely. However, for the purpose of evaluating whether the November 8, 2010 petition to revive is a grantable petition, the submission of the November 8, 2010 response satisfies item (1).[1]

Accordingly, the November 8, 2010 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,859,438 issued for the present proceeding on November 2, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on July 9, 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 6,859,438 to Stephen R. Haddock et al. of Los Gatos, CA (US) for POLICY BASED QUALITY OF SERVICE, appearing in the *Official Gazette* of November 2, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The November 8, 2010 petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the July 9, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued November 2, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 6,678,248 patent consistent with this decision.

---

[1] This decision is not directed to the persuasiveness and propriety of the information presented in the November 8, 2010 response as to each of the rejections set forth in the April 6, 2010 Office action; such is the examiner's province.

5. Art Unit 3992 of the Central Reexamination Unit will process the November 8, 2010 response to Office action in the 90/010,433 reexamination proceeding, after which the examiner will proceed to take appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Scott Weaver, of Art Unit 3992, at (571) 272-7548.

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

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

01/19/11
Kenwd+vacate

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,434	03/03/2009	6104700	E2003-701750	7873

7590 01/24/2011

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BLVD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LANDO & ANASTASI LLP
ONE MAIN STREET
SUITE 1100
CAMBRIDGE, MA 02142

Date: MAILED

JAN 24 [illegible]

CENTRAL REEXAM[illegible]NIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010434
PATENT NO. : 6104700
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

LANDO & ANASTASI LLP
ONE MAIN STREET
SUITE 1100
CAMBRIDGE, MA 02142

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010434
PATENT NO. : 6104700
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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12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

MAILED

JAN 24 2011

CENTRAL REEXAMINATION UNIT

In re Stephen R. Haddock et al.
Ex Parte Reexamination Proceeding
Control No. 90/010,434
Filed: March 3, 2009
For: U.S. Patent No. 6,104,700

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the November 10, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination ("the November 10, 2010 petition to revive").

The November 10, 2010 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 10, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,104,700 issued October 5, 2010, for the present proceeding, and the July 9, 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:

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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 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.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the November 10, 2010 petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a proper response to the April 6, 2010 Office action pursuant to 37 CFR 1.550(b). 37 CFR 1.550(b) provides that the patent owner will be given at least thirty days to file a proper response to any Office action. The April 6, 2010 Office action set a two-month period for response. A response to the April 6, 2010 Office action was not filed until November 10, 2010, which was untimely. However, for the purpose of evaluating whether the November 10, 2010 petition to revive is a grantable petition, the submission of the November 10, 2010 response satisfies item (1).[1]

Accordingly, the November 10, 2010 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,104,700 issued for the present proceeding on October 5, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on July 9, 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 6,104,700 to Stephen R. Haddock et. al. of Los Gatos, CA (US) for POLICY BASED QUALITY OF SERVICE, appearing in the *Official Gazette* of October 5, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The November 10, 2010 petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the July 9, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued October 5, 2010, is **vacated**.

4. The Office of Patent Publications will take action with respect to the 6,104,700 patent consistent with this decision.

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[1] This decision is not directed to the persuasiveness and propriety of the information presented in the November 10, 2010 response as to each of the rejections set forth in the April 6, 2010 Office action; such is the examiner's province.

5. Art Unit 3992 of the Central Reexamination Unit will process the November 10, 2010 response to Office action in the 90/010,434 reexamination proceeding, after which the examiner will proceed to take appropriate action.

6. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Scott Weaver, of Art Unit 3992, at (571) 272-7548.

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

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

01/19/11
Kenwd+vacate

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,465	04/24/2009	6200569	76642-8004.US00	2045

22918 7590 04/19/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Avery N. Goldstein

GIFFORD, KRASS et al.

P.O. BOX 7021

Troy, MI 48007-7021

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,465*.

PATENT NO. *6200569*.

ART UNIT *3991*.

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

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

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PERKINS COIE LLP
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(For Patent Owner)

Avery N. Goldstein
GIFFORD, KRASS et al.
P.O. BOX 7021
TROY, MI 48007-7021

(For Requester)

In re Cheng	:	
Reexamination Proceeding	:	**DECISION ON PETITIONS**
Control No.: 90/010,465	:	**UNDER 37 CFR 1.181**
Filed: April 24, 2009	:	
For: U.S. Patent No.: 6,200,569	:	

This is a decision on the petitions filed by the patent owner on November 30, 2010 and March 17, 2011. Both petitions are entitled "PETITION UNDER 37 CFR 1.181 TO REQUEST RE-OPENING PROSECUTION" [hereinafter "the petitions"], and are requests to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and to designate the grounds of rejection as new grounds of rejection in the Examiner's Answer, mailed November 4, 2010 and the supplemental Examiner's Answer, mailed January 21, 2011 and reopen prosecution.

The petitions are before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

The petitions under 37 CFR 1.181 to invoke the supervisory authority of the Director dated November 30, 2010 and March 17, 2011 are denied with respect to designating the grounds of rejection as new grounds of rejection and reopening prosecution.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,200,569 (hereinafter, the '569 patent) issued on March 13, 2001.

2. A request for *ex parte* reexamination, assigned control No. 90/010,465 (hereinafter, the '465 proceeding), was filed by a third party requester on April 24, 2009.

3. *Ex parte* reexamination was ordered for the '465 proceeding on June 5, 2009. The order determined that the Kimura reference raised a SNQ (see pages 4-6 of the order).

4. The patent owner did not filed comments on the order.

5. On August 13, 2009, a non-final Office action, which rejected claims 1-12, was mailed in the '465 reexamination proceeding. The action included rejections based upon Kimura.

6. On October 13, 2009, the patent owner filed a response, including amendments to claims 1 and 10-12 and proposed new claims 13-20. No arguments were made that the claims were limited to treatment of "humans" or that Kimura was non-enabled.

7. On October 29, 2009, a final Office action, which maintained the same rejections for claims 1-12 and added new rejections for proposed new claims 13-20.

8. On December 10, 2009, a personal interview was conducted.

9. On December 29, 2009, patent owner filed a response and a proposed amendment to further amend claims 1, 11, and 12, cancel claims 3, 4, 7, and 8, and add new claims 13-26. On December 30, 2009, patent owner submitted a replacement response that contained the proper amendment format. This response included a half-page argument that Kimura was not enabled. See page 13 of the response.

10. On January 21, 2010, the Office mailed an advisory action that stated that the December 2009 amendment is not entered. The advisory action stated that the arguments presented are not commensurate with the scope of the claims because the proposed amendment was not entered.

11. On January 26, 2010, patent owner filed another after-final response and a proposed amendment to further amend claims 1, 11, and 12, cancel claims 3, 4, 7, and 8, and add new claims 13-24. The response did not include arguments but only referred to the non-entered December 29, 2009 response.

12. On February 19, 2010, the Office issued an advisory action that stated the January 26, 2010 amendment will be entered for purposes of appeal. The advisory action also explained how the rejections will be applied to the amended and new claims. Specifically, the advisory action stated that given the teachings of Kimura, it would have been obvious to try cinnamon extract alone as a treatment for hyperglycemia and there would have been a reasonable expectation of success.

13. On March 10, 2010, a personal interview was conducted. No specific arguments were made that the claims were limited to treatment of "humans" or that Kimura was non-enabled. See the interview summaries of March 10, 2010 and March 17, 2010.

14. On March 29, 2010, a Notice of Appeal was filed.

15. On April 7, 2010, patent owner filed another response. No specific arguments were made that the claims were limited to treatment of "humans" or that Kimura was non-enabled.

16. On April 16, 2010, a third advisory action was mailed. The action stated that the request for reconsideration was considered but did not place the proceeding in condition for allowance.

17. On June 29, 2010, after a one-month extension of time, an appeal brief was filed.

18. On July 30, 2010, a replacement appeal brief was filed in response to a notice of noncompliance regarding the June 29, 2010 brief.

19. On November 4, 2010, the Office mailed an Examiner's Answer.

20. On November 30, 2010, the patent owner filed the first instant petition.

21. On January 4, 2011, the patent owner filed a reply brief to the Examiner's Answer.

22. On January 21, 2011, the Office mailed a supplemental Examiner's Answer.

23. Om March 17, 2011, the patent owner filed the second instant petition and another response including proposed amendments.

24. On March 21, 2011, the patent owner filed a reply brief to the supplemental Examiner's Answer.

DECISION

The patent owner (petitioner) states that the examiner made, in effect, new grounds of rejection in the Examiner's Answer and the supplemental Examiner's Answer. In the November 30, 2010 petition, the petitioner explains that the Examiner's Answer contains "new" responses to patent owner's arguments that the Kiruma reference is not enabled. See pages 2-3 of the November 30, 2010 petition. In the March 17, 2011 petition, the petitioner explains that the supplemental Examiner's Answer contains "new" response to patent owner's arguments that the claims are limited to treatments in "human" patients. See pages 2-3 of the March 17, 2011 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 because of the alleged "new" responses in the Examiner's Answer and supplemental 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. The record does not support patent owner's statement that the examiner had an opportunity to respond to the non-enablement arguments and elected not do to so. See the relevant facts section above. Patent owner did not present any non-enablement arguments until the after-final response of December 29, 2009, which was not entered into the record. The non-enablement argument consisted of the following text:

> "4. Kimura is not enabling for the claimed method.
> For a reference to be applicable as prior art, the disclosure of the reference must enable one skilled in the art to produce the claimed invention without undue experimentation. Kimura is not

> an enabling reference against the instant claims for the following reasons.
> The only data that Kimura showed on cinnamon water extract alone are Tables III-VI. The results of Tables III-VI of Kimura are in vitro assays of lipolysis and lipogenesis, not human data.
> There is no mentioning in Kimura as to the use of cinnamon water extract for decreasing the blood glucose level in a human. There is no teaching in Kimura as to the dosage for treating hyperglycemia in a human. There is no data in Kimura to show how the cinnamon water extract alone could decrease blood glucose level in a human. Therefore, Kimura is not enabled for a method for treating hyperglycemia in a human."

See page 13 of the December 29 or 30, 2009 response. The argument only consisted of a few brief statements regarding the teachings of Kimura, which were substantially similar to the previous arguments regarding Kimura, and then a conclusion that Kimura is not enabled for a method of treating hyperglycemia in a human. No evidence or detailed analysis, such as applying the Wands factors, was included.

In the advisory action of January 21, 2010, the examiner explained that while the request for reconsideration was considered, the arguments were not commensurate with the scope of the claims. In other words, the non-enablement argument was based upon the proposed amendment to claim 1 (e.g., the "essentially consisting of" limitation) that was not entered into the record. Therefore, it was not ripe for the examiner to address the non-enablement argument at that time.

The patent owner filed another after-final response on January 26, 2010. This response included similar proposed amendments but did not include any explicit arguments. Instead, the paper referred to the arguments in the non-entered December 2009 paper. The following advisory action of February 19, 2010 stated that the claim amendments would be entered for appeal purposes and explained how the rejections would be applied if and when the appeal occurred, in accordance with MPEP 2272 and 714.13. This advisory action was responsive to the brief non-enablement argument because it explained that in light of the teachings of Kimura, it would have been obvious to try cinnamon extract alone as a treatment for hyperglycemia. In other words, the advisory action clearly stated that the rejection is based on obviousness and was not based on the fact that Kimura explicitly taught treating hyperglycemia by using cinnamon extract alone. This position is consistent with the examiner's response under A.5. on page 16 in the November 4, 2010 Examiner's Answer. Specifically, the examiner stated:

> "A.5. Appellant argues that Kimura is not enabling for the claimed methods. This argument is not persuasive because the rejection is not for anticipation, but for obviousness. "While a reference must enable someone to practice the invention in order to anticipate under §102(b), a non-enabling reference may qualify as prior art for the purpose of determining obviousness under §103." See *Symbol Technologies Inc. v. Opticon Inc.*, 19 USPQ2d 1241, 1247."

It is true that the examiner did not use the same format in the advisory action as in the Examiner's Answer, which was done to correspond to the format of patent owner's appeal brief.

However, a change in the format of the response, or the addition of a citation to case law, is not deemed a new ground of rejection. Furthermore, the citation to case law was not in the explanation of the rejection, but instead in the response to arguments. In addition, the case law citation is straight from MPEP 2121.01. For these reasons, petitioner's allegation that the above-quoted explanation provided on page 16 of the Examiner's Answer amounts to a new ground of rejection is not persuasive.

Similarly, the record does not support patent owner's statement that the examiner had changed his claim interpretation in the supplemental Examiner's Answer. See the relevant facts section above. Patent owner did not present any arguments concerning the method of treating hyperglycemia being for a human until the after-final response of December 29, 2009, which was not entered into the record. See page 2 of the March 17, 2011 petition. These arguments were directed to lack of teaching *in the prior art*, and not towards the scope of the claims. In other words, all of the examples listed on page 2 of the March 17, 2011 petition are pertaining to arguments as to what Kimura failed to teach. None of these examples are explicitly arguing that the claimed invention is limited to treatment of "human" patients. Furthermore, a review of the record shows that the examiner consistently interpreted the claim scope to include more than humans. See, e.g., pages 4-6 of the order, pages 3-5 of the August 13, 2009 Office action, and pages 3-7 of the final rejection. For example, the examiner recognized that the teachings of Kimura are directed to results of testing in rats. When applying Kimura to the claims, the examiner did not explain how it would be obvious to apply Kimura's teachings to humans instead of rats. This is clear evidence that the examiner deemed the scope of the claims to encompass more than just "human" patients throughout the proceeding.

Patent owner asserts the following two sentences on page 4 of the supplemental examiner's answer should be deemed a new ground of rejection:

> "Appellant fails to consider the prior art as a whole, ignoring the fact that Cinnamomum is an ingredient in a medicine known to be clinically effective. Appellant also fails to consider the full scope of the claims, which are not limited to type 2 diabetes or to humans."

First, it is noted that the sentences are located in the response to arguments section and not in the grounds of rejection. Second, these two sentences are entirely consistent with the examiner's position throughout the prosecution. See the examples above. In fact, when read in their context, these two sentences are directly tied to the examiner's position that one skilled in the art would have been led to try cinnamon extracts to treat hyperglycemia upon reading Kimura and would have had a reasonable expectation of success (see the full response to the arguments spanning pages 4-5 of the supplemental Examiner's Answer). Therefore, petitioner's allegation that the above-quoted sentences provided on page 4 of the supplemental Examiner's Answer amounts to a new ground of rejection is not persuasive.

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."

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the Examiner's Answer and the supplemental Examiner's Answer did not introduce new grounds of rejection. 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 designate certain rejections as new grounds of rejection.

Accordingly, good and sufficient reasons to designate certain rejections as new grounds of rejection in the Examiner's Answer and the supplemental Examiner's Answer in the reexamination proceeding have not been provided and the patent owner's petition is denied.

CONCLUSION

1. The petitions under 37 CFR 1.181 for consideration of designating certain rejections as new grounds of rejection in the Examiner's Answer are denied.

2. This proceedings will be forwarded to the examiner for consideration of whether the response, filed March 17, 2011, and the reply brief, filed March 21, 2011, should be entered or not entered. If appropriate, the 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 Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

Irem Yücel, Director
Technology Center 1600

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For Patent Owner

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OCT 18 2010

CENTRAL REEXAMINATION UNIT

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
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For 3rd Party Requester
(both Requests)

Ex Parte Reexamination Proceeding
Control No. 90/010,467
Filed: April 22, 2009
For: U.S. Patent No. 6,352,559

Ex Parte Reexamination Proceeding
Control No. 90/010,997
Filed: May 17, 2010
For: U.S. Patent No. 6,352,559

DECISION MERGING REEXAMINATION PROCEEDINGS

The above noted reexamination proceedings are before the Supervisory Patent Examiner of Central Reexamination Art Unit 3993 for consideration of merger of the above-identified proceedings.

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. 90/010,467 was ordered in a decision mailed November 25, 2009. It is noted that the request for this reexamination asked for reexamination of claims 1-9, 11-25, 27-41, 43-57, and 59-64 of US Patent No. 6,352,559. On February 22, 2010, a non-final Office action was mailed rejecting all of the claims for which reexamination was requested. Following an interview held March 23, 2010, patent

owner filed a response on April 22, 2010 along with an Information Disclosure Statement. No changes to the specification, claims and/or drawings were made by this response. No Office action has been rendered since the receipt of the April 22, 2010 patent owner response.

Reexamination in application Control No. 90/010,997 was ordered in a decision mailed July 22, 2010, indicating that claims 1-9, 11-25, 27-41, 43-57, and 59-64, the only claims for which reexamination was requested, would be reexamined. Patent owner did not file a Patent Owner Statement as permitted by 37 CFR 1.530. No Office action has been rendered since the mailing of the decision ordering reexamination.

As evidenced by the above facts, reexamination Control No. 90/010,467 and reexamination control No. 90/010,997 are currently pending. Since the order to reexamine has been mailed in both reexamination proceedings, 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

The patent owner is required to maintain identical claims, drawings, and specification in both files. In view of the fact that both proceedings are identical at this point, no amendment is necessary at this time.

Conduct of Proceedings

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Claims 1-9, 11-25, 27-41, 43-57, and 59-64, all of claims for which reexamination has been requested, 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. 90/010,467 and 90/010,997 are hereby merged into a single proceeding. Upon the mailing of this decision, all files will be forwarded to the examiner in the Central Reexamination Unit for issuance of an Office action on the merits.

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

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(Patent Owner)

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OFFICE OF PETITIONS

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

(Courtesy Copy)

JONES DAY
Attention: Anthony M. Insogna
222 East 41st Street
New York, NY 10017-6702

(Requestor)

In re Banerjee et al.
Reexamination Proceeding
90/010,488
Filed: May 11, 2009
For: U. S. Patent No. 6,667,344
Issued: June 22, 2001
Title: Bronchodilating Compositions, and Methods

DECISION ON PETITION

This is a decision on the July 10 and 13, 2009 petitions by the Patent Owner seeking to strike and/or vacate the filing date of the May 11, 2009 for the request for reexamination and to disqualify the Jones Day law firm from reexaminations involving U.S. Patent Nos. 6,667,344 ("the '344 patent") and 6,814,953 ("the '953 patent"). The petition is based on an alleged conflict of interest under §§ 10.57, 10.62 and 10.66 and provisions of the Office's Code of Professional Responsibility by a certain practitioner, who is now employed by the Jones Day law firm that is participating in the reexamination proceeding for the '344 patent and the '953 patent. The petition is treated as a petition under 37 CFR 1.182, and is now before the Office of Patent Legal Administration for decision.

The petition is dismissed.

I. Background

1. An *ex parte* request for reexamination of patent number 6,667,344 was first deposited on April 7, 2009:

a. The party requesting reexamination is practitioner Shahrokh Falati at Heslin Rothenberg Farley & Mesiti P.C. in Albany, New York. The patent owner is Dey, L.P. (Dey).

b. Copending litigation exists and is styled *Dey, LP et al. v. Sepracor, Inc.*, 1:07 CV 2353, USDC SDNY.[1]

2. On April 10, 2009, the Office mailed a "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements (37 CFR 1.510(c))." The notice stated that the request failed to comply with filing date requirements due to failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents & printed publications to every claim for which reexamination is requested.

3. On May 11, 2009 a replacement request for reexamination was filed:

a. The replacement request is a 151 page document and supporting documents, which asserts substantial new questions of patentability and identifies 15 proposed rejections based cited references applied under 35 U.S.C. §§ 102 and 103 for claims 1-24, 27-41, 48, 61, 62, 65, and 68-74 of the '344 patent.

4. Also, on May 11, 2009, a "Revocation and Power of Attorney" paper was filed which revoked all previous powers of attorney and appointed power of attorney to Anthony M Insogna and Hoon Choi and set the correspondence address to the Jones Day law firm for the third party requester, Sepracor, Inc.

5. On May 28, 2009, a Notice of Reexamination Request Filing date was mailed. The Notice stated that the request for reexamination received a filing date of May 11, 2009.

6. An order granting reexamination of claims 1-24, 27-41, 48, 61, 62, 65, and 68-74 of the '344 patent was mailed on July 8, 2009. The examiner found that the cited references raised substantial new questions of patentability.

7. The instant petition requesting the Office to strike and/or vacate the filing date of the instant reexamination request and vacate the order granting reexamination was filed on July 10 and 13, 2009:

a. The petition is supported by a Declaration by Imtiaz Chaudry, a Senior Vice President, Scientific Affairs of Dey, a Declaration by Robert Colletti, partner in the law

[1] See page 2 of the transmittal form of the Request for Reexamination.

firm of Frommer Lawrence & Haug LLP, who represents Dey in litigation, and other supporting documents.

b. The petition is based on the fact that practitioner Dale L. Reiger, who works for Jones Day law firm, had been privy to confidential information supplied by the patent owner in regard to the '344 patent, and therefore, Jones Day should not now be allowed to request reexamination of the '344 patent and the '953 patent.

8. Status of the reexamination request:

a. A first Office action was mailed on June 8, 2010.

b. Patent owner's response has been filed.

c. No Office action has been mailed in response to patent owner's response.

II. Petitions to Strike and/or Vacate the Filing Date of the Reexamination Request

The petition seeks to have the Office strike the instant reexamination proceedings, vacate the orders granting reexamination, and disqualify both the Jones Day law firm and Sepracor, Inc. in the instant and any future reexamination proceedings for the '344 and '953 patents based on the following facts supplied in the petitions:

a. The reexamination request was filed by Jones Day law firm. Dale L. Rieger is employed by Jones Day.

b. Previously, practitioner Dale L. Rieger worked for Dey in filing patent applications, including the applications that issued as the '344 patent and the '953 patent.

c. As part of the above-mentioned litigation, Sepracor filed an inequitable conduct claim again Dey based on alleged fraud on the PTO during the course of Rieger's work for Dey.

d. As part of discovery in the litigation, Rieger met with Dey's counsel. Rieger was accompanied by Steven Geise, who is a partner at Jones Day. Dey's counsel states that they were not informed that Jones Day was representing anyone adverse to Dey on the same or substantially same matters for which Rieger worked on for Dey.

e. Jones Day, representing Sepracor, filed a replacement request for reexamination on May 11, 2009 and is appointed power of attorney for the third party requester.

f. Dey's counsel has written to Jones Day to object to their participation in the reexamination proceedings due to possible conflict of interest.

Petitioner argues that having been privy to confidential and secret information concerning Dey, it is improper for practitioner Dale Rieger, who is employed by Jones Day, to turn

against the owner of the patents that issued from applications, which Dale Rieger filed. Reference is made to § 10.57, § 10.62 and § 10.66 identifying a practitioner's obligation to preserve the confidences and secrets of a client and to not assist in attacking one's own prior work product or the work product of a current partner of Jones Day. Petitioner asserts that Rieger's conflict of interest is imputed to all lawyers who work at Jones Day. In summary, petitioner argues that Jones Day has multiple conflict of interests, and therefore, should be disqualified from the reexamination proceedings of the '344 patent and the '953 patent. See, e.g., pages 11-17 of the July 10, 2009 petition.

III. Standard for Disqualification of Opposing Counsel

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[2] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[3]

37 CFR 10.56 provides that a "practitioner should preserve the confidences and secrets of a client." 37 CFR 10.61 states that a "practitioner should exercise independent professional judgment on behalf of a client." More particularly, § 10.66(a) provides that proffered employment shall be declined "if it would be likely to involve the practitioner in representing different interests ...." 37 CFR 10.110 provides that a "practitioner should avoid even the appearance of impropriety."

The Office has utilized the following standard in regard to representations of patent matters:[4]

An attorney should be disqualified if a party can show that the:

(1) attorney was its former attorney,
(2) attorney now represents an adverse party, and
(3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The assumption will be made where the standard is met that confidences were disclosed and an inquiry will not be made into their nature and extent.[5] The Office has chosen a narrow interpretation of the expression "substantially related" to mean 'identical or essentially the same."[6]

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[2] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." Petitions to disqualify a practitioner in *ex parte* or *inter partes* proceedings in the Office are not governed by Parts 10 and 11 and will be handled on a case-by-case basis under such conditions as the Director deems appropriate. The MPEP does not generally address Parts 10 and 11 of the rules of practice.

[3] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.

[4] *SCM v. Aktieselskabet Niro Atomizer*, 212 USPQ 93 (Comm'r of Patents, December 16, 1980 and January 8, 19871).

[5] *Anderson v Eppstein.*

[6] *Id.*

IV. Decision on Petitions Under 37 CFR 1.182

37 CFR 1.182 provides relief for situations not specifically provided for in the regulations of Part 1 and is an appropriate basis for raising the issue of conflict of interest.

The patent owner's § 1.182 petition to strike the reexamination proceedings is improper.

The gravamen of the § 1.182 petition is the alleged access of the practitioner filing the reexamination request to confidential information relating to the patent for which he requests reexamination. It is noted that there is not one instance where petitioner has identified the actual use of confidential information to support the request for reexamination, or any instance of Rieger's involvement with the reexamination requests filed May 11, 2009. Moreover, exhibit F of the petition includes an assertion by Jones Day that Mr. Rieger, in advance of his arrival at Jones Day, was screened from any matters adverse to Dey or any Sepracor matters related to patents involving formoterol or its isomers that Mr. Rieger prosecuted while at his prior firms. The reexamination request is entirely based on publicly available U.S. patents and printed publications. It is not stated that Rieger's knowledge of the materiality of these patents and printed publications arose from information obtained from Rieger's access to the patent owner's files.

The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts in a reexamination proceeding. The resulting delay of the substantive reexamination proceeding from any attempt to treat the instant conflict matter 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). For example, to address the conflict issue would require, as a matter of fairness, the opportunity for Jones Day to present its position, a process that would not only extend the reexamination merits but also extend participation by the requestor beyond the bounds permitted by an *ex parte* requestor. On balance, the instant reexamination proceeding is not the forum for resolving this issue. Instead, petitioner should utilize an existing appropriate vehicle for addressing this issue. A request may be filed with the Director of the U.S. Patent & Trademark Office that practitioner Rieger and/or Jones Day be disqualified from the instant reexamination proceedings for future submissions, and with identification of any remedial action to be taken to remedy any inappropriate submissions by Jones Day based on confidential information.[7]

The July 10 and 13, 2009 petitions will be closed in the file record.

V. POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address filed June 8, 2010 is ineffective because the form PTO/SB/81B used to revoke the power of attorney and appoint a new power of attorney and correspondence address was not clearly signed by a party authorized to sign for the patent owner. See the *Sua Sponte* Decision to Vacate the June 9, 2010

[7] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a register practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

Notices, mailed contemporaneously with this decision. **The current power of attorney and correspondence address in this reexamination proceeding remains to be** LUCAS & MERCANTI, LLP, 475 PARK AVENUE SOUTH, 15TH FLOOR, NEW YORK, NY 10016. All future Office correspondence will be mailed to the above-mentioned address. As a one time courtesy, a copy is also being mailed to MCDERMOTT WILL & EMERY LLP at the address listed in the June 8, 2010 communication.

VI. Contact

Telephone inquiries related to this decision (*e.g.*, only strictly procedure inquires from petitioner) should be directed to the undersigned at (571) 272-7735.

Robert A. Clarke

Robert A. Clarke
Deputy Director
Office of Patent Legal Administration
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
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,488	05/11/2009	6667344	086016-0052	1806

20277 7590 07/26/2011

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/26/2011

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
JONES DAY
222-EAST 41st STREET
NEW YORK, NY 10017-6702

Date: MAILED
JUL 26 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010488
PATENT NO. : 6667344
ART UNIT : 3991

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:90/010,488

1. The petitions under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed April 7, 2011, June 6, 2011, and August 9,2010 are 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: Since the documents were filed electronically, they will be closed in the file and will not become part of this record.

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit

Deborah Jones 7/20/2011 — Deborah D. Jones, Supervisory Patent Examiner, CRU - Art Unit 3991

[*Signature*] (Title)

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK, NY 10016

(Patent Owner)

MAILED

JAN 10 2011

OFFICE OF PETITIONS

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

(Courtesy Copy)

JONES DAY
Attention: Anthony M. Insogna
222 East 41st Street
New York, NY 10017-6702

(Requestor)

In re Banerjee et al.
Reexamination Proceeding
90/010,489
Filed: May 15, 2009
For: U. S. Patent No. 6,814,953
Issued: November 9, 2004
Title: Bronchodilating Compositions, and Methods

DECISION ON PETITION

This is a decision on the July 10 and 13, 2009 petitions by the Patent Owner seeking to strike and/or vacate the filing date of the May 15, 2009 for the request for reexamination and to disqualify the Jones Day law firm from reexaminations involving U.S. Patent Nos. 6,667,344 ("the '344 patent") and 6,814,953 ("the '953 patent"). The petition is based on an alleged conflict of interest under §§ 10.57, 10.62 and 10.66 and provisions of the Office's Code of Professional Responsibility by a certain practitioner, who is now employed by the Jones Day law firm that is participating in the reexamination proceeding for the '344 patent and the '953 patent. The petition is treated as a petition under 37 CFR 1.182, and is now before the Office of Patent Legal Administration for decision.

The petition is dismissed.

I. Background

1. An *ex parte* request for reexamination of patent number 6,814,953 was first deposited on April 7, 2009:

a. The party requesting reexamination is practitioner Shahrokh Falati at Heslin Rothenberg Farley & Mesiti P.C. in Albany, New York. The patent owner is Dey, L.P. (Dey).

b. Copending litigation exists and is styled *Dey, LP et al. v. Sepracor, Inc.*, 1:07 CV 2353, USDC SDNY.[1]

2. On April 15, 2009, the Office mailed a "Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements (37 CFR 1.510(c))." The notice stated that the request failed to comply with filing date requirements due to failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents & printed publications to every claim for which reexamination is requested.

3. On May 15, 2009 a replacement request for reexamination was filed:

a. The replacement request is a 357 page document and supporting documents, which asserts substantial new questions of patentability and identifies 16 proposed rejections based cited references applied under 35 U.S.C. §§ 102 and 103 for claims 1-23, 26-40, 57-63, 74-96, 99-113, 120-124, and 130-136 of the '953 patent.

4. Also, on May 15, 2009, a "Revocation and Power of Attorney" paper was filed which revoked all previous powers of attorney and appointed power of attorney to Anthony M Insogna and Hoon Choi and set the correspondence address to the Jones Day law firm for the third party requester, Sepracor, Inc.

5. On June 2, 2009, a Notice of Reexamination Request Filing date was mailed. The Notice stated that the request for reexamination received a filing date of May 15, 2009.

6. An order granting reexamination of claims 1-23, 26-40, 57-63, 74-96, 99-113, 120-124, and 130-136 of the '953 patent was mailed on July 8, 2009. The examiner found that the cited references raised substantial new questions of patentability.

7. The instant petition requesting the Office to strike and/or vacate the filing date of the instant reexamination request and vacate the order granting reexamination was filed on July 10 and 13, 2009:

a. The petition is supported by a Declaration by Imtiaz Chaudry, a Senior Vice President, Scientific Affairs of Dey, a Declaration by Robert Colletti, partner in the law

[1] See page 2 of the transmittal form of the Request for Reexamination.

firm of Frommer Lawrence & Haug LLP, who represents Dey in litigation, and other supporting documents.

b. The petition is based on the fact that practitioner Dale L. Reiger, who works for Jones Day law firm, had been privy to confidential information supplied by the patent owner in regard to the '953 patent, and therefore, Jones Day should not now be allowed to request reexamination of the '344 patent and the '953 patent.

8. Status of the reexamination request:

a. A first Office action was mailed on June 8, 2010.

b. Patent owner's response has been filed.

c. No Office action has been mailed in response to patent owner's response.

II. Petitions to Strike and/or Vacate the Filing Date of the Reexamination Request

The petition seeks to have the Office strike the instant reexamination proceedings, vacate the orders granting reexamination, and disqualify both the Jones Day law firm and Sepracor, Inc. in the instant and any future reexamination proceedings for the '344 and '953 patents based on the following facts supplied in the petitions:

a. The reexamination request was filed by Jones Day law firm. Dale L. Rieger is employed by Jones Day.

b. Previously, practitioner Dale L. Rieger worked for Dey in filing patent applications, including the applications that issued as the '344 patent and the '953 patent.

c. As part of the above-mentioned litigation, Sepracor filed an inequitable conduct claim again Dey based on alleged fraud on the PTO during the course of Rieger's work for Dey.

d. As part of discovery in the litigation, Rieger met with Dey's counsel. Rieger was accompanied by Steven Geise, who is a partner at Jones Day. Dey's counsel states that they were not informed that Jones Day was representing anyone adverse to Dey on the same or substantially same matters for which Rieger worked on for Dey.

e. Jones Day, representing Sepracor, filed a replacement request for reexamination on May 15, 2009 and is appointed power of attorney for the third party requester.

f. Dey's counsel has written to Jones Day to object to their participation in the reexamination proceedings due to possible conflict of interest.

Petitioner argues that having been privy to confidential and secret information concerning Dey, it is improper for practitioner Dale Rieger, who is employed by Jones Day, to turn

against the owner of the patents that issued from applications, which Dale Rieger filed. Reference is made to § 10.57, § 10.62 and § 10.66 identifying a practitioner's obligation to preserve the confidences and secrets of a client and to not assist in attacking one's own prior work product or the work product of a current partner of Jones Day. Petitioner asserts that Rieger's conflict of interest is imputed to all lawyers who work at Jones Day. In summary, petitioner argues that Jones Day has multiple conflict of interests, and therefore, should be disqualified from the reexamination proceedings of the '344 patent and the '953 patent. See, e.g., pages 11-17 of the July 10, 2009 petition.

III. Standard for Disqualification of Opposing Counsel

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[2] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[3]

37 CFR 10.56 provides that a "practitioner should preserve the confidences and secrets of a client." 37 CFR 10.61 states that a "practitioner should exercise independent professional judgment on behalf of a client." More particularly, § 10.66(a) provides that proffered employment shall be declined "if it would be likely to involve the practitioner in representing different interests ...." 37 CFR 10.110 provides that a "practitioner should avoid even the appearance of impropriety."

The Office has utilized the following standard in regard to representations of patent matters:[4]

An attorney should be disqualified if a party can show that the:

(1) attorney was its former attorney,
(2) attorney now represents an adverse party, and
(3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The assumption will be made where the standard is met that confidences were disclosed and an inquiry will not be made into their nature and extent.[5] The Office has chosen a narrow interpretation of the expression "substantially related" to mean 'identical or essentially the same."[6]

---

[2] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." Petitions to disqualify a practitioner in *ex parte* or *inter partes* proceedings in the Office are not governed by Parts 10 and 11 and will be handled on a case-by-case basis under such conditions as the Director deems appropriate. The MPEP does not generally address Parts 10 and 11 of the rules of practice.

[3] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.

[4] *SCM v. Aktieselskabet Niro Atomizer*, 212 USPQ 93 (Comm'r of Patents, December 16, 1980 and January 8, 19871).

[5] *Anderson v Eppstein.*

[6] *Id.*

IV. Decision on Petitions Under 37 CFR 1.182

37 CFR 1.182 provides relief for situations not specifically provided for in the regulations of Part 1 and is an appropriate basis for raising the issue of conflict of interest.

The patent owner's § 1.182 petition to strike the reexamination proceedings is improper.

The gravamen of the § 1.182 petition is the alleged access of the practitioner filing the reexamination request to confidential information relating to the patent for which he requests reexamination. It is noted that there is not one instance where petitioner has identified the actual use of confidential information to support the request for reexamination, or any instance of Rieger's involvement with the reexamination requests filed May 15, 2009. Moreover, exhibit F of the petition includes an assertion by Jones Day that Mr. Rieger, in advance of his arrival at Jones Day, was screened from any matters adverse to Dey or any Sepracor matters related to patents involving formoterol or its isomers that Mr. Rieger prosecuted while at his prior firms. The reexamination request is entirely based on publicly available U.S. patents and printed publications. It is not stated that Rieger's knowledge of the materiality of these patents and printed publications arose from information obtained from Rieger's access to the patent owner's files.

The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts in a reexamination proceeding. The resulting delay of the substantive reexamination proceeding from any attempt to treat the instant conflict matter 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). For example, to address the conflict issue would require, as a matter of fairness, the opportunity for Jones Day to present its position, a process that would not only extend the reexamination merits but also extend participation by the requestor beyond the bounds permitted by an *ex parte* requestor. On balance, the instant reexamination proceeding is not the forum for resolving this issue. Instead, petitioner should utilize an existing appropriate vehicle for addressing this issue. A request may be filed with the Director of the U.S. Patent & Trademark Office that practitioner Rieger and/or Jones Day be disqualified from the instant reexamination proceedings for future submissions, and with identification of any remedial action to be taken to remedy any inappropriate submissions by Jones Day based on confidential information.[7]

The July 10 and 13, 2009 petitions will be closed in the file record.

V. POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address filed June 8, 2010 is ineffective because the form PTO/SB/81B used to revoke the power of attorney and appoint a new power of attorney and correspondence address was not clearly signed by a party authorized to sign for the patent owner. See the *Sua Sponte* Decision to Vacate the June 11, 2010

[7] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a register practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

Notices, mailed contemporaneously with this decision. **The current power of attorney and correspondence address in this reexamination proceeding remains to be** LUCAS & MERCANTI, LLP, 475 PARK AVENUE SOUTH, 15TH FLOOR, NEW YORK, NY 10016. All future Office correspondence will be mailed to the above-mentioned address. As a one time courtesy, a copy is also being mailed to MCDERMOTT WILL & EMERY LLP at the address listed in the June 8, 2010 communication.

VI. Contact

Telephone inquiries related to this decision (*e.g.*, only strictly procedure inquires from petitioner) should be directed to the undersigned at (571) 272-7735.

Robert A. Clarke

Robert A. Clarke
Deputy Director
Office of Patent Legal Administration
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
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,489	05/15/2009	6814953	086016-0051	1171

20277 7590 07/26/2011
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/26/2011

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
JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

Date: MAILED
JUL 26 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010489
PATENT NO. : 6814953
ART UNIT : 3991

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

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

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:90/010,489

1. The petitions under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed April 7, 2011, June 6, 2011, and August 9,2010 are 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: Since the documents were filed electronically, they will be closed in the file and will not become part of this record.

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit

Deborah D. Jones
Supervisory Patent Examiner
CRU - Art Unit 3991

[Signature] 7/20/2011 (Title)

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

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.
90/010,524	05/05/2009	7184922	8195-1	4224

35690 7590 11/09/2010

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2010

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
F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11797

Date:
MAILED

NOV 0 9 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010524
PATENT NO. : 7184922
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

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.
90/011,173	08/23/2010	7184922	8195-2 Reexam	2226

35690 7590 11/09/2010

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2010

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
F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11797

Date:
MAILED

NOV 0 9 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011173
PATENT NO. : 7184922
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

MAILED

NOV 0 9 2010

CENTRAL REEXAMINATION UNIT

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

(For Patent Owner)

F. CHAU & ASSOCIATES, LLC
130 WOODBURY ROAD
WOODBURY, NY 11979

(For Third Party Requester)

In re Ousley *et alia*	:
Reexamination Proceeding	: DECISION *SUA SPONTE*
Control No. 90/010,524	: MERGING
Request Deposited: May 5, 2009	: REEXAMINATION
For: U.S. Patent No. 7,184,922	: PROCEEDINGS
In re Ousley *et alia*	:
Reexamination Proceeding	:
Control No. 90/011,173	:
Request Deposited: August 23, 2010	:
For: U.S. Patent No. 7,184,922	:

The above identified *ex parte* reexamination files are before the Director of the Central Reexam Unit for consideration of merger of proceedings under 37 CFR 1.565(c).

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,184,922 (hereinafter, the '922 patent), issued to Ousley *et alia*, on February 27, 2007.

2. On May 5, 2009, a third party deposited a Request for *Ex Parte* Reexamination of the '922 patent. The reexamination proceeding was assigned Control No. 90/010,524 (hereinafter, the '524 proceeding).

3. On August 23, 2010, a third party deposited a Request for *Ex Parte* Reexamination of the '922 patent. The reexamination proceeding was assigned Control No. 90/011,173 (hereinafter, the '173 proceeding).

4. The Reexamination Order was granted for claims 1-33 in the '524 proceeding on December 19, 2007. Prosecution has resulted in amendments to the claims including the addition of new claims.

5. The Reexamination Order was granted for claims 1-33 in the '173 proceeding recently.

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.

In accordance with 37 C.F.R. § 1.565(c), the '8910 and the '10609 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.

As noted above, numerous original claims have been amended in the '524 reexamination proceedings. It appears that original claims 8, 10, 11 and 24 were amended and claims 34 – 69 were added with the paper of March 17, 2010. It further appears claims 1, 16, and 17 were amended and claims 70-76 were added with the amendment of April 9, 2010. Additionally it appears claims 4,5,16, 17 and 19 were cancelled, claims 1, 3, 6, 9-12, 18, 20, and 24 were amended and claims 77 – 83 were added with the after final amendment submitted October 19, 2010 and entered by the examiner recently. And it is noted Patent owner has waived the owner's statement in the '173 proceeding indicating a desire to receive the first office action with the order determination. Patent owner is required to maintain the same claims and specification in all merged files. Patent owner is required to submit an appropriate "housekeeping" amendment within **15 days** of this decision placing the same amendment(s) in all files. The paper should be

strictly limited to the bare presentation of the amendment(s). Any discussion of the merits or issues of the proceeding would be improper under 37 C.F.R. § 1.540 and would result in the return of the paper as an improper submission.

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 duplicate, each bearing an original signature, for entry in each file. All papers filed by the patent owner must be served on the requesters and requesters will be sent copies of all papers mailed by the Office.

After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.

In the event that a housekeeping amendment is not timely submitted to place the same changes in both proceedings, any claim which does not contain identical text in both proceedings will be rejected under 35 USC 112, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

CONCLUSION

1. Reexamination Control Nos. 90/010,524 and 90/011,173 are MERGED.

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.

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

/J. Harrison/

Jessica Harrison
SPE AU 3992 Central Reexamination Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110321

DATE : March 21, 2011

TO SPE OF : ART UNIT 3992

SUBJECT : Request for Certificate of Correction on Patent No.: 6,195,662 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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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540 95/000,470	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 09/02/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
SEP 02 2010
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540; 95/000,470
PATENT NO. : 6564281
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paul M. Anderson, PLLC (For Patent Owner)
P.O. Box 160006
Austin TX 78716

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

MAILED

SEP 02 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

DECISION ON PETITION

This is a decision on patent owner's May 13, 2010 petition entitled "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS." The third party requester, on June 14, 2010, filed an opposition to patent owner's May 13, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on May 13, 2010, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent owner's May 13, 2010 petition is dismissed.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of

the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

---

[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.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

14. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".

15. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.

16. On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '470 *inter partes* reexamination proceeding.

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10540 *ex parte* reexamination proceeding.

19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

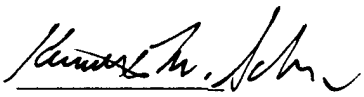
DECISION

As pointed out, on July 13, 2010, requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '470 and '10540 reexamination proceedings. Until the reconsideration of the June 22, 2010 decision is concluded, patent owner's May 13, 2010 petition to strike third party comments from previously merged proceedings is premature, and will only be necessary if the Office reverses its current position. The status of all papers made of record during the period when the proceedings were merged is subject to requester's merger challenge, until the petition for reconsideration of the issue of merger is decided. Should the merger be reinstated, then patent owner may renew the present petition, but under 37 CFR 1.181, as a petition challenging entry of the papers.

CONCLUSION

1. Patent owner's May 13, 2010 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 01/06/2011

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

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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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 01/06/2011

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

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

Date: MAILED
JAN 0 6 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

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Date: JAN 06 2011
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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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Paul M. Anderson, PLLC (For Patent Owner)
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NOVAK, DRUCE & QUIGG, LLP (For Third Party Requester)
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1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

MAILED
JAN 06 2011
CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

DECISION ON PETITION

This is a decision on third party requester's July 13, 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 credit card on July 14, 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.**

The Office *Sua Sponte* directs the examiner to reestablish the record with regard to the Rosen reference in accordance with this decision.

As discussed below, the requester was not precluded from filing another *inter partes*

reexamination request on the same day requester filed the '470 *inter partes* reexamination request (or even shortly thereafter). Further, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either a single *inter partes* request with all issues, or a second *inter partes* request raising the issues presented in the *ex parte* request, concurrently or before the '470 *inter partes* request was ordered. In short, requester has made the conscious choice to present the issues in the *ex parte* reexamination request in a manner that does not provide requester *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, so now has no basis to complain that *inter partes* rights are not being afforded.

The June 22, 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 of the order date of 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.

Finally, in order to address a point made in the third party requester petition, the present decision instructs the examiner of record to recreate the record by incorporating the appropriate issues from the previously vacated Office action of December 17, 2009 and mail an appropriate Office action presenting all issues of patentability, to include the issues of patentability regarding the Rosen reference. This recreation of the record is for the purpose of preserving all party appeal rights, to thereby address the requester petition.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). This request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for the filing of a Patent Owner's Statement. The order stated that all the claims of the '281 patent, i.e., claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, i.e., claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

---

[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 further input from the parties.

14. On March 17, 2010, patent owner timely filed a response to the December 17, 2009 Office action.[2]

15. On April 16, 2010, third party requester timely filed comments after the response.

16. On June 22, 2010, the Office issued a decision dissolving the merger of the '470 and the '10540 proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '470 proceeding confirming all the claims in light of the prior art of record to include a US patent to Rosen ("the Rosen reference").

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10540 proceeding, neither citing nor discussing the Rosen reference.

19. On July 13, 2010, third party requester filed the present petition, requesting reconsideration of the June 22, 2010 decision.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '470 proceeding.

21. On September 20, 2010, third party requester filed a notice of appeal in the '470 proceeding.

22. On October 12, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7805th) for US Patent No. 6,564,281 C1 the '10540 proceeding. The certificate stated that the '470 proceeding was still pending with respect to the '281 patent.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 22, 2010 decision is: (1) Arbitrary, Capricious and an Abuse of Discretion; (2) A violation of Third Party Requester's Appeal 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 June 22, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding.

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[2] On January 21, 2010, the Office granted patent owner a one month extension of time.

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 13, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision on December 16, 2009, dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's concurrently filed requests for reexamination were filed with an "intent to harass" and that the finding of a substantial new question of patentability in each request precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives for handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

b. The January 19, 2010 Patent Owner Petition, January 29, 2010 Requester Opposition, and June 22, 2010 Office Decision

On January 19, 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 19, 2010 petition: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination

proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision. The requester argued (1) Merger of the reexamination proceedings was proper and in accordance with statute and policy; (2) An *ex parte* requester that is also an *inter partes* requester in a merged proceeding is subject to the estoppel provisions of 35 U.S.C. 315(c) as to the *ex parte* issues; (3) Waiver of 37 CFR 1.989(b) should not be granted as no interview right exists; and (4) No intent to harass exists.

On June 22, 2010, the Office issued a decision granting patent owner's January 19, 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 June 22, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester, citing Office's Federal Register rulemaking commentary,[3] argues that the June 22, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

The June 22, 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 commentary is based upon.[4] The present circumstance involves the same third party requester concurrently filing, on the same day, both an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding on the same patent. The cited comment by requester in the July 13, 2010 petition addressed a circumstance where an *inter partes*

[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.

reexamination proceeding was already ordered and under active examination and a requester had discovered relevant information that could not be admitted 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. As pointed out, both reexamination requests under consideration *were filed on the same day.* Under such circumstances, the requester was not precluded from filing another *inter partes* reexamination request on the same day requester filed the '470 *inter partes* reexamination request (or even shortly thereafter). More significantly, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either: (1) A single *inter partes* request with all issues; or (2) A second *inter partes* request raising the issues presented in the *ex parte* request. Requester could have either concurrently filed two *inter partes* requests or filed the second request before the '470 *inter partes* request was ordered. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of two different types of proceedings as a vehicle to obtain *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),[5] 37 CFR 1.989(a),[6] MPEP 2686.01 I,[7] MPEP 2686.01 IV,[8] MPEP 2283,[9] and MPEP 2286.[10] 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 (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

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[5] "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).

[6] "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[7] "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.'"

[8] "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."

[9] "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.'"

[10] "[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.'"

In summary, requester made the conscious choice to present the issues in the *ex parte* reexamination request, which does not provide a requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights beyond what an *ex parte* request would accord, and therefore now has no basis to complain.

Requester's citation to *inter partes* reexamination proceeding 95/000,050 (the '50 proceeding) in support of requester's position, fails to acknowledge the significant differences between the '50 proceeding and the present proceeding. In the '50 proceeding, the request for *inter partes* reexamination antedated the filing of the 90/007,885 *ex parte* request (the '7885 proceeding) by over a year. Thus the circumstances of the '50 proceeding in terms of date order, unlike the circumstances of the present proceeding, were in accord with Office policy and procedure commented upon with regard to 37 CFR 1.948. Furthermore, the '7885 proceeding was filed by the patent owner and not by the same third party requester (as in the present instance). Significant prosecution had taken place in the '50 proceeding and unlike a third party requester, a patent owner in an *inter partes* proceeding, was not bound by 37 CFR 1.948 in order to submit relevant prior art into the *inter partes* proceeding. The facts and circumstances of the '50 proceeding differ significantly from the facts and circumstances of the present proceeding. Therefore the '50 proceeding cannot serve as a basis to establish that the Office has acted in an arbitrary and capricious manner. If anything, the contrast of the present proceedings with the cited '50 proceeding illustrates how unforeseeable, disparate sets of circumstances can arise with regard to merger, thus bolstering the soundness of the policy of giving the Office sole discretion to merge, not-merge or demerge on a case-by-case basis.

b. The June 22, 2010 Office decision is not a violation of Requester's Appeal Rights

The requester asserts that the June 22, 2010 dissolution decision somehow alters requester's substantive appeal rights.

The dissolution decision does not alter the requester's appeal 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 appeal 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* appeal rights as to the *ex parte* request issues. Even after merger, the third party requester had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. 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."

In any event, 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 filed a second *inter partes* request raising the issues presented, instead of filing an *ex parte* request. In this instance, the filing of a second *inter partes* request was clearly permissible under the statute. The *ex parte* proceeding request was filed prior to the issue of an order for reexamination in the *inter partes* reexamination; thus, a second *inter partes* request could have been filed instead of the *ex parte* request, and it should have been filed if requester desired *inter partes* reexamination treatment for the proposed rejections. 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.

CORRECTION OF THE PRESENT RECORD:

Requester has actually identified the problem of accounting for issues of patentability raised by the Office when the proceedings were merged, which were not based upon the submitted requests, *e.g.* the Rosen reference based issues of patentability. As a preliminary matter, the Office possesses statutory authority to add a reference in reexamination. Pursuant to 35 U.S.C. § 314(a), " [e]xcept 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." 35 U.S.C. § 305 provides analogous language. Under 35 U.S.C. § 132, the Office is entitled to introduce any art it deems relevant. Also, the Office possesses statutory authority, pursuant to 35 U.S.C. § 312, to consider information outside a request for reexamination.[11] The Rosen based issues of patentability were proposed by the examiner based upon the Office's statutory authority, and they must be accounted for to ensure that the record is clear with regard to the Rosen reference. In the December 17, 2009 Office action of the merged proceeding, the examiner exercised the Office's statutory authority, and in addition to considering the patentability issues raised in the requests, the examiner issued rejections based upon US 5,235,543 issued to Rosen. After the June 22, 2010 merger dissolution decision, the examiner issued a NIRC in the '10540 *ex parte* reexamination proceeding confirming all the claims and issued an ACP in the '470 *inter partes* reexamination proceeding, also confirming all the claims. In the '10540 *ex parte* proceeding's NIRC confirmation of the claims the examiner

[11] ". . .[T]he Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, **with or without consideration of other patents or printed publications**. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." 35 U.S.C. § 312, emphasis added.

was silent with regard to the Rosen reference. In the '470 *inter partes* proceeding's ACP confirmation of the claims, the examiner discussed how the Rosen reference did not obviate patentability of the claims, and thus inadvertently omitted a patentability rejection that was raised by the Office action vacated in the June 22, 2010 merger dissolution decision. This took away the rights of the requester as to the use of the Rosen reference (the confirmation of the claims in the ACP of the *inter partes* proceeding does not constitute a rejection that the requester could appeal). Accordingly, the examiner of record is directed to recreate the record in the '470 proceeding and issue an appropriate Office action presenting all issues of patentability appropriate to this proceeding, to including the issues of patentability regarding the Rosen reference, to recreate the record and preserve all party participation rights.

c. The June 22, 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. *Requester's counsel has explicitly recognized the Office's authority and discretion extending to demerge in accordance with special dispatch in previous proceedings.*[12] Additionally, 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 administrative act of a consolidation of cases 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 the issuance of the merger and dissolution of the merger decisions.

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

[12] See e.g. Petition to Demerge 95/000283 and 90/008,170 filed August 16, 2008.

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.[13]

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 June 22, 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. The '10540 proceeding has advanced to issuance of a reexamination certificate and the '470 proceeding has advanced to the appeal stage. Issuance of a new ACP in the '470 proceeding, recreating the record therefore better serves special dispatch. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 22, 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 the '470 proceeding has advanced to the appeal stage and a reexamination certificate has issued in the '10540 proceeding, special dispatch would not be served by remerging the proceedings and re-opening prosecution back to the point in prosecution just prior to the initial merger of the proceedings.

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

[13] 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.

the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Regarding previous Office decisions, to include the '50 *inter partes* reexamination proceeding cited by requester, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.[14] Furthermore, as noted in section III a. of this decision, the facts and circumstances of the '50 proceeding significantly differ from the facts and circumstances of the present proceeding. In the present instance, as noted in the June 22, 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 June 22, 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. Policy considerations that requester asserts dictate that merger must occur when multiple, co-pending proceedings on the same patent exist.

In response, the June 22, 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 June 22, 2010 dissolution decision is in accord with and not contrary to public policy, as the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination 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 on the same day for the same patent, albeit 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. Requester asked for separate proceedings for separate issues of patentability on the same patent. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a 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

[14] See MPEP 2686.01 IV.

instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The June 22, 2010 dissolution decision, the MPEP, and Office practice and procedure provides 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.[15] As of October 12, 2010 a certificate has issued in the '10540 proceeding containing an appropriate notice regarding the existence of an outstanding reexamination proceeding.[16] 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 June 22, 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.[17] 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 June 22, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to recreate the record by issuing an appropriate Office action presenting all issues of patentability appropriate for the '470 proceeding, including the issues of patentability regarding the Rosen reference rejection. The record is being recreated to preserve all party participation rights, to thereby address the requester petition.

CONCLUSION

1. The petition is **dismissed**.

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[15] See the June 22, 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.
[16] *Ex Parte* Reexamination Certificate (7805th) No. 6564281 C1, right column notice under the abstract.
[17] See Petition at page 9, section C.

2. The examiner of record is directed to recreate the record by issuing an appropriate Office action in the '470 proceeding presenting all issues of patentability, which is to include the issues of patentability regarding the Rosen reference.

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

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

1-5-11

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EXAMINER

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CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,542
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

DECISION ON PETITION

This is a decision on patent owner's May 13, 2010 petition entitled "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS." The third party requester, on June 14, 2010, filed an opposition to patent owner's May 13, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on May 13, 2010, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent owner's May 13, 2010 petition is dismissed.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of

the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

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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.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

14. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".

15. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.

16. On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '471 *inter partes* reexamination proceeding.

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10542 *ex parte* reexamination proceeding.

19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '471 *inter partes* reexamination proceeding.

DECISION

As pointed out, on July 13, 2010, requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '471 and '10542 reexamination proceedings. Until the reconsideration of the June 22, 2010 decision is concluded, patent owner's May 13, 2010 petition to strike third party comments from previously merged proceedings is premature, and will only be necessary if the Office reverses its current position. The status of all papers made of record during the period when the proceedings were merged is subject to requester's merger challenge, until the petition for reconsideration of the issue of merger is

decided. Should the merger be reinstated, then patent owner may renew the present petition, but under 37 CFR 1.181, as a petition challenging entry of the papers.

CONCLUSION

1. Patent owner's May 13, 2010 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