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. |
|---|---|---|---|---|
| 90/011,198 | 08/31/2010 | 5787449 | 6620-81781-02 | 4394 |

26111 7590 09/29/2011

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 09/29/2011

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
KLARQUIST SPARKMAN LLP
121 S.W. SALMON STREET
SUITE 1600
PORTLAND, OR 97204

Date:
MAILED
SEP 29 2011
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011198
PATENT NO. : 5787449
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

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

(For Patent Owner)

MAILED

SEP 29 2011

CENTRAL REEXAMINATION UNIT

RICHARD D. MCLEOD
ONE WORLD TRADE CENTER, SUITE 1600
121 S.W. SALMON STREET
PORTLAND, OR 97204

(For Requester)

In re Vulpe *et alia*
Reexamination Proceeding
Control No. 90/011,198
For: U.S. Patent No. 5,787,449

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the December 27, 2010 paper entitled "Petition To Reconsider The Examiner's Decision To Deny Reexamination Pursuant To 37 CFR 1.515(c) and 37 CFR 1.181". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,787,449 (hereinafter, the '449 patent) issued on July 28, 1998 to Vulpe *et alia.*

2. On August 31, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 14-20 of the '449 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,198 (hereinafter, the '11198 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on November 24, 2010.

4. On December 27, 2010, the present petition was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11198 reexamination proceeding has petitioned seeking relief from the examiner's November 24, 2010 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the August 31, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '449 patent filed in the '11198 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

The '449 patent matured from application number 08/253,263 (the '263 application). During prosecution of the '263 application, the office applied teachings from Rosenbaum (US Patent Number 5,404,435), Mizuta *et alia* (US Patent Number 5,280,574), and Kugimiya (US Patent Number 5,587,449) to various features in the method claims 14-19 and 21 that would be renumbered claims 14-20 at allowance. Of particular note are the applied teachings of Kugimiya and the distinguishing features.

The interview summary of December 10, 1997 states that the claim language was discussed as compared to Kugimiya and references the claim terms "metacode menus" and "distinct storage". Applicant's response of December 15, 1997 states,

> "We seemed to reach agreement that the reference does not teach providing a "menu of metacodes" or a persistent storage for the metacode map...Contrast this with the Kugimiya reference which, like many other references, teaches the use of only temporary storage of metacodes while the program is doing its processing. When the program is finished, the document continues to be stored permanently with the metacodes intermixed with the content."

The '263 application was then allowed without further comments. Therefore, the record indicates that the examiner concluded that Kugimiya taught most of the claim limitations, but did not teach "providing a menu of metacodes" and the "distinct map storage means" limitations. It is noted that "providing a menu of metacodes" appears in independent claim 14 and the "distinct map storage means" limitation appears in independent claims 14 and 20.

Stated another way, during prosecution of the '263 application, the office had before them the Kugimiya reference and the technological teachings therein to reject hypothetical claims as follows:

Claim H1. A method for producing a first map of metacodes and their addresses of use in association with mapped content, the method comprising:

providing the mapped content to mapped content storage means;

compiling a map of the metacodes, by locating, detecting and addressing the metacodes; and

providing the document as the content of the document and the metacode map of the document.

Claim H2. A method for producing from a document made up of metacodes and content, a map of metacodes and their addresses of use in association with mapped content of the document, the method comprising:

(a) reading the content of the document until a metacode is found;

(b) copying the content and storing the copied content in a mapped content storage;

(c) noting in the map the found metacode and its position in the content;

(d) repeating the processing of (a)-(c) until the entire document has been processed; and then

(e) providing the document as the content of the document separately from the metacode map of the document.

Therefore, any discussion of how Kugimiya, or other cumulative references, teach the above features is not germane as to whether an SNQ is raised by the '11198 request as such teachings are not "new" to the office. Furthermore, continued reconsideration of previous arguments that Kugimiya, or other cumulative references, allegedly teach the other features in claims 14 and 20 would not be a "new" question. To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

> However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:
>
> This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.

> Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:
>
> [The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.
> *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary* , 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

The '449 patent was also subject to a previous reexamination, control number 90/010,347 (the '10347 proceeding). The requester provided new references to Cowan (RITA) and DeRose (US Patent Number 6,101,512) which raised an SNQ as to claims 14-20 of the '449 patent. Both Cowan and DeRose teach tree based systems. The pointers in those systems were considered by the examiner to not meet the addresses of use limitation as the pointers do not identify the place in the content at which the metacode is to exert its effect. The examiner also discussed an alternative manner of viewing the entire tree structure as meeting the "addresses of use" limitation; however, such a reading would not meet the limitation in context of additional claimed elements as the "tree" could not be considered the requisite "unique identifier" and the "address of use" would contain the metacodes themselves. The teachings from Cowan and DeRose are, at best, cumulative, and in many cases less on point than the teachings of Kugimiya with respect to most claim limitations (including all those in hypothetical claims H1 and H2 above).

Many claim terms are explicitly defined in the specification of the '449 patent. Specifically, column 4, lines 14-20 and lines 36-41 disclose:

> A metacode, which includes but is not limited to a descriptive code, is an individual instruction which controls the interpretation of the content of the data, i.e., it differentiates the content. A metacode map is a multiplicity of metacodes and their addresses associated with mapped content. An address is the place in the content at which the metacode is to exert its effect.
>
> By "detecting" is meant recognizing, identifying or differentiating a metacode from content; by "locating" is meant finding the position of a metacode in and relative to an input content stream; and by "addressing" is meant forming a

unique identifier which defines the position of a metacode relative to the mapped content stream.

These explicit definitions limit the scope of the claim language and mirror the district court's construction of the terms. It is noted that requester points to a perceived difference in the definition of the claim term "addresses of use" in the reasons for confirmation in the '10347 proceeding and the explicit definitions, which carry into the court's claim construction.

The court's claim construction reads, "a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect". The reasons for confirmation in the '10347 proceeding reads, "a unique identifier which defines the position of a metacode relative to a mapped content stream which clearly identifies the place in the content at which the metacode is to exert its effect".

So, the office in the '10347 proceeding has more broadly interpreted the claim term. The office's construction has "a unique identifier which defines the position ...which clearly identifies the place in the content..." That is, the unique identifier "defines the position" but only "clearly identifies the place". Whereas the court's construction has "a unique identifier which defines the position...and the place in the content..." (i.e. the unique identifier defines both the position and the place).

Requester's position that "defining" the place is broader than merely "clearly identifying" the place is not well taken or understood. That is, one can identify a place without defining it, but if one has defined a place, they have clearly identified it. However, the broader definition given in the '10347 proceeding is arguably at odds with the explicit definition in the specification, so the office will now favor a narrower construction of addresses of use defined as "a unique identifier which defines the position of a metacode relative to a mapped content stream and the place in the content at which the metacode is to exert its effect".

Two other terms do not have explicit definitions. Specifically, the "providing a menu of metacodes" and "distinct map storage means" limitations (variously in the limitations "a first map of metacodes and their addresses of use in association with mapped content and stored in distinct map storage means" and "compiling a map of the metacodes in the distinct storage means, by locating, detecting and addressing the metacodes", "a map of metacodes and their addresses of use in association with mapped content of the document and stored in distinct map storage means") are not explicitly defined.

The '449 patent discloses that the processing system (134) "produces a menu of metacodes to select from using the instructions provided in Box 136". Although the step of selecting is not required in the claims, "providing a menu of metacodes" must be read more narrowly than asserting that the existence of metacodes implies "providing a menu of metacodes".

The examiner of the '263 application viewed Kugimiya's map of metacodes in buffer F (Fig. 13) to not meet the claim limitations regarding the map stored in a distinct storage means. The contents of buffer F are added into buffer B (see Fig. 16) during step S17 of Fig. 10 after they were only initially read to buffer F in steps S12 or S14.

Requester does not proffer a new teaching in Kugimiya to address the distinct storage means limitations. Requester relies on the old teachings in Kugimiya and asserts that they are "In A New Light In View Of The Patentee's Admissions In the Litigation". However, requester does not provide a statement by patent owner that Kugimiya teaches the distinct storage means limitations. Requester appears to want the office to reconsider the argument already decided by the office in the '263 application. However, the reexam statute guards against simply repeating a prior examination on the same issues and arguments.

Regarding "providing a menu of metacodes", requester asserts "the Applicants also argued that Kugimiya does not teach a "menu of metacodes," claim 20 has no such limitation, and, as explained, herein, the Patentee admitted that the was simply an SGML DTD, and that this was known in all markup languages." Providing a menu of metacodes (in claim 14) can not be read as broadly as SGML has metacodes, which could be provided as a menu. In arguendo, if the claim limitation could be read that broadly, then the existence of metacodes in SGML is not a new technological teaching as the SGML standard (and the existence of metacodes in SGML) is admitted and discussed as prior art in the background sections of both the '449 patent and Kugimiya.

On page 77, requester asserts Kugimiya in view of Fukumochi raises an SNQ to meet the "distinct storage means" limitations:

> "Plainly, Kugimiya teaches keeping the metacode map and mapped content separate long enough to run a translation process, and during that process the content may expand or shrink since Japanese-English would never be expected a literal word-for-word or character-for-character translation. *(See e.g.,* Fukumochi, col. 1, lines 42-62)."

Fukumochi, col. 1, lines 42-62, reads, as follows:

> For example, when the English sentence "Time flies like an arrow" is input, some Japanese equivalents are provided depending on the interpretation of the part of speech of each word. That is, "Time" may be interpreted as a noun or a verb, "flies" may be interpreted as a noun or a verb, "like" may be interpreted as a noun or a preposition. The resulting Japanese equivalents are as follows:

1. " "(ya-no-youna-jikan-bae) (meaning that "arrow-analogous flies (insects) called as time")

2. " "(ya-no-youni-hae-wo-hakare) (meaning that "Measure flies as if an arrow moves through air")

3. " "(ya-no-youna-hae-wo-hakare) (meaning that "Measure arrow-analogous flies")

4. " "(jikan-bae-wa-ya-wo-konomu) (meaning that "Flies called as time are fond of an arrow")

5. " "(jikan-wa-ya-noyouni-tobu) (meaning that "Time passes as if an arrow moves through air")

A selection of a proper Japanese equivalent from these Japanese equivalent candidates depends on an operator's judgment.

Requester's position is not well taken. A generic teaching of translating Japanese is already present in Kugimiya, a reasonable examiner would not consider this further teaching in Fukumochi important in determining the patentability of the claims.

Requester's position that DeRose alone raises an SNQ reiterates the reason DeRose raised an SNQ in the '10347. However, this is not a new question in the present request. Then, requester argues against the reasons for confirming the claims over DeRose alone. However, the SNQ requirement protects patent owners from having to respond to, or participate in unjustified reexaminations and bars reconsideration of any argument already decided by the Office, whether during the original examination or an earlier reexamination. Thus the statute guards against simply repeating the prior examination on the same issues and arguments.

Requester then proposes the combination of DeRose in view of Kugimiya raises an SNQ. A position that requester did not set forth in the '10347 request. Requester alleges that the combination presents these references in a new light. Requester presents a modification of DeRose's table on page 127 of the request to include both the information from DeRose, Fig. 6 and additional information they allege to be similar to what appears in Kugimiya.

The table on page 127 of the request is inaccurate. The column that requester arbitrarily labeled "Tag" represents nodes in the tree structure of Fig. 5. Although there is a tag for book, and there are separate tags for book and front matter, there is no tag "BOOK, FM". Furthermore, there is no tag "#TEXT" as this represents the actual text in the tree structure of Fig. 5.

Requester seems to alter what they consider a tag to suit their current argument. However, these changing definitions are internally inconsistent within the request. For example, on page 9 of the request, requester asserts that "[e]nd-tags are also considered complete metacodes, as indicated by "next code"." Requester cites to column 9, lines 28-31 of the '449 patent to support that assertion:

> read characters until code reads to <Chapter> which is a complete code.
> raw content =
> character position = 0
> metacode map = 1 is <Chapter> at character position 0
> map elements = 1
> read characters until code reads to <Title> which is the next code.

However, the section cited refers to start tags for Chapter and Title. Reading until the next code is found does not necessarily mean that the next code is an end code and, in the portion that requester refers to, it is not the end tag. Furthermore, these tags have nothing to do with the nodes in the tree structure of DeRose (Fig. 5) presented in a table form (Fig. 6).

Requester is forcing the term tag to take on an unsupportable meaning to attempt to combine the references in a manner that would contain a new teaching. The combination of DeRose and Kugimiya presented by requester is untenable and would not result in the table shown on page 127. Therefore, the combination set forth by requester does not contain any new teaching that a reasonable examiner would consider important in determining the patentability of the claims.

Requester asserts that Borgendale (incorporating Hesse) and/or Hesse raise an SNQ. Hesse, Fig. 2, starts with an alphanumeric string that includes tags. Hesse creates a table which includes the tags as well as their position within the alphanumeric string. This teaching is inferior to the teachings of Kugimiya considered during prosecution of the '263 application because the location of the tags within an alphanumeric string is not the location at which the tag exerts its influence. Additionally, Hesse teaches the use of a buffer and the generic teaching of SGML which are the same as the teachings from Kugimiya. So, the teachings from Borgendale (incorporating Hesse) and/or Hesse are the same as or less on point than the teachings of Kugimiya that were already considered during prosecution of the '263 application.

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 5,787,449 has been presented in the corrected request filed August 31, 2010 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,200 | 08/31/2010 | 5991735 | 8767R004E | 4806 |

22334 7590 08/16/2011

PETER F WEINBERG
GIBSON DUNN AND CRUTCHER LLP
SUITE 4200
1801 CALIFORNIA STREET
DENVER, CO 80202

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 08/16/2011

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

United States Patent and Trademark Office

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

PETER F. WEINBERG
GIBSON DUNN AND CRUTCHER LLP
SUITE 4200
1801 CALIFORNIA STREET
DENVER, CO 80202

(For Patent Owner)

MAILED
AUG 16 2011
CENTRAL REEXAMINATION UNIT

DANIEL M. DE VOS
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

(For Requester)

In re Gerace
Reexamination Proceeding
Control No. 90/011,200
For: U.S. Patent No. 5,991,735

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the December 29, 2010 paper entitled "PETITION FOR REVIEW UNDER 37 C.F.R. §1.181". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,991,735 (hereinafter, the '735 patent) issued on November 23, 1999 to Gerace.

2. On August 31, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-23 and new claims 24-26 of the '735 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,200 (hereinafter, the '11200 reexamination proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on November 29, 2010.

4. On December 29, 2010, the present petition ("Petition") was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11200 reexamination proceeding has petitioned seeking relief[1] from the Examiner's November 29, 2010 Order denying *ex parte* reexamination[2].

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

---

[1] Petitioner "requests that the Director reverse the order denying the Second Request for each of the SNQs discussed herein, and further requests the consolidation of the 90/011,200 reexamination with the pending 90/010,543 reexamination under 37 C.F.R. § 1.565(c)." (Page 10 of the Petition.)

[2] The Petition sets forth:

> The order denying the Second Request mailed November 29, 2010, determined that the **requested SNQs** based on the *Herz* patent and the *Robinson* patent **as presented in the Second Request** do not raise SNQs with regard to the currently confirmed claims, because the new prior art references do not teach the claim limitations.
>
> However, Requester respectfully submits that the new prior art **sufficiently** teaches the limitations of the currently confirmed claims so as to raise **new and different SNQs**.
>
> Specifically, Requester presents the following issues to be reviewed:
>
> Issue 1: *Herz* raises an SNQ under 35 USC § 102 with respect to currently confirmed Claims 8 and 20 and the combination of *Herz* and *Rose* raise an SNQ under 35 USC § 103 for Claims 9-10 and 21-22; and
>
> Issue 2: *Robinson* raises an SNQ under 35 USC § 102 with respect to confirmed Claims 8 and 20.
>
> (Bold and underlining emphasis added.) (Page 5 of the Petition.)

Note also footnotes 5 and 9 *infra.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the August 31, 2010 **request** for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the 8-31-10 **request** for reexamination of the '735 patent filed in the '11200 reexamination proceeding has been found not to present any SNQ. Therefore, the Examiner's decision to deny reexamination is proper.

The '735 patent matured from application number 09/132,277 (the '277 application) which is a continuation of U.S. Patent No. 5,848,396.[3] On June 29, 1999, the examiner allowed claims 1-23 on first action. Allowance thereof appears to be contingent on the inclusion of a limitation, i.e. "recording indications of user response and physical activity during viewing of the displayed agate data, based on the indications generating a psychographic profile of the user", see claim 15 filed 6-21-99.

On May 18, 2009, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-23 of the '735 patent be reexamined. This reexamination proceeding was assigned Control No. 90/010,543 (hereinafter, the '10543 reexamination proceeding). In such request of the '10543 reexamination proceeding, the section of the request entitled "Statements Pointing Out Each Substantial New Question of Patentability (SNQ) Pursuant to 37 C.F.R. § 1.510(b)" (see pages 8-19), set forth requester's position that the references, i.e. patents or printed publications, cited in the request (i.e. Dedrick, **Rose**, Sheth and Wilkins) raise a substantial new question of patentability as to original claims 1-23 of the '735 patent, i.e. namely disclose "...the purportedly novel feature claimed in the 735 patent of recording indications of user responses and physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user." The USPTO mailed an Order Granting Request for *Ex Parte* Reexamination on July 30, 2009.[4] A non-final Office Action was mailed by the USPTO on January 29, 2010 in which original claims 1-7, 11-19, and 23 were rejected, and original claims 8-10 and 20-22 were confirmed. The Patent Owner filed an IDS on March 22, 2010, citing **Herz** (U.S. Patent No. 5,754,939, hereinafter referred to as Herz or '939), **Robinson** (U.S. Patent No. 5,918,014, hereinafter referred to as Robinson or '014) and **Bull**

[3] See footnotes 1 and 2 of the Petition.
[4] Note page 6, last full paragraph, and page 11, second full paragraph of the 7-30-09 Order in the '10543 proceeding.

(U.S. Patent No. 5,901,287, hereinafter referred to as Bull or '287). On March 22, 2010, the Patent Owner also filed a response, in which original claims 1-7, 11-19, and 23 were unamended but new claims 24-26 were added. An *ex parte* reexamination Interview was conducted on July 22, 2010. An Interview Summary by the Examiner was mailed by the USPTO on August 2, 2010, and Patent Owner's Interview Summary was filed on August 20, 2010.

Turning back to the '11200 reexamination proceeding, on August 31, 2010, the request, i.e. a second request, for *ex parte* reexamination was deposited by the same third party requester requesting not only claims 1-23 of the '735 patent but also new claims 24-26 added in the '10543 proceeding be reexamined. An Order denying this second Request was mailed by the USPTO on November 29, 2010.

Subsequent to the denial of the Order in the '11200 proceeding, a FINAL rejection was mailed by the USPTO on December 23, 2010 in the '10543 proceeding not only maintaining the previous rejections, but also setting forth "**Herz, Robinson** and **Bull** raise a non-cumulative Substantial New Question (SNQ) of patentability because it provides a technical teaching not previously on record. Accordingly, rejections based on **Herz, Robinson** and **Bull** are presented herein." (Note the nature of the SNQ and technical teaching were not set forth) and adding new rejections as to such rejected claims also based on this prior art. However, claims 8-10 and 20-22 remained confirmed.[5] The FINAL set forth:

> The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:
>
> ...
>
> Herz discloses a high interest search profiles for each user (Herz, 56:14-17). Herz further discloses monitoring "which articles the user read, keeping track of how many pages of text are viewed by the user, how much time is spent viewing the article, and whether all pages of the article were viewed [, and] [t]his information can be combined to measure the depth of the user's interest in the article, yielding a passive relevance feedback score" (Herz, 58:56-62). Herz discloses providing positive relevance feedback when a consumer buys a product (Col. 60, ll. 64 to Col. 61, l. 6). However, Herz does not disclose "for each advertisement recording," the "number of times viewed" or "number of times selected" or "number of times a purchase was obtained through the advertisement".
>
> Robinson discloses "pages visited; length of time spent on the page; amount of money spent by the user; identifier of the ad displayed to the user in the Smart Ad Box; whether or not the user clicked on the ad; whether or not the user rejected the ad; or an identifier of each particular item purchased" (Robinson,

[5] Contrast to the Petition at page 6, first full paragraph, first sentence, and the paragraph bridging pages 8-9, first sentence thereof.

9:21-35). However, Robinson does not disclose for each advertisement, number of times viewed, or number of times selected or number of times a purchase was obtained through the advertisement.

Bull is directed to a system that analyzes a user's profile and session looking activity against a profile established by a supplier. When the profile is approximately matched, the supplier is notified so it can contact the user to offer goods or services (Bull, 14:10-20). However, Bull is silent as to "recording for each advertisement.., the number of times viewed, selected or number of times a purchase was obtained through the advertisement" as recited in Claims 8 and 20.

Therefore, ...Herz, Bull or Robinson do not disclose or suggest, alone or in combination:

**Regarding claim 8**, "the advertisement module further records history of users viewing the advertisements, including for each advertisement, at least one of (i) number of times viewed by a user, (ii) number of times selected for further information, and (iii) number of times a purchase was obtained through the advertisement", in combination with the other elements and features of the claimed invention.

**Regarding claim 20**, (e) creating an advertisement target profile as a function of: (i) number of times an advertisement is viewed, (ii) number of times the advertisement is selected, and (iii) number of times a purchase is made through display of the advertisement, in combination with the other elements and features of the claimed invention.

**As for claims 9-10 and 21-22**, these claims are dependent on claims 8 and 20, respectively, and therefore, the same reasons applied to claims 8 and 20 above apply as well for these claims.

On March 28, 2011, a Notice of Intent to Issue *Ex Parte* Reexamination Certificate ("NIRC") was mailed by the USPTO as a consequence of Patent Owner's failure to respond to the Final Rejection mailed on December 23, 2010, which set a statutory period to respond of two months. The NIRC, by Examiner's Amendment, cancelled original claims 1-7, 11-19 and 23 as well as new claims 24-26 which were subject to rejection in the Office action mailed December 23, 2010 that Patent Owner failed to timely respond to. Accordingly the NIRC set forth the status of claims as: "Original claims 8-10 and 20-22 are confirmed. Original claims 1-7, 11-19 and 23 have been canceled. New claims 24-26 have been cancelled." A "STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION" set forth the same reasons as those set forth in the FINAL rejection discussed *supra*. The *Ex Parte* Reexamination

Certificate for the '10543 proceeding issued on June 7, 2011 as US 5,991,735 C1 confirming the patentability of claims 8-10 and 20-22.[6]

Continuing with the '11200 proceeding, the section of the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-18, esp. the last paragraph of page 7, page 9, first full paragraph, page 11, first full paragraph, page 12, last full paragraph, page 14, last full paragraph, page 16, last full paragraph, page 17 first full paragraph and page 18, last full paragraph) sets forth third party requester's position that the references cited in the request (i.e. Herz, Robinson and Bull) raise a substantial new question of patentability as to claims, i.e. claims 8 and 20, of the '735 patent[7], namely because:

> The prior art as presented herein by Requestor clearly and unequivocally discloses the exact features identified by the Applicant and the Examiner as distinguishing from the cited art during the original prosecution of **the 735 patent.** For example, as discussed in detail below, at the time of the alleged invention and/or priority filing date of the 735 patent, the claimed initial formation/creation of psychographic profiles of users, using display of agate information and tracking and recording of user requests for and response to said displayed agate information was well known in the prior art and, therefore, was not novel and/or non-obvious.

and

> *Herz*[, *Robinson* or *Bull*] discloses the purportedly novel feature claimed **in the 735 patent** of recording indications of a user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user.
>
> (Bold and underlining emphasis added.)[8]

However, the discussion ignores the prosecution history, see *supra.* This SNQ outlined in this second request with regard to claims, i.e. claims 8 and 20, (i.e., "the purportedly novel feature

---

[6] Accordingly, the consolidation requested as relief by the Petition, see footnote 1 supra, is no longer available.

[7] See however footnote 2 *supra*, i.e. the Petition does not request review of issues with respect to claims 1-7, 11-19 and 23-26, and note the NIRC of the '10543 proceeding which cancelled claims 1-7, 11-19 and 23-26, i.e. as of 6-7-11 the claims "in effect" are only claims 8-10 and 20-22 (See MPEP 2243, i.e. "Amendments and/or new claims presented in any copending reexamination or reissue proceeding for the patent to be reexamined will not (see MPEP § 2240, subsection II.) be considered nor commented upon when deciding a request for reexamination.", and MPEP 2240, i.e. "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. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)).")

[8] Compare to the 11-29-10 Order at pages 6 and 9, second full paragraphs thereof.

claimed in the 735 patent of recording indications of a user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user", e.g. pages 11, 14 and 17 of the '11200 Request) is not **different from** that raised in the pending reexamination, i.e. the '10543 proceeding, for **the claims in effect at the time of the determination** (i.e. "...the purportedly novel feature claimed in the 735 patent of recording indications of user responses and physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user.", e.g. pages 11 and 14 of the '10543 Request.)[9]

To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

> However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:
>
> This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.
>
> Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:
>
> [The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.

---

[9] Compare to the 11-29-10 Order at pages 6 and 9, first and third full paragraphs thereof and the Petition at page 3, second full paragraph, second to last sentence thereof and page 6, second full paragraph, line 1.

> *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

as is MPEP 2240, DECISION ON REQUEST, 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...
>
> ...
>
> ...However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination.** The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

and MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

> The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.
>
> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, **unless** *the same question of patentability has already been decided*...(B) by the Office in a previous examination or

> pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. ...
>
> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" **unless** *the same question of patentability has already been decided as to the claim*...by the Office in a previous examination. ...For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim....
>
> (Emphasis added.)

Returning to the '11200 proceeding and claims 8 and 20 with respect to the Herz reference, the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-18, esp. page 11, second full paragraph and page 12, last full paragraph, and thereby also pages 33-35 and 52-53 of the Request and Exhibit CC-A at pages 12-13 and 27 - 28) sets forth third party requester's position that Herz raises a further substantial new question of patentability as to claims 8 and 20 of the '10543 proceeding:

> In addition, ... *Herz* raises an SNQ different from that **in the pending 90/010,543 reexamination**, because *Herz* more explicitly discloses the requirements of Claim 8.
>
> (Bold and underlining emphasis added.)

More specifically:

In particular, *Herz* discloses creating an advertisement target profile as a function of: (i) number of times an advertisement is viewed and (ii) number of times the advertisement is selected. As discussed above with respect to Claim 1, *Herz* discloses the news clipping service (e.g., including advertisements as well as news articles), which as disclosed in the *Herz* patent stores a set of high-interest search profiles for each user in which the search profiles associated with a given user can change over time. *See*, e.g., *Herz*, 56:14-17 ("The news clipping service instantiates target profile interest summaries as search profile sets, so that a set of high interest search profiles is stored for each user. The search profiles associated with a given user change over time."). After the system delivers the newspaper articles to the user, ***the user's search profiles set generator monitors "which articles the user read, keeping track of how many pages of text are viewed by the user, how much time is spent viewing the article, and whether all pages of the article were viewed [, and] [t]his information can be combined to measure the depth of the user's interest in the article, yielding a passive relevance feedback score.***" *Herz*, 58:56-62 (emphasis added). *See also Herz*, 60:7-9 ("The news clipping service may deliver news articles (or advertisements and coupons for purchasables) to off-line users as well as to users who are on-line.") (emphasis added) and 60:16-22 ("In one application, the news clipping service chooses a set of news articles (respectively, advertisements and coupons) that are predicted to be of interest to user U. thereby determining the content of a customized newspaper (respectively, advertising/coupon circular) that may be printed and physically sent to user U. via other methods.").

In addition, *Herz* discloses creating an advertisement target profile as a function of: ... (iii) number of times a purchase is made through display of the advertisement. For example, *Herz* discloses an application for "paying advertisers, who may be companies or individuals, are the source of advertisements or other messages, ***which take the place of news articles in the news clipping service. A consumer who buys a product is deemed to have provided positive relevance feedback on advertisements for the product, and a consumer who buys a product apparently because of a particular advertisement (for example, by using a coupon clipped from that advertisement)is deemed to have provided particularly high relevance feedback on that advertisement.***" *Herz*, 60:64-61:6. (Emphasis added). *See also Herz*, 40:34-37 (describing that the proxy server transmits a message to the advertiser each time the advertisement is transmitted to the user).

Accordingly, *Herz* discloses creating an advertisement target profile as a function of: (i) number of times an advertisement is viewed, (ii) number of times

> the advertisement is selected, and (iii) number of times a purchase is made through display of the advertisement.[10]

However, such portions of Herz cited by the request do not present the technological teachings alleged by the third party requester that a reasonable examiner would consider important in whether the claims are patentable, i.e. the cited technological teachings of the prior art patents and/or printed publications do not raise a/the substantial question of patentability regarding at least one claim.[11,12]

To this point, MPEP 2216, Substantial New Question of Patentability, is instructive:

> Under 35 U.S.C. 304, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised. 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 prior patents and printed publications." If such a new question is found, an order for ex parte reexamination of the patent is issued. It is therefore important that the request clearly set forth in detail what the requester considers the "substantial new question of patentability" to be in view of prior patents and printed publications. The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office.
>
> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.
>
> (Emphasis added.)

---

[10] Compare to the 11-29-10 Order at page 6, line 15-page 7, line 9 and page 7, line 12-page 8, line 6 and the Petition at page 6, sixth line from bottom-page 7 last line. However, note the Request did not cite or discuss Herz at col. 12, lines 18-21 or col. 44, lines 16-19 as does the Petition.

[11] Compare to the 11-29-10 Order at page 6, lines 2-4, page 7, lines 9-11 and page 8, lines 6-11 and the Petition at page 3, second to last sentence, page 6, second full paragraph except the last line thereof. Contrast to the Petition at page 4, lines 1-5 and 7-9, page 6, lines 17-20 and page 8, first two full paragraphs.

[12] Note also the prosecution history shows the same question of patentability as to claims 8 and 20 (i.e. as of 6-7-11 the claims "in effect", see footnote 7 supra, are only claims 8-10 and 20-22) and Herz has been decided by the Office in a previous examination or pending reexamination, i.e. see discussion of the December 23, 2010 FINAL and the 6-7-11 NIRC in the '10543 proceeding *supra*.

as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:, *see supra.*

Specifically, claims 8 and 20 require, e.g., an advertisement module which records history of "users" viewing advertisements, "including for **each** advertisement...(i) **number of times viewed** *by a user*" (Emphasis added) (Note also the '735 patent at col. 5, lines 55-57 which discloses recording the number of times the advertisement is displayed, the number of **users** ( as compared to a user) to whom the advertisement is displayed or both). The cited portions of the Request, esp. Herz, col. 58, lines 56-62, do not disclose recording the number of times each advertisement is viewed by a user as compared to, e.g., which advertisements are read and the page and time viewing specifics thereof.[13]

Returning to the '11200 proceeding and claims 9-10 and 21-22 with respect to the Herz and Rose references, the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-18, esp. the paragraph bridging pages 12-13, first sentence, page 13, first full paragraph, and thereby also pages 57-64 of the Request and Exhibit CC-B, pages 2-6) sets forth third party requester's position that Herz and Rose raise a further substantial new question of patentability as to claims 9-10 and 21-20 of the '10543 proceeding:

> In addition, ... *Herz* in view of *Rose* raises an SNQ different from that **in the pending 90/010,543 reexamination**, because *Herz* in view of *Rose* more explicitly discloses the requirements of Claims 9 and 10.
>
> (Bold and underlining emphasis added.)

More specifically:

> *Rose* discloses performing a regression analysis on a history of users viewing electronic information. For example, *Rose* discloses ranking the relevance of items of information to be presented to a user by performing a regression analysis of attribute-based and correlation-based factors for each item of information. *See, e.g., Rose*, Abstract ("regression analysis ... can be carried out with respect to various factors pertaining to document content and user correlation, to generation a prediction of relevance. The user correlation data is obtained from feedback information provided by users when they retrieve items of information."), 2:41-45 ("Other information evaluation techniques, such as multiple regression analysis ... can ... be employed to evaluate various factors pertaining to document content and user correlation, and thereby generate a prediction of relevance."), and 7:41-50 ("Other approaches which take into

[13] Contrast to the Petition at page 4, lines 1-5 and 7-9 and page 6, ninth line from the bottom-page 7, last line. It is noted the portions of Herz only cited therein and not in the Request i.e. col. 12, lines 18-21 or col. 44, lines 16-19, also do not teach recording for each advertisement the number of times viewed by a user. For example, col. 12, lines 18-21 are part of the paragraph beginning at lines 3-5 which set forth, "[it is worth noting some additional attributes that are of interest in some domains. In the case of documents and certain other domains..." but does not teach the advertisement domain. Col. 44, lines 16-19 of Herz discusses estimating costs and benefits of "prefetching" files, i.e. records the number of requests of files of a cluster(s) by users of the cluster(s) not, e.g., recording the number of views of an/each advertisement/file by a user, with regard to **prefetching** files.

> account both the attribute-based information and user correlation information can be employed. For example, multiple regression analysis can be utilized to combine the various factors. In this approach, regression methods are employed to identify the most important attributes that are used as predictors, e.g., salient terms in a document and users having similar feedback responses, and how much each one should be weighted. Alternatively, principal components analysis can be used to identify underlying aspects of content-based and correlation-based data that predict a score.").[14]

However, the teachings of Rose outlined in the '11200 request, see, e.g., *supra,* were considered and discussed in the '10543 reexamination proceeding for the same reasons, see, esp., the paragraph bridging pages 12-13 of the 5-18-09 Request of the '10543 proceeding.[15]

To this point, MPEP 2216, Substantial New Question of Patentability, discussed supra, is again instructive, i.e.:

> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.
>
> The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office **if the reference is presented in a new light or a different way that escaped review during earlier examination**....
>
> After the enactment of the Patent and Trademark Office Authorization Act of 2002 ("the 2002 Act"), a substantial new question of patentability can be raised by patents and printed publications "previously cited by or to the Office or considered by the Office" ("old art"). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002 Act, MPEP § 2242, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, but only if the old art is "**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."...

[14] Compare to the 11-29-10 Order at page 8, last paragraph.
[15] Compare to the 11-29-10 Order at page 8, last paragraph and the Petition at page 8, third full paragraph.

(Emphasis added.)

as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim...by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim....
>
> (Emphasis added.)

For the reasons discussed supra with regard to Herz[16] and because the technological teachings of Rose are not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e. obviousness of the same claim limitations, during a prior proceeding involving the patent for which reexamination is requested, the combination thereof does not raise does not raise a substantial new question of patentability.[17]

---

[16] Contrast to the petition at page 8, third full paragraph. Note such paragraph premises the combination raising a SNQ due to at least the reasons set forth with regard to claims 8 and 20 and Herz.

[17] Compare to the 11-29-10 Order at page 8, third full paragraph and contrast to the Petition at page 8, third full paragraph.

Returning to the '11200 proceeding finally with respect to claims 8 and 20 and the Robinson reference, the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-18, esp. the paragraph bridging pages 14-15 and page 16, last full paragraph, and thereby also pages 74-75 and 90-91 of the Request and Exhibit CC-C at pages 9 and 22) sets forth third party requester's position that Robinson raises a further substantial new question of patentability as to claims 8 and 20 of the '10543 proceeding:

> In addition, ... *Robinson* raises an SNQ different from that **in the pending 90/010,543 reexamination**, because *Robinson* more explicitly discloses the requirements of Claim 8.
>
> (Bold and underlining emphasis added.)

More specifically:

> In particular, *Robinson* discloses a "Smart Ad Box", which is an area on a web page that is used to display Web advertising (e.g., classified advertisements). *See, e.g., Robinson*, 4:8-10; *see also Robinson Provisional* at 2 (describing the "Smart Ad Box" as also quoted above)....
>
> Claim 8 depends on Claim 5 ... *Robinson* discloses that the advertisement module further records history of users viewing the advertisements, including for each advertisement, at least one of (i) number of times viewed by a user, (ii) number of times selected for further information, and (iii) number of times a purchase was obtained through the advertisement. In particular, the system tracks the activities of the user in the interactive medium (e.g., interactions/clicking of advertisements on a web page). *See, e.g., Robinson*, 8:61-11:25 ("Tracking Users" section); *see also Robinson Provisional* at 9-14 ("Tracking Users" section). Various types of information regarding the user's Web interactions include: pages visited; length of time spent on the page; amount of money spent by the user; identifier of the ad displayed to the user in the Smart Ad Box; whether or not the user clicked on the ad; whether or not the user rejected the ad; or an identifier of each particular item purchased. *Robinson*, 9:21-35; *see also Robinson Provisional* at 10. "Every time a user visits a tracking-enabled page, a central database will be updated to show that that 74 particular user visited the page." *Robinson*, 9:8-10; *see also Robinson Provisional* at 10 (same quote).[18]

However, such portions of Robinson cited by the request also do not present the technological teachings alleged by the third party requester that a reasonable examiner would consider important in whether the claims are patentable, i.e. the cited technological teachings of the prior

[18] Compare to the 11-29-10 Order at page 9, line 15-page 10, second to last line and the Petition at page 9, line 8-page 10, line 9. However, note the Request did not cite or discuss Robinson at col. 16, lines 53-58 or col. 18, lines 1-4 as does the Petition.

art patents and/or printed publications do not raise a/the substantial question of patentability regarding at least one claim.[19,20]

To this point, MPEP 2216, Substantial New Question of Patentability, as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:, *see* supra, are again instructive.

Specifically, claims 8 and 20 require, e.g., an advertisement module which records history of "users" viewing advertisements, "including for **each** advertisement...(i) **number of times viewed** *by a user*" (Emphasis added) (Note also the '735 patent at col. 5, lines 55-57 which discloses recording the number of times the advertisement is displayed, the number of **users** ( as compared to a user) to whom the advertisement is displayed or both). The cited portions of the Request, esp. Robinson, col. 8, line 61-col. 11, line 25, do not disclose recording the number of times each advertisement is viewed by a user as compared to, e.g., which web pages containing advertisements are visited and page viewing specifics thereof.[21]

---

[19] Compare to the 11-29-10 Order at page 9, lines 1-3, page 10, second to last line-page 11, line 2 and the Petition at page 3, second to last sentence, page 9, first full paragraph except the last line thereof. Contrast to the Petition at page 4, lines 1-5 and 7-9, page 9, lines 6-10 and page 10, first two full paragraphs.

[20] Note also prosecution history shows the same question of patentability as to claims 8 and 20 (i.e. as of 6-7-11 the claims "in effect", see footnote 7 supra, are only claims 8-10 and 20-22) and Robinson has been decided by the Office in a previous examination or pending reexamination, i.e. see discussion of the December 23, 2010 FINAL and the 6-7-11 NIRC in the '10543 proceeding supra.

[21] Contrast to the Petition at page 4, lines 1-5 and 7-9 and page 9, line 8-page 10, line 9. It is noted the portions of Robinson only cited therein and not in the Request i.e. col. 16, lines 53-58 or col. 18, lines 1-4, also do not teach recording for each advertisement the number of times viewed by a user. For example, col. 16, lines 53-58 teaches calculating an average number, i.e. not recording the actual number, of times an ad is viewed by a user, i.e. total number of all views divided by total numbers of users. Col. 18, lines 1-4 discusses the total number of times an ad is shown to users but not recording the number of views of an/each advertisement/file by a user, i.e. the number of impressions recorded is the total of all views by all users not the total of all views by a user.

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 5,991,735 has been presented in the request filed August 31, 2010 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director of Technology Center 1600
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. |
|---|---|---|---|---|
| 90/011,201 | 08/31/2010 | 5,848,396 | 8767R003E | 4812 |

22334 7590 08/15/2011

PETER F WEINBERG
GIBSON DUNN AND CRUTCHER LLP
SUITE 4200
1801 CALIFORNIA STREET
DENVER, CO 80202

| EXAMINER | |
|---|---|

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 08/15/2011

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
www.uspto.gov

Date: 8-15-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011201
PATENT NO. : 5848396
ART UNIT : 3993

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

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

United States Patent and Trademark Office

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

MAILED

AUG 15 2011

CENTRAL REEXAMINATION UNIT

PETER F. WEINBERG (For Patent Owner)
GIBSON DUNN AND CRUTCHER LLP
SUITE 4200
1801 CALIFORNIA STREET
DENVER, CO 80202

DANIEL M. DE VOS (For Requester)
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

| | |
|---|---|
| In re Gerace | : DECISION DENYING |
| Reexamination Proceeding | : PETITION UNDER |
| Control No. 90/011,201 | : 37 CFR 1.181 AND |
| For: U.S. Patent No. 5,848,396 | : 37 CFR 1.515(c) |

This is a decision on the December 29, 2010 paper entitled "PETITION FOR REVIEW UNDER 37 C.F.R. §1.181". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,848,396 (hereinafter, the '396 patent) issued on December 8, 1998 to Gerace.

2. On August 31, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-28 and new claim 29 of the '396 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,201 (hereinafter, the '11201 reexamination proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on November 29, 2010.

4. On December 29, 2010, the present petition ("Petition") was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11201 reexamination proceeding has petitioned seeking relief[1] from the Examiner's November 29, 2010 Order denying *ex parte* reexamination[2].

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

---

[1] Petitioner "requests that the Director reverse the order denying the Second Request for each of the SNQs discussed herein, and further requests the consolidation of the 90/011,201 reexamination with the pending 90/010,544 reexamination under 37 C.F.R. § 1.565(c)." (Page 11 of the Petition.)

[2] The Petition sets forth:

> The order denying the Second Request mailed November 29, 2010, determined that the **requested SNQs** based on the *Herz* patent and the *Robinson* patent do not raise SNQs with regard to the currently confirmed claims, because the new prior art references do not teach the claim limitations.
>
> However, Requester respectfully submits that the new prior art **sufficiently** teaches the limitations of the currently confirmed claims so as to raise **new and different SNQs**.
>
> Specifically, Requester presents the following issues to be reviewed:
>
> Issue 1: *Herz* raises an SNQ under 35 USC § 102 with respect to currently confirmed Claim 7 and the combination of *Herz* and *Rose* raise an SNQ under 35 USC § 103 for Claims 8-9; and
>
> Issue 2: *Robinson* raises an SNQ under 35 USC § 102 with respect to confirmed Claim 7.
>
> (Bold and underlining emphasis added.) (Page 5 of the Petition.)

Note also footnotes 5 and 9 *infra.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the August 31, 2010 **request** for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the 8-31-10 **request** for reexamination of the '396 patent filed in the '11201 reexamination proceeding has been found not to present any SNQ. Therefore, the Examiner's decision to deny reexamination is proper.

The '396 patent matured from application number 08/634,900 (the '900 application) which is the parent of U.S. Patent No. 5,991,735.[3] On May 28, 1998, the examiner allowed claims 1-28. The Notice of Allowance included the following examiner's statement of reasons for allowance:

> [As to claim 1,] a tracking and profiling member responsive to the data assembly upon display of requested agate information in response to a user viewing requested agate information, the tracking and profiling member recording indications of user's physical activity during viewing of the displayed requested agate information including user response to the displayed requested agate information and as such generating a psychographic profile of the user;
>
> [As to claim 9, renumbered claim 10,] from the recorded indications of physical activities and responses of the user, creating user profiles, each user profile providing an indication of categories of interest to the user and display preferences for each category; and
>
> [As to claim 13, renumbered claim 14,] recording computer activity by users during display and user viewing of the certain pieces of information, said computer activity including physical activity and response by the user during viewing of the certain pieces of information.
>
> Hence, forestated reasons make the said independent claims 1, 9 and 13 allowable over the prior art of record.

[3] See footnotes 1 and 2 of the Petition.

On May 18, 2009, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-28 of the '396 patent be reexamined. This reexamination proceeding was assigned Control No. 90/010,544 (hereinafter, the '10544 reexamination proceeding). In such request of the '10544 reexamination proceeding, the section of the request entitled "Statements Pointing Out Each Substantial New Question of Patentability (SNQ) Pursuant to 37 C.F.R. § 1.510(b)" (see pages 8-19), set forth requester's position that the references, i.e. patents or printed publications, cited in the request (i.e. Dedrick, **Rose**, Sheth, Wilkins and Imaide) raise a substantial new question of patentability as to original claims 1-28 of the '396 patent, i.e. namely disclose "...the purportedly novel feature claimed in the 396 patent of recording indications of user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user." The USPTO mailed an Order Granting Request for *Ex Parte* Reexamination on July 30, 2009.[4] A non-final Office Action was mailed by the USPTO on January 29, 2010 in which original claims 1-6 and 10-28 were rejected, and original claims 7-9 were confirmed. The Patent Owner filed an IDS on March 22, 2010, citing **Herz** (U.S. Patent No. 5,754,939, hereinafter referred to as Herz or '939), **Robinson** (U.S. Patent No. 5,918,014, hereinafter referred to as Robinson or '014) and **Bull** (U.S. Patent No. 5,901,287, hereinafter referred to as Bull or '287). On March 29, 2010, the Patent Owner also filed a response, in which original claims 1-6 and 10-28 were unamended but new claim 29 was added. An *ex parte* reexamination Interview was conducted on July 22, 2010. An Interview Summary by the Examiner was mailed by the USPTO on August 2, 2010, and Patent Owner's Interview Summary was filed on August 20, 2010.

Turning back to the '11201 reexamination proceeding, on August 31, 2010, the request, i.e. a second request, for *ex parte* reexamination was deposited by the same third party requester requesting not only claims 1-28 of the '396 patent but also new claim 29 added in the '10544 proceeding be reexamined. An Order denying this second Request was mailed by the USPTO on November 29, 2010.

Subsequent to the denial of the Order in the '11201 proceeding, a FINAL rejection was mailed by the USPTO on December 23, 2010 in the '10544 proceeding not only maintaining the previous rejections, but also setting forth "**Herz**, **Robinson** and **Bull** raise a non-cumulative Substantial New Question (SNQ) of patentability because it provides a technical teaching not previously on record. Accordingly, rejections based on **Herz**, **Robinson** and **Bull** are presented herein." (Note the nature of the SNQ and technical teaching were not set forth) and adding new rejections as to such rejected claims also based on this prior art. However, claims 7-9 remained confirmed.[5] The FINAL set forth:

---

[4] Note the paragraph bridging pages 7-8, page 11, second full paragraph, page 12, 2nd full paragraph, page 14, first full paragraph, page 16, fourth full paragraph and page 18, first full paragraph of the 7-30-09 Order in the '10544 proceeding.

[5] Compare to the Petition at page 6, first full paragraph, first sentence, and the last paragraph on page 8, first sentence thereof.

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

...

Herz discloses a high interest search profiles for each user (Herz, 56:14-17). Herz further discloses monitoring "which articles the user read, keeping track of how many pages of text are viewed by the user, how much time is spent viewing the article, and whether all pages of the article were viewed [, and] [t]his information can be combined to measure the depth of the user's interest in the article, yielding a passive relevance feedback score" (Herz, 58:56-62). Herz discloses providing positive relevance feedback when a consumer buys a product (Col. 60, ll. 64 to Col. 61, l. 6). However, Herz does not disclose "for each advertisement recording," the "number of times viewed" or "number of times selected" or "number of times a purchase was obtained through the advertisement".

Robinson discloses "pages visited; length of time spent on the page; amount of money spent by the user; identifier of the ad displayed to the user in the Smart Ad Box; whether or not the user clicked on the ad; whether or not the user rejected the ad; or an identifier of each particular item purchased" (Robinson, 9:21-35). However, Robinson does not disclose for each advertisement, number of times viewed, or number of times selected or number of times a purchase was obtained through the advertisement.

Bull is directed to a system that analyzes a user's profile and session looking activity against a profile established by a supplier. When the profile is approximately matched, the supplier is notified so it can contact the user to offer goods or services (Bull, 14:10-20). However, Bull is silent as to "recording for each advertisement.., the number of times viewed, selected or number of times a purchase was obtained through the advertisement" as recited in Claim 7.

Therefore, ...Herz, Bull or Robinson do not disclose or suggest, alone or in combination:

**Regarding claim 7**, "the advertisement component further records history of users viewing the advertisements, including for each advertisement, at least one of (i) number of times viewed by a user, (ii) number of times selected for further information, and (iii) number of times a purchase was obtained through the advertisement", in combination with the other elements and features of the claimed invention.

**As for claims 8-9**, these claims are dependent on claim 7, therefore, the same

reasons applied to claim 7 apply as well for these claims.

On March 28, 2011, a Notice of Intent to Issue *Ex Parte* Reexamination Certificate ("NIRC") was mailed by the USPTO as a consequence of Patent Owner's failure to respond to the Final Rejection mailed on December 23, 2010, which set a statutory period to respond of two months. The NIRC, by Examiner's Amendment, cancelled original claims 1-6 and 10-28 as well as new claim 29 which were subject to rejection in the Office action mailed December 23, 2010 that Patent Owner failed to timely respond to. Accordingly the NIRC set forth the status of claims as: "Original claims 7-9 are confirmed. Original claims 1-6 and 10-28 have been canceled. New claim 29 has been cancelled." A "STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION" set forth the same reasons as those set forth in the FINAL rejection discussed *supra*. The *Ex Parte* Reexamination Certificate for the '10544 proceeding issued on June 14, 2011 as US 5,848,396 C1 confirming the patentability of claims 7-9.[6]

Continuing with the '11201 proceeding, the section of the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-21, esp. the first full paragraph of page 7, the paragraph bridging pages 8-9, the paragraph bridging pages 10-11, page 12, first full paragraph, page 17, first full paragraph, page 19, first full paragraph, page 19, last full paragraph and page 21, last full paragraph) sets forth third party requester's position that the references cited in the request (i.e. Herz, Robinson and Bull) raise a substantial new question of patentability as to the claims, i.e. claim 7, of the '396 patent[7], namely because:

> The prior art as presented herein by Requestor clearly and unequivocally discloses the exact features identified by the Applicant and the Examiner as distinguishing from the cited art during the original prosecution of **the 396 patent.** For example, as discussed in detail below, at the time of the alleged invention and/or priority filing date of the 396 patent, the claimed recording indications of a user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from recorded indications of physical activities and responses of the user was well known in the prior art and, therefore, was well known in the prior art and, therefore, was not novel and/or non-obvious.

---

[6] Accordingly, the consolidation requested as relief by the Petition, see footnote 1 supra, is no longer available.

[7] See however footnote 2 *supra*, i.e. the Petition does not request review of issues with respect to claims 1-6 and 10-29. Note also the NIRC of the '10544 proceeding which cancelled claims 1-6 and 10-29, i.e. as of 6-14-11 the claims "in effect" are only claims 7-9 (*See* MPEP 2243, i.e. "Amendments and/or new claims presented in any copending reexamination or reissue proceeding for the patent to be reexamined will not (see MPEP § 2240, subsection II.) be considered nor commented upon when deciding a request for reexamination.", and MPEP 2240, i.e. "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. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)).")

and

> *Herz*[, *Robinson* or *Bull*] discloses the purportedly novel feature claimed **in the 396 patent** of recording indications of a user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user.
>
> (Bold and underlining emphasis added.)[8]

However, the discussion ignores the prosecution history, see *supra.* This SNQ outlined in this second request with regard to the claims, i.e. claim 7, (i.e., "the purportedly novel feature claimed in the 396 patent of recording indications of a user's physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user", e.g. pages 12, 17 and 19 of the '11201 Request) is not **different from** that raised in the pending reexamination, i.e. the '10544 proceeding, for **the claims in effect at the time of the determination** (i.e. "...the purportedly novel feature claimed in the 396 patent of recording indications of user responses and physical activity during viewing of displayed requested agate information, and generating a psychographic profile of the user from the recorded indications of physical activities and responses of the user.", e.g. pages 10 and 15 of the '10544 Request.)[9]

To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

> However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:

---

[8] Compare to the 11-29-10 Order at the paragraph bridging pages 5-6, page 7, first full paragraph and the paragraph bridging pages 9-10.

[9] Compare to the 11-29-10 Order at page 5, second and fourth full paragraphs, page 6, first-third paragraphs, page 7, first-third paragraphs, page 9, last full paragraph, and page 10, first full paragraph and the Petition at page 3, second full paragraph, last sentence thereof and page 6, second full paragraph, line 1.

> This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.
>
> Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:
>
> [The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.
> *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

as is MPEP 2240, DECISION ON REQUEST, 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...
>
> ...
>
> ...However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination.** The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

and MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

> The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.
>
> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, **unless** *the same question of patentability has already been decided*...(B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. ...
>
> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" **unless** *the same question of patentability has already been decided as to the claim*...by the Office in a previous examination. ...For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim....
>
> (Emphasis added.)

Returning to the '11201 proceeding and claim 7 with respect to the Herz reference, the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-21, esp. page 12, first full paragraph and page 13, first full paragraph, and thereby also pages 36-37 of the Request and Exhibit CC-A at pages 11-12) sets forth third party requester's position that Herz raises a further substantial new question of patentability as to claim 7 of the '10544 proceeding:

> In addition, ... *Herz* raises an SNQ different from that **in the pending 90/010,544 reexamination**, because *Herz* more explicitly discloses the requirements of Claim 7.
>
> (Bold and underlining emphasis added.)

More specifically:

> *Herz* discloses that the advertising component further records the history of users viewing the advertisements, including for each advertisement, at least one of (i) number of times is viewed by a user, (ii) number of times selected for further information and (iii) number of times a purchase was obtained through the advertisement. As discussed above with respect to Claim 1, *Herz* discloses the news clipping service (e.g., including advertisements as well as news articles), which as disclosed in the *Herz* patent stores a set of high-interest search profiles for each user in which the search profiles associated with a given user can change over time. *See*, e.g., *Herz*, 56:14-17 ("The news clipping service instantiates target profile interest summaries as search profile sets, so that a set of high interest search profiles is stored for each user. The search profiles associated with a given user change over time."). After the system delivers the newspaper articles to the user, ***the user's search profiles set generator monitors "which articles the user read, keeping track of how many pages of text are viewed by the user, how much time is spent viewing the article, and whether all pages of the article were viewed [, and] [t]his information can be combined to measure the depth of the user's interest in the article, yielding a passive relevance feedback score.***" *Herz*, 58:56-62 (emphasis added). *See also Herz*, 60:7-9 ("The news clipping service may deliver news articles (or advertisements and coupons for purchasables) to off-line users as well as to users who are on-line.") (emphasis added) and 60:16-22 ("In one application, the news clipping service chooses a set of news articles (respectively, advertisements and coupons) that are predicted to be of interest to user U. thereby determining the content of a customized newspaper (respectively, advertising/coupon circular) that may be printed and physically sent to user U. via other methods.").
>
> *Herz* further discloses an application for "paying advertisers, who may be companies or individuals, are the source of advertisements or other messages, ***which take the place of news articles in the news clipping service. A consumer who buys a product is deemed to have provided positive relevance feedback on advertisements for the product, and a consumer who buys a product***

> ***apparently because of a particular advertisement (for example, by using a coupon clipped from that advertisement)is deemed to have provided particularly high relevance feedback on that advertisement.***" *Herz*, 60:64-61:6. (Emphasis added).[10]

However, such portions of Herz cited by the request do not present the technological teachings alleged by the third party requester that a reasonable examiner would consider important in whether the claims are patentable, i.e. the cited technological teachings of the prior art patents and/or printed publications do not raise a/the substantial question of patentability regarding at least one claim.[11,12]

To this point, MPEP 2216, Substantial New Question of Patentability, is instructive:

> Under 35 U.S.C. 304, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised. 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 prior patents and printed publications." If such a new question is found, an order for ex parte reexamination of the patent is issued. It is therefore important that the request clearly set forth in detail what the requester considers the "substantial new question of patentability" to be in view of prior patents and printed publications. The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office.
>
> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.
>
> (Emphasis added.)

---

[10] Compare to the 11-29-10 Order at page 7, line 11-page 8, line 6 and page 8, line 10-page 9, line 1 and the Petition at page 6, fifth line from bottom-page 8, line 2. However, note the Request did not cite or discuss Herz at col. 12, lines 18-21 or col. 44, lines 16-19 as does the Petition.

[11] Compare to the 11-29-10 Order at page 6, last full paragraph, page 8, lines 6-9 and page 9, lines 1-6 and the Petition at page 3, last full sentence, page 6, second full paragraph except the last line thereof. Contrast to the Petition at page 4, lines 3-6 and 9-10, page 6, lines 18-21 and page 8, first two full paragraphs.

[12] Note also the prosecution history shows the same question of patentability as to claim 7 (i.e. as of 6-14-11 the claims "in effect", see footnote 7 supra, are only claims 7-9) and Herz has been decided by the Office in a previous examination or pending reexamination, i.e. see discussion of the December 23, 2010 FINAL and the 6-14-11 NIRC in the '10544 proceeding *supra*.

as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:, *see supra.*

Specifically, claim 7 requires, e.g., an advertisement component which records history of "users" viewing advertisements, "including for **each** advertisement...(i) **number of times viewed** *by a user*" (Emphasis added) (Note also the '396 patent at col. 5, lines 27-29 which discloses recording the number of times the advertisement is displayed, the number of **users** ( as compared to a user) to whom the advertisement is displayed or both). The cited portions of the Request, esp. Herz, col. 58, lines 56-62, do not disclose recording the number of times each advertisement is viewed by a user as compared to, e.g., which advertisements are read and the page and time viewing specifics thereof.[13]

Returning to the '11201 proceeding and claims 8-9 with respect to the Herz and Rose references[14], the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-21, esp. the paragraph bridging pages 13-14, first sentence, page 14, first full paragraph, and the paragraph bridging pages 14-15 and thereby also pages 49-54 of the Request and Exhibit CC-B, pages 2-6) sets forth third party requester's position that Herz and Rose raise a further substantial new question of patentability as to claims 8-9 of the '10544 proceeding:

> In addition, ... *Herz* in view of *Rose* raises an SNQ different from that **in the pending 90/010,544 reexamination**, because *Herz* in view of *Rose* more explicitly discloses the requirements of Claims 8 and 9.
>
> (Bold and underlining emphasis added.)

More specifically:

> *Rose* discloses performing a regression analysis on a history of users viewing electronic information. For example, *Rose* discloses ranking the relevance of items of information to be presented to a user by performing a regression analysis of attribute-based and correlation-based factors for each item of information. *See, e.g., Rose*, Abstract ("regression analysis ... can be carried out with respect to various factors pertaining to document content and user correlation, to generation a prediction of relevance. The user correlation data is

---

[13] Contrast to the Petition at page 4, lines 3-6 and 9-10 and page 6, eighth line from the bottom-page 8, line 2. It is noted the portions of Herz only cited therein and not in the Request i.e. col. 12, lines 18-21 or col. 44, lines 16-19, also do not teach recording for each advertisement the number of times viewed by a user. For example, col. 12, lines 18-21 are part of the paragraph beginning at lines 3-5 which set forth, "[it is worth noting some additional attributes that are of interest in some domains. In the case of documents and certain other domains..." but does not teach the advertisement domain. Col. 44, lines 16-19 of Herz discusses estimating costs and benefits of "prefetching" files, i.e. records the number of requests of files of a cluster(s) by users of the cluster(s) not, e.g., recording the number of views of an/each advertisement/file by a user, with regard to **prefetching** files.

[14] See footnote 2 *supra* again, i.e. the Petition does not request review of issues with respect to claims 13-16 and 19-28, and note the NIRC of the '10544 proceeding which cancelled claims 13-18 and 19-28, i.e. as of 6-14-11 the claims "in effect", see footnote 7 *supra*, are only claims 7-9.

> obtained from feedback information provided by users when they retrieve items of information."), 2:41-45 ("Other information evaluation techniques, such as multiple regression analysis ... can ... be employed to evaluate various factors pertaining to document content and user correlation, and thereby generate a prediction of relevance."), and 7:41-50 ("Other approaches which take into account both the attribute-based information and user correlation information can be employed. For example, multiple regression analysis can be utilized to combine the various factors. In this approach, regression methods are employed to identify the most important attributes that are used as predictors, e.g., salient terms in a document and users having similar feedback responses, and how much each one should be weighted. Alternatively, principal components analysis can be used to identify underlying aspects of content-based and correlation-based data that predict a score.").[15]

However, the teachings of Rose outlined in the '11201 request, see, e.g., *supra,* were considered and discussed in the '10544 reexamination proceeding for the same reasons, see, esp., the first full paragraph of page 12 of the 5-18-09 Request of the '10544 proceeding.[16]

To this point, MPEP 2216, Substantial New Question of Patentability, discussed supra, is again instructive, i.e.:

> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.
>
> The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office **if the reference is presented in a new light or a different way that escaped review during earlier examination**....
>
> After the enactment of the Patent and Trademark Office Authorization Act of 2002 ("the 2002 Act"), a substantial new question of patentability can be raised by patents and printed publications "previously cited by or to the Office or considered by the Office" ("old art"). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002

[15] Compare to the 11-29-10 Order at page 8, last paragraph.
[16] Compare to the 11-29-10 Order at page 8, last paragraph and the Petition at page 8, third full paragraph.

> Act, MPEP § 2242, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, but only if the old art is "**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.)

as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim...by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim....
>
> (Emphasis added.)

For the reasons discussed *supra* with regard to Herz[17] and because the technological teachings of Rose are not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e.

---

[17] Contrast to the petition at page 8, third full paragraph. Note such paragraph premises the combination raising a SNQ due to at least the reasons set forth with regard to claim 7 and Herz.

obviousness of the same claim limitations, during a prior proceeding involving the patent for which reexamination is requested, the combination thereof does not raise does not raise a substantial new question of patentability.[18]

Returning to the '11201 proceeding finally with respect to claim 7 and the Robinson reference, the 8-31-10 request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY (SNQs)" (pages 2-21, esp. page 17, second full paragraph and page 19, first full paragraph, and thereby also pages 96 and 100-101 of the Request and Exhibit CC-C at pages 7-8) sets forth third party requester's position that Robinson raises a further substantial new question of patentability as to claim 7 of the '10544 proceeding:

> In addition, ... *Robinson* raises an SNQ different from that **in the pending 90/010,544 reexamination**, because *Robinson* more explicitly discloses the requirements of Claim 7.
>
> (Bold and underlining emphasis added.)

More specifically:

> In particular, *Robinson* discloses a "Smart Ad Box", which is an area on a web page that is used to display Web advertising (e.g., classified advertisements). *See, e.g., Robinson*, 4:8-10; *see also Robinson Provisional* at 2 (describing the "Smart Ad Box" as also quoted above)....
>
> Claim 7 depends on Claim 5 ... *Robinson* discloses that the advertisement module further records history of users viewing the advertisements, including for each advertisement, at least one of (i) number of times viewed by a user, (ii) number of times selected for further information, and (iii) number of times a purchase was obtained through the advertisement. In particular, the system tracks the activities of the user in the interactive medium (e.g., interactions/clicking of advertisements on a web page). *See, e.g., Robinson*, 8:61-11:25 ("Tracking Users" section); *see also Robinson Provisional* at 9-14 ("Tracking Users" section). Various types of information regarding the user's Web interactions include: pages visited; length of time spent on the page; amount of money spent by the user; identifier of the ad displayed to the user in the Smart Ad Box; whether or not the user clicked on the ad; whether or not the user rejected the ad; or an identifier of each particular item purchased. *Robinson*, 9:21-35; *see also Robinson Provisional* at 10. "Every time a user visits a tracking-enabled page, a central database will be updated to show that that 74

[18] Compare to the 11-29-10 Order at page 8, third full paragraph and contrast to the Petition at page 8, third full paragraph.

particular user visited the page." *Robinson*, 9:8-10; *see also Robinson Provisional* at 10 (same quote).[19]

However, such portions of Robinson cited by the request also do not present the technological teachings alleged by the third party requester that a reasonable examiner would consider important in whether the claims are patentable, i.e. the cited technological teachings of the prior art patents and/or printed publications do not raise a/the substantial question of patentability regarding at least one claim.[20,21]

To this point, MPEP 2216, Substantial New Question of Patentability, as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:, *see* supra, are again instructive.

Specifically, claim 7 requires, e.g., an advertisement component which records history of "users" viewing advertisements, "including for **each** advertisement...(i) **number of times viewed** *by a user*" (Emphasis added) (Note also the '396 patent at col. 5, lines 27-29 which discloses recording the number of times the advertisement is displayed, the number of **users** ( as compared to a user) to whom the advertisement is displayed or both). The cited portions of the Request, esp. Robinson, col. 8, line 61-col. 11, line 25, do not disclose recording the number of times each advertisement is viewed by a user as compared to, e.g., which web pages containing advertisements are visited and page viewing specifics thereof.[22]

---

[19] Compare to the 11-29-10 Order at page 10, line 9-page 11, line 15 and the Petition at page 9, line 6-page 10, fourth to last line. However, note the Request did not cite or discuss Robinson at col. 16, lines 53-58 or col. 18, lines 1-4 as does the Petition.

[20] Compare to the 11-29-10 Order at page 9, last full paragraph, page 11, lines 15-17 and the Petition at page 3, last full sentence, page 9, first full paragraph except the last line thereof. Contrast to the Petition at page 4, lines 3-7 and 9-10, page 9, lines 4-8, page 10, last full paragraph and page 11, first full paragraph.

[21] Note also prosecution history shows the same question of patentability as to claim 7 (i.e. as of 6-14-11 the claims "in effect", see footnote 7 supra, is only claim 7) and Robinson has been decided by the Office in a previous examination or pending reexamination, see discussion of the December 23, 2010 FINAL and the 6-14-11 NIRC in the '10544 proceeding *supra*.

[22] Contrast to the Petition at page 4, lines 3-7 and 9-10 and page 9, line 6-page 10, fourth to last line. It is noted the portions of Robinson only cited therein and not in the Request i.e. col. 16, lines 53-58 or col. 18, lines 1-4, also do not teach recording for each advertisement the number of times viewed by a user. For example, col. 16, lines 53-58 teaches calculating an average number, i.e. not recording the actual number, of times an ad is viewed by a user, i.e. total number of all views divided by total numbers of users. Col. 18, lines 1-4 discusses the total number of times an ad is shown to users but not recording the number of views of an/each advertisement/file by a user, i.e. the number of impressions recorded is the total of all views by all users not the total of all views by a user.

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 5,848,396 has been presented in the request filed August 31, 2010 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director of Technology Center 1600
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

Murphy & King Professional Corporation
1055 Thomas Jefferson Street, NW
Suite 400
Washington, DC 20007

For Patent Owner

MAILED

JAN 07 2011

CENTRAL REEXAMINATION UNIT

2nd Reexam Group
Novak Druce & Quigg, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

For 3rd Party Requester
90/011,205

Lerner, David, Littenberg, Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

For 3rd Party Requester
90/011,253

*Ex Parte* Reexamination Proceeding
Control No. 90/011,205
Filed: September 2, 2010
For: U.S. Patent No. 5,471,967

*Ex Parte* Reexamination Proceeding
Control No. 90/011,253
Filed: September 22, 2010
For: U.S. Patent No. 5,471,967

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/011,205 and 90/011,253 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. 90/011,205 was ordered in a decision mailed September 30, 2010, granting reexamination of claims 1-18, all of the claims appearing in US Patent No. 5,471,967. Patent owner file a letter on November 30, 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. 90/011,253 was ordered in a decision mailed October 13, 2010, indicating that claims 1-18, all of the claims appearing in US patent No. 5,471,967 would be reexamined. Patent owner file a letter on December 13, 2010 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. 90/011,205 and reexamination control No. 90/011,253 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.

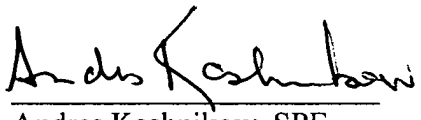
**Conduct of Proceedings**

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-18, all of the claims in US patent No. 5,471,967, 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. 90/011,205 and 90/011,253 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

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. |
|---|---|---|---|---|
| 90/011,208 | 10/29/2010 | 5251294 | 1144-004 | 1201 |

26980 7590 02/28/2011

Lawrence A. Aaronson, P.C.
Lawrence A. Aaronson
12850 Highway 9
Suite #600 PMB 338
Alpharetta, GA 30004

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MICHAEL N. HAYNES
1341 HUNTERSFIELD CLOSE
KESWICK, VA 22947

Date: MAILED

FEB 23 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011208
PATENT NO. : 5251294
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

(For Patent Owner)

MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

LAWRENCE A. AARONSON, P.C.
12850 HWY. 9
SUITE 600-PMB-338
ALPHARETTA, GA 30004

(For Third Party Requester)

MICHAEL N. HAYNES
1341 HUNTERSFIELD CLOSE
KESWICK, VA 22947

(For Third Party Requester)

TOWNSEND AND TOWNSEND AND CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

| | |
|---|---|
| *In re* Abelow | : |
| Reexamination Proceeding | : DECISION *SUA SPONTE* |
| Control No. 90/011,208 | : MERGING |
| Corrected Request Deposited: October 29, 2010 | : REEXAMINATION |
| For: U.S. Patent No. 5,251,294 | : PROCEEDINGS |
| | |
| *In re* Abelow | : |
| Reexamination Proceeding | : |
| Control No. 90/011,229 | : |
| Request Deposited: September 22, 2010 | : |
| For: U.S. Patent No. 5,251,294 | : |

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. 5,251,294 (hereinafter, the '294 patent), issued to Abelow, on October 5, 1993.

2. On September 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '294 patent. The reexamination proceeding was assigned Control No. 90/011,229 (hereinafter, the '11229 proceeding).

3. The Reexamination Order was granted in the '11229 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 28-33, 35, 37, 40-44, 47, 48, 51, 53, 55, 58, 64, and 65.

4. On October 29, 2010, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '294 patent. The reexamination proceeding was assigned Control No. 90/011,208 (hereinafter, the '11208 proceeding).

5. The Reexamination Order was granted in the '11208 proceeding on December 17, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-8, 12-21, 28, 29, 31-33, 37, 40-44, 47, 53, 55, and 78.

6. 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 '11208 and '11229 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 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. 90/011,208 and 90/011,229 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,217 | 10/11/2010 | 6594565 | INPOF 102 | 6305 |

7590 06/29/2011

CHARLES L. THOEMING
BIELEN, LAMPE & THOEMING
1390 WILLOW PASS ROAD
SUITE 1020
CONCORD, CA 94502

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/29/2011

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
KREMBLAS & FOSTER
7632 SLATE RIDGE BOULEVARD
REYNOLDSBURG, OH 43068

Date: MAILED

JUN 2 9 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011217
PATENT NO. : 6594565
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 29 2011

CENTRAL REEXAMINATION UNIT

Charles L. Thoeming : (For Patent Owner)
Bielen, Lampe & Thoeming :
1390 Willow Pass Road :
Suite 1020 :
Concord, CA 94502 :

Frank H. Foster : (For Requester)
Kremblas, Foster, Phillips and Pollick :
7632 Slate Ridge Blvd. :
Reynoldsburg, Ohio 43068 :

*In re Shafer et al.*. :
*Ex Partes* Reexamination Proceeding : **DECISION ON**
Control No. 90/011,217 : **PETITION UNDER**
Filed: October 11, 2010 : **37 CFR 1.181**
For: U.S. Patent No. 6,594,565 :

This is a decision on a petition filed by the patent owner on June 10, 2011. The petition is entitled "PETITION UNDER 37 CFR § 1.181(a)(1) and (3) to Obtain Review of a Non-Appealable Decision by Examiner" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the after-final amendments filed on May 11 and May 26, 2011.

The petition is before the Group Director overseeing the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 10, 2011 is denied with respect to entry of the after-final amendments filed on May 11 and May 26, 2011.

## REVIEW OF FACTS

1. U.S. Patent No. 6, 594,565 (hereinafter, the '565 patent) issued on July 15, 2003.

2. On October 11, 2010, a third party requester deposited a request for ex *partes* reexamination for claims 18-22 of the '565 patent, and the resulting reexamination proceeding was assigned Control No. 90/011,217 (hereinafter, the '217 reexamination proceeding).

3. On November 18, 2010, an order granting the request for reexamination for claims 21 and 22 of the '565 patent was mailed. The examiner did not agree that a substantial new question of patentability (SNQ) was raised for claims 18-20.

4. On December 21, 2010, a non-final Office action was mailed rejecting claims 18 and 20-22. The examiner added a SNQ for claims 18 and 20 (see page 4 of the non-final Office action).

5. On January 21, 2011, patent owner filed a response to the non-final Office action, No amendments to claims 18 and 20-22 were filed. New claims 23-30 were added.

6. On April 12, 2011, a final Office action was mailed. Claims 18 and 20-30 were finally rejected.

7. On May 11, 2011, patent owner filed an after-final response to the final Office action as well as a Notice of Appeal. The response included new claims 31-38.

8. On May 23, 2011, an advisory action was mailed. The action indicated that the proposed after-final amendment would not be entered because it presented additional claims without canceling a corresponding number of finally rejected claims. The action also indicated that the proposed after-final amendment did not comply with 37 CFR 1.530(f)(2) because claims 23-30 were not underlined and claims 11-13 were canceled in the previous reexamination proceeding, but had been represented as original claims.

9. On May 26, 2011, patent owner filed a second after-final response to the final Office action.

10. On June 6, 2011, a second advisory action was mailed. The action indicated that the proposed after-final amendment would not be entered because it presented additional claims without canceling a corresponding number of finally rejected claims. The action also indicated that although the amended claims now complied with 37 CFR 1.530(f)(2), they would not be entered because claims 31-38 were additional claims presented without canceling a corresponding number of finally rejected claims.

11. On June 10, 2011, patent owner filed the instant petition under 37 CFR § 1.181.

## DECISION

The patent owner (petitioner) argues that new claims 31-38 were "expressly directed to the merits of the patent under reexamination, and more specifically highlighting the disclosed Intelligent Lift Interlock System. . .' (see page 5 of the petition). Petitioner also argues that proposed new claims 31-38 "were first presented in the response to the final Office action when the examiner took the position that the Khan reference [U.S. Patent 2,812,827] 'teaches the equivalence of the neutral position of the transmission to the park position in the case of so called automatic transmissions'" (see page 6 of the petition). Petitioner also argues that, in the same final Office action, the examiner stated that "Khan discloses 'that neutral in a manual transmission vehicle is equivalent to park in a manual transmission" that "Khan combined with Hanson 'prevent(s) the vehicle from being inadvertently operated" and that "Khan 'specifically states that it is know to include park in an automatic transmission vehicle" (see pages 6-7 of the petition).

Patent owner then argues that in its response to the final Office action, patent owner underscored the arguments previously made in the response to the first Office action and reiterated the argument with additional proposed claims 31-38 (see page 7 of the petition). Patent owner then states that an adequate showing of good and sufficient reasons why the amendment proposing additional claims 31-38 is necessary and was not earlier presented under 37 CFR § 116(b)(3) has been made, and proposed amended claims 31-38 should be added to the claims presented in the appeal of the final rejection or referred back to the examiner for further prosecution relating to new claims 31-38 (see pages 7-8 of the petition).

In response to patent owner's arguments, the director finds there are not good and sufficient reasons to enter the proposed after-final amendments . First, 35 U.S.C. 305 requires that all *ex parte* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a final rejection and for consideration of after final responses. See MPEP 2272.

Upon review of the entire record, it is determined that the examiner appropriately applied Office policies and procedures in determining that the after-final amendments of May 11 and 26 should not be entered. The patent owner had an opportunity to enter amendments as of right following the non-final Office action of December 21, 2010. As aptly pointed out by the examiner in the advisory actions mailed May 23 and June 6, 2011, patent owner has presented new claims without the cancelation of a corresponding number of finally-rejected claims. 37 CFR § 1.116 and 41.33(a) are clear that additional claims cannot be presented without canceling a corresponding number of finally rejected claims.

In the petition, patent owner alleges that the new claims were added to "underscore the arguments previously made in the response to the first Office action and reiterated the argument." Turning to the facts in this proceeding, the final rejection of April 12, 2011 sets forth new grounds of rejection that were necessitated by amendment (see the final Office action). However, patent owner's argument does not constitute good and sufficient reasons for why the

amendment was not earlier presented. The examiner's final rejection was proper. Patent owner is not entitled to have a new claims entered after a final rejection simply because the examiner set forth a new grounds of rejection in the final rejection and patent owner wishes to underscore and reiterate previously set forth arguments. It is also noted that in both advisory.actions, the examiner has indicated that she fully considered the amendments but continues to maintain her rejections and declines to enter the amendment. It should also be noted that disagreement with the examiner's rejections is an appealable matter, not a petitionable matter.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the after-final amendments filed May 11 and 26, 2011 .

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is denied.

## CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the after-final amendments dated May 11 and 26, 2011 is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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. |
|---|---|---|---|---|
| 90/011,228 | 09/13/2010 | 5530469 | 20001306-0002-007 | 9052 |

545 7590 03/16/2011

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York, NY 10022-6030

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/16/2011

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
SNR DENTON US LLP
P O BOX 061080
WACKER DRIVE STATION, WILLIS TOWER
CHICAGO, IL 60606-1080

Date:

MAILED

MAR 16 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011228
PATENT NO. : 5530469
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

(For Patent Owner)

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York NY 10022-6030

MAILED

MAR 16 2011

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

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

(For Third Party Requester)

THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

*In re* Garfinkle
Reexamination Proceeding
Control No. 90/011,228
Request Deposited: September 13, 2010
For: U.S. Patent No. 5,530,469

*In re* Garfinkle
Reexamination Proceeding
Control No. 90/011,240
Request Deposited: September 29, 2010
For: U.S. Patent No. 5,530,469

: 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. 5,530,469 (hereinafter, the '469 patent), issued to Garfinkle, on June 25, 1996.

2. On September 13, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '469 patent. The reexamination proceeding was assigned Control No. 90/011,228 (hereinafter, the '11228 proceeding).

3. The Reexamination Order was granted in the '11228 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6.

4. On September 29, 20100, a third party requester deposited a Request for *Ex Parte* Reexamination of the '469 patent. The reexamination proceeding was assigned Control No. 90/011,240 (hereinafter, the '11240 proceeding).

5. The Reexamination Order was granted in the '11240 proceeding on November 10, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6.

## 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 '11228 and '11240 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 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. 90/011,228 and 90/011,240 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,229 | 09/13/2010 | 5251294 | 028552-000100US | 1001 |

21921 7590 02/28/2011

DOV ROSENFELD
5507 COLLEGE AVE
SUITE 2
OAKLAND, CA 94618

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER,
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:

MAILED

FEB 23 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011229
PATENT NO. : 5251294
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

(For Patent Owner)

LAWRENCE A. AARONSON, P.C.
12850 HWY. 9
SUITE 600-PMB-338
ALPHARETTA, GA 30004

(For Third Party Requester)

MICHAEL N. HAYNES
1341 HUNTERSFIELD CLOSE
KESWICK, VA 22947

(For Third Party Requester)

TOWNSEND AND TOWNSEND AND CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834

MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

*In re* Abelow
Reexamination Proceeding
Control No. 90/011,208
Corrected Request Deposited: October 29, 2010
For: U.S. Patent No. 5,251,294

*In re* Abelow
Reexamination Proceeding
Control No. 90/011,229
Request Deposited: September 22, 2010
For: U.S. Patent No. 5,251,294

: 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. 5,251,294 (hereinafter, the '294 patent), issued to Abelow, on October 5, 1993.

2. On September 22, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '294 patent. The reexamination proceeding was assigned Control No. 90/011,229 (hereinafter, the '11229 proceeding).

3. The Reexamination Order was granted in the '11229 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 28-33, 35, 37, 40-44, 47, 48, 51, 53, 55, 58, 64, and 65.

4. On October 29, 2010, a third party requester deposited a corrected Request for *Ex Parte* Reexamination of the '294 patent. The reexamination proceeding was assigned Control No. 90/011,208 (hereinafter, the '11208 proceeding).

5. The Reexamination Order was granted in the '11208 proceeding on December 17, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-8, 12-21, 28, 29, 31-33, 37, 40-44, 47, 53, 55, and 78.

6. 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 '11208 and '11229 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 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. 90/011,208 and 90/011,229 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,231 | 09/14/2010 | 5,828,420 | | 1972 |

75563 7590 02/17/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2011

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
TONY D. CHEN
CHEN YOSHIMURA L.L.P.
255 S. GRAND AVE., # 215
LOS ANGELES, CA 90012

Date:
MAILED
FEB 17 2011
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011231
PATENT NO. : 5828420
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.: 90/011,231 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED 08 February 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 14 January 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: _____.

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 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 notes previously scheduled meetings, some outside the country, met with experts and scheduled an interview.

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 proceedings before counsel, 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 inter partes 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 other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Further, while the personal interview is noted, interviews are not considered to support great weight when considering "sufficient cause" for the purpose of extensions of time

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 has "sufficient cause" to grant one (1) month.

The petition for extension of time is hereby granted.

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. |
|---|---|---|---|---|
| 90/011,231 | 09/14/2010 | 5,828,420 | 003597-0003-501 | 1972 |

75563 7590 02/17/2012

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

TONY D. CHEN
CHEN YOSHIMURA LLP
255 S. GRAND AVE., #215
LOS ANGELES, CA 90012

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,231*.

PATENT NO. *5,828,420*.

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

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

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

Ropes & Gray LLP (Patent Owner)
Patent Docketing 39/361
1211 Avenue of the Americas
New York, NY 10036-8704

Tony D. Chen (For Requester)
Chen Yoshimura LLP
255 S. Grand, #215
Los Angeles, CA 90012

In re Connie T. Marshall et al. :
*Ex Parte* Reexamination Proceeding : **DECISION GRANTING**
Control No. 90/011,231 : **PETITION UNDER**
Filed: September 14, 2010 : **37 CFR 1.137(b)**
For: U.S. Patent No. 5,828,420 :

This is a decision on the November 21, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated[1] reexamination prosecution ("the November 21, 2011 petition to revive").

The November 21, 2011 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 21, 2011 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 the written statement of interview required under 37 CFR 1.560(b) for the interview of October 12, 2011.

**35 U.S.C. 133 provides:**

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

**35 U.S.C. 305 provides, in pertinent part:**

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

**37 CFR 1.137 provides, in pertinent part:**

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
>
> (d) *Terminal disclaimer.*
> *
> *
> (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

**37 CFR 1.550 provides, in pertinent part:**

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
> *
> *

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

**37 CFR 1.560(b) provides:**

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

**MPEP 2268 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), *>subsection< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

## DECISION

***The Petition Under 37 CFR 1.137(b) is Granted***

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the

filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the October 12, 2011 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 November 21, 2011, which was untimely under the circumstances. However, for the purpose of evaluating whether the November 21, 2011 petition to revive is a grantable petition, patent owner's November 21, 2011 Examiner Interview Summary satisfies item (1).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the November 21, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the November 21, 2011 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

## CONCLUSION

1. The November 21, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, of Art Unit 3992, at (571) 272-7537.

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

February 16, 2012

[2] *See*: 37 CFR 1.137(d)(3).

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. |
|---|---|---|---|---|
| 90/011,236 + 90101548 | 09/15/2010 | 6020929 | 20160-00310 | 3277 |

75563 7590 06/17/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/17/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

TONY D. CHEN
CHEN YOSHIMURA LLP
255 S. GRAND AVE., #215
LOS ANGELES, CA 90012

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,236. → 90/011548

PATENT NO. 6020929.

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

MAILED

JUN 17 2011

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

(For Third Party Requester)

Tony Chen, Chen Yoshimura LLP
255 S. Grand Ave., #215
Los Angeles, CA 90012

(For Third Party Requester)

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

| | |
|---|---|
| *In re* Marshall *et alia* | : |
| Reexamination Proceeding | : DECISION *SUA SPONTE* |
| Control No. 90/011,236 | : MERGING |
| Request Deposited: September 15, 2010 | : REEXAMINATION |
| For: U.S. Patent No. 6,020,929 | : PROCEEDINGS |
| | |
| *In re* Marshall *et alia* | : |
| Reexamination Proceeding | : |
| Control No. 90/011,548 | : |
| Request Deposited: March 7, 2011 | : |
| For: U.S. Patent No. 6,020,929 | : |

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. 6,020,929 (hereinafter, the '929 patent), issued to Marshall *et alia*, on February 1, 2000.

2. On September 15, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '929 patent. The reexamination proceeding was assigned Control No. 90/011,236 (hereinafter, the '11236 proceeding).

3. The Reexamination Order was granted in the '11236 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 1, 8-13, and 20-24.

4. A non-final office action was mailed in the '11236 proceeding on January 14, 2011.

5. On April 14, 2011, Patent Owner responded to the office action in the '11236 proceeding. No claims were amended or added.

6. On March 7, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '929 patent. The reexamination proceeding was assigned Control No. 90/011,548 (hereinafter, the '11548 proceeding).

7. The Reexamination Order was granted in the '11548 proceeding on April 4, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-24.

8. Patent Owner did not waive their right to a file a Patent Owner statement. 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 '11236, and '11548 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all merged files.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in each proceeding, each bearing an original signature, for entry in each file. 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. 90/011,236 and 90/011,548 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
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. |
|---|---|---|---|---|
| 90/011,236 | 09/15/2010 | 6020929 | 003597-0003-502 | 3277 |

75563 7590 02/17/2012

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Tony D. Chen
CHEN YOSHIMURA LLP
255 S. Grand Ave., #215
Los Angeles, CA 90012

Date: MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011236
PATENT NO. : 6020929
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

FEB 17 2012

CENTRAL REEXAMINATION UNIT

Ropes & Gray LLP (For Patent Owner)
Patent Docketing 39/361
1211 Avenue of the Americas
New York, NY 10036-8704

Tony D. Chen (For 90/011,236 Requester)
Chen Yoshimura LLP
255 S. Grand, #215
Los Angeles, CA 90012

Finnegan, Henderson, Farabow, (For 90/011,548 Requester)
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413

In re Connie T. Marshall et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,236
Filed: September 15, 2010
For: U.S. Patent No. 6,020,929

In re Connie T. Marshall et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,548
Filed: March 7, 2011
For: U.S. Patent No. 6,020,929

**DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)**

This is a decision on the November 21, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated[1] merged reexamination prosecution ("the November 21, 2011 petition to revive").

The November 21, 2011 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 21, 2011 petition to revive is **granted**.

[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 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 October 12, 2011.

## 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:**

(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 merged proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this merged reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the October 12, 2011 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 November 21, 2011, which was untimely under the circumstances. However, for the purpose of evaluating whether the November 21, 2011 petition to revive is a grantable petition, patent owner's November 21, 2011 Examiner Interview Summary satisfies item (1).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the November 21, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the November 21, 2011 patent owner petition to revive is **granted**. Prosecution in the above-identified merged reexamination proceeding will be resumed.

## CONCLUSION

1. The November 21, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of this merged reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, of Art Unit 3992, at (571) 272-7537.

---

[2] *See*: 37 CFR 1.137(d)(3).

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

February 16, 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. |
|---|---|---|---|---|
| 90/011,237 | 09/16/2010 | 6305016 | 20160-00320 | 5242 |

75563 7590 02/10/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/10/2011

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
TONY D. CHEN, CHEN YOSHIMURA LLP
255 S. GRAND AVENUE
#215
LOS ANGELES, CA 90012

Date:

MAILED

FEB 10 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011237
PATENT NO. : 6305016
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.: 90/011,237 MAILED |
|---|---|

FEB 10 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 08 February 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 14 January 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 fourteen (14) days , because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   - B. ☒ Other/comment: EOTs of more than one month are only granted in extraordinary circumstances se MPEP § 2265
   - 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) |

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 involved with other litigation as well as client meetings not related to the instant proceeding and ITC deadline.

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 traveling out of the country and a scheduled interview, the petitioner also recited other litigation and client meetings unrelated to the instant 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 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 other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time.

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 granted-in-part

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. |
|---|---|---|---|---|
| 90/011,237 | 09/16/2010 | 6305016 | 003597-0003-503 | 5242 |

75563 7590 02/17/2012

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TONY D. CHEN, CHEN YOSHIMURA LLP
255 S. GRAND AVENUE
#215
LOS ANGELES, CA 90012

Date:

MAILED
FEB 17 2012
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011237
PATENT NO. : 6305016
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

Ropes & Gray LLP
Patent Docketing 39/361
1211 Avenue of the Americas
New York, NY 10036-8704

(For Patent Owner)

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

Tony D. Chen
Chen Yoshimura LLP
255 S. Grand, #215
Los Angeles, CA 90012

(For Requester)

In re Connie T. Marshall et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,237
Filed: September 16, 2010
For: U.S. Patent No. 6,305,016

**DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)**

This is a decision on the November 21, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated[1] reexamination prosecution ("the November 21, 2011 petition to revive").

The November 21, 2011 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 21, 2011 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 the written statement of interview required under 37 CFR 1.560(b) for the interview of October 12, 2011.

**35 U.S.C. 133 provides:**

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

**35 U.S.C. 305 provides, in pertinent part:**

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

**37 CFR 1.137 provides, in pertinent part:**

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> > (1) The reply required to the outstanding Office action or notice, unless previously filed;
> > (2) The petition fee as set forth in § 1.17(m);
> > (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *
> *
> (d) *Terminal disclaimer.*
> *
> *
> (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

**37 CFR 1.550 provides, in pertinent part:**

> (d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the *ex parte* reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.
>
> (e) If a response by the patent owner is not timely filed in the Office,
> *
> *

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

**37 CFR 1.560(b) provides:**

In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

**MPEP 2268 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, all *ex parte* reexamination proceedings by section 4605 of the American Inventors Protection Act of 1999. The unintentional delay provisions of 35 U.S.C. 41(a)(7) became effective in reexamination proceedings on November 29, 2000. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee set forth in 37 CFR 1.17(m).

*

*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

See also MPEP § 711.03(c), *>subsection< III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

## DECISION

***The Petition Under 37 CFR 1.137(b) is Granted***

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the

filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the October 12, 2011 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 November 21, 2011, which was untimely under the circumstances. However, for the purpose of evaluating whether the November 21, 2011 petition to revive is a grantable petition, patent owner's November 21, 2011 Examiner Interview Summary satisfies item (1).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the November 21, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the November 21, 2011 patent owner petition to revive is **granted**. Prosecution in the above-identified reexamination proceeding will be resumed.

## CONCLUSION

1. The November 21, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, of Art Unit 3992, at (571) 272-7537.

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

February 16, 2012

[2] *See*: 37 CFR 1.137(d)(3).

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. |
|---|---|---|---|---|
| 90/011,240 | 09/29/2010 | 5530469 | | 7897 |

545 7590 03/16/2011

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York, NY 10022-6030

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 03/16/2011

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
THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

Date:

MAILED

MAR 16 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011240
PATENT NO. : 5530469
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

(For Patent Owner)

MAILED

MAR 16 2011

CENTRAL REEXAMINATION UNIT

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York NY 10022-6030

(For Third Party Requester)

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

(For Third Party Requester)

THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

*In re* Garfinkle
Reexamination Proceeding
Control No. 90/011,228
Request Deposited: September 13, 2010
For: U.S. Patent No. 5,530,469

*In re* Garfinkle
Reexamination Proceeding
Control No. 90/011,240
Request Deposited: September 29, 2010
For: U.S. Patent No. 5,530,469

: 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. 5,530,469 (hereinafter, the '469 patent), issued to Garfinkle, on June 25, 1996.

2. On September 13, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '469 patent. The reexamination proceeding was assigned Control No. 90/011,228 (hereinafter, the '11228 proceeding).

3. The Reexamination Order was granted in the '11228 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6.

4. On September 29, 20100, a third party requester deposited a Request for *Ex Parte* Reexamination of the '469 patent. The reexamination proceeding was assigned Control No. 90/011,240 (hereinafter, the '11240 proceeding).

5. The Reexamination Order was granted in the '11240 proceeding on November 10, 2010 finding a substantial new question of patentability (SNQP) as to claims 1-6.

## 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 '11228 and '11240 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 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. 90/011,228 and 90/011,240 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

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

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

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. |
|---|---|---|---|---|
| 90/011,246 | 09/21/2010 | 6376677 | REXX-0184 | 1478 |

23869 7590 01/27/2012

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/27/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Barbara A. McDowell
ROSSI KIMMS & McDOWELL LLP
20609 Gordon Park Square, Suite 150
Ashburn, VA 20147

Date: MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011246
PATENT NO. : 6376677
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.:90/011,246 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED January 25, 2012.

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 submitting an Appeal Brief in response to the Notice of Appeal submitted on November 29, 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 The Appeal Brief is due on or before February 29, 2012.

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit.

/Deborah Jones/ SPE, Art Unit 3991, CRU
[*Signature*] (Title)

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. |
|---|---|---|---|---|
| 90/011,246 | 09/21/2010 | 6376677 | REXX-0184 | 1478 |

23869 7590 01/27/2012

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/27/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

Date: JAN 27 2012

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Barbara A. McDowell
ROSSI KIMMS & McDOWELL LLP
20609 Gordon Park Square, Suite 150
Ashburn, VA 20147

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011246
PATENT NO. : 6376677
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.:90/011,246 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED January 18, 2012 .

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 submitting an Appeal Brief in response to the Notice of Appeal submitted on November 29, 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 , 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 or before January 29, 2012.

   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) |
|---|---|

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

Murphy & King Professional Corporation
1055 Thomas Jefferson Street, NW
Suite 400
Washington, DC 20007

For Patent Owner

MAILED

JAN 03 2011

CENTRAL REEXAMINATION UNIT

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

For 3rd Party Requester
90/011,194

Lerner, David, Littenberg, Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

For 3rd Party Requester
90/011,247

*Ex Parte* Reexamination Proceeding
Control No. 90/011,194
Filed: August 27, 2010
For: U.S. Patent No. 5,611,322

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,247
Filed: September 21, 2010
For: U.S. Patent No. 5,611,322

Reexamination proceedings control Nos. 90/011,194 and 90/011,247 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. 90/011,194 was ordered in a decision mailed September 29, 2010, granting reexamination of claims 1-11, all of the claims appearing in US Patent No. 5,611,322. Patent owner file a letter on November 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. 90/011,247 was ordered in a decision mailed October 8, 2010, indicating that claims 1-11, all of the claims appearing in US patent No. 5,611,322 would be reexamined. Patent owner file a letter on December 8, 2010 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. 90/011,194 and reexamination control No. 90/011,247 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 1-11, all of the claims in US patent No. 5,611,322, 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. 90/011,194 and 90/011,247 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

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. |
|---|---|---|---|---|
| 90/011,250 | 09/22/2010 | 6772132 | 049506/296191 | 3537 |

39310 7590 07/15/2011

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/15/2011

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET,
SUITE 4000
CHARLOTTE, NC 28280-4000

Date:

MAILED
JUL 15 2011
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011250
PATENT NO. : 6772132
ART UNIT : 3993

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

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

United States Patent and Trademark Office

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

MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

(For Patent Owner)

MAILED
JUL 15 2011
CENTRAL REEXAMINATION UNIT

ALSTON & BIRD
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

(For Requester)

In re Kemp, II *et alia*
Reexamination Proceeding
Control No. 90/011,250
For: U.S. Patent No. 6,772,132

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.515(c)

This is a decision on the January 14, 2011 paper entitled "PETITION TO REVIEW REFUSAL TO ORDER REEXAMINATION (37 C.F.R. §1.515(c))". The petition was timely filed. A fee of $400 was required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 6,772,132 (hereinafter, the '132 patent) issued on August 3, 2004 to Kemp II, *et alia.*

2. On September 22, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-2, 8, 14, 20, 22-23, 25, 27-28, 30, 32-33, 37-38, 40, 42-43, 47-48, and 53 of the '132 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,250 (hereinafter, the '11250 reexamination proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on December 14, 2010.

4. On January 14, 2011, the present petition was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11250 reexamination proceeding has petitioned seeking relief from the examiner's December 14, 2010 Order denying *ex parte* reexamination.[1]

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

---

[1] The Petition petitioned for relief in the form of "(a) reexamination of the '132 patent on the grounds set forth in the Request for Reexamination No. 90/011,250 of September 22, 2010; or (b) have the Examiner reconsider the Request for Reexamination of September 22, 2010 under the appropriate standard; or (c) permit the Requestor to re-file the Request for Reexamination without prejudice and strike the Examiner's Refusal to Order Reexamination of December 14, 2010."

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the December 14, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '132 patent filed in the '11250 reexamination proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.[2]

The '132 patent matured from application number 09/590,692 (the '692 application). During prosecution of the '692 application, the examiner allowed claims 22-70, renumbered as 1-49, in a first Notice of Allowance mailed July 31, 2002 stating as the reasons therefore:

> The prior art fails to teach a method of placing a trade order, computer readable medium with instructions for placing a trade order, and/or a client system for placing a trade order comprising a dynamic display and a static display. The static display, directed to the commodity price, does not change. In contrast, the values of the bid/ask, reflecting the market depth for the commodity, are dynamically displayed and are aligned with the corresponding static price values. Theses features in combination with the claim features of claims 22, 29 and/or 35 render the claims allowable.
>
> PCT WO99/23099 is representative of the closest Foreign Patent prior art.
>
> The closet US Patent prior art and Non Patent Literature prior art are of record.

Subsequent to further prosecution of the '692 application, the examiner again allowed claims 22-70 as well as claims 89-95, renumbered as 1-56, in a second Notice of Allowance mailed February 10, 2004 stating as the reasons therefore:

---

[2] The Examiner's decision, although arguably wanting for more artful presentation, does not rise to level of "arbitrary, capricious, an abuse of discretion or otherwise not in accordance with the law" as argued by the Petition.

> This statement of reasons for allowance includes the major differences in the claims not found in the prior art of record[3] and reasons why that [sic] differences are considered to define patentably over the prior art. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be relied upon for this purpose. Rather, this statement reflects what the examiner considers important and therefore the primary reasons for the allowance of the claims.
>
> The primary reason for allowance is the limitation directed to the "dynamic display" of a plurality of the quantity of bids and asks aligned with a "static display" of corresponding prices. Here, unlike the prior art, the "static" display of prices is just that, static, and does not move in response to a change in the inside market. With this display of market depth, claimed in each of the independent claims, a trader places a trade order with the pointer in the area of the order entry region of the dynamic market depth region, through a single computer implemented action, see Figures 3 and 4. For example, in figure 3, a click on Bid Q 18 will send an order to the market to sell 17 lots of the commodity at a price of 89.
>
> The closest prior art including US Patent 6,408,282, PCT WO 01/16852 and commonly owned non-patent literature "X Trader" (see, applicant's response to USPTO's request for information) all lack this feature...

On April 6, 2007, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-56 of the '132 patent be reexamined. This reexamination proceeding was assigned Control No. 90/008,576 (hereinafter, the '08576 reexamination proceeding). Turning to the request of the '08576 reexamination proceeding, the section of the request entitled "STATEMENT OF SUBSTANTIAL NEW QUESTION OF PATENTABILITY" (see page 4) and the section entitled "D. Dependent claims 23, 33 and 43" (see pages 151-153) sets forth requester's position with regard to the references, i.e. patents or printed publications, cited in the request (i.e. the patents or printed publications to The TSE Orientation Materials, TSE Operation Procedures, Friesen[4] and Amazon), i.e.:

> ...were not cited to, nor considered by, the Examiner in the original prosecution that led to the allowance and issuance of the Kemp '132 patent and are both non-cumulative and more pertinent than the cited references. Therefore, there is a substantial likelihood that a reasonable examiner would consider the TSE Orientation Materials, TSE Operation Procedures, Friesen and Amazon references important in deciding whether or not the claims are patentable. Accordingly, whether the issued claims of the Kemp '132 patent are patentable over the teachings of the TSE Orientation Materials, TSE Operation Procedures,

---

[3] U.S. Patent No. 5,297,031 to **Gutterman et al** was made of record on July 31, 2002. PCT WO 01/16852, in which **Friesen et al** are the inventors was made of record February 11, 2003.

[4] U.S. Patent Application Publication No. 2003/0097325, entitled "USER INTERFACE FOR AN ELECTRONIC TRADING SYSTEM," filed April 9, 1999 and published May 22, 2003, to **Friesen et al.**

> Friesen and Amazon references, as applied below, is a substantial new question of patentability.

and

> Whether claim ... is patentable over the teachings of the TSE Orientation Materials and TSE Operation Procedures references and further in view of Friesen is a substantial new question of patentability as the TSE Orientation Materials, TSE Operation Procedures and Friesen references were not cited to, nor considered by, the Examiner in the original prosecution that led to the allowance and issuance of the Kemp ' 132 patent and are both non-cumulative and more pertinent than the cited references and there is a substantial likelihood that a reasonable examiner would consider these references important in deciding whether or not the claim is patentable.
>
> ... In particular, the following claim limitation would have been obvious to one of ordinary skill in the art at the time the invention was made: wherein said displaying the market depth of a commodity traded in a market further comprises displaying said bids and asks in different colors, as claimed in claim 23 (*See* Friesen, paras. 8 and 37).

The USPTO mailed an Order Granting Request for *Ex Parte* Reexamination on August 1, 2007 2010. In such Order the Examiner set forth at, e.g., pages 6, 7, 8 and 9:

> TSE ... has teachings to similar method steps or apparatus to the claim limitations (e.g., a dynamic display of bids and asks aligned with a display of prices and order entry region) cited to in the reasons for allowance in application number 09/590,693 [sic] that issued as the 6,722,132 patent. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, TSE ... raises a substantial new question of patentability as to Claims 1-56, which question has not been decided in a previous examination of the 6,722,132 patent.
>
> Amazon has teachings to similar method steps or apparatus to the claim limitations (e.g., an order entry region that allows entry of an order through a single action of the user) cited to in the reasons for allowance in application number 09/590,693 [sic] that issued as the 6,722,132 patent. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, Amazon raises a substantial new question of patentability as to Claims 1, 3, 8, 10, 14, and 16, which question has not been decided in a previous examination of the 6,722,132 patent.

> Friesen, like the invention claimed in the 6,772, 132 [sic] patent, recognizes the importance of display trading data in an intuitive format, which allows for the trader to make informed decisions quickly and has teachings to graphical user interface that creates an intuitive display of data combined with a single action order entry region (e.g., an order entry region that allows entry of an order through a single action of the user) cited to in the reasons for allowance in application number 09/590,693 [sic] that issued as the 6,722,132 patent. Therefore, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, Amazon raises a substantial new question of patentability as to Claims 23, 33, and 43, which question has not been decided in a previous examination of the 6,722,132 patent.
>
> Therefore, TSE (Orientation) A, TSE (Operation) B, Amazon, and Friesen raise a substantial new question of patentability as to claims 1-56, which question has not been decided in a previous examination of U.S. Patent No. 6,772,132.

The USPTO mailed a Notice of Intent to Issue *Ex Parte* Reexamination Certificate on January 16, 2008. In such Notice the Examiner set forth:

> The **prior art of record** *fails to teach* a method, computer readable medium, or a system having a dynamic display of bids and asks in a commodity market *aligned with a static display of prices corresponding thereto*, wherein *the static display of prices does not move in response to a change in the inside market* **in combination with the other claim limitations** in independent claims 1, 8 and 14. Dependent claims 2-7, 9-13, and 15-56 are found patentable for the same reason.
>
> Although TSE (Orientation) A, TSE (Operation) B, Amazon, and Friesen raised a substantial new question of patentability as set forth in the order granting reexamination dated August 1, 2007, these references do not anticipate the above-mentioned claim limitations and do not render the claims obvious. TSE (Orientation) A and TSE (Operation) B clearly teach that the display of prices is automatically updated every three seconds so as to keep the "center price" in the middle of the screen. This teaching is directly counter to the static display of U.S. Patent No. 6,772,132, which uses the static display of prices so that the user does not accidentally place an order at the unintended price (see column 2 lines 56-63). The requester relies on the one statement in TSE (Operation) B on page 640, which states that in the scroll screen the price display locations do not change automatically, for the teaching of a "static" display of prices. This teaching does not meet the claim limitations, as it is only a teaching that the automatically centering of the "center price" does not occur when the user is in the scroll mode. If it did, the user would not be able to scroll to the desired price, because the scrolling would result in the "center price" not being in the center of

> the screen. Amazon and **Friesen also do not teach such claim limitations nor render the claims obvious.**
>
> (Emphasis added.)

Patent Owner filed an IDS on January 15, 2008 which crossed the Notice in the mail. The IDS was considered by the Examiner on February 28, 2008. The USPTO mailed out a communication on March 4, 2008 in which the Examiner stated:

> An information disclosure statement (IDS) was filed on January 15, 2008, one day prior to the mailing of the Notice of Intent to Issue A Reexamination Certificate. This information disclosure has been considered by the examiner, and the initialed forms are attached.[5] The IDS submitted was voluminous and had numerous seemingly duplicative citations. Citations that are lined through are either because it is duplicative or that a copy of the citation could not be located in the file record....
>
> In accordance with MPEP 609.05(b), consideration by the examiner of the information submitted in an IDS means that the examiner considered the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (see MPEP § 609.04(a), subsection III.) and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.
>
> **The IDS does not effect the issuance of the Notice of Intent to Issue an Reexamination Certificate, mailed on January 16, 2008. Accordingly, that action still stands.**

---

[5] The initialed, i.e. considered, citations included those to The Application Program Interface (API) Reference Manual for **LIFFE Connect**, 9/00/1998, release 3.1, EP 1 319 211 B1 Exhibit 7A, eS0060146-eS0060237 and U.S. Patent No. 5,297,031 to **Gutterman et al.** The crossed thru citations included that to Swiss Exchange **SWX** Exchange TS User Manual V2.1, 12/31/1998.

(Emphasis added)

Patent Owner also filed another IDS on April 28, 2008 for reasons including to provide copies of previous citations in the 1-15-08 IDS for which "a copy of the citation could not be located in the file record" by the Examiner. The IDS was considered on September 26, 2008. The USPTO mailed an Interview Summary form on November 6, 2008 in which the Examiner stated "[a]ttached to this interview summary is the initialed IDS listing."[6]

An *Ex Parte* Reexamination Certificate for the '132 patent issued on March 31, 2009.

Turning back to the '11250 reexamination proceeding, this second request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-2, 8, 14, 20, 22-23, 25, 27-28, 30, 32-33, 37-38, 40, 42-43, 47-48 and 53 of the '132 patent be reexamined. The section of the request entitled "Statement of Substantive New Question of Patentability" (esp. pages 2 and 13-16) sets forth requester's position that the references cited in the request (i.e. Friesen, Gutterman, LIFFE CONNECT and SWX, see footnotes 2-5 *supra*) raise a substantial new question of patentability as to claims 1-2, 8, 14, 20, 22-23, 25, 27-28, 30, 32-33, 37-38, 40, 42-43, 47-48 and 53 of the '132 patent, because "[s]pecifically, and as discussed in more detail below, each of these claims is invalid as anticipated by, or obvious in view of, Gutterman, Friesen, LIFFE CONNECT, and SWX, alone or in combination" and "[t]he written record of the '132 patent, as well as that of the '8576 Reexamination, contains no consideration by any Examiner of whether the prior art, as currently presented and discussed, renders the claimed subject matter anticipated or obvious in view of " such art.

Turning specifically to the references to Friesen, i.e. U.S. Patent Publication No. US 2003-0097325 A1 or Patent No. 7,212,999 which matured from the application, the Request states at page 13:

> The Friesen publication was not cited to, or by, the Examiner during the prosecution of the '692 application. Though **the PCT publication that corresponds to the Friesen publication** was cited, the Friesen PCT publication is not prior art under § 102(e). The Friesen publication is, however, prior art under § 102(e). Thus, **the teachings** of the **Friesen** publication **of a graphical user interface having a dynamic display of a market in a commodity in which a trade order is placed by a single action of a user input device was not considered.** *See e.g.*, Fig. 3b of the Friesen publication. During the '8756 [sic] Reexamination, the Friesen publication was cited only as a secondary reference; the Central Reexamination Unit **never considered or analyzed the above referenced teachings of the Friesen publication.** Further, **the Friesen publication** was not applied in any rejection of the claims, nor **discussed on the**

[6] The initialed IDS included citation to Swiss Exchange SWX-TS User Manual, 12/31/1998, DTX 2215, eS0032393-eS0032547.

> **record during either the prosecution** of the '692 application, or that **of the '8756** [sic] **Reexamination.** (Bold emphasis added.)

However, the discussion ignores the prosecution history of the '132 patent, *see supra.*[7] The teachings of Friesen outlined in this request (e.g., *supra* and pages 17-41) were considered and discussed in the '08567 reexamination proceeding for the same reasons, esp. note again the January 16, 2008 Notice, i.e.:

> The **prior art of record** *fails to teach* a method, computer readable medium, or a system having a dynamic display of bids and asks in a commodity market aligned with a static display of prices corresponding thereto, wherein the static display of prices does not move in response to a change in the inside market in combination **with the other claim limitations in independent claims 1, 8 and 14.** Dependent claims 2-7, 9-13, and 15-56 are found patentable for the same reason.
>
> Although TSE (Orientation) A, TSE (Operation) B, Amazon, and Friesen raised a substantial new question of patentability as set forth in the order granting reexamination dated August 1, 2007, these references do not anticipate the above-mentioned claim limitations and do not render the claims obvious. TSE (Orientation) A and TSE (Operation) B clearly teach that the display of prices is automatically updated every three seconds so as to keep the "center price" in the middle of the screen. This teaching is directly counter to the static display of U.S. Patent No. 6,772,132, which uses the static display of prices so that the user does not accidentally place an order at the unintended price (see column 2 lines 56-63). The requester relies on the one statement in TSE (Operation) B on page 640, which states that in the scroll screen the price display locations do not change automatically, for the teaching of a "static" display of prices. This teaching does not meet the claim limitations, as it is only a teaching that the automatically centering of the "center price" does not occur when the user is in the scroll mode. If it did, the user would not be able to scroll to the desired price, because the scrolling would result in the "center price" not being in the center of the screen. Amazon and **Friesen also do not teach such claim limitations nor render the claims obvious.**

To this point, MPEP 2216, Substantial New Question of Patentability, is instructive:

> Under 35 U.S.C. 304, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised. 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 prior patents and printed publications." If such a new question is found, an order for ex parte reexamination of the patent is issued. It is therefore important that the request clearly set forth in detail what the requester considers the "substantial

[7] See also page 9, line 1-page 10, line 3 of the Petition.

> new question of patentability" to be in view of prior patents and printed publications. The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office.
>
> It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.
>
> The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office **if the reference is presented in a new light or a different way that escaped review during earlier examination**....
>
> After the enactment of the Patent and Trademark Office Authorization Act of 2002 ("the 2002 Act"), a substantial new question of patentability can be raised by patents and printed publications "previously cited by or to the Office or considered by the Office" ("old art"). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002 Act, MPEP § 2242, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, but only if the old art is "**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.)

as is MPEP 2242, Criteria for Deciding Request, I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY:

> The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.
>
> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new

> question of patentability is present, unless the same question of patentability has already been decided...(B) by the Office in a previous examination or pending reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination. ...
>
> A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim...by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.
>
> For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim....
>
> (Emphasis added.)

Friesen does not raise a substantial new question of patentability because the technological teachings thereof are not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e. anticipation and/or obviousness of the same claim limitations,

during a prior proceeding involving the patent for which reexamination is requested.[8]

Turning now specifically to Gutterman, i.e. U.S. Patent No. 5,297,031, the Request states at page 14:

> The Gutterman patent was cited by the patent owner in an information disclosure statement in the original examination. Although the Examiner initialed the information disclosure statement, **no evidence exists that the Examiner considered any of the technical teachings of the Gutterman patent to a degree greater than documents are generally considered during a search of Office file records**. The **Gutterman** patent **teaches** a client system for placing a trade order having a parameter setting component, a display device, a user input device, and a trade order sending component, i.e., **the subject matter of Claim 8**. *E.g.*, col. 7: 19-27. Furthermore, the **Gutterman** patent was not applied in any rejection of the claims, or **discussed on the record during either the prosecution of the '692 application, or that of the '8756** [sic] **Reexamination**.
>
> (Bold emphasis added.)

However, as with the Friesen reference, the discussion ignores the prosecution history of the '132 patent, *see supra.* The teachings of Gutterman outlined in this request (e.g., *supra* and pages 41-68) were considered and discussed for the same reasons not only in the '08567 reexamination proceeding, esp. note again the January 15, 2008 IDS the USPTO mailed out on March 4, 2008 in which the Examiner stated:

> The IDS does not effect the issuance of the Notice of Intent to Issue an Reexamination Certificate, mailed on January 16, 2008. Accordingly, that action still stands.

which Notice mailed January 16, 2008 set forth:

> The **prior art of record** *fails to teach* a method, computer readable medium, or a system having a dynamic display of bids and asks in a commodity market aligned with a static display of prices corresponding thereto, wherein the static display of prices does not move in response to a change in the inside market in combination **with the other claim limitations in independent claims 1, 8 and**

---

[8] See the December 14, 2010 Order Denying Reexamination at pages 7-9, e.g. "The reference to Friesen et al ('325) was cited in the record of reexamination 90/008,576. It was listed as one of the cited references of the proceeding on the reexamination certificate published March 31, 2009. **Additionally,** Friesen et al ('325) **was commented on and considered by the Examiner in the "reasons for patentability" attached to the NIRC action of June 16, 2008.** Accordingly, the re-appearance of Friesen et al ('325) in this proceeding provides **no new technological teachings. Its content was considered during the prior reexamination proceeding and is merely cumulative to the identical citation of this reference in the prior reexamination proceeding."** (Bold emphasis added.) Contrast to the Petition at, e.g., page 5 thereof regarding such Order, i.e. "In other words, the Examiner merely stated that the reference upon which the Request for Reexamination relied, namely Friesen *et al.*. U.S.S.N. 09/289,500, as originally filed was **old art.**"

> **4.** Dependent claims 2-7, 9-13, and 15-56 are found patentable for the same reason. (Emphasis added.)

but the prosecution of the '692 application as well, *see supra*, esp. noting the second Notice of Allowance mailed February 10, 2004, i.e.:

> This statement of reasons for allowance includes the major differences in the claims not found in the prior art of record[9] and reasons why that differences are considered to define patentably over the prior art. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be relied upon for this purpose. Rather, this statement reflects what the examiner considers important and therefore the primary reasons for the allowance of the claims.
>
> The primary reason for allowance is the limitation directed to the "dynamic display" of a plurality of the quantity of bids and asks aligned with a "static display" of corresponding prices. Here, unlike the prior art, the "static" display of prices is just that, static, and does not move in response to a change in the inside market. With this display of market depth, claimed in each of the independent claims, a trader places a trade order with the pointer in the area of the order entry region of the dynamic market depth region, through a single computer implemented action, see Figures 3 and 4. For example, in figure 3, a click on Bid Q 18 will send an order to the market to sell 17 lots of the commodity at a price of 89.

Gutterman also does not raise a substantial new question of patentability because the technological teachings thereof are not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e. anticipation and/or obviousness of the same claim limitations during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.[10]

---

[9] U.S. Patent No. 5,297,031 to **Gutterman et al** was made of record on July 31, 2002.

[10] See the December 14, 2010 Order Denying Reexamination at pages 10-13, e.g. "The reference to Gutterman et al was cited during the prosecution of US Patent 6,772,132...The reference to Gutterman et al was also cited a second time during prior reexamination proceeding 90/008,576...The reasons for allowance attached to the action of July 31, 2002 refers to "the prior art" (page 1, section 2) as being considered in the decision for patentability. Since Gutterman et al was part of the prior art in the record at the date of this decision, the record reflects that Gutterman et al was previously considered by the examiner. Gutterman et al was considered a second time by the Examiner in the prior reexamination 90/008,576,...Accordingly,...Gutterman et al in this proceeding provides no new technological teachings. Its content was considered during the prior prosecution and is merely cumulative to the citation of this reference in the prior prosecution history and the prior reexamination proceeding Contrast to the Petition at, e.g., page 6 thereof regarding such Order, i.e. "Again, the Examiner merely stated that the reference, Gutterman *et al*., was **old art**."

Turning now specifically to LIFFE CONNECT, i.e. LIFFE, The Application Program Interface (API) Reference Manual For LIFFE CONNECT ™, manual, Sept. 1998, pp. 1-65, Release 3.1, LIFFE, London, England, the Request states at page 14:

> The LIFFE CONNECT publication was not cited to, or by, the Examiner during the prosecution of the '692 application. Thus, **the teachings of the LIFFE CONNECT** publication **of a graphical user interface having a dynamic display of a market in a commodity were not considered**. *See e.g.*, LIFFE CONNECT publication at F-65. The LIFFE CONNECT publication was cited in an information disclosure statement during the' 8756 Reexamination, but the **Central Reexamination Unit never considered the above-referenced teachings of the LIFFE CONNECT publication**. Furthermore, **the LIFFE CONNECT publication** was not applied in any rejection of the claims, or **discussed on the record during** either **the prosecution** of the '692 application, or that **of the ' 8756[sic] Reexamination**.
>
> (Bold emphasis added.)

However, as with the Friesen and Gutterman references, the discussion ignores the prosecution history of the '132 patent, *see supra.* The teachings of LIFFE CONNECT outlined in this request (e.g., *supra* and pages 68-80) were considered and discussed for the same reasons in the '08567 reexamination proceeding, esp. note again the f January 15, 2008 IDS the USPTO mailed out on March 4, 2008 in which the Examiner stated:

> The IDS does not effect the issuance of the Notice of Intent to Issue an Reexamination Certificate, mailed on January 16, 2008. Accordingly, that action still stands.

which Notice mailed January 16, 2008 set forth:

> The **prior art of record** *fails to teach* a method, computer readable medium, or a system having a dynamic display of bids and asks in a commodity market aligned with a static display of prices corresponding thereto, wherein the static display of prices does not move in response to a change in the inside market in combination **with the other claim limitations in independent claims 1, 8...**
>
> (Emphasis added.)

LIFFE CONNECT also does not raise a substantial new question of patentability because the technological teachings thereof are not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e. anticipation and/or obviousness of the same claim limitations, during

the prosecution of another prior proceeding involving the patent for which reexamination is requested.[11,12]

Finally, turning now specifically to SWX, i.e. Swiss Exchange SWX, Swiss Exchange SWX TS User Manual, manual, 12/31/1998, pp. 1-249, Version 2.1, Swiss Exchange SWX, Zurich, Switzerland, the Request states at page 14:

> The SWX Manual publication was not cited to, or by, the Examiner during the prosecution of the '692 application. Thus, **the teachings of the SWX Manual** publication **of a graphical user interface having a dynamic display of a market in a commodity in which a trade order is placed by the use of a single action of a user input device was**[sic] **not considered.** *See e.g.*, SWX Manual publication at 6-14. The SWX Manual publication was cited in an information disclosure statement during the '8756 [sic] Reexamination, but **the Central Reexamination Unit never considered the above-referenced teachings** of the SWX Manual publication. Furthermore, the SWX Manual publication was not applied in any rejection of the claims, or discussed on the record during either the prosecution of the '692 application, or that of the '8756 Reexamination.
>
> (Bold emphasis added.)

However, as with the Friesen, Gutterman and LIFFE CONNECT references, the discussion ignores the prosecution history of the '132 patent, *see supra.* The teachings outlined in this request for which SWX is being offered (e.g., *supra* and pages 80-92) were considered, esp. note again the IDS mailed November 6, 2008. Even if such SWX teachings were not already considered, such teachings outlined in this request (e.g., page 14, i.e. "...the teachings...of a graphical user interface having a dynamic display of a market in a commodity in which a trade order is placed by the use of a single action of a user input device...") are cumulative to the teachings that the Office had before it for consideration in the '08576 reexamination proceeding, esp. note again the discussion *supra* of the references on pages 6, 7, 8, 9 of the

---

[11] See the December 14, 2010 Order Denying Reexamination at pages 13-15, e.g. "LIFE CONNECT [sic]was previously considered by the Examiner in the prior reexamination 90/008,576, as evidenced by the information disclosure statement signed February 28, 2008 at page 31 (paper of March 4, 2008). Accordingly, the re-appearance LIFE CONNECT [sic] in this proceeding provides no new technological teachings. Its content was considered during the prior reexamination proceeding and its submission in this proceeding is merely cumulative..." Contrast to the Petition at, e.g., page 6 thereof regarding such Order, i.e. "Once more, the Examiner merely found the reference, LIFE CONNECT[sic], was **old art.**"

[12] Attention is also invited to pages 15-16 of the December 14, 2010 Order, which additionally pointed out that the portions of LIFFE CONNECT set forth by the request as teaching the claim limitations cited to in the reasons for confirmation of patentability in the '08576 reexamination proceeding (e.g., a system having a dynamic display of bids and asks in a commodity market aligned with a static display of prices corresponding thereto, wherein the static display of prices does not move in response to a change in the inside market) did not clearly do so and thereby additionally there would not be a substantial likelihood that a reasonable examiner would consider such prior printed publication important in deciding whether or not he claim is patentable, i.e. does not raise a substantial question of patentability additionally for this reason.

Order during such reexamination proceeding, e.g. "TSE ... has teachings to similar method steps or apparatus to the claim limitations (e.g., a dynamic display of bids and asks aligned with a display of prices and order entry region)", see *supra,* "Friesen, like the invention claimed in the 6,772, 132 patent, recognizes the importance of display trading data in an intuitive format, which allows for the trader to make informed decisions quickly and has teachings to graphical user interface that creates an intuitive display of data combined with a single action order entry region (e.g., an order entry region that allows entry of an order through a single action of the user)...", see *supra,* and "One of ordinary skill in the art would have been motivated to combine the TSE Orientation Materials and/or TSE Operation Procedures references with Friesen as all of these references relate to user interfaces for trading commodities.", *see* '08576 Request at page 150. Note again MPEP 2242, i.e. "For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim."

SWX also does not raise a substantial new question of patentability because the technological teachings thereof are either not "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", i.e. namely it is presented for technological teachings that were previously considered and discussed on the record for the same use/reason/light/way, i.e. anticipation and/or obviousness of the same claim limitations, during the prosecution of another prior proceeding involving the patent for which reexamination is requested nor, alternatively, even if considered an additional (newly provided) printed publication, provide teachings which are non-cumulative to similar prior art/teachings already fully considered by the Office in a previous examination of the claim and thereby, decide the same question of patentability already been decided by the Office.[13,14]

---

[13] See the December 14, 2010 Order Denying Reexamination at pages 16-17, e.g. "SWX Manual was previously considered by the Examiner in the prior reexamination 90/008,576, as evidenced by the information disclosure statement signed September 26, 2008 at page 10 (paper of November 6, 2008). Also note that the examiner placed a notation on this page stating "All References Considered Except Where Lined Through". Since the SWX Manual citation (citation #98 on the page) is not lined through, the record explicitly indicates consideration of this reference by the Examiner in the prior reexamination proceeding. Accordingly, the re-appearance SWX Manual in the present proceeding provides no new technological teachings. Its content was considered during the prior reexamination proceeding and its Submission in this proceeding is merely cumulative. Contrast to the Petition at, e.g., page 6 thereof regarding such, Order i.e. "In sum, the Examiner merely found the reference, the SWX Manual, was **old art**."

[14] Pages 17-20 of the December 14, 2010 Order additionally point out that the portions of SWX cited and shown by the request and SWX at such cited and shown portions are not the same and thereby, a reasonable examiner also would not necessarily consider SWX actually provides the teachings argued as important in deciding whether or not he claim is patentable.

Control Number: 90/011,250
Art Unit: 3992

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,772,132 has been presented in the request filed January 14, 2011 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director of Technology Center 1600
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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

NOV 0 8 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,251
Filed: September 22, 2010
For: U.S. Patent No. 6,739,433

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b) filed May 31, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be confidential material. It is also assumed that the same treatment is expected for the Information Disclosure Statement Under 37 CFR 1.555 filed June 15, 2011 and marked as "Confidential".

The petition is **DISMISSED**.

Petitioner requests that confidential material submitted in a sealed envelope on May 31, 2011 and presumably, the submission of June 15, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

It is noted, however, that the petitions are deficient because the petition of May 31, 2011 lack items (B) through (D) listed above, and the submission of June 15, 2011 lacks items (B) through (E)..

If patent owner still wishes to have the material in question expunged, a renewed petition should be promptly filed or, shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process) the mailing of the NIRC. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

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, SPE
Central Reexamination Unit 3993

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

Murphy & King Professional Corporation
1055 Thomas Jefferson Street, NW
Suite 400
Washington, DC 20007

For Patent Owner

MAILED

JAN 07 2011

CENTRAL REEXAMINATION UNIT

2nd Reexam Group
Novak Druce & Quigg, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

For 3rd Party Requester
90/011,205

Lerner, David, Littenberg, Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090

For 3rd Party Requester
90/011,253

*Ex Parte* Reexamination Proceeding
Control No. 90/011,205
Filed: September 2, 2010
For: U.S. Patent No. 5,471,967

*Ex Parte* Reexamination Proceeding
Control No. 90/011,253
Filed: September 22, 2010
For: U.S. Patent No. 5,471,967

DECISION MERGING
REEXAMINATION
PROCEEDINGS

Reexamination proceedings control Nos. 90/011,205 and 90/011,253 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. 90/011,205 was ordered in a decision mailed September 30, 2010, granting reexamination of claims 1-18, all of the claims appearing in US Patent No. 5,471,967. Patent owner file a letter on November 30, 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. 90/011,253 was ordered in a decision mailed October 13, 2010, indicating that claims 1-18, all of the claims appearing in US patent No. 5,471,967 would be reexamined. Patent owner file a letter on December 13, 2010 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. 90/011,205 and reexamination control No. 90/011,253 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.

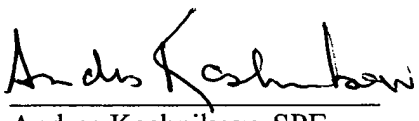
**Conduct of Proceedings**

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently claims 1-18, all of the claims in US patent No. 5,471,967, 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. 90/011,205 and 90/011,253 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

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

OCT 28 2011

CENTRAL REEXAMINATION UNIT

Trop, Pruner & Hu, P.C. (For Patent Owner)
1947 S. Voss Road
Suite 750
Houston, TX 77057-2631

Novak Druce & Quigg LLP (For *Inter Partes* and *Ex Parte* Requesters)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

In re Russell W. White et al.
*Inter Partes* Reexamination Proceeding
Control No.: 95/001,262
Filed: November 13, 2009
For: U.S. Patent No. 7,187,947

In re Russell W. White et al.
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,254
Filed: September 23, 2010
For: U.S. Patent No.: 7,187,947

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

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

*Inter partes* reexamination proceeding No. 95/001,262 and *ex parte* reexamination proceeding No. 90/011,254 **are merged** into a single proceeding.

## BACKGROUND

1. United States Patent Number 7,187,947 ("the '947 patent") issued to Russell W. White et al. on March 6, 2007, with 42 claims.

2. A request for *inter partes* reexamination of claims 1-42 of the '947 patent was filed November 13, 2009, by a third party requester, and was assigned Reexamination Control

No. 95/001,262 ("the '1262 proceeding"). The request identified Apple Inc. as the real party in interest.

3. The Office mailed an order granting *inter partes* reexamination of claims 1-42 of the '947 patent for the '1262 proceeding on February 5, 2010.

4. The Office mailed a non-final rejection action for the '1262 proceeding on May 24, 2010.

5. On July 26, 2010, the patent owner filed a response to the May 24, 2010 Office action, requesting reconsideration of the rejections of the original claims and adding new claims 43-64.

6. The third party requester in the '1262 proceeding filed comments to patent owner's July 26, 2010 response on August 25, 2010.

7. A request for *ex parte* reexamination of claims 1-19 and 29-42 of the '947 patent was filed on September 23, 2010, by third party requester Tracy W. Druce, and the request was assigned control number 90/011,254 ("the '11254 proceeding").

8. An order granting *ex parte* reexamination of claims 1-19 and 29-42 of the '947 patent was mailed for the '11254 reexamination proceeding on December 16, 2010. No Office action has been issued in the '11254 reexamination proceeding. No Patent Owner statement has been filed in the '11254 reexamination proceeding; and the time for filing same has expired.

## DECISION

## I. MERGER OF PROCEEDINGS

Reexamination is ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '1262 proceeding) is an *inter partes* proceeding. The other proceeding (the '11254 proceeding) is an *ex parte* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. Therefore, consideration of merger is ripe at this point in time.

37 CFR 1.989 provides:

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

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

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 95/001,262 and 90/011,254 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

New claims 43-64 have been proposed in the '1262 proceeding, while there is no amendment in the '11254 proceeding. Thus, the claims are not currently the same in both proceeding files. Accordingly, a copy of claims 43-64 from the amendment in the *inter partes* reexamination proceeding is being placed in the *ex parte* reexamination IFW file, and is entered in the *ex parte* reexamination. Claims 1-64 will be addressed in the next Office action on the merits for the now merged proceeding. Such action is appropriate in this situation, because the *inter partes* reexamination requester has already had an opportunity to comment on the amendment in the *inter partes* reexamination and has done so.

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

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

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

**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. 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.

---

[1] 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.

**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 requesters, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file.

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

| | |
|---|---|
| by Mail to: | Attn: Mail Stop "*Inter Partes* Reexam"<br>Central Reexamination Unit<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| by FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| by Hand to: | Customer Service Window<br>Attn: Central Reexamination Unit<br>Randolph Building, Lobby Level<br>401 Dulany Street<br>Alexandria, VA 22314 |
| by EFS: | Registered users may submit papers via the electronic filing system EFS-Web, at:<br><br>https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html |

Patent owner and 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 the other party, and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903.[2] 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.

---

[2] It is noted that the *inter partes* requester and the *ex parte* requester are to be treated as separate parties, even if the parties are being represented by the same practitioner.

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.

## CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,262 and *ex parte* Reexamination Control No. 90/011,254 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. A copy of the new claims added via the 95/001,262 *inter partes* reexamination proceeding has been placed in the *ex parte* 90/011,254 reexamination proceeding, thus, making the claims the same in both proceedings.

3. The examiner will prepare an Office action on the merits for the merged proceeding in due course.

4. Any questions concerning this communication should be directed to Raul Tamayo, Legal Advisor, at 571-272-7728.

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

10-27-2011

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

(For Patent Owner)

MAILED

APR 26 2011

CENTRAL REEXAMINATION UN

Chen Yoshimura LLP
Attention Ying Chen
333 W. El Camino Real, Suite 380
Sunnyvale CA 94087

(Courtesy Copy)

ADLI LAW GROUP P.C.
633 WEST FIFTH STREET
SUITE 5880
LOS ANGELES, CA 90071

(Courtesy Copy)

YLX Corporation
960 Saratoga Avenue, Suite 117
San Jose, CA 95129

*In re*: Yi Li *et alia*
Reexamination Proceeding
Control No. 90/011,262
Request Deposited: October 4, 2010
For: U.S. Patent No. 7,547,114

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

The *ex parte* reexamination is before the Central Reexamination Unit for consideration of the petition filed January 26, 2011 entitled "Petition for Grant of Filing Date of the Original *Ex Parte* Reexamination Request" requesting:

> "the USPTO grant the Requestor October 4, 2010 as the filing date given that the requirement had been met in the request documents as originally filed and that the Requestor did not receive timely notice from the PTO re any deficiency thereof."

It is noted that the petition was electronically filed by requester, but requester did not direct it to control number 90/011,262. Requester's error was detected by the office on March 1, 2011 and the papers were electronically forwarded to control number 90/011,262 on March 1, 2011.

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

Initially, it is noted that the petition does not appear to be properly signed. The /s/ appears to be in the form of an electronic signature. However, it appears to be manually written.

Accordingly, the petition is **dismissed** as not being properly signed.

Rather than addressing the merits of the present petition at a later date when the petition is properly signed, the following analysis is provided.

Requester's proposed relief of granting the filing date of October 4, 2010 can not be granted as the request deposited on that date is defective for the reasons set forth in the Notice of Failure to Comply with *Ex Parte* Reexamination Request Filing Requirements of October 13, 2010.

The "corrected Request" attached to the present petition also can not be granted the filing date of October 4, 2010 (because the papers did not exist on that date) nor can they be granted the filing date of March 1, 2011 (the date at which the Office could first identify it as potentially a Request for Reexamination). That paper fails to comply the requirements of 37 CFR 1.510(b)(2) because it improperly lumps proposed rejections with only a single explanation (see MPEP 2217). For example, starting on page 20, requester proposes that certain claims are unpatentable under 35 USC 102 as being anticipated and/or under 35 USC 103 as being obvious, but only contains a single lumped explanation for the plural proposed rejections.

This decision does not preclude requester from filing a new request for reexamination. However, if requester chooses to do so, they should not direct the request to control number 90/011,262 or any other existing control or application number. It should be filed as a new request for reexamination.

Control number 90/011,262 remains terminated. The refund of the filing fee was credited to deposit account number 50-5225.

## CONCLUSION

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

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

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

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. |
|---|---|---|---|---|
| 90/011,264 | 10/06/2010 | 5,388,101 | 549407-010005-001 | 4511 |

35617 7590 08/15/2011

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/15/2011

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

Date: MAILED

AUG 15 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011264
PATENT NO. : 5388101
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

(For Patent Owner)

AUG 15 2011

CENTRAL REEXAMINATION UNIT

Daffer McDaniel LLP
P.O. Box 684908
Austin, TX 78768-4908

David B. Cochran
Jones Day
901 Lakeside Avenue
Cleveland, Ohio 44114-1190

(For Requester)

In re Dinkins
Reexamination Proceeding
Control No. 90/011,264
For: U.S. Patent No. 5,388,101

: DECISION GRANTING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the January 13, 2011 paper entitled "PETITION TO RECONSIDER ORDER DEYING REQUEST FOR EX PARTE REEXAMINATION UNDER 37 CFR 1.181 AND 1.151(c)." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,388,101 (hereinafter, the '101 patent) issued on February 7, 1995 to Dinkins.

2. On January 9, 2009, a first request for *ex parte* reexamination of the '101 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/010,383 (hereinafter, the '10383 proceeding).

3. On February 25, 2009, reexamination was granted in the '10383 proceeding. Claims 1-20 were rejected in a non-final office action mailed August 7, 2009. Claims 19 and 20 were rejected and claims 1-18 were confirmed in a final office action mailed May 10, 2010. The '10383 proceeding is currently docketed to the BPAI awaiting decision on the rejection of claims 19-20.

4. On October 6, 2010, the instant request for *ex parte* reexamination of the '101 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/011,264 (hereinafter, the '11264 proceeding).

5. An order denying the request for *ex parte* reexamination was mailed on December 14, 2010. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

6. On January 13, 2011, the present petition was filed.

## DECISION

Third party requester ("Petitioner") in the '11268 proceeding has petitioned seeking relief from the Examiner's December 14, 2010 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1, 2, 4-6, 8, and 12 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is

timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '369 Patent

The '101 patent issued on February 7, 1995 to Dinkins. The prosecution of the '101 patent proceeded as follows. In the first office action mailed on November 5, 1993, claims 16, 17, 28, 29, 31, and 32 were rejected as anticipated by Martinez. Claims 1-15 were rejected under §112, but where not rejected in view of any prior art. The Applicant responded by canceling claims 16, 17, 28, 29, 31, and 32 and amending claims 1-15 in an attempt to overcome the rejections under §112. A second office action was mailed on May 18, 1994 that further rejected claims 1-15 under §112. The Applicant responded by amending claim 1 to overcome the §112 rejection. A third office action was mailed on July 11, 1994 that rejected previously allowed claim 34 in view of Martinez. In response, the Applicant canceled claim 34. The remaining claims were allowed without a statement of reasons for allowance in a Notice of Allowance mailed on September 7, 1994. The allowed claims that would become patent claims 1-19 were never rejected in view of any prior art.

The record regarding the '101 Patent is unclear as to the reasons for allowance. However, the prosecution history of US Patent No. 5,481,546 (the '546 patent), a child to the '101 patent, provides some clarity. In the prosecution of the '546 patent, patent claim 14 (original claim 47) was rejected in view of the same Martinez reference as cited in the '101 patent prosecution. The remaining claims were rejected under the doctrine of double patenting in view of the claims of the '101 patent. The Martinez reference was noted as failing to anticipate or render the claim obvious because:

> "Applicant points out that the Martinez reference does not disclose a system in which a cell site digital transmitter transmits directly to at least one subscriber unit, and then the subscriber unit transmits back to the cell site digital transmitter using a receive only digital receiver as set forth in claims of the present invention. " *'546 Patent, Notice of Allowance at 4.*

In light of this argument, the rejection was dropped. The features noted in the argument are present in the claims of the '101 patent. Accordingly, the record suggests that these features were the reasons for allowance of the '101 patent.

In the '10383 proceeding, claims 1-20 were initially rejected in a non-final office action mailed August 7, 2009. In the final rejection mailed May 10, 2010, the rejections of claims 1-18 were withdrawn and the claims were confirmed. In discussing the reasons for confirmation, the May 10, 2010 office action noted that the Morales-Garza, Cunningham, and Martinez patents singularly or in combination failed to teach the base station comprising means for "receiving from subscriber units synchronously related data messages of variable lengths."

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A *de novo* determination, has been made as to whether the October 6, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '101 patent filed in the '11264 proceeding has been found to present an SNQ over claims 1, 2, 4-6, 8, and 12. Therefore, the examiner's decision to deny reexamination is improper.

Petitioner argues that the Krebs and Labedz references each raise a SNQ over claims 1, 2, 4-6, 8, and 12 because they teach the distinguishing features of the claims of the '101 patent. Krebs and Labedz will raise an SNQ if a reasonable examiner would consider their teaching to be important in deciding whether or not the claims are patentable. Specifically, Krebs or Labedz will raise an SNQ if they provide teachings relevant to the distinguishing feature of a cell site digital transmitter transmits directly to at least one subscriber unit, and then the subscriber unit transmits back to the cell site digital transmitter using a receive only digital receiver or a base station comprising means for "receiving from subscriber units synchronously related data messages of variable lengths."

The Request asserts that an SNQ is raised because Krebs and Labedz teach variable length data messages by stating the following on Page 2:

> "Unlike the prior art of record from the earlier, pending reexamination, the newly-submitted Krebs and Labedz patents disclose digital cellular communication systems that anticipate '101 patent claims 1-2, 4-6, 8, and 12. In particular, Krebs and Labedz each disclose and teach the limitations the PTO found missing from the prior art of record in the pending reexamination:
>
> • Variable-length digital data messages: Krebs is titled "Method and Apparatus for Communicating Variable Length Messages Between a Primary Station and Remote Stations of a Data Communications System" and discloses variable-length data messages; Labedz also discloses data message formats and framing used to communicate digital messages having variable lengths. "

Beginning with Krebs, the footnotes associated with the above statement cites to Krebs at Figures 3, 4, 16-17, column 3 line 65 – column 4 line 25, column 6 lines 26-31, column 7 line 46 – column 8 line 37. These portions of Krebs are relevant to the distinguishing feature of receiving from subscriber units synchronously related data messages of variable lengths. For example, Krebs states "[a] variable length physical message can be constructed by transmitting a variable number of channel blocks continuously" (*Krebs, column 6 lines 26-31*). Krebs notes that the variable length messages include a "block count field 241" that specifies the size of the variable length message (*Krebs, column 6 lines 62-66).* Krebs further states that the data transmission stream includes one or more physical messages that are synchronized using a "preamble 201 or 202...to establish bit and message synchronization between the transmitting and receiving ends of the link (*Krebs, column 3 line 65 – column 4 line 3*).

Krebs' teachings regarding variable length messages would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to the distinguishing features of claim of the '101 patent. Accordingly, for at least this reason, Krebs raises a SNQ over the requested claims.

Turning to Labedz, the footnotes noted in the Request point to Figs. 6-7, 9a, 9b, 10a, 10b, 1 la, 1 lb, 12a, 12b, 14a, and 14b, column 10 lines 49-59, and column 11 lines 6-16 as disclosing various data word formats having different lengths and that can be combined for larger transmissions. These portions of Labedz are relevant to the distinguishing feature of receiving from subscriber units synchronously related data messages of variable lengths. For example, Labedz discloses base stations that transmit and receive digital data messages as part of the communication channel setup that are of a variable length as evidenced by the message headers including a field designated as "message length" (*Labedz, Figures 10a and 10b; column 10 lines 49-59; column 11 lines 6-16*). These data messages are synchronized in order to provide an efficient design (*Labedz, column 4 line 65 – column 5 line 4*).

Labedz's teachings regarding variable length messages would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to

the distinguishing features of claim of the '101 patent. Accordingly, for at least this reason, Labedz raises a SNQ over the requested claims.

The Request further asserts that an SNQ is raised because Krebs and Labedz teach subscriber units that transmit back to the cell site digital transmitter using a receive-only digital receiver by stating the following on Page 2:

> "Digital remote receivers: Krebs discloses plural receivers that receive and relay subscriber messages; Labedz similarly teaches "receivers located remote from the central site" that receive low-power subscriber messages and return them to the central site as a prior art technique "in use for some time."

Beginning with Krebs, the footnotes associated with the above statement cites to Krebs at Figure 2, column 3 lines 2-5. These portions of Krebs are relevant to the distinguishing feature of "each cell subdivision site being adapted for receiving-only low power digital messages transmitted from local subscriber units" as claimed. For example, Krebs describes a communication system over a large geographic area that is divided into cells or zones utilizing several RF signal transmitters (*Krebs, column 2 lines 55-63*). "Each zone of the radio communication system is covered by an assigned one or the transmitters...and *at least one of the receivers*" (*Krebs, column 3 lines 2-5*). Hence, the one or more receivers of each zone suggest a cell subdivision for receiving-only low power digital messages transmitted from local subscriber units.

Krebs' teachings regarding subscriber units that transmit back to the cell site digital transmitter using a receive-only digital receiver would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to the distinguishing features of claim of the '101 patent. Accordingly, for at least this reason, Krebs raises a SNQ over the requested claims.

Turning to Labedz, the footnotes noted in the Request point to column 1 lines 15-21 as teaching subscriber units that transmit back to the cell site digital transmitter using a receive-only digital receiver. In the cited portion, Labedz states "mobile transmissions, due to their lower power, are received by a network of receivers located from the central site and returned to the central site." This teaching regarding subscriber units that transmit back to the cell site digital transmitter using a receive-only digital receiver would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to the distinguishing features of claim of the '101 patent. Accordingly, for at least this reason, Labedz raises a SNQ over the requested claims.

Accordingly, the petition is **granted**.

## SUMMARY AND 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, 2, 4-6, 8, and 12 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).

**Waiver of Patent Owner Statement Period:** 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. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

**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 the undersigned at (571) 272-0700.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,265 | 10/06/2010 | 5481546 | 5822-00600 | 4531 |

35617 7590 08/12/2011

DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/12/2011

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DAVID B. COCHRAN, ESQ.
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,265*.

PATENT NO. *5481546*.

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.: 90/011,265 |
|---|---|

1. The petitions under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed May 23, May 27, May 31 (x2), and June 6 (x3), 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 petitions do 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)

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. |
|---|---|---|---|---|
| 90/011,266 | 10/06/2010 | 5946546 | 21716-0012RX2 | 5072 |

62204 7590 07/26/2011

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2A62A
NISKAYUNA, NY 12309

| 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

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. |
|---|---|---|---|---|
| 90/010,669 | 09/09/2009 | 5946546 | 21716-0012RX1 | 2369 |

62204 7590 07/26/2011

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2A62A
NISKAYUNA, NY 12309

| 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

Gilbert H. Hennessey
FISH & RICHARDSON P.C.(BO)
P.O. BOX 8
Minneapolis, MN 55440-1022

Date: MAILED

JUL 26 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011266
PATENT NO. : 5946546
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

MAILED
JUL 26 2011
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Date:

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90010669
PATENT NO. : 5946546
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

GE TRADING & LICENSING
1 RESEARCH CIRCLE
ATTN: BRANDON, K1 - 2A62A
NISKAYUNA NY 12309

(For Patent Owner)

MAILED

AUG 26 2011

CENTRAL REEXAMINATION UNIT

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

For Third Party Requester)

*In re*: Fillion *et alia*
*Ex Parte* Reexamination Proceeding
Control No. 90/010,669
Deposited : 23 June 2008
For: US Patent No. 5,946,546

*In re*: Buchanan *et alia*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,266
Deposited : 10 September 2009
For: US Patent No. 5,946,546

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 31 August 1999 US Patent No. 5,946,546 was granted to Fillion *et alia*.

2. On 09 September 2009 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,669.

3. On 25 November 2009 the Order was granted for *ex parte* reexamination in control number 90/010,669.

4. On 28 May 2010 a non-final Office action was mailed in 90/010,669.

5. On 10 August 2010 an amendment and remarks were received in 90/010,669.

6. On 06 October 2010 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,266.

7. On 03 December 2010 the Order was granted for ex parte reexamination in control number 90/011,266.

8. There are no amendments to the claims in control number 90/011,266.

## 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. 90/010669 & 90/011,266 *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. 90/010,669 & 90/011,266 *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; 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

SCOTT M. DANIELS, WESTERMAN, HATTORI, DANIELS & ADRIAN
1250 CONNECTICUT AVENUE, N.W., STE 700
WASHINGTON, DC 20036

(For Patent Owner)

**MAILED**

**AUG 16 2011**

**CENTRAL REEXAMINATION UNIT**

JOHN V. BIERNACKI
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Requester)

In re Application of: Darin Ellis et al.
Control No.: 90/011,267
Deposited: October 6, 2010
For: US Patent No. 6,195,662

**RESPONSE TO PETITION UNDER 37 CFR 1.59**

This is a response to the petition under 37 CFR 1.59(b), filed on May 5, 2011, by which patent owner requests to expunge information from the above identified proceeding.

The decision on the petition is will be held in abeyance until prosecution on the merits is closed, at which time the petition will be decided.

Petitioner requests that Document Nos. 1-6 contained in the envelope or container attached to a concurrently filed Information Disclosure Statement, dated May 5, 2011, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

The documents in question will not be available to the public during prosecution.

## CONCLUSION

1. The decision on the petition under 37 CFR 1.59(b) will be held in abeyance until the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), at which time the petition will be decided.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Andy Kashnikow
SPE AU 3993
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,267 | 10/06/2010 | 6195662 | 343355-600264 | 5085 |

14958 7590 09/14/2011

Scott M. Daniels, Westerman, Hattori,
Daniels & Adrian LLP
1250 Connecticut Avenue, NW. Ste. 700
Suite 1500
Washington, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 09/14/2011

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
JOHN V. BIERNACKI, ESQ.
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OHIO 44114

Date:

MAILED

SEP 14 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011267
PATENT NO. : 6195662
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*** | 90/011,267 |
|---|---|

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 12 May 2011 which was extended to a four (4) month period for filing a response to the Office action, be extended by thirty (30) days.

   - 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).
   - 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: The petition is moot because of the Notice of Appeal dated 09 September 2011.

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) |

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. |
|---|---|---|---|---|
| 90/011,267 | 10/06/2010 | 6195662 | 110529RX | 5085 |

14958 7590 11/30/2011

Scott M. Daniels, Westerman, Hattori,
Daniels & Adrian LLP
1250 Connecticut Avenue, NW. Ste. 700
Suite 1500
Washington, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/30/2011

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

JOHN V. BIERNACKI, ESQ.
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OHIO 44114

Date:

MAILED

NOV 30 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011267
PATENT NO. : 6195662
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.: 90/011,267 |
|---|---|

MAILED

NOV 23 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 16 November 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 09 September 2011 which sets a two (2) month period for filing a response to the Office action, be further extended by sixty (60) days.

   - 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 thirty (30) days, 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 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, 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 other 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 timely response to Office actions on the merits.

A first petition for extension of time was granted for thirty (30) days time for "sufficient cause." The instant petition seeks an additional sixty (60) days time to respond to the Notice of Appeal.

Pursuant to MPEP § 2265 (in part)

"*Ex parte* prosecution will be conducted by initially setting either a 1-month or a 2-month shortened period for response, see MPEP § 2263. The patent owner also will be given a 2-month period after the order for reexamination to file a statement (by statute (35 U.S.C. 304 ), this period cannot be less than 2-months, even in a proceeding where the patent is being litigated). See 37 CFR § 1.530(b). First requests for extensions of these statutory 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 by the CRU or TC 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. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations." (emphasis added)

Absent evidence of extraordinary situations there is not "sufficient cause" for granting any additional time.

The petition is hereby dismissed.

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. |
|---|---|---|---|---|
| 90/011,267 | 10/06/2010 | 6195662 | 110529RX | 5085 |

14958 7590 02/17/2012

Scott M. Daniels, Westerman, Hattori,
Daniels & Adrian LLP
1250 Connecticut Avenue, NW. Ste. 700
Suite 1500
Washington, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOHN V. BIERNACKI, ESQ.
JONES DAY
901 LAKESIDE AVENUE
CLEVELAND, OHIO 44114

Date: MAILED

FEB 09 2010

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011267
PATENT NO. : 6195662
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

Scott M. Daniels
Westerman, Hattori, Daniels & Adrian LLP
1250 Connecticut Avenue, NW. Ste. 700
Suite 1500
Washington, DC 20036

(For Patent Owner)

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

JOHN V. BIERNACKI, ESQ.
JONES DAYS
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

(For Third Party Requester)

*In re:* Ellis *et al.*
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,267
Deposited: October 6, 2010
For: U.S. Patent No.: 6,195,662

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on August 23, 2011 entitled "PETITION UNDER 37 C.F.R. 1.181 REGARDING EXAMINER'S REFUSAL TO WITHDRAW FINALITY OF REJECTION IN *EX PARTE* REEXAMIANTION OF U.S. PATENT NO. 6,195,662" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to withdraw the finality of the Office action mailed May 12, 2011.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. The petition is denied.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,195,662 issued on February 27, 2001.
- A request for *ex parte* reexamination was filed on October 6, 2010 and assigned control no. 90/011,267.
- *Ex parte* reexamination was ordered and prosecution progressed until a final Office action was mailed on May 12, 2011.
- Patent owner filed a response on May 23, 2011 including substitute declarations.
- The examiner issued an Advisory Action on June 7, 2011.
- Patent owner filed an after final response on July 12, 2011.
- The examiner issued an advisory action on August 11, 2011.
- On August 23, 2011, patent owner filed the instant petition.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### MPEP § 706.07(a) Final Rejection, When Proper on Second Action (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). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent

owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

## DECISION

Patent owner ["petitioner"] argues that the final Office action issued May 12, 2011 ["Final Action"] is improper and should be reissued as a non-final action. Petitioner apparently has two separate concerns with the examiner's actions—that the examiner did not give the patent owner a fair opportunity to substantively respond to the final rejection, and that the final rejection included, as characterized by petitioner, new grounds of rejection.

Unfairness Concerning Failure to Address Declarations[1]

In the first Office action, the examiner applied two rejections: anticipation by DBMS Copy Pus ["DBMS"], and obviousness over DAISy in view of DBMS. With its first response of March 7, 2011, the patent owner filed several declarations—one by Gregory and several by Rudd. The Gregory Declaration claimed that DAISy is not a prior art printed publication. The Rudd Declarations claimed that the references lack a "data bug" (Exh. A), that DBMS does not operate in a multiple computer system environment (Exh. B), that DBMS is not enabling (Exh. C), and that the references cannot be combined due to teaching away or inoperability (Exhs. D & E).

In the Final Action, the examiner maintained both rejections and refused to consider the declarations, stating they were non-compliant with formal requirements. Final Action pp. 3-4. She stated the Gregory Declaration was given no consideration; she stated the opinions set forth in the declarations related to patent owner's arguments would be addressed. *Id.* The examiner did address arguments as to the references teaching a data bug, pp. 6-7, DBMS operating in a multiple computer environment and whether that is claimed, pp. 7-8, enablement of DBMS, pp. 8-9, and whether the combination of references teach away, pp. 9-11, or are inoperable, pp. 11-12. The examiner therefore addressed the issues presented by the Rudd Declarations.

Patent owner filed substitute declarations on May 23, 2011, complying with the examiner's formal requirements. In that filing patent owner stated that it discussed the situation with the examiner and that they agreed that the examiner would substantively consider the new declarations and issue an advisory action based on that consideration. They agreed that the

[1] It is not entirely clear whether the petitioner is relying on this argument as a basis for removal of the finality of the Final Action. It is, quite frankly, unclear why petitioner even discussed this issue, as the complained of actions have resulted in withdrawal of one of the rejections, and it appears that the examiner did exactly what she said she would do. But in any case, to the extent petitioner alleges improper examiner actions as to this issue, it will be addressed.

patent owner would then be permitted to respond to the advisory action to substantively respond to any rejections then remaining. Patent owner further stated that it did not agree that the original declaration were non-compliant, but nonetheless filed the substitute declarations to avoid any unnecessary dispute.

The examiner then issued an advisory action on June 7, 2011, considering the declarations and agreeing that DAISy is not available as prior art. Accordingly, the obviousness rejection based on DAISy was withdrawn. The examiner stated that the issues of the Rudd Declarations as to DBMS were effectively presented and responded to in the Final Action, and she referenced that action. The examiner additionally stated that the Rudd Declarations concerning DAISy were moot and were not further addressed.

Patent owner responded on July 12, 2011, claiming that the Final Action was improper as including new grounds of rejection, presenting new arguments as to DBMS, and presenting a new Rudd Declaration. Patent owner filed a supplemental response on August 10, 2011, allegedly based on "new Federal Circuit authority." This response cited a new decision that the patent owner alleges applies to the facts of this case.

The examiner issued another advisory action on August 11, 2011. The examiner stated that the response of July 12th and accompanying Rudd Declaration were entered but were not persuasive, and the "[c]laim rejections are maintained as per Final Office Action (05/12/2011) for reasons of record therein." Presumably the examiner meant only the DBMS anticipation rejection was maintained, and the withdrawal of DAISy remained as in the June 7th Advisory Action.

Now, patent owner complains of the "injustice" of these acts. Yet, the examiner, in the Final Action, discussed the issues presented in the Rudd Declarations; the examiner permitted substitute declarations to be filed on May 23rd, after the final rejection. The examiner withdrew a rejection because of the substitute declarations, therefore she clearly considered them. The examiner permitted for entry a second after-final response and an additional after-final declaration with that second response.[2] This even though patent owner's only showing under 37 CFR § 1.116 was an allegation of new grounds of rejection, a point that as discussed *infra* is not persuasive.

Additionally, the examiner did exactly what patent owner said that they agreed to in its May 23rd submission. Again, she considered the substitute declarations, then issued an advisory action.

---

[2] It is of no moment that patent owner "reserved the right," when filing the May 23rd substitute declarations, to file an additional substantive response. It is not up to the patent owner to determine the number and type of responses that it may file after a final rejection, particularly as its second after final response included new evidence subject to 37 CFR § 1.116(e). This type of submission is not entered as a matter of right, therefore patent owner had no rights to reserve. This underscores the lack of injustice in the examiner's acts, as she was not required to enter this submission.

Patent owner responded to the advisory action with a substantive response, explaining why it believed the examiner had erred. This response included a declaration, i.e. additional evidence whose entry is subject to 37 CFR § 1.116. The examiner entered all of these responses and declarations. The examiner did everything that patent owner says they agreed upon. The examiner did more than was required by the regulations.

Patent owner says that the examiner merely paid "lip service" to the declarations in the Final Action. Even "lip service" is more consideration than she needed to give, as the declarations were deemed non-compliant.[3] In any case, the examiner addressed the very issues presented in all of the Rudd Declarations and responded to those issues in the Final Action. She did not consider the Gregory Declaration because it was not properly of record; there is nothing improper with not considering evidence that was not properly made of record.

Patent owner's only possible complaint as to any unfairness is the fact that the action was made final to begin with, though as we will see that also was not improper. Accordingly, any argument as to unfairness is unpersuasive and not a reason to remove finality.

New Grounds

Petitioner alleges the Final Action was improper as it included new grounds of rejection. While both the first Office action and the Final Action relied upon anticipation by DBMS, petitioner argues there is a new ground because the examiner (1) relied upon a new fact to support her definition of "data bag", (2) provided a new theory as to what part of the prior art met the data bag, and (3) provided a new theory as to why DBMS operates in a "multiple computer system environment." The ultimate criterion of whether a rejection is considered "new" is whether the patent owner has had fair opportunity to react to the thrust of the rejection. *In re Leithem*, 100 USPQ2d 1155, 1158 (Fed. Cir. 2011) (referring to new grounds issued by the Board, a different but analogous situation).

Pages 2-16 of the Final Action are a response to patent owner's previous submission, including a response to patent owner's arguments against the rejections. On page 17 of the Final Action, the examiner stated "Examiner maintains the rejections of claims 1-11 and 14-19. Rejections are incorporated by reference from Non Final Action 01/07/2011." Clearly, in that sense, the rejections are the same as those presented previously, as they are explicitly incorporated by reference. Petitioner argues, however, that the examiner's response to arguments set forth new grounds of rejection.

---

[3] Patent owner apparently disputed this, but it never petitioned this issue. While the Director agrees that it is good for parties to resolve disputes with the examiner if possible, rather than resorting to petitions, if the examiner keeps important evidence out of the record that can be a case-changing issue. If a party believes that act is improper, it would be wise to petition that issue, rather than complain of that fact later and potentially lose the chance to have that evidence entered.

As to arguments (1) and (2), petitioner relies upon the following paragraph of the Final Action as showing the examiner relied upon new facts and theories:

> Examiner asserts that a 'data bag' is fairly construed as a buffer or file type of software structure (i.e.. record or database) that is described as containing data and definitions of the data. However, the term is broadened by way of the '662 Specification teaching at 8: 63-67, "...specific terms...are used in a generic and descriptive manner only and not for purposed of limitation..." Notably, the '662 Specification does not narrowly define the 'definitions of the data.' DBMS Copy Plus teaches 'record' transferring from the input database (p. 4, i.e., data is stored in record format). An example given at p. 8 of DBMS Copy Plus shows an input data base (data bag for storing imported data) with a .rxd extension, as an indication of the Reflex file format of the data (definition of the data). Also see p. 58, "The extension must be the pseudo extension associated with the particular software system the file is written in." Records with related extensions, required by DBMS Copy Plus, are used in a manner analogous to an import data bag/export data bag, where the extensions fairly teach a 'definition of the data.'

Final Action pp. 6-7.

Petitioner states that the reliance on the language at the end of the specification (col. 8 ll. 63-67) is a reliance on a new fact, i.e. argument (1). It is apparent, however, that the examiner's citation to this part of the specification was merely for rebuttal of the patent owner's argument that it acted as its own lexicographer to define "data bag" in the specification. The examiner's citation to the specification was merely to say "you did not precisely define data bag because you left it open to broader terms." Mere rebuttal of a patent owner's argument is not a new ground of rejection, otherwise nearly every final rejection would include a new ground. Argument (1) is therefore unpersuasive.

Petitioner states the examiner's reliance on an input data base as the claimed "data bag" is a new theory of how the prior art meets the claim, i.e. argument (2). Upon careful consideration the theory of the rejection has not changed at all, therefore this argument is unpersuasive.

The third party requester (and the examiner, via incorporating the third party's arguments) alleged the claimed "data bags" were met by the DBMS memory data structures that receive rows of data from a database, and that receive filtered data after a rule is applied. See Request pp. 21; 34-36. The Request, however, also appears to refer to records as data bags. The "select statement" was said by the requester to "evaluate[] all rows imported into memory (an input data bag)." Request p. 35; First Action at p. 5. Thus, it would seem that the thing that the select statement "evaluates" is what the third party calls a data bag. But DBMS also says the select statement "evaluates each record in the input database." See Request p. 35; DBMS p. 90. An

example is shown as well—the 40,000 dollar employee example—where it is said that employee.rxd is input, and badbucks.ssd is output. *Id.* In other words, it evaluates each record in the database "employee.rxd" and outputs any records that return true to "badbucks.ssd."

So, the third party/examiner said that the select statement evaluates all rows imported to memory (an input data bag). The reference also says, as explicitly quoted and cited by the third party/examiner, the select statement evaluates each record in an input database. Thus, it seems the third party/examiner said, or at least implied, that the records in the input database are a data bag. These records would seem to be the "rows imported into memory" as the records are what is actually input and evaluated.

In light of this, the examiner said not present a new ground of rejection in the Final Action. While the patent owner characterizes the first action as applying the "buffers" to the data bags, and the Final Action as referring instead to records or databases, this is not correct. It was patent owner who limited its discussion to the "buffers" of DBMS in its response, not the examiner in the first action. The request referred to the item evaluated by the select statement as the input data bag, and the records of the input database are what are to be evaluated. The paragraph of the Final Action quoted above merely refers to the input database and the records of that database as the input data bag. This is not a new theory. Perhaps it is an extension of the prior theory, but if that is the case it is an extension that necessarily flows from what was said in the request and is therefore still the same theory. The patent owner had a full and fair opportunity to respond to this theory as it is no more than what was presented in the Request and incorporated by reference into the first Office action. The citations to pp. 8 and 53 of DBMS do not change this result, given that these pages were explicitly cited in the original rejection. Argument (2) is therefore unpersuasive.

As to (3), petitioner argues that the examiner, for the first time in the Final Action, relied on MS-DOS 2.1 or higher to support the rejection. It is abundantly clear that this statement by the examiner is merely rebuttal and is not in any way a part of the examiner's rejection. The context, which petitioner unhelpfully omitted when quoting the Final Action, clearly shows that the examiner was merely rebutting the patent owner's statements in its previous response. In patent owner's March 7 response at page 11, it argued that DBMS system requirements include only a reference to MS-DOS 2.1, without any indication of network connectivity. The examiner's mention of MS-DOS 2.1 or higher was merely pointing out to the patent owner that it was not correct in stating that DBMS refers only to MS-DOS 2.1, but that it also says "or higher." Apparently patent owner believes that it can say whatever it likes in a response, and if the examiner corrects it then that constitutes a new ground of rejection. It is clear that the examiner is not in any way "relying" on MS-DOS 2.1 or higher as a part of the rejection. This is therefore not some new thrust of the rejection to which patent owner has not had an opportunity to respond. Argument (3) is unpersuasive.

Accordingly, for the above reasons the Director finds no new ground of rejection in the Final Action. It was not improper or unfair to issue a final Office action, and the petition is denied.

## CONCLUSION

1. The petition filed August 23, 2011 is denied. The finality of the May 12, 2011 action is not disturbed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

HOWREY LLP-CA
C/O IP DOCKETING DEPARTMENT
1299 PENNSYLVANIA AVENUE, NW, ROOM B-3
WASHINGTON, DC 20004-2402

MAILED

FEB 10 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

CONVERGENT LAW GROUP LLP
P.O. BOX 1329
MOUNTAIN VIEW, CA 94042

In re *Beach et al.*
Reexamination Proceeding
Control No. 90/011,272
Filed: October 8, 2010
For: U.S. Patent No. 7,425,617

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181
:

The paper filed by requester on December 14, 2010, styled as "Petition from Denial of Request under 37 CFR §§ 1.515(c) and 1.181," is before the Director of TC 1600, who oversees the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated November 18, 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. 7,425,617 (hereinafter, the '617 patent) issued on September 16, 2008.

2. On October 8, 2010, a third party requester deposited a new request for *ex parte* reexamination for claims 1 and 2 of the '617 patent, and the resulting reexamination proceeding was assigned Control No. 90/07,272 (hereinafter, the '7272 proceeding).

5. A Notice of Reexamination Request Filing Date was issued on October 15, 2010.

6. An order denying the request for reexamination was issued on November 18, 2010.

6. On December 14, 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

Petitioner (the third party requester) alleges that the examiner erred in not finding that substantial new question of patentability exists. The petitioner states that the request established a substantial new question of patentability based upon the Xiong et al. in view of Busch et al. because of the deletion of the reference to U.S. application number 07/991,997 in the benefit claim of the '617 patent by the amendment under 37 CFR 1.312, dated July 15, 2008. Specifically, petitioner states that the change in the benefit claim causes the Xiong et al. reference to be prior art against the claims of the '617 patent. Petitioner's arguments hinge on establishing that the change in the benefit claim brings a "new light" to the Xiong et al. reference.

## 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 the claims of the '617 patent, for which reexamination was requested, 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. As will be discussed in further detail in section III.B. below, consideration is limited as to whether the Xiong et al. raises a substantial new question of patentability (SNQ) to patent claim. 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).

## 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 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.

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

---

[1] Public Law 96-517, enacted on December 12, 1980.

different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.
>
> The decision denying the request will then indicate, 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.
>
> The examiner should also, in 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

In response to the petition filed on December 14, 2010, a *de novo* review of the request was made. It is determined that the request fails to raise a substantial new question of patentability regarding the Xiong et al. that is different from patentability issues raised in the prior examination of the '617 patent.

The request for reexamination, dated October 8, 2010, stated that the following substantial new question of patentability (SNQ) existed:

1. Claims 1 and 2 of the '617 patent are rendered obvious by Xiong et al. in view of Busch et al. under 35 U.S.C. § 103(a).

Upon review of the prior examination in U.S. patent application 09/016,869, Xiong et al. in view of Busch was applied multiple times in rejections of (at least) claims 1 and 2 of the '617 patent. See, e.g., the Office actions dated November 20, 2001, June 3, 2002, and December 2, 2002. Therefore, since Xiong et al. in view of Busch et al. was previously considered in the prior examination of the '617 patent, the request must present the Xiong et al. in view of Busch et al. "in a new light" in order to raise a substantial ***new*** question of patentability and allow the granting of a request for reexamination.

The evidence and explanation, as set forth in the request dated October 8, 2010, simply does not support ordering a request for reexamination. The request does not present sufficient evidence to present the Xiong et al. in view of Busch et al. in a new light. There is little doubt that the teachings of the Xiong et al. in view of Busch et al. were extensively considered in a previous examination for the same or substantially the same purpose. As stated in the Order denying reexamination, dated November 18, 2010, the request present the same question of patentability that was in the prior prosecution (namely the obviousness of claims 1 and 2 based on Xiong et al. in view of Busch et al.) and fails to present the Xiong et al. in view of Busch et al. in a new light. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. The fact that the benefit claim was amended to delete the reference to earlier-filed application number 07/991,997, which was used as evidence of invention prior to Xiong et al., fails to present any new technical teachings as to the Xiong et al. reference. In other words, the requests fails to show any new light regarding the teachings of the Xiong et al. reference, but instead states that a different legal conclusion regarding Xiong et al. should be reached based upon the change in the benefit claim in the '617 patent. In order to grant reexamination, there must be a clear explanation for how the technical teachings in the Xiong et al. are viewed in a new light and how this new light creates a substantial new question of patentability to the claims of the '617 patent for which reexamination is requested. Accordingly, since the teachings of Xiong et al. in view of Busch et al. was already consider in a prior proceeding for the same purpose and the request of October 8, 2010, does not present the Xiong et al. in view of Busch et al. in a new light, a reasonable examiner would not consider these teachings important in light of the entire record of the previous examination.

In summary, the review of the record of the present proceeding, and of the prior proceeding, fails to establish any error in the examiner's determination that the reexamination request of October 8, 2010 failed to raise a SNQ. As explained in the order denying reexamination, 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. 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.

## REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the '617 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). The third party requester should file all evidence, with a new and complete request for reexamination, which supports the third party requester's position that a SNQ is raised. This decision is without prejudice to the right of the requester to file a new request for reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination or in any other currently pending reexamination proceeding.

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. Given the facts involved in this proceeding, the request for *ex parte* reexamination of the claims of the '617 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

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

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. |
|---|---|---|---|---|
| 90/011,277 | 10/08/2010 | 6803906 | 214906-00110 | 9943 |

27160 7590 02/15/2012

KATTEN MUCHIN ROSENMAN LLP
(C/O PATENT ADMINISTRATOR)
2900 K STREET NW, SUITE 200
WASHINGTON, DC 20007-5118

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/15/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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
JIAWEI HUANG (J.C. PATENTS)
4 VENTURE
SUITE 250
IRVINE, CA 92618

Date: MAILED
FEB 15 2012
CENTRAL REEXAMINATION

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011277
PATENT NO. : 6803906
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

KATTEN MUCHIN ROSENMAN LLP
(C/O PATENT ADMINISTRATOR)
2900 K STREET NW, SUITE 200
WASHINGTON DC 20007-5118

(Patent Owner)

MAILED
FEB 15 2012
CENTRAL REEXAMINATION

JIAWEI HUANG (J.C. PATENTS)
4 VENTURE, SUITE 250
IRVINE, CA 92618

(Third Party Requester)

*In re* Morrison *et al.*
Reexamination Proceeding
Control No.: 90/011,277
Filed: October 8, 2010
For: U.S. Patent No.: 6,803,906

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the December 16, 2011 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, an information disclosure statements (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 statement filed December 16, 2011 has not been entered for consideration by the examiner.**

## BACKGROUND

1. On October 12, 2004, the Office issued U.S. Patent No. 6,803,906 to Morrison *et al* (the '906 patent).
2. On October 8, 2010, a third party requester filed a request for *ex parte* reexamination of the '906 patent. The request was assigned reexamination control number 90/011,277 (the '11277 proceeding).
3. On December 3, 2010, the Office issued an order granting reexamination for the '11277 reexamination proceeding.
4. The proceeding progressed to the point where, on December 7, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '11277 proceeding.[1]

[1] Concurrent with the issuance of the NIRC a copy of a PTO/SB/08a IDS form filed by patent owner on November 22, 2011 was annotated as considered by the examiner. This form misidentified a U.S. patent reference by using the wrong patent number. The remaining information identifying the U.S. patent reference was correct.

5. On December 12, 2011, the '11277 proceeding was designated 452 status, *i.e.*, as entering the printing cycle.

6. On December 16, 2011, patent owner filed the instant petition requesting entry and consideration of a concurrently filed IDS submission.

7. On February 10, 2012, the Office issued a miscellaneous communication reflected a correction of the record regarding the patent number of U.S. Patent 6144366, considered by the examiner during the proceeding.

8. The '11277 reexamination proceeding is in the final phase of the publication process for printing the 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 proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 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 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)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the reexamination proceeding, and it fails to provide a statement as to why the submitted IDS information (art citation JP-10-222646) makes at least one claim unpatentable. Nor has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. Patent owner asserts only that the reference being cited is the Japanese counterpart of the misidentified U.S. reference.[2] Moreover, the patent owner does not

[2] See petition at the top of page 3.

provide a discussion of the substance of the information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding.

Furthermore, patent owner has provided no factual accounting to explain why the information submitted could not have been submitted earlier. In fact patent owner has admitted on the record in the petition awareness of the existence of the Japanese reference when submitting the November 22, 2011 IDS as it was cited in the Japanese Patent Office (JPO) decision included in the November 22, 2011 IDS. The JPO decision is dated August 18, 2011, and dated as dispatched (received on) on August 24, 2011. Patent owner therefore was aware of the Japanese reference incident with the dispatch of the JPO decision, approximately three to four months before submission of the Japanese reference to the Office on December 16, 2011. There is no factual accounting whatsoever as to why patent owner waited three to four months to file the instant IDS containing the Japanese reference cited in the JPO decision. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after a NIRC has been mailed, and entered the printing 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 December 7, 2011, and the proceeding has now entered the final stages of the publication process, *i.e.* the printing cycle as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted provides a sufficient basis for granting a new reexamination request as to at least one claim of the patent, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

## ANCILLARY MATTER

Patent owner draws to the Office's attention that a U.S. patent reference listed in an IDS submitted during examination was misidentified, using the wrong patent number. The remaining information identifying the U.S. patent reference was correct. On February 10, 2012, the Office issued a miscellaneous communication indicated a correction of the record regarding the patent number of the U.S. Patent 6144366, considered by the examiner during the proceeding.

## CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on December 16, 2011.

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. 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.

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

February 14, 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. |
|---|---|---|---|---|
| 90/011,284 | 10/15/2010 | 6,547,780 | CRDIO-044X3 | 9152 |

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

76808 7590 02/07/2011

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

DATE MAILED: 02/07/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STETINA BRUNDA GARRED & BRUCKER
ATTN: MATTHEW A. NEWBOLES
75 ENTERPRISE, SUITE 250
ALISO VIEJO, CA 92656

Date:
MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011284
PATENT NO. : 6547780
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LEASON ELLIS LLP
81 MAIN STREET
SUITE 503
WHITE PLAINS, NY 10601

**FOR PATENT OWNER**

MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

STETINA, BRUNDA, GARRED & BRUCKER
75 ENTERPRISE
SUITE 250
ALISO VIEJO, CA 92656

**FOR THIRD PARTY REQUESTER**

*In re Sinofsky*
Reexamination Proceeding
Control No. 90/011,284
Filed: October 15, 2010
For: U.S. Patent No. 6,547,780

**DECISION UNDER 37 CFR 1.181**

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. 90/011,284 (the '284 proceeding), was filed by a third party requester on October 15, 2010.

3. Reexamination was ordered in the '284 reexamination proceeding on November 22, 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 '780 patent was filed on October 15, 2010. Reexamination was ordered on November 22, 2010. The time for filing the patent owner filed a statement pursuant to 37 CFR 1.530 expired on January 22, 2011, and the record in the '284 reexamination proceeding shows that the patent owner did not make any statement pursuant to 37 CFR 1.530. The requester's submission of litigation documents were deposited prior to 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 '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 January 28, 2011, contains 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 '284 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 23 2011

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 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, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,285 | 10/15/2010 | 5843073 | CRDIO-046X3 | 9183 |

76808 7590 02/07/2011

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/07/2011

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 Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Matthew A. Newboles

Stetina, Brunda Garred & Brucker

75 Enterprise, Suite 250

Aliso Viejo, CA 92656

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,285*.

PATENT NO. *5843073*.

ART UNIT *3993*.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 07 2011

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* :
Reexamination Proceeding : **DECISION**
Control No. 90/011,285 : **UNDER**
Filed: October 15, 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. 90/011,285 (the '285 proceeding), was filed by a third party requester on October 15, 2010.

3. Reexamination was ordered in the '285 reexamination proceeding on November 22, 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 October 15, 2010. Reexamination was ordered on November 22, 2010. The time for filing the patent owner filed a statement pursuant to 37 CFR 1.530 expired on January 22, 2011, and the record in the '285 reexamination proceeding shows that the patent owner did not make any statement pursuant to 37 CFR 1.530. The requester's submission of litigation documents were deposited prior to 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 '285 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

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

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

For Patent Owner

**MAILED**

**FEB 23 2011**

**CENTRAL REEXAMINATION UNIT**

Stetina, Brunda, Garred & Brucker
75 Enterprise
Suite 250
Aliso Viejo, CA 92656

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, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,304 | | 6,604,033 | WTWI.P0001RE2 | 4336 |

39894 7590 01/21/2011

HUGHES TELEMATICS, INC.
2002 Summit Blvd
Suite 1800
ATLANTA, GA 30319

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

MAILED

JAN 21 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011304
PATENT NO. : 0977603
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)).

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

JAN 2 1 2011

CENTRAL REEXAMINATION UNIT

John Doughty Esq.
Hughes Telematics, INC
2002 Summit Blvd., Suite 1800
ATLANTA GA 30319

(For Patent Owner)

David H. Tannenbaum
Fullbright & Jaworski LLP
2200 Ross Avenue, Suite 2800
DALLAS, TX 75201-2784

(For Requester)

In re *Banet et al.*
Reexamination Proceeding
Control No. 90/011,304
Filed: October 27, 2010 (original request)
December 1, 2010 (corrected request)
For: U.S. Patent No. 6,604,033

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 16, 2010, styled as "PETITION UNDER 37 CFR 1.181 TO VACATE THE TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST", filed pursuant to 37 CFR 1.181, is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that the Notice of Termination of Preprocessing of Ex Parte Reexamination Request mailed December 6,2010 was mailed in error and that the corrected request for reexamination filed December 1, 2010 be found compliant and granted a filing date. No fee is due.

The petition is GRANTED for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 6,604,033 (hereinafter, the '033 patent) issued on August 5, 2003.

2. On October 27, 2010, the third party requester deposited a request for *ex parte* reexamination for claims 1, 2, 6-16, 20, 21, 24-30 and 32 of the '033 patent, and the resulting reexamination proceeding was assigned Control No. 90/011,304 (hereinafter, the '11304 proceeding).

3. On November 2, 2010 a Notice of Incomplete *Ex Parte* reexam Request was mailed by the Office.

4. On December 1, 2020, the third party requester timely filed a corrected/replacement request.

5. On December 6, 2010 the Office issued a Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request.

6. On December 16, requester timely filed the instant petition.

## DECISION

### I. Standard of Review

37 CFR 1.181 provides petition may be taken to the Director to invoke the supervisory authority of the Director in appropriate circumstances 37 CFR 1.181 (a) (3).

### II. The Legal Standard for Granting Reexamination Filing Date:

37 CFR 1.510. Request for ex parte reexamination.
(a) Any person may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).
(b) Any request for reexamination must include the following parts:
(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.
(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
(4) A copy of the entire patent including the front face, drawings, and specification /claims (in

double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

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.

**III. Analysis of the Request for Reexamination**

The Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request alleges the corrected request of December 1, 2010 was deficient as it failed to provide the requisite identification and explanation in compliance with 37 CFR 1.510 (b)(1) of what substantial new questions of patentability are being raised by the cited prior art documents. No other deficiencies were noted by the Office.

A review of the December 1, 2010 request reveals that a substantial new question of patentability affecting claims 1, 2, 6-16, 20, 21, 24-30 and 32 of the '033 patent is raised by the request for reexamination.

In particular, the corrected request notes the prosecution history of the '033 patent and that no reasons for allowance were given by the examiner. Further the corrected request notes that in the original prosecution patent owner amended at least claim 1 to recite "using a wireless communication network to transfer data from a vehicle to a host computer system" and further argued that at least this limitation was not found in the prior art applied against this claim. See pages 6-8 corrected request. The corrected request then points out how each of the Lawrence, Jenkins and Spaur references teach this limitation. See pages 10- 15 of the corrected request.

Thus, at least one substantial new question of patentability is asserted by the request and granting of a filing date is warranted.

**CONCLUSION**

1. Based on a review of the record as a whole, the petition is GRANTED.

2. Accordingly, the filing date for the request for *ex parte* reexamination of claims 1, 2, 6-16, 20, 21, 24-30 and 32 of the '033 patent is GRANTED, and a filing date of December 1, 2010 is accorded to control number 90/011, 304.

3. The closed corrected request papers of December 1, 2010 will be returned to public view, preprocessing of the request will be completed and the request will be assigned to an examiner for determination of the decision on the request prior to March 1, 2011.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4929.

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
www.uspto.gov

MAILED

JAN 21 2011

CENTRAL REEXAMINATION UNIT

Kean J DeCarlo (For Patent Owner)
Ballard Spahr LLP
999 Peachtree Street, Suite 1000
ATLANTA GA 30309-3915

David H. Tannenbaum (For Requester)
Fullbright & Jaworski LLP
2200 Ross Avenue, Suite 2800
DALLAS, TX 75201-2784

In re *Lightner et al.*
Reexamination Proceeding
Control No. 90/011,306
Filed: October 28, 2010 (original request)
December 3, 2010 (corrected request)
For: U.S. Patent No. 6,636,790

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 16, 2010, styled as "PETITION UNDER 37 CFR 1.181 TO VACATE THE TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST", filed pursuant to 37 CFR 1.181, is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that the Notice of Termination of Preprocessing of Ex Parte Reexamination Request mailed December 8,2010 was mailed in error and that the corrected request for reexamination filed December 3, 2010 be found compliant and granted a filing date. No fee is due.

The petition is GRANTED for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 6,636,790 (hereinafter, the '790 patent) issued on October 21, 2003.

2. On October 28, 2010, the third party requester deposited a request for *ex parte* reexamination for claims 1, 6-9, 11-16, 19, 22-28, 31 and 36 of the '790 patent, and the resulting reexamination proceeding was assigned Control No. 90/011,306 (hereinafter, the '11306 proceeding).

3. On November 4, 2010 a Notice of Incomplete *Ex Parte* reexam Request was mailed by the Office.

4. On December 3, 2020, the third party requester timely filed a corrected/replacement request.

5. On December 8, 2010 the Office issued a Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request.

6. On December 16, requester timely filed the instant petition.

## DECISION

### I. Standard of Review

37 CFR 1.181 provides petition may be taken to the Director to invoke the supervisory authority of the Director in appropriate circumstances 37 CFR 1.181 (a) (3).

### II. The Legal Standard for Granting Reexamination Filing Date:

37 CFR 1.510. Request for ex parte reexamination.
(a) Any person may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).
(b) Any request for reexamination must include the following parts:
(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.
(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.
(4) A copy of the entire patent including the front face, drawings, and specification /claims (in

double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

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.

**III. Analysis of the Request for Reexamination**

The Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request alleges the corrected request of December 3, 2010 was deficient as it failed to provide the requisite identification and explanation in compliance with 37 CFR 1.510 (b)(1) of what substantial new questions of patentability are being raised by the cited prior art documents. No other deficiencies were noted by the Office.

A review of the December 3, 2010 request reveals that a substantial new question of patentability affecting claims 1, 6-9, 11-16, 19, 22-28, 31 and 36 of the '790 patent is raised by the request for reexamination.

In particular, the corrected request notes the prosecution history of the '790 patent and that the reasons for allowance given by the examiner quoted the claimed limitations and stated they were not taught. The corrected request then points out how at least the Lawrence reference discloses the claimed "retrieving data representative of the vehicles performance through the vehicles OBD or OBD-II connector according to a communication protocol" with his teachings of generation and sending data to a central data repository at Lawrence col 2: 8-17 and the data including OBD-II data at Lawrence col 3:42-65. See pages 10- 12 of the corrected request.

Thus, at least one substantial new question of patentability is specifically asserted by the request and granting of a filing date is warranted.

## CONCLUSION

1. Based on a review of the record as a whole, the petition is GRANTED.

2. Accordingly, the filing date for the request for *ex parte* reexamination of claims 1, 6-9, 11-16, 19, 22-28, 31 and 36 of the '790 patent is GRANTED, and a filing date of December 3, 2010 is accorded to control number 90/011, 306.

3. The closed corrected request papers of December 3, 2010 will be returned to public view, preprocessing of the request will be completed and the request will be assigned to an examiner for determination of the decision on the request prior to March 3, 2011.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel
Director Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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. |
|---|---|---|---|---|
| 90/011,307 | | 6732031 | WTWI.P0001RE1/10910205 | 6667 |

39894 7590 01/21/2011

HUGHES TELEMATICS, INC.
2002 Summit Blvd
Suite 1800
ATLANTA, GA 30319

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FULBRIGHT & JAWORSKI LLP
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

Date: MAILED

JAN 2 1 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011307
PATENT NO. : 6732031
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John Doughty, ESQ
Hughes Telematics, Inc.
2002 Summit Blvd, Suite 1800
Atlanta GA 30319

(For Patent Owner)

David H. Tannenbaum
Fullbright & Jaworski LLP
2200 Ross Avenue, Suite 2800
DALLAS, TX 75201-2784

(For Requester)

MAILED

JAN 2 1 2011

CENTRAL REEXAMINATION UNIT

In re *Lightner et al.*
Reexamination Proceeding
Control No. 90/011,307
Filed: October 29, 2010 (original request)
December 2, 2010 (corrected request)
For: U.S. Patent No. 6,732,031

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by requester on December 16, 2010, styled as "PETITION UNDER 37 CFR 1.181 TO VACATE THE TERMINATION OF PREPROCESSING OF *EX PARTE* REEXAMINATION REQUEST", filed pursuant to 37 CFR 1.181, is before the Director of the Central Reexamination Unit (CRU). Specifically, petitioner requests that the CRU Director find that the Notice of Termination of Preprocessing of Ex Parte Reexamination Request mailed December 6, 2010 was mailed in error and that the corrected request for reexamination filed December 2, 2010 be found compliant and granted a filing date. No fee is due.

The petition is GRANTED for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 6,732,031 (hereinafter, the '031 patent) issued on May 4, 2004.

2. On October 29, 2010, the third party requester deposited a request for *ex parte* reexamination for claims 1, 5, 8-10, 14, 19, 20, 23-25, 27, 32-37, 39, 41, 42, 44-48, 50, 51, 55, 56, 58, 61-67, 69, 70, 72-76, 78, 106-109, 111 and 114 of the '031 patent, and the resulting reexamination proceeding was assigned Control No. 90/011,307 (hereinafter, the '11307 proceeding).

3. On November 3, 2010 a Notice of Incomplete *Ex Parte* reexam Request was mailed by the Office.

4. On December 2, 2020, the third party requester timely filed a corrected/replacement request.

5. On December 6, 2010 the Office issued a Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request.

6. On December 16, requester timely filed the instant petition.

## DECISION

### I. Standard of Review

37 CFR 1.181 provides petition may be taken to the Director to invoke the supervisory authority of the Director in appropriate circumstances 37 CFR 1.181 (a) (3).

### II. The Legal Standard for Granting Reexamination Filing Date:

37 CFR 1.510. Request for ex parte reexamination.
(a) Any person may, at any time during the period of enforceability of a patent, file a request for an ex parte reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).
(b) Any request for reexamination must include the following parts:
(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.
(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.
(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) A copy of the entire patent including the front face, drawings, and specification /claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

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.

**III. Analysis of the Request for Reexamination**

The Notice of Termination of Preprocessing of *Ex Parte* Reexamination Request alleges the corrected request of December 2, 2010 was deficient as it failed to provide the requisite identification and explanation in compliance with 37 CFR 1.510 (b)(1) of what substantial new questions of patentability are being raised by the cited prior art documents. No other deficiencies were noted by the Office.

A review of the December 3, 2010 request reveals that a substantial new question of patentability affecting claims 1, 5, 8-10, 14, 19, 20, 23-25, 27, 32-37, 39, 41, 42, 44-48, 50, 51, 55, 56, 58, 61-67, 69, 70, 72-76, 78, 106-109, 111 and 114 of the '031 patent is raised by the request for reexamination.

In particular, the corrected request notes the prosecution history of the '031 patent and that the reasons for allowance given by the examiner quoted the claimed limitations and stated they were not taught. The corrected request then points out how at least the Lawrence reference discloses the claimed "retrieving data representative of the vehicles performance through the vehicles OBD or OBD-II connector according to a communication protocol" with his teachings of

generation and sending data to a central data repository at Lawrence col 2: 8-17 and the data including OBD-II data at Lawrence col 3:42-65. See pages 10- 12 of the corrected request. Additionally the request points out how Lang retrieves data representative of the vehicle performance through the vehicle's OBD or OBD- II connectors at col 2: 6 – 27 and abstract. Thus, at least one substantial new question of patentability is specifically asserted by the request and granting of a filing date is warranted.

**CONCLUSION**

1. Based on a review of the record as a whole, the petition is GRANTED.

2. Accordingly, the filing date for the request for *ex parte* reexamination of claims 1, 5, 8-10, 14, 19, 20, 23-25, 27, 32-37, 39, 41, 42, 44-48, 50, 51, 55, 56, 58, 61-67, 69, 70, 72-76, 78, 106-109, 111 and 114 of the '031 patent is GRANTED, and a filing date of December 3, 2010 is accorded to control number 90/011, 307.

3. The closed corrected request papers of December 2, 2010 will be returned to public view, preprocessing of the request will be completed and the request will be assigned to an examiner for determination of the decision on the request prior to March 2, 2011.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4929.

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
www.uspto.gov

Jonathan Berall
173 Columbia Heights
Brooklyn, NY 11201

For Patent Owner

MAILED

MAR 23 2011

CENTRAL REEXAMINATION UNIT

Black Lowe & Graham PLLC
701 Fifth Avenue, Suite 4800
Seattle, WA 98104

For 3rd Party Requester
90/011,308

Oblon, Spivak, McClellan, Maier & Neustadt
1940 Duke Street
Alexandria, VA 22314

For 3rd Party Requester
90/011,383

*Ex Parte* Reexamination Proceeding
Control No. 90/011,308
Filed: October 29, 2010
For: U.S. Patent No. 5,827,178

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,383
Filed: December 10, 2010
For: U.S. Patent No. 5,827,178

Reexamination proceedings control Nos. 90/011,308 and 90/011,383 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. 90/011,308 was ordered in a decision mailed December 16, 2010, granting reexamination of claims 1-16, all of the claims appearing in US Patent No. 5,827,178. No patent owner statement under 37 CFR 1.530(b) was filed in this reexamination proceeding. No Office action has yet been rendered in this proceeding.

Reexamination in application Control No. 90/011,383 was ordered in a decision mailed January 7, 2011, indicating that claims 1-16, all of the claims appearing in US patent No. 5,827,178 would be reexamined. No patent owner statement under 37 CFR 1.530(b) was filed in this reexamination proceeding. No Office action has yet been rendered in this proceeding.

As evidenced by the above facts, reexamination Control No. 90/011,308 and reexamination control No. 90/011,383 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 1-16, all of the claims in US patent No. 5,827,178, 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. 90/011,308 and 90/011,383 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

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. |
|---|---|---|---|---|
| 90/011,310 | 11/01/2010 | 7568964 | GANZ-36219US28 | 1138 |

26206 7590 01/26/2012

Pearne & Gordon LLP
1801 East 9th Street
Suite 1200
Cleveland, OH 44114-3108

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/26/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MAILED**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PERKINS COIE LLP
POST OFFICE BOX 1208
SEATTLE, WA 98111-1208

Date: JAN 26 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011310
PATENT NO. : 7568964
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Pearne & Gordon LLP
1801 E. 9th Street
Suite 1200
Cleveland, OH 44114-3108

(For Patent Owner)

MAILED

JAN 26 2012

CENTRAL REEXAMINATION UNIT

Perkins Coie LLP
P.O. Box 1208
Seattle, WA 98111-1208

(For Requester)

*In re* Ganz
Reexamination Proceeding
Control No. 90/011,310
For: U.S. Patent No. 7,568,964

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.515 AND
: 37 CFR 1.181

This is a decision on the January 6, 2011 paper entitled "PETITION UNDER 37 C.F.R. 1.515 and 1.181 FOR DIRECTOR TO REVIEW THE DENIAL OF REEXAMINATION REQUEST NO. 90/011,310" No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 7,568,964 ('964 patent") issued on August 4, 2009 to Howard Ganz.

2. On April 20, 2010, a Request for *Inter Partes* Reexamination of the '964 patent was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 95/001,345 ("IP proceeding"). The Request sought reexamination of claims 1-20.

3. On July 10, 2010, reexamination of claims 1-20 was ordered in the IP proceeding.

4. On September 8, 2010, an action closing prosecution, which confirmed claims 1-20 as patentable, was mailed in the IP proceeding.

5. On November 1, 2010, a Request for *Ex Parte* Reexamination of the '964 patent was deposited by a third party requester, and this proceeding was assigned Control No. 90/011,310 ("EP proceeding"). The Request sought reexamination of claims 1-20.

6. On December 10, 2010, the Request for Reexamination filed in the EP proceeding was Denied.

7. A petition was filed by the Third Party Requester "petition" was received on January 6, 2011

8. The IP proceeding is pending Decision on the appeal filed April 7, 2011 at the Patent Trial and Appeal Board.

9. A copy of the Third Party Requester's January 6, 2011 petition along with a "Status Inquiry" letter was received on January 13, 2012.

## DISCUSSION

Third party requester ("Petitioner") in the EP proceeding has petitioned seeking relief from the Examiner's December 10, 2010 Order denying *ex parte* reexamination for all requested claims.

### I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1-20 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

> The requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely

filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2242(I) provides, in pertinent part:

Where a second or subsequent request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the ongoing pending reexamination proceeding. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Once the second or subsequent request has provided a "different" substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. The information directed to a proposed new or amended claim in the pending reexamination is addressed during the later filed reexamination (where a substantial new question is raised in the later reexamination for the existing claims in the patent), in order to permit examination of the entire patent package. When a proper basis for the subsequent reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate. This also prevents a patent owner from simply amending all the claims in some nominal fashion to preclude a subsequent reexamination request during the pendency of the reexamination proceeding.

MPEP § 2242(II)(A) provides, in pertinent part:

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 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 substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability 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 examination(s), in view of a material new argument or interpretation presented in the request.

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be de novo. Each decision by the CRU Director will conclude with the paragraph:

> This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

If the petition is granted, the decision of the CRU Director should include a sentence setting a 2-month period for filing a statement under 37 CFR 1.530, the reexamination file will then be returned to the CRU Supervisory Patent Examiner (SPE) of the art unit that will handle the reexamination for consideration of reassignment to another examiner.

## II. Summary of the Most Pertinent Patent Prosecution History, the Reexamination Prosecution History, and the Basis for the SNQ.

*Pertinent Patent Prosecution History (12/250,757)*

On Oct. 14, 2008, claims 1-20 were filed with a **Petition to Make Special Under Accelerated Examination**.

With this petition, Applicant filed Accelerated Examination Supporting Documentation ("Supporting Documentation") that deemed the cited references to be most closely related to the subject matter of each of the claims. (Supporting Documentation, pg. 5)

Applicant also provided identification of all the limitations of the claims that are disclosed by each reference specifying where the limitation is disclosed in the cited reference. (Supporting Documentation, pgs. 6-73)

Applicant also provided a detailed explanation of how each of the claims are patentable over these references and why it would not be obvious to combine any of these references to arrive at the claimed combination of steps. (Supporting Documentation, pgs. 74-103)

As to reasons for patentability, Applicant states: (Supporting Documentation, pg. 74)

> In section 9(B), above, each limitation of each claim is discussed with respect to each reference. As should be apparent from the above discussion, with respect to independent claim 1, none of the references identified above teach every limitation of this claim, in particular, none of the references teach the combined steps of: 1) providing a toy that is represented on a website via a virtual replica of the toy, wherein the toy is associated with a registration code; and 2) interacting the virtual replica of the toy with at least one of one or more virtual furnishings. Further, for the following reasons, it would not be obvious to combine these references to arrive at the claimed combination of steps.

On April 9, 2009, the Examiner noted the Supporting Documentation had been reviewed and issued double patenting and 35 USC §101 rejections but otherwise did not issue an art rejection. *Inter alia*, USP 6910186 to Kim ("Kim") was applied and distinguished in the Supporting Documentation.

On June 15, 2009, claims 1-20 were allowed and the Examiner indicated the following as reasons for allowance. (Notice of Allowance, pg. 2)

> *Using a registration code obtained from a plush toy to register the toy on a website where the plush toys come to life in a virtual environment; and*
>
> *Providing a virtual room for the virtual toy replica where the virtual furnishing can be arranged in the virtual room and the virtual replica can interact with the virtual furniture.*

*Pertinent IP Proceeding Prosecution History (95/001,345)*

On Apr. 20, 2010, an *inter partes* request for reexamination was deposited by a Third Party Requester requesting reexamination of claims 1-20 of the '964 patent.

On Jul. 10, 2010, *inter partes* reexamination of claims 1-20 was ordered because, *inter alia*, the *The Sims Booklet, The People Simulator from the Creators of SimCity* published 2000 ("Sims Booklet") presented a Substantial New Question of Patentability ("SNQ").

On Sept. 8, 2010, an action closing prosecution was mailed confirming claims 1-20 as patentable.

On Feb. 10, 2011, Third Party Requester filed a Notice of Appeal.

After receiving the Appeal Brief, Respondent's Brief, and Rebuttal Briefs, the proceeding is pending review on the appeal.

*Basis for the SNQ*

Based on the prosecution history of the application for the '964 patent, a reasonable Examiner would consider a teaching of "*using a registration code obtained from a plush toy on a website where the plush toys come to life in a virtual environment*" and "*providing a virtual room for the virtual toy replica where the virtual furnishing can be arranged in the virtual room and the virtual replica can interact with the virtual furniture*" to form the basis of an SNQ as to claims 1-20 because the Examiner of the application (12/250,757), which became the '964 patent, reviewed the Detailed Explanation of Patentability (Supporting Documentation, pgs. 74-103) and found the arguments distinguishing the cited references to be persuasive. (Non-Final Rejection, pg. 2)

As such, a reasonable Examiner would consider the following teaching to form the basis for a SNQ as to claims 1-20.

> *Using a registration code obtained from a plush toy to register the toy on a website where the plush toys come to life in a virtual environment; and*
>
> *Providing a virtual room for the virtual toy replica where the virtual furnishing can be arranged in the virtual room and the virtual replica can interact with the virtual furniture.*

## DECISION

I. The SNQ Allegedly Raised by Kim

*A. 3PR argues there is no indication that Kim was ever considered.*

Kim does not present an SNQ because it was previously considered in the application (12/250,757) that became the '964 patent.

In order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination (95/001,345) for the claims in effect (claims 1-20) at the time of the determination. MPEP §2242(I)

Here, 3PR argues Kim presents a SNQ because on the whole, the record suggests that the content of Kim escaped review during earlier examination. (Petition mailed Jan. 6, 2011, pgs. 4-5) 3PR argues based on a comparison of Kim to the reasons for allowance, it can be reasonably inferred that the relevant sections of Kim escaped review in the original examination. The argument that the record on a whole suggest that Kim escaped review, however, is not persuasive because 3PR has omitted the Examiner's Non-Final Rejection mailed Apr. 9, 2009, wherein the Examiner expressly notes that the Supporting Documentation submitted via the Accelerated Examination process was reviewed.

As such, 3PR's argument that Kim escaped review in the examination of the application (12/250,757) that became the '964 patent is not persuasive because the record on a whole suggests that Kim was reviewed and considered as indicated in the Non-Final Action.

*B.* *3PR Argues the Request Relies on Portions Not Previously Considered.*

The cited portions of Kim do not present this 'old art' in a new light.

A substantial new question of patentability 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 examination, in view of a material new argument or interpretation presented in the request. MPEP §2242(II)(A)

Here, 3PR argues Kim presents a SNQ because the request filed in the instant proceeding relies on portions of Kim, which were not previously considered. (Petition mailed Jan. 6, 2011, pgs. 5-6) 3PR argues col. 18:13-35, col.17:63-67, and col. 3:49-50 present Kim in a new light. (Petition mailed Jan. 13, 2012, pg. 5)

First, 3PR argues col. 18:13-35 of Kim is a portion not previously considered and as such presents Kim a new light. (Petition mailed Jan. 6, 2011, pg. 5) The argument that this portion of Kim was not previously considered, however, is not persuasive because a review of the prosecution history of the application (12/250,757) that became the '964 patent indicates, *inter alia*, that at least col.18:13-31 was considered and applied to the references because the Supporting Documentation, which was reviewed by the Examiner, is replete with citations and discussions of col.18:23-31. A sample is excerpted below. (Supporting Documentation, pg. 9)

With respect to claim 1, Kim teaches a method that provides a virtual presentation (column 8, line 66 to column 9, line 5) comprising:

providing a toy that is represented on a website via a virtual replica of the toy, wherein the toy is associated with a registration code (column 17, lines 37-43; column 18, lines 23-25);

displaying said virtual replica of the toy representing said toy on said website (column 18, lines 27-31);

providing at least one virtual room on the website for the virtual replica of the toy (column 17, lines 37-43; column 18, lines 27-31); and

one or more virtual furnishings for the at least one virtual room (column 17, lines 57-62).

Further, col. 18:32-35, which is not cited in the prosecution history, does not present Kim in a new light because a teaching as to 'generic avatars' as set forth in col.18:32-35, does not form the basis of an SNQ as to claims 1-20, as set forth above. For the reader's convenience, col.18:32-35 of Kim are excerpted below.

able to use the corresponding WARRIORS avatar in the graphic chatroom **223** (FIG. 9D). Users that are unable to enter such a password may be limited to using generic avatars (selected from a predetermined list **222**), or may not even be allowed to enter chatroom **223**, depending on the implementation. Such restriction in the use of organizational

. Second, 3PR argues col.17:63-67 of Kim is a portion not previously considered and as such presents Kim a new light. (Petition mailed Jan. 6, 2011, pg. 5) The argument that this portion of Kim presents Kim in a new light is not persuasive because col.17:63-67, which is reproduced below, is cumulative to teachings of Kim because it is merely another implementation of an embodiment (col.17:57-62) that is discussed and applied repeatedly in the prosecution history of the application that became the '947 patent. See below for excerpt of the col.17:57-62 citation discussed in the Supporting Documentation. Further, for the reader's convenience col.17:57-67 of Kim is reproduced below.

across the world can become friends. The just-described graphic chatroom of the alternative embodiment may be designed with a background appropriate for the corresponding avatars (see act **215** in FIG. 9B), e.g. may contain furniture of a BARBIE® doll house, and may be in pink color.

In one implementation, one or more users are allowed to use such avatars free of charge, so as to familiarize the user(s) with the corresponding products, thereby to serve as an advertisement for the products. Depending on the embodiment, all avatars used in a chatroom may share a

Third, 3PR argues col. 3:49-50 of Kim is a portion not previously considered and as such presents Kim a new light. (Petition mailed Jan. 6, 2011, pg. 5) The argument that this portion of Kim presents Kim in a new light is not persuasive because col.3:49-50, which is

reproduced below, is cumulative to teachings of Kim that was applied and considered in the prosecution history because this teaching is merely a recitation of the background of the '947 patent.

> another pane on the user's computer display screen. Avatars can move freely throughout sites, express themselves 50

As such, for the reasons set forth above, it is not agreed that the portions cited in the request present the 'old art' of Kim in a new light, or in a different way, as compared with its use in the earlier examination (12/250,757), in view of col. 18:13-35, col.17:63-67, and col. 3:49-50 of Kim.

II. The SNQ Allegedly Presented by the Sims Booklet

The portions of Kim cited in the Request do not present this 'old art' in a new light and as such, the Sims Booklet is not presented in a new light by virtue of its presence with Kim.

A substantial new question of patentability 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 examination, in view of a material new argument or interpretation presented in the request.

Here, 3PR argues that although the teaching of the Sims Booklet was considered in the pending IP proceeding, it is presented in a new light by virtue of its presence with Kim. (Petition mailed Jan. 6, 2011, pgs. 9-10) This argument, however, is not persuasive because Kim is 'old art' that has not been presented in a new light for the reasons set forth above. As such, the Sims Booklet is not presented in a new light by virtue of its presence with Kim. Further, the Sims Booklet is cited for the same teaching presented in the pending IP proceeding. As such, the combination of Kim and the Sims Booklet merely present teachings cumulative to the prior art of record because the alleged new teachings of Kim were previously considered in the application that became the '947 patent and the teaching of the Sims Booklet is being considered in the pending IP proceeding and the combination of Kim and the Sims Booklet, as a whole, do not present these teachings a new light.

Consequently, the Sims Booklet, alone or combined with Kim, does not present a SNQ in a new light, or in a different way, as compared to its use in the earlier examination (12/250,757 and 95/001,345) as to claims 1-20 of the '947 patent.

Accordingly, the petition is **DENIED**.

## SUMMARY AND CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is **DENIED**.

2. This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,315 | 12/06/2010 | 5792753 | 44242.21500 | 4512 |

30734 7590 12/22/2011

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

| 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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-22-11

John F. Dolan
FREDRIKSON & BYRON, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011315
PATENT NO. : 5792753
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MAILED**

DEC 22 2011

CENTRAL REEXAMINATION UNIT

BAKER & HOSTETLER, LLP (For Patent Owner)
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

JOHN F. DOLAN (For Third Party Requester)
FREDRIKSON & BYRON, P.A.
200 SOUTH 6TH STREET,
SUITE 4000
MINNEAPOLIS, MN 55402

In re Falk et al.
Reexamination Proceeding
Control No.: 90/011,315
Filed: December 6, 2010
For: U.S. Patent No.: 5,792,753

**DECISION ON PETITION UNDER 37 CFR 1.182**

This is a decision on the October 19, 2011 patent owner petition under 37 CFR 1.182 to enter, and 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 October 19, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. On August 11, 1998, U.S. Patent No. 5,792,753 (the '753 patent) was issued to Falk et al.

2. On November 3, 2010, a request for *ex parte* reexamination of claims 1-5 and 7-16 of the '753 patent was initially deposited by a third party requester, which request was assigned Reexamination Control No. 90/011,315 (the '315 proceeding). A corrected request was then filed, and received a filing date of December 6, 2010.

3. On February 10, 2011, the Office issued an order granting the '315 reexamination request.

4. The '315 proceeding progressed to the point where a Notice of Intent to Issue a Reexamination Certificate (NIRC) issued on September 29, 2011. A supplemental NIRC was issued on October 19, 2011.

5. On October 19, 2011, patent owner filed the instant petition accompanied by an IDS, for which patent owner requests consideration by the Office.

6. The reexamination proceeding is being processed toward publication of the reexamination certificate.

## RELEVANT LAW AND PROCEDURE

**35 U.S.C. 305 Conduct of reexamination proceedings states (in part):**

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

**MPEP 2256 states (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

In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process, for consideration of the accompanying IDS papers, has been appropriately filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

In the present instance, the submission fails to satisfy both items (A) and (B), because there is not a full ***factual accounting*** to explain why the information submitted could not have been submitted earlier or an ***explanation of the relevance*** of the information submitted with respect to the **claimed invention** in the reexamination proceeding. The instant petition was filed very late in the reexamination proceeding, and no substantive attempt is made to satisfy the guidance of MPEP 2256. In this instance, patent owner has not made a full factual accounting to explain why the information is being submitted so late, and also has not provided a discussion of the substance of the information, i.e., patent owner has not explained the relevance of the same with respect to the claim limitations in the present reexamination proceeding.

Patent owner does not explain in the instant petition how the references were "inadvertently" omitted from submission in the present proceeding, for the entirety of the delay. In regards to providing a factual accounting to explain why the information could not have been submitted earlier, the petitioner/patent owner only indicates that it determined on or about October 11, 2011 that the references were "inadvertently" omitted from submission. This is not a full and proper factual accounting in accordance with MPEP 2256 guidance as to why the references could not have been submitted sooner. The inadvertent omission realization of October 11, 2011 is an insufficient factual accounting for the entirety of the delay. Namely, patent owner needs to provide a factual accounting from when notice of the information arose in copending litigation, where the information was identified in the defendant's invalidity contentions, until the submission of the IDS on October 19, 2011. Patent owner knew of the existence of the references as early as the date of the defendant's invalidity contentions, which presumably is prior to the issuance of the September 29, 2011 NIRC. The mere fact that patent owner did not realize that it wished to submit the information until October 19, 2011 does not provide a basis for regressing the present proceeding to consider the proffered information. As is pointed out below, patent owner can present the information to the Office via a new reexamination request, if the information is relevant enough to raise a substantial new question of patentability as to at least one claim of the patent *different* from that raised in this proceeding.

Without a detailed and meaningful factual accounting for the entire time period of delay in the IDS submission, it is unclear as to why there should have been any delay in submitting the references pre-NIRC in addition to the twenty day delay from September 29, 2011 NIRC issuance until Office receipt of the IDS submission in the '315 proceeding. Accordingly, patent owner has failed to satisfy the factual accounting requirement in MPEP 2256 for submission of a post NIRC IDS. It is noted that patent owner states in the present petition that the complete listing of the documents identified by the defendant in the copending litigation is attached thereto as Appendix A; however, such an appendix (which does not affect the present evaluation of the factual accounting requirement) does not appear to be included in the instant petition.

In regard to explaining the relevance of the submitted information (item (B) in MPEP 2256), the patent owner makes only a broad generalization about the content of the references, stating that the listed references are purportedly relevant to the claimed invention in the reexamination proceeding, as these references were identified in the defendant's invalidity contentions in the copending litigation. Such a patent owner statement does not constitute an explanation of relevance with respect to the claimed invention and the claim limitation. Instead, it amounts to nothing more than a broad characterization of the references un-tethered to the claimed invention. Therefore, the patent owner has failed to satisfy the MPEP 2256, item (B) requirement for submission of a post NIRC IDS.

Patent owner has requested waiver of the unequivocal statement requirement in MPEP 2256, which requires patent owner to unequivocally explain why the art submitted makes at least one claim unpatentable. The unequivocal statement is required when an IDS is submitted and the proceeding is in the printing cycle. The October 19, 2011 IDS was submitted before the present proceeding entered the printing cycle. Therefore, an unequivocal statement was not required. Accordingly, the request for waiver of the unequivocal statement requirement in MPEP 2256 is dismissed.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, nor does patent owner explain the relevance of the information submitted with respect to the claimed invention and the claim limitations in the reexamination proceeding. Therefore, the instant petition does not satisfy the requirements for a petition submitted for consideration of an IDS after the NIRC has been mailed.

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." A review of the record shows that the examiner terminated prosecution on the merits by issuing a NIRC on September 29, 2011 (as supplemented on October 19, 2011), and the proceeding is being prepared to enter 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 provide the requisite discussion (factual accounting and explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers.

If however, the patent owner in fact believes that any reference submitted raises a substantial new question of patentability as to at least one claim of the patent *different* from that 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.

## CONCLUSION

1. The petition is dismissed.

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 Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

December 22, 2011

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

Himanshu Amin, LLC
127 Public Square, 57th Floor
Cleveland, OH 44114

For Patent Owner

MAILED

JUN 14 2011

CENTRAL REEXAMINATION UNIT

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

For 3rd Party Requester
90/011,366

Paul, Hastings, Janofsky & Walker LLP
875 15th Street, NW
Washington, DC 20005

For 3rd Party Requester
90/011,316

*Ex Parte* Reexamination Proceeding
Control No. 90/011,366
Filed: December 6, 2010
For: U.S. Patent No. 5,855,343

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,316
Filed: December 30, 2010
For: U.S. Patent No. 5,855,343

Reexamination proceedings control Nos. 90/011,366 and 90/011,316 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. 90/011,366 was ordered in a decision mailed December 21, 2010, granting reexamination of claims 1, 2, 5-8, 10, 14-17, and 19 appearing in US Patent No. 5,855,343. Patent owner did not file a patent owner statement. No Office action has yet been rendered in this proceeding.

Reexamination in application Control No. 90/011,316 was ordered in a decision mailed March 23, 2011 indicating that claims 1, 10, and 19 appearing in US Patent No. 5,855,343 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. 90/011,366 and reexamination control No. 90/011,316 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 only claims 1, 2, 5-8, 10, 14-17, and 19 appearing in US Patent No. 5,855,343, 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. 90/011,366 and 90/011,316 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

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. |
|---|---|---|---|---|
| 90/011,319 | 11/08/2010 | 6208804 | 155727-0013 | 1853 |

25224 7590 04/05/2011

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/05/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

Date:

MAILED

APR 05 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011319
PATENT NO. : 6208804
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

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

(For Patent Owner)

MAILED
APR 05 2011
CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

(For Requester)

In re Ottesen *et alia*
Reexamination Proceeding
Control No. 90/011,319
For: U.S. Patent No. 6,208,804

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the February 4, 2011 paper entitled "PETITION UNDER 37 C.F.R. §1.515 FROM DENIAL OF EX PARTE REEXAMINATION REQUEST". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 6,208,804 (hereinafter, the '804 patent) issued on March 27, 2001 to Ottesen *et alia.*

2. On November 8, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-7, 11, 13-19, 23-25 and 27-28 of the '804 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,319 (hereinafter, the '11319 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on January 24, 2011.

4. On February 4, 2011, the present petition was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11319 reexamination proceeding has petitioned seeking relief from the examiner's January 24, 2011 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the November 8, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '804 patent filed in the '11319 reexamination

proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

The '804 patent matured from application number 09/035,624 (the '624 application). During prosecution of the '624 application, the examiner applied an obviousness rejection of most original claims over Abecassis (US Patent Number 5,434,678) in view of Russo (US Patent Number 5,701,383). The combination of Abecassis and Russo contains teachings directed to a direct access storage device with a controller that writes and stores non-chronologically ordered source program segments and reads the non-chronologically ordered source program segments as chronologically ordered source program segments as well as many other features. The combination rendered all claims unpatentable other than claims 12 and 40. Claim 12 was cancelled and claim 40 was renumbered as claim 12 at allowance (and is not subject to the present request).

In response to the rejection, applicant amended the independent claims on September 18, 2000 to include a common actuator and added various details of the read and write transducers as follows (claim numbers as renumbered at allowance):

1. A direct access storage device for buffering at least a chronological portion of a multimedia program defined by non-chronologically ordered source program segments, each of the source program segments being representative of a unique portion of the chronological multimedia program portion, the direct access storage device comprising:

at least one data storage disk having a plurality of data storing regions disposed on any of a lower disk surface and an upper disk surface;

a spindle motor for rotating the at least one data storage disk;

a[n] common actuator having elongated arms;

a transducer comprising read and write elements disposed on each of the elongated arms; and

a controller that coordinates writing of the non-chronologically ordered source program segments to the plurality of data storing regions using the write elements of the transducers, and coordinates reading of the non-chronologically ordered source program segments from the data storing regions as chronologically ordered local program segments using the read elements of the transducers.

14. A direct access storage device for buffering at least a sequential portion of a multimedia program defined by non-sequentially ordered source program segments each representing a unique portion of the sequential multimedia program portion, the direct access storage device comprising:

at least one data storage disk having a lower data storing region defined on a lower surface of the disk and an upper data storing region defined on an upper surface of the disk;

a spindle motor for rotating the at least one data storage disk;

a[n] common actuator having elongated upper and lower actuator arms;

an upper transducer disposed on the upper actuator arm and a lower transducer disposed on the lower actuator arm, each of the upper and lower transducers respectively comprising a read element and a write element; and

controller means for controlling the transfer of the non-sequential source program segments from the upper and lower transducers to the upper and lower data storing regions, respectively, and for controlling the transfer of the non-sequential source program segments as sequentially ordered local program segments from the upper and lower data storing regions respectively to the upper and lower transducers.

24. A method for transferring non-chronologically ordered source program segments representing a chronological portion of a multimedia program to and from a direct access storage device, wherein each of the source program segments represents a unique portion of the chronological multimedia program portion, the method comprising:

providing a direct access storage device having a plurality of data storing regions defined on a surface of at least one data storage disk disposed in the direct access storage device, the direct access storage device further comprising at least one pair of read/write transducers arranged for simultaneous movement by a common actuator;

moving the common actuator to sweep the read/write transducers repeatedly between respective inner and outer diameter locations of the at least one data storage disk;

writing, while moving the common actuator, the non-chronologically ordered source program segments to at least two of the plurality of data storing regions; and

reading, while moving the common actuator, the non-chronologically ordered source program segments from the at least two of the plurality of data storing regions as chronologically ordered local program segments.

Since the office had highly relevant technological teachings regarding the program segments and only lacked teachings regarding details of the disk including a common actuator and various details of the transducers, further teachings to the program segment limitations would be cumulative to the art considered by the office in the '624 application.

Turning to the '11319 request, the section of the request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY" (pages 14-20) sets forth requester's position that the MPEG standard, Boyce (US Patent Number 5,805,762) and Kupnicki et al. (US Patent Number 4,742,544) raise a substantial new question of patentability as to claims 1-7, 11, 13-19, 23-25, 27, and 28 of the '804 patent. However, the discussion ignores the prosecution history of the '624 application. The teachings outlined in this section are cumulative (and in some cases, less on point) to the teachings that the Office had before it when the original claims of the '624 application were rejected as being obvious over Abecassis in view of Russo and requester presents no position to the contrary.

To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

> However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:
>
> This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.
>
> Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:
>
> [The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing

> patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.
> *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary*, 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

It is noted that a single sentence is added to the end of the SNQ discussion of each of the three references that requester alleges raises an SNQ. These sentences refer the Office to the detailed explanation of requester's proposed rejections. However, it is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.

Since requester has only presented SNQs with respect to the MPEG standard, Boyce, and Kupnicki et al., and the technological teachings therein are cumulative to the combined teachings of Abecassis and Russo applied to the claims in the '624 application before the September 18, 2000 amendment, the examiner reached the correct conclusion in denying the '11319 request. Accordingly, the petition is **denied**.

Petitioner argues that the Office should analyze the other references in their proposed rejections to determine whether an SNQ is raised by those references. The Office disagrees. However, in the interest of not having a similar request filed with sections of the proposed rejections submitted as the alleged new technological teachings, the Office will analyze the other references in this decision.

Before turning to whether an SNQ may appear in the proposed rejections that does not appear in the section of the request entitled "SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY", a discussion of a previous reexamination proceeding on the '804 patent is informative.

The '804 patent was the subject of a previous reexamination, control number 90/008,097 (the '8097 proceeding). During the '8097 proceeding, the examiner rejected each of the independent claims over the teachings of Hooper alone and with the combined teachings of Lang and Sedlmayer with either Sierra or Quantum. Those rejections were appealed to the Board of Patent Appeals and Interferences (BPAI). On July 1, 2010, BPAI issued a decision reversing the rejections.

The BPAI held that "claim 1 requires the segments to be, or arrive in, non-chronological order...thereby defining the type of segments to be written as non-chronologically ordered", thus rendering the claims non-obvious over the combination of references. Also, the BPAI held

that, among other features, "Hooper does not teach coordinating the reading of non-chronologically order data as chronologically order as set forth in the disputed clause".

Returning to the '11319 request, requester proposes four grounds of rejection. Three rejections include the Hooper reference (in view of the MPEG standard, Boyce, or Kupnicki et al.). However, Hooper does not disclose the common actuator limitations. Requester points to the following within the Hooper reference

> Hooper states that the buffer memory can be a disk drive similar to drives used in personal computers ("In the preferred embodiment of the invention, the memory block 300 is a small form factor disk drive, similar to the disk drives that are used in personal computers." *(at col. 15:12-15)*

Since Hooper is at best silent as to the common actuator, requester turns to a declaration to provide a teaching that a common actuator was known:

> The memory block 300 would have been deployed, as noted above, in the form of a conventional, suitably high throughput hard drive. *(Schonfeld Dec. 17)* One such hard drive was the Hawk 4 from Seagate, which had upper and lower disk surfaces. *(Schonfeld Dec. 18)* It is well known that such disk drives included a common actuator for read/write heads. *(Schonfeld Dec. 18)*

So, it is not the Hooper reference that provides the teaching, it is a declarant's assertion that it was well known to include a common actuator that might raise an SNQ. It should be noted that declarant does not allege that Hooper inherently contains a teaching for a common actuator (because Hooper does not). Requester's position set forth in the proposed rejection is that Hooper is silent as to the common actuator teaching but a declarant states it would have been well known to use a common actuator. So, the alleged SNQ is not based on prior art patents or printed publications, but is based on a declaration asserting that common actuators were well known. Although such a declaration may be used as part of a proposed rejection, the declaration may not be the basis for establishing a substantial new question of patentability as it is not a prior art patent or printed publication.

Lastly, requester presents a proposed rejection of claims 1, 14, and 24 only as being obvious over Ton-That in view of the MPEG standard. The Ton-that patent is assigned to Quantum and contains similar teachings to the Quantum reference applied in the '8097 proceeding for the relevant claim limitations. Requester asserts that the MPEG Standard contains teachings drawn to taking the transmitted MPEG bitstream with frames that are out of order relative to the original sequence of video frames and reordering the frames at the decoder "prior to display or storage". So, the MPEG Standard teaches reordering the frames to be chronological or sequential, then writing the chronological or sequential frames to storage. This is the opposite of the claim language that requires writing the non-chronological or non-sequential program segments to storage. The MPEG Standard is less on point than previously considered teachings during prosecution of the '624 application or the '8097 proceeding. The combination with Ton-that does not cure the deficiency and is less on point than the obviousness rejections that were reversed by the BPAI in the '8097 proceeding.

This decision also addresses another paper filed on February 4, 2011 entitled "PETITION TO EXPEDITE UNDER 37 C.F.R. §1.182". Requester appears to want to have the other petition filed February 4, 2011 decided (presumably granted) before a stay of outside litigation is lifted. It is noted that the stay was lifted on February 8, 2011. Since the petition on denial is denied and the stay has been lifted, the petition to expedite is **dismissed as moot**.

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,208,804 has been presented in the request filed November 8, 2010 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,321 | 11/09/2010 | 5,774,186 | 155727-0024(REDJ) | 2679 |

25224 7590 05/09/2011

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/09/2011

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

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

Date:

**MAILED**

**MAY 09 2011**

**CENTRAL REEXAMINATION UNIT**

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011321
PATENT NO. : 5774186
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

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

(For Patent Owner)

MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

(For Requester)

In re Brodsky *et alia*
Reexamination Proceeding
Control No. 90/011,321
For: U.S. Patent No. 5,774,186

: DECISION
: DISMISSING
: PETITIONS
:

This is a decision on the February 4, 2011 paper entitled "PETITION UNDER 37 C.F.R. §1.515(C) FROM DENIAL OF EX PARTE REEXAMINATION REQUEST AS TO CLAIM 3". The petition was timely filed. No fee is required. The petition is before the Central Reexamination Unit for decision.

The petition is **dismissed as moot** for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 5,774,186 (hereinafter, the '186 patent) issued on June 30, 1998 to Brodsky *et alia.*

2. On November 9, 2010, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 3, 11-20 and 35 of the '186 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,321 (hereinafter, the '11321 proceeding).

3. An order granting the request for *ex parte* reexamination was mailed on January 25, 2011. The order found that the request raised a substantial new question

(SNQ) of patentability for claims 11-20 and 35; but the request did not raise an SNQ as to claim 3.

4. On February 4, 2011, the present petition was filed.

5. On May 6, 2011, a Notice of Intent to Issue Reexamination Certificate (NIRC) was mailed. The NIRC made claim 3 subject to reexamination.

## DECISION

Since claim 3 was made subject to reexamination in the NIRC of May 6, 2011, the petition from denial as to claim 3 is **dismissed as moot**.

This decision also addresses another paper filed on February 4, 2011 entitled "PETITION TO EXPEDITE UNDER 37 C.F.R. §1.182". Requester appears to want to have the other petition filed February 4, 2011 decided before a stay of outside litigation is lifted. It is noted that the stay was lifted on February 8, 2011. Since the petition on denial is dismissed as moot and the stay has been lifted, the petition to expedite is **dismissed as moot**.

## SUMMARY AND CONCLUSION

1. Both petitions are **dismissed as moot**.

2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

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

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,323 | 12/23/2010 | 6,300,863 | 1001/216A | 3623 |

26588 7590 04/05/2012

LIU & LIU
444 S. FLOWER STREET SUITE 1750
LOS ANGELES, CA 90071

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/05/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PATENT LAW OFFICE OF RICK MARTIN PC
P.O. BOX 1839
LONGMONT, CO 80502

Date: MAILED

APR 05 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011323
PATENT NO. : 6300863
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

Liu & Liu
444 S. Flower Street
Suite 1750
Los Angeles, CA 90071

**MAILED**

APR 05 2012

**CENTRAL REEXAMINATION UNIT**

Patent Law Office of Rick Martin, PC
P.O. Box 1839
Longmont, CO 80502

In re Christian Cotichini et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,323
Filed: December 23, 2010
For: U.S. Patent No. 6,300,863

: **DECISION**
: **GRANTING PETITION**
: **UNDER 37 CFR 1.137(b)**
: **AND VACATING**
: **CERTIFICATE**

This is a decision on the December 6, 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 December 6, 2011 petition to revive").

The December 6, 2011 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 6, 2011 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,300,863 issued December 13, 2011, for the present proceeding, and the October 28, 2011 Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.[1]

## 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] The December 6, 2011 petition to revive was filed prior to the December 13, 2011 issuance of the reexamination certificate.

**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 under 37 CFR 1.550(d) due to patent owner's failure to timely submit a compliant response to the July 27, 2011 Notice of Defective Paper in Ex Parte Reexamination.[2] MPEP 2266.02 states that the patent owner will be given a time period of one month or thirty days, whichever is longer, from the mailing date of the notice of defective paper to respond to the notice. A response to the July 27, 2011 notice was not filed until December 6, 2011, which was untimely.[3] However, for the purpose of evaluating whether the December 6, 2011 petition to revive is a grantable petition, the submission of the December 6, 2011 response satisfies item (1).[4]

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the December 6, 2011 petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the December 6, 2011 petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,300,863 issued for the present proceeding on December 13, 2011. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) issued on October 28, 2011, 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 6,300,863 to Christian Cotichini of Vancouver (CA) et al. for METHOD AND APPARATUS TO MONITOR AND LOCATE AN ELECTRONIC DEVICE USING A SECURED INTELLIGENT AGENT VIA A GLOBAL NETWORK, appearing in the *Official Gazette* of December 13, 2011, should be deleted, since the reexamination certificate has been vacated.

## CONCLUSION

1. The December 6, 2011 petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the October 28, 2011 NIRC, and the NIRC itself, are **vacated**.

3. The *Ex Parte* Reexamination Certificate issued December 13, 2011, is **vacated**.

---

[2] See: MPEP 2266.02.

[3] Although an extension of time to correct the defect(s) could have been requested under 37 CFR 1.550(c), no such request was made.

[4] The December 6, 2011 response has been found, by the examiner, to be compliant in matters of form. This decision is not directed to the persuasiveness and propriety of the information presented in the December 6, 2011 response as to each of the rejections set forth in the April 1, 2011 Office action; such is the examiner's province.

4. The Office of Patent Publications will take action with respect to the 6,300,863 patent consistent with this decision.

5. Art Unit 3992 of the Central Reexamination Unit will process the December 6, 2011 response to Office action in the 90/011,323 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, Minh Dieu Nguyen, of Art Unit 3992, at (571) 272-3873.

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

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

03/19/12

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. |
|---|---|---|---|---|
| 90/011,328 | 11/19/2010 | 4974088 | 8027-5 | 8274 |

24998 7590 02/13/2012

DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/13/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KANE KESSLER, PC
1350 AVENUE OF THE AMERICAS
26th FLOOR
NEW YORK, NY 10019

Date: MAILED

FEB 13 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011328
PATENT NO. : 4974088
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

DICKSTEIN SHAPIRO LLP : (For Patent Owner)
1825 EYE STREET NW :
Washington, DC 20006-5403 :

MAILED

FEB 13 2012

CENTRAL REEXAMINATION UNIT

KANE KESSLER, PC : (For Third Party
1350 AVENUE OF THE AMERICAS : Requester)
26th FLOOR :
NEW YORK, NY 10019 :

*In re:* Sasaki :
*Ex Parte* Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/011,328 : UNDER 37 CFR § 1.181
Deposited: November 19, 2010 :
For: U.S. Patent No.: 4,974,088 :

This is a decision on a petition filed by the patent owner on March 18, 2011 entitled "PETITION TO VACATE THE ORDER GRANTING REEXAMINATION" ["the petition"] and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to vacate the January 20, 2011 Order Granting Request for *Ex Parte* Reexamination.

The petition is before the Director of the Central Reexamination Unit. Also before the Director are the oppositions filed by the third party requester on April 1 and April 4, 2011 ["the opposition"].

The petition under 37 CFR § 1.181 is dismissed. To the extent the opposition asks for additional relief, it is also dismissed.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 4,974,088 issued on November 27, 1990.
- A request for *ex parte* reexamination was filed and assigned control number 90/011,328, receiving a filing date of November 19, 2010.
- Reexamination was ordered for claims 2-5 of the '088 patent in a decision mailed January 20, 2011. The examiner found an SNQ was not raised in Issue 1 by exhibits B, C and D. The examiner found an SNQ was raised in Issue 2 by exhibits B, C and D combined with exhibit E.
- On March 18, 2011, patent owner filed the instant petition.
- On April 1, 2011, the third party requester filed an opposition as permitted by MPEP § 2246(II). A second, identical, opposition was filed April 4, 2011. It appears the only difference is that the latter includes a certificate of service while the former does not. The Office accepts the opposition filings as timely.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

**MPEP § 2646 Decision Ordering Reexamination**

**II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION (in part):**

A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. *See Joy Mfg. Co. v. Nat 'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is

based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

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:

(A) the reexamination order is not based on prior art patents or printed publications;
(B) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
(C) reexamination was ordered for the wrong patent;
(D) reexamination was ordered based on a duplicate copy of the request; or
(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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration.

## DECISION

The Patent owner ["petitioner"] states that the Order Granting the Request for *Ex Parte* Reexamination is *ultra vires* and must be vacated. Petitioner argues that the Office found the references submitted in the request are either old art or cumulative to those already considered in a previous reexamination and therefore cannot raise a new question of patentability.

Petitioner's arguments do not set forth a proper basis for vacating the Order Granting the Request. As discussed in MPEP § 2246, quoted above, there is no right to petition from an allegedly improper grant of a reexamination request, unless the grant is *ultra vires*. A petition will be entertained "[i]n cases where no discretion to grant a request for reexamination exists." MPEP § 2246(II). This is a rare situation, where the USPTO acted in "brazen defiance" of its statutory authority to grant the request. *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001).

It should therefore be emphasized what the present decision is not. It is not a determination whether the examiner was correct or incorrect in his SNQ analysis, i.e. a decision on the merits of the SNQ. That is not properly within the scope of this decision, as such matters have been delegated to the Board. *See* Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings, 75 Fed. Reg. 36357-58 (June 25, 2010); *see also Ex parte Muzzy Prods. Corp.*, Appeal No. 2009-011350 (B.P.A.I. Aug. 30, 2010). The present decision only determines whether the examiner had discretion to order reexamination, whether the grant was *ultra vires*.

The only potential argument here is that MPEP § 2646(II) permits a petition to vacate, as *ultra vires*, when:

> (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).
>
> As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

As can be seen, the MPEP points to *In re Recreative Technologies* and MPEP § 2242(II)(A) as describing when a reexamination might be vacated. *In re Recreative Technologies* was drawn to purely old art, and to the extent it is still relevant its holding has been modified by statute. This

is explained in MPEP § 2242(II)(A), which tells us that old art may now form the basis of an SNQ if it is determined that it is being viewed in a new and different way. Here, the examiner has provided such an explanation of why the old/cumulative art is being viewed in a new way, such that his determination falls within his discretion to grant the request.

The examiner found that the references at issue here are cumulative to those present and discussed during the prior examination. At the same time, the examiner found that the references, even if cumulative, were being viewed in a new way because it was not clear to what extent they were considered as to obviousness of these particular claims. In the previous examination the Board did not apparently consider obviousness in the prior examination. The prior examiner stated in the NIRC after appeal that claim 2 would not have been obvious because VPS 1200 Documentation and Sensormatic Documentation each fail to teach the input means of the claim, and further that VPS 1200 Documentation lacks the controlling means. The current examiner found in the Order that the Board said that Sensormatic could be combined with VPS 1200 to teach the controlling means with respect to previous claim 1, and doing so now as to claim 2 would therefore have been important to a reasonable examiner such that a new question of patentability is present.

What this means is that the examiner did indeed explain why he was finding that the references were viewed in a new light, why this was a new question of patentability. That explanation of why puts the decision squarely within his discretion. If the examiner is wrong, and the question of patentability was not in fact new, this goes to the merits of whether an SNQ actually exists. As described above, the merits of an SNQ determination are not subject to review by petition; they may be argued and appealed to the Board.[1] Only a grant where no discretion exists is subject to petition. Accordingly, the petition is dismissed.

*Additional Issue Raised by the Opposition*

In section II of the opposition the third party argues that the RCA Manual is not cumulative to the old art from the prior examination, and therefore the examiner should amend the order "to include the RCA Manual as the basis for the reexamination" or issue a new order setting forth the RCA Manual as an additional basis for reexamination. Under 37 CFR § 1.515(c), the requester must seek review of any decision refusing reexamination within one month of the order. This time period is not somehow extended due to patent owner's petition. Accordingly, to the extent the opposition requests review of the order it is untimely and is dismissed.

---

[1] This is only emphasized by the fact that petitioner cites to court and Board decisions in support of its arguments. Petition pp. 2-3. For example, if petitioner is correct that *Ex parte Muzzy Prods. Corp.*, *supra*, controls, then petitioner essentially concedes that this issue has been delegated to the Board and is not an issue for petition.

Furthermore, MPEP § 2248 explains that section 1.515(c) applies only to a denial of a request, not a request that, like here, is granted for other reasons. The opposition's request for review is therefore not a petitionable issue under section 1.515(c) and is dismissed for this additional reason.

Accordingly, both the petition and the opposition are dismissed.

## CONCLUSION

1. The petition under 37 CFR § 1.181 for vacating the Order as *ultra vires* is dismissed.

2. To the extent the opposition sought additional review of the Order, it is dismissed.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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

SEP 29 2011

CENTRAL REEXAMINATION UNIT

Buchanan, Ingersoll & Rooney PC
C/O Charles Wieland III
Post Office Box 1404
Alexandria, VA 22313-1404

(For Patent Owner)

Tracy W. Druce
Novak Druce + Quigg LLP
1000 Louisiana Street, Fifty-Third Floor
Houston, Texas 77002

(For Requester)

In re O'Sullivan et al
Reexamination Proceeding
Control No. 90/011,331
For: U.S. Patent No. 5,487,069

: DECISION GRANTING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the February 1, 2011 paper entitled "PETITION PURSUANT TO 37 CFR § 1.181 FOR SUPERVISORY REVIEW OF ORDER DENYING EX PARTE REEXAMINATION." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 5,487,069 (hereinafter, the '069 patent) issued on January 23, 1996 to O'Sullivan et al.

2. On December 22, 2008, a first request for *ex parte* reexamination of the '069 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/010,367 (hereinafter, the '10367 proceeding).

3. On February 20, 2009, reexamination was granted over all claims in the '10367 proceeding.

4. On April 15, 2010, a second request for *ex parte* reexamination of the '069 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/010,950 (hereinafter, the '10950 proceeding).

5. An order denying the request for *ex parte* reexamination in the '10950 proceeding was mailed on June 21, 2010. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

6. On November 12, 2010, the instant request for *ex parte* reexamination of the '069 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/011,331 (hereinafter, the '11331 proceeding).

7. An order denying the request for *ex parte* reexamination in the '11331 proceeding was mailed on June 21, 2010. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

8. On February 1, 2011, the present petition was filed.

## DECISION

Third party requester ("Petitioner") in the '11331 proceeding has petitioned seeking relief from the Examiner's January 13, 2011 Order denying *ex parte* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 4-16, 20-32, 36-48, 52-60, and 64-152 (all claims currently in effect) was correct.

The following rules and procedures are applicable to this review:

> 35 U.S.C. § 303(c) provides:
>
> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. MPEP §2242.

II. Summary of the Prosecution and Reexamination History of the '069 Patent

The '069 patent issued on January 23, 1996 to O'Sullivan et al claiming priority to a foreign application, Australian Application No PL6069, filed November 27, 1992. During the prosecution of the '069 patent, original claims 1-21 were initially presented. Following a rejection, claims 1-21 were canceled and claims 22-91 were added. On August 7, 1995, claims 22-91 were allowed.

The Examiner separately indicated each independent claim allowable for failing to teach a particular combination of the elements of:

- means for modulating input data of said input data channel into a plurality of sub-channels comprised of a sequence of data symbols such that the period of a sub-channel symbol is longer than a predetermined period representative of the time delay of significant ones of non-direct transmission paths.

- each said transceiver being operable to transmit and receive data at radio frequencies in excess of 10 GHz

- radio transmissions to one of said hub receivers in a confined multipath environment

- a wireless LAN

- a plurality of mobile transceivers

In the '10367 proceeding, patented claims 1-72 were initially rejected in a non-final office action mailed November 14, 2009. Patent Owner responded to the non-final office action and amended the claims to add the "interleaving" element to each independent claim and added new claims 73-138. Patent Owner argued that the interleaving element distinguished the claims over the prior art and that the Telia reference did not qualify as prior art because it was not publicly disseminated.

A second non-final rejection was mailed on June 15, 2010 that rejected claims 4-16, 20-32, 36-48, 52-60, 64-90, 83, 84, 86, 90-94, 96-102, 105, 106, 108, 110-114, 116-122, 125-128, 130-134, and 136-138. Patent Owner responded on August 16, 2010 and argued again that the interleaving element distinguished the claims over the prior art and that the Telia reference was not prior art.

On November 4, 2010, a Notice of Intent to Issue a Reexamination Certificate was mailed that allowed the pending claims. The Examiner indicated that the claims were allowed because Telia was disqualified as prior art. The certificate issued on March 15, 2011 confirming claims 10-16, 26-32, 42-48, 56-60, and 68-72, allowing claims 4-9, 20-25, 36-41, 52-55, 64-67, and 73-152, and canceling claims 1-3, 17-19, 33-35, 49-51, and 61-63. Hence, claims 4-16, 20-32, 36-48, 52-60, and 64-152 are currently in effect.

## III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the November 12, 2010 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ") over the claims currently in force as of the reexamination certificate issued on March 15, 2011. This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

For the reasons set forth below, the request for *ex parte* reexamination of the '069 patent filed in the '11331 proceeding has been found to present an SNQ over claims 4-16, 20-32, 36-48, 52-60, and 64-152 (all claims currently in effect). Therefore, the examiner's decision to deny reexamination is improper.

Petitioner requests the granting of reexamination and presents the following grounds for review:

> 1) Petitioner asserts that Morris qualifies as prior art and raises a SNQ because the claims of the '069 patent incorporating the interleaving element are not entitled to claim foreign priority to the Australian Patent Application PL6069 (hereinafter, PL6069) and Morris teaches frequency interleaving.
>
> 2) Petitioner argues that Okada in view of Le Floch raises a SNQ over the requested claims.
>
> 3) Petition requests the new evidence regarding Telia be reviewed to determine if it is important to the issue of publication.

Beginning with Morris, Petitioner first argues that the claims of the '069 patent are not entitled to the claimed foreign priority date and thus Morris is prior art. Specifically, Petitioner asserts that the interleaving element present in each independent claim (as of the reexamination certificate issued March 15, 2011) is not supported by PL6069 which was cited for foreign priority.

The interleaving feature is described in the specification of the '069 patent at column 2 lines 58-60, column 8 lines 17-21, column 10 lines 14-46, Figure 7 Item 43 and Figure 8 Item 67. As an example, the specification states:

> "The third technique is interleaving (to be described hereafter) which is essentially a further data reliability enhancement. This technique improves the performance or many FEC schemes in overcoming the problems caused by nulls in the channel's frequency response." *'069 Patent, column 8 lines 17-21.*
>
> "As referred to above, link data interleaving schemes can be used, in this system, to further improve the error correcting performance of FEC codes which distribute the contribution of individual data elements over fewer carriers than the total number in the ensemble. Link data interleaving schemes do this by distributing the encoded data between the carriers in such a way that the correlation in error probability of those carriers associated with any given element of uncoded input data is minimized. On average, this corresponds to maximizing the minimum frequency spacing between those carriers." *'069 Patent, column 10 lines 14-25.*

In comparison, PL6069 never specifically mentions data interleaving. PL6069 describes two techniques for providing high speed bit transmission in a hostile radio environment (*see PL6069 at Page 9).* The '069 patent contains the same disclosure of the two techniques and adds a third technique: frequency interleaving (*see '069 patent at column 8 lines 17-21).* The portions of the '069 patent specification appearing above describing data interleaving are not presented in PL6069. Further, the data interleaving elements presented in the figures of the '069 patent appear do not appear in the figures presented in PL6069. Thus, the data interleaving feature present in each independent claim is not supported by PL6069 and accordingly the claims of the '069

patent are not entitled to foreign priority. As a result, the earliest effective priority date of the '069 patent is the filing date of November 23, 1993.

In view of the above, Morris is prior art to the '069 patent in view of its September 1993 date. Now turning to the question of whether a SNQ is raised, the Request asserts that Morris raises a SNQ stating:

> "Morris explicitly discloses, modulation means using inverse Fast Fourier Transforms, Forward Error Correction, using 1/1 rate convolutional encoding, and interleaving within one block that is transmitted simultaneously (i.e., frequency-only interleaving). See Morris at 40, 46, 48, 60, and 71-73. Morris also explicitly discloses the confined multipath environment, and elongating the signal to overcome the effects of non-direct transmission paths. Id. at 40, 46, and 48." *Request for Reexamination at 33.*

The Request cites Morris at page 71 which states:

> "D-OFDM over the frequency selective channel has burst error characteristics as described earlier. By utilizing interleaving it is possible to break up bursts and distribute the errors more uniformly. By breaking up the bursts, once correlated errors become more or less independent and thus more easily corrected by convolutional codes. Interleaving has in the past, received limited acceptance for realtime systems due to the decoding delay it introduces. The block nature of D-OFDM lends itself to interleaving across one block at a time. This results in the burst errors due to fades being distributed across the block with no decoding delay penalty. In limiting interleaving to one block, the maximum interleaving depth is constrained to the square root of the number of bits in the block. If the square root is not an integer, then the nearest factors of the block size are the limit. For example, for a block length of 1008 bits, the upper limit is 31.75 bits with the nearest factors being 28*36. Therefore, the maximum interleaving depth is 28 bits.
>
> By varying the number of sub carriers used in D-OFDM, the maximum interleaving depth in bits can be increased or decreased. Figure 4.4 shows interleaving depth in bits versus number of sub carriers and interleaving depth in MHz versus number of sub carriers for a 100 MHz channel." *Morris at 71-72.*

Morris raises a SNQ over claims 4-16, 20-32, 36-48, 52-60, and 64-152 (all claims currently in effect) because it provides teachings relevant to the interleaving element that was argued as the distinguishing feature of the claims. A reasonable Examiner would consider Morris' teachings of frequency interleaving of bits across a channel described above important in determining the patentability of the claims. Accordingly, Morris raises a SNQ over claims 4-16, 20-32, 36-48, 52-60, and 64-152.

Petitioner next argues that Okada in view of Le Floch raises a SNQ over the requested claims. The Petition focuses upon features found distinguishing during the prosecution of the '069 patent. However, with the publishing of the certificate on March 15, 2011, the analysis of whether a SNQ is raised turns upon the features argued to be distinguishing in the prior reexamination. The Request relies asserts that Le Floch teaches the interleaving element found

to be distinguishing in the '10367 proceeding. In discussing Le Floch's teachings of the interleaving feature and how it raises a SNQ, the Request states:

> "Furthermore, Patent Owner has made multiple representations throughout the Response filed on 8-16-10, that the interleaver must "interleave[] data blocks having one or more bits across frequency but not across time." Response filed 8-16-10 at 9. Accordingly, since Le Floch discloses each and every one of these limitations, the Office would consider the teachings of Le Floch important when deciding the issue of patentability. Based on those teachings the Office should reexamine and find claims 1-152 unpatentable based on Le Floch in the combinations presented herein below and cancel claims 1-152 of the '069 patent, rendering these claims of the '069 patent null, void and otherwise unenforceable.
>
> ... Moreover, Le Floch explicitly discloses, modulation means using Inverse Fast Fourier Transforms, Forward Error Correction, using 1/1 rate convolutional encoding, and interleaving within one block that is transmitted simultaneously (i. e., frequency-only interleaving). See Le Floch at 495-497,502." *Request for Reexamination, Page 34.*

Le Floch raises a SNQ over claims 4-16, 20-32, 36-48, 52-60, and 64-152 (all claims currently in effect) because it provides teachings relevant to the interleaving element that was argued as the distinguishing feature of the claims in the prior reexamination. A reasonable Examiner would consider Le Floch's teachings of frequency-only interleaving of the bits of one block transmitted simultaneously described above important in determining the patentability of the claims. Accordingly, Le Floch raises a SNQ over claims 4-16, 20-32, 36-48, 52-60, and 64-152.

Turning to Telia, Petitioner requests Supervisory review of the new evidence submitted regarding the Telia reference's publication to determine if it is important to the issue of publication. In the '10367 proceeding, Telia was found to not qualify as prior art because "there is no evidence that it was presented in a public forum or otherwise made available publicly prior to the earliest effective data of the '069 patent." *See '10367 proceeding, NIRC at 12-13.*

The instant Request asserts that the combination of Telia and Proakis renders claims 68 and 128 obvious. *See Request at 246.* The Request asserts that a SNQ is raised by the new evidence submitted regarding Telia's publication and by Proakis' teaching "that interleaving is added to the system as an effective way to deal with burst errors, which are prevalent in multipath and fading environments. Id. at 441-442." The cited portions of Proakis states:

> "An effective method for dealing with burst error channels is to interleave the coded data in such a way that the bursty channel is transformed into a channel having independent errors. Thus, a code designed for independent channel errors (short bursts) is used.
>
> A block diagram of a system that employs interleaving is shown in Fig. 5.2.24. The encoded data are reordered by the interleaver and transmitted over the channel. At the receiver, after (either hard or soft decisions) demodulation, the deinterleaver puts the data

in proper sequence and passes it to the decoder. As a result of the interleaving/deinterleaving, error bursts are spread out in time so that errors within a code word appear to be independent." *Proakis at 440-441.*

Proakis' teachings regarding interleaving would be important to a reasonable Examiner in determining the patentability of claims 68 and 128 because it provides teachings relevant to the interleaving element that was argued as the distinguishing feature of the claims in the prior reexamination. Accordingly, Proakis independently raises a SNQ over claims 68 and 128 and a discussion of the Telia reference is omitted.

Accordingly, the petition is **granted**.

## SUMMARY AND 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 4-16, 20-32, 36-48, 52-60, and 64-152 (all claims currently in effect) 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).

**Waiver of Patent Owner Statement Period:** 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. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

**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. This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,332 | 11/15/2010 | 5,803,101 | 4953/2401-US0 | 1407 |

7590 02/24/2012

EVERETT G. DIEDERIKS
DIEDERIKS AND WHITELAW PLC
12471 DILLINGHAM SQUARE
# 301
WOODBRIDGE, VA 22192

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/24/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LEASON ELLIS LLP
81 MAIN STREET
SUITE 503
WHITE PLAINS, NY 10601

Date: 2-24-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011332
PATENT NO. : 5803101
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)).

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

Everett G. Diederiks (For Patent Owner)
Diederiks and Whitelaw PLC
12471 Dillingham Square
#301
Woodbridge, VA 22192

Leason Ellis LLP (For Third Party Requester)
81 Main Street
Suite 503
White Plains, NY 10601

In re Charles V. Gallo :
*Ex Parte* Reexamination Proceeding : **DECISION**
Control No. 90/011,332 : **GRANTING**
Filed: November 15, 2010 : **PETITION UNDER**
For: U.S. Patent No. 5,803,101 : **37 CFR 1.137(b)**

This is a decision on the December 20, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to final Office action and revive the present terminated[1] reexamination ("the December 20, 2011 patent owner petition to revive").

The December 20, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 20, 2011 patent owner petition to revive is **granted**.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### 35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

[1] Although a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.550(d) for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.113, to the final Office action of September 14, 2011.

**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.

Regarding item (1), the instant reexamination proceeding was terminated due to the failure to timely submit a response to the September 14, 2011 final Office action pursuant to 37 CFR 1.550(b). In a reexamination proceeding terminated for failure to reply to a final Office action, the reply required for consideration of a petition to revive must be (i) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable or (ii) a Notice of Appeal and appeal fee.[2] Patent owner submitted a Notice of Appeal and paid the corresponding fee of $310.00 on December 20, 2011, thereby satisfying item (1).

The petition fee of $930.00 was also submitted as part of the December 20, 2011 patent owner petition to revive, thereby satisfying item (2).

Additionally, a proper statement under 37 CFR 1.137(b)(3) was submitted on December 20, 2011. Therefore, item (3) is deemed to have been satisfied.

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the December 20, 2011 patent owner petition to revive is **granted**.

## CONCLUSION

1. The December 20, 2011 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

---

[2] See: MPEP 2268(IV) and MPEP 711.03(c)(II)(A)(2)(b).
[3] *See*: 37 CFR 1.137(d)(3).

2. Art Unit 3991 of the Central Reexamination Unit will process the December 20, 2011 Notice of Appeal in the 90/011,332 reexamination proceeding.

3. The time period for filing an appeal brief is set to expire **TWO MONTHS** from the mailing date of this decision. See MPEP 711.03(c)(II)(A)(2)(b). The time 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, Elizabeth McKane, of CRU Art Unit 3991, at (571) 272-1275.

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

02/23/12

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. |
|---|---|---|---|---|
| 90/011,340 | 11/18/2010 | 5903803 | 00684.002278.38 | 6037 |

5514 7590 03/02/2011

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/02/2011

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

MAILED

Date: MAR 02 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MEI & MARK LLP
P.O. BOX 65981
WASHINGTON, D.C. 20035-5981

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011340
PATENT NO. : 5903803
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.: 90/011,181 & 90/011,340 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED 28 February 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 20 January 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: _____
   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/
[*Signature*]

SPE, AU 3992 Central Reexamination Unit
(Title)

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

FITZPATRICK CELLA HARPER
& SCINTO
1290 Avenue of the Americas
NEW YORK NY 10104-3800

(For Patent Owner)

MAILED

MAY 19 2011

CENTRAL REEXAMINATION UNIT

MEI & MARK LLP
P.O. BOX 65981
WASHINGTON, DC 20035-5981

(For Third Party Requester)

*In re:* Kawai *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,182 :
Deposited on: 24 August 2010 :
For: US Patent No. 6,128,454 :

*In re:* Kawai *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,341 :
Deposited on: 18 November 2010 :
For: US Patent No. 6,128,454 :

**DECISION DISMISSING PETITION FOR EXPUNGEMENT OF PAPERS [37 CFR §§ 1.59(b) & 1.181]**

This is a decision on the petition dated 03 May 2011, petition entitled, "Petition to Expunge Information Under 37 CFR § 1.59(b)." The petition seeks to have documents submitted under MPEP § 724.02 expunged from the file of *Ex Parte* Reexamination Proceeding control numbers 90/011,182 & 90/011,341.

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

The petition is dismissed for the reasons set forth below.

## DISCUSSION

The Patent Owner's representative requests for expungement of material subject to protective order filed under MPEP § 724.02 filed as exhibits in a sealed envelope. The petition does not meet all of the requirements of MPEP § 724.05 and has provided the appropriate fee.

The request is dismissed.

## CITATION OF RELEVENT AUTHORITY

**37 CFR § 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in

support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

...

**37 CFR § 1.59 Expungement of information or copy of papers in application file.**

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

**MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File** (in-part)

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).
...

## ANALYSIS AND FINDINGS

The Patent Owner's representative requests expungement of material subject to protective order filed under MPEP § 724.02. Since the petition lacks the statement I. (C) for "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," the petition is not fully compliant with the requirements of MPEP § 724.05 the petition is hereby dismissed.

## CONCLUSION

1. The patent owner's petitions to expunge Under Seal papers dated 03 May 2011 is hereby **dismissed.**

2. The proceedings continue in the process to issue a Reexamination Certificate. The Patent Owner may re-file the petition for reconsideration. If however, the petition is not timely and the Certificate issues, the documents will be made public

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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. |
|---|---|---|---|---|
| 90/011,341 | 11/18/2010 | 6,128,454 | 00684.002278.39 | 6093 |

5514 7590 03/01/2011

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/01/2011

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
MEI & MARK LLP
P.O. BOX 65981
WASHINGTON, DC 20035-5981

Date:

MAILED

MAR 01 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011341 + 90/011,182
PATENT NO. : 6128454
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.: 90/011,182 & 90/011,341 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED 28 February 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 31 January 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: _____
   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/
[*Signature*]

SPE, AU 3992 Central Reexamination Unit
(Title)

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

FITZPATRICK CELLA HARPER
& SCINTO
1290 Avenue of the Americas
NEW YORK NY 10104-3800

(For Patent Owner)

MAILED

MAY 19 2011

CENTRAL REEXAMINATION UNIT

MEI & MARK LLP
P.O. BOX 65981
WASHINGTON, DC 20035-5981

(For Third Party Requester)

*In re:* Kawai *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,182 :
Deposited on: 24 August 2010 :
For: US Patent No. 6,128,454 :

*In re:* Kawai *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,341 :
Deposited on: 18 November 2010 :
For: US Patent No. 6,128,454 :

**DECISION DISMISSING PETITION FOR EXPUNGEMENT OF PAPERS [37 CFR §§ 1.59(b) & 1.181]**

This is a decision on the petition dated 03 May 2011, petition entitled, "Petition to Expunge Information Under 37 CFR § 1.59(b)." The petition seeks to have documents submitted under MPEP § 724.02 expunged from the file of *Ex Parte* Reexamination Proceeding control numbers 90/011,182 & 90/011,341.

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

The petition is dismissed for the reasons set forth below.

## DISCUSSION

The Patent Owner's representative requests for expungement of material subject to protective order filed under MPEP § 724.02 filed as exhibits in a sealed envelope. The petition does not meet all of the requirements of MPEP § 724.05 and has provided the appropriate fee.

The request is dismissed.

## CITATION OF RELEVENT AUTHORITY

**37 CFR § 1.181 Petition to the Director.**

(a) Petition may be taken to the Director:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in

support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

...

**37 CFR § 1.59 Expungement of information or copy of papers in application file.**

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

**MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File** (in-part)

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).
...

## ANALYSIS AND FINDINGS

The Patent Owner's representative requests expungement of material subject to protective order filed under MPEP § 724.02. Since the petition lacks the statement I. (C) for "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," the petition is not fully compliant with the requirements of MPEP § 724.05 the petition is hereby dismissed.

## CONCLUSION

1. The patent owner's petitions to expunge Under Seal papers dated 03 May 2011 is hereby **dismissed.**

2. The proceedings continue in the process to issue a Reexamination Certificate. The Patent Owner may re-file the petition for reconsideration. If however, the petition is not timely and the Certificate issues, the documents will be made public

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

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

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

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

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

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

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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. |
|---|---|---|---|---|
| 90/011,182 | 08/24/2010 | 6,128,454 | 20014.0007-00 | 3830 |

5514 7590 05/26/2011

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/26/2011

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



Copied from 90011182 on 11/30/2011

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
MEI & MARK LLP
P.O. BOX 65981
WASHINGTON, DC 20035-5981

Date: MAILED

MAY 26 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011182
PATENT NO. : 6128454
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 90011182 on 11/30/2011

| ***Decision Granting 37 CFR 1.59 Petition in Reexamination*** | Control No.: 90/011,182 |
|---|---|

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 05-23-2011 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

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



Copied from 90011182 on 11/30/2011

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

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, SPE
Central Reexamination Unit 3993

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

Schmeiser, Olsen & Watts
22 Century Hill Drive
Suite 302
Latham, NY 12110

For Patent Owner

MAILED

APR 28 2011

CENTRAL REEXAMINATION UNIT

Holland Law Office, PLLC
P.O. Box 1840
Boise, ID 83701-1840

For 3rd Party Requester
90/011,072

Welsh Flaxman & Gitler LLC
2000 Duke Street
Suite 100
Alexandria, VA 22314

For 3rd Party Requester
90/011,357

*Ex Parte* Reexamination Proceeding
Control No. 90/011,072
Filed: June 29, 2010
For: U.S. Patent No. 6,536,188

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,357
Filed: November 29, 2010
For: U.S. Patent No. 6,536,188

Reexamination proceedings control Nos. 90/011,072 and 90/011,357 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. 90/011,072 was ordered in a decision mailed September 3, 2010. The decision indicating that claims 1-20, all of the claims in US Patent No. 6,536,188 would be reexamined. A non-final Office action was mailed

November 5, 2010, rejecting claims 1-20. Patent owner filed a timely response on January 5, 2011. The response included an amendment to claims 15, 17, and 18 and added new claims 21-25[1]. No Office action has been rendered in response to patent owner's reply of January 5, 2011.

Reexamination in application control No. 90/011,357 was ordered in a decision mailed January 20, 2011. The decision indicating that claims 1-20, all of the claims in US Patent No. 6,536,188 would be reexamined. No patent owner's statement pursuant to 37 CFR 1.530 was filed and no Office action has been rendered in this reexamination proceeding.

As evidenced by the above facts, reexamination Control No. 90/011,072 and reexamination control No. 90/011,357 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. As noted above, claims 15, 17, and 18 have been amended and new claims 21-25 added in reexamination control no. 90/011,072 by virtue of the response filed January 5, 2011. **Accordingly, patent owner is hereby required to provide a "housekeeping" amendment within one month of the mailing date of this decision placing identical claims in each of the files, which amendment must comply with the requirements of 37 CFR 1.530(f)(1) (i.e., use single bracketing rather than double bracketing to show deletion of original patent text).** 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.

**Conduct of Proceedings**

The reexamination proceedings are consolidated and will result in the issuance of a single certificate. Currently original claims 1-20 and newly added claims 21-25 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

[1] It is noted that the amendment fails to comply with the requirements of CFR 1.530(f)(1) in that deletions of text from the claims has been shown by using double brackets rather than single brackets.

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. 90/011,072 and 90/011,357 are hereby merged into a single proceeding. **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 each of the files.** Upon receipt of the response or expiration of the time period indicated above, whichever comes first, 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 Primary Examiner, at telephone No. (571) 272-4361.

Andres Kashnikow, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,357 ~~90/011072~~ | 11/29/2010 | 6536188 | STEU.2418RE2 | 7570 |

5409 7590 02/29/2012

SCHMEISER, OLSEN & WATTS
22 CENTURY HILL DRIVE
SUITE 302
LATHAM, NY 12110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/29/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

WELSH FLAXMAN & GITLER LLC
2000 DUKE STREET
SUITE 100
ALEXANDRIA, VA 22314

Date: 2-29-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011357 ~ 90/011072
PATENT NO. : 6536188
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MAILED**

**FEB 29 2012**

**CENTRAL REEXAMINATION UNIT**

Schmieser, Olsen, & Watts
22 Century Hill Drive
Suite 302
Latham, NY 12110

(For Patent Owner)

Holland Law Office, PLLC
P.O. Box 1840
Boise, ID 83701-1840

(For Requester in 90/011,072)

Welsh, Flaxman & Gitler
200 Duke Street
Suite 100
Alexandria, VA 22314

(For Requester in 90/011,357)

*In re* Taggart
*Ex Parte* Reexamination Proceeding
Control No. 90/011,072
Filed: June 29, 2010
For: U.S. Patent No. 6,536,188

and

*Ex Parte* Reexamination Proceeding
Control No. 90/011,357
Filed: November 29, 2010
For: U.S. Patent No. 6,536,188

**DECISION**
**DISMISSING PETITION**
**UNDER § 1.183**

This is a decision on the February 3, 2012 patent owner petition entitled "Petition For Suspension of Rules Under 37 C.F.R. § 1.183."

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 to request rule waiver and entry of the supplemental reply filed on February 3, 2012 is **dismissed**.

## BACKGROUND

- On September 3, 2010, *ex parte* reexamination was ordered for claims 1-20 of U.S. Patent 6,536,188, in response to a June 29, 2010 request filed by a third party requester. This proceeding was accorded control number 90/011,072 ("the '11072 proceeding").

- On November 5, 2010, reexamination was ordered, and a non-final Office action rejecting claims 1-20 was issued.

- On January 5, 2011, patent owner filed a response to the non-final Office action, including proposed claim amendments and affidavits, including a declaration by Taggart that addresses a "Bosch aseptic machine."

- On February 4, 2011, *ex parte* reexamination was ordered for claims 1-20 of U.S. Patent 6,536,188, in response to a November 29, 2010 request filed by a third party requester. This proceeding was accorded control number 90/011,357 ("the '11357 proceeding").

- On April 8, 2011, the '11072 and '11357 proceedings were merged.

- On May 17, 2011, patent owner filed Information Disclosure Statements, including at least one article addressing a Bosch aseptic method. Patent owner further filed claim amendments and new claims 21-25.

- On October 3, 2011, the Office mailed a non-final Office action in the merged proceeding, rejecting claims 1-25. The Office extended the time for response by a month, in response to a request by patent owner based in part upon time needed to prepare declarations.

- On January 3, 2012, patent owner filed a timely response which included four evidence submissions, including a declaration by Haan attesting to a licensing agreement on technology covered by the '188 patent.

- On February 3, 2012, patent owner filed a supplemental reply which included a declaration by Sokal attesting to the existence of a licensing agreement and the existence of a Bosch machine in use by that licensee. Patent owner filed a petition under 37 C.F.R. § 1.183 to waive rules barring entry of the reply, if required.

## APPLICABLE REGULATION

37 CFR § 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

## DECISION

The present patent owner petition under § 1.183 to waive the rules barring entry of a supplemental response was filed on February 3, 2012. Patent owner requests entry of this supplemental response, which contains evidence submitted for the purpose of rebutting positions taken by the Office in the non-final Office action of October 3, 2011.

Patent owner alleges that the instant situation is such that the "extraordinary situation" requirements of § 1.183 are met, justifying waiver of any rule under section 37 of the C.F.R., including § 1.111, which restricts entry of a supplemental response, to the extent that the supplemental response is not found to comply with that rule.[1] In support of the contention that the situation justifies relief under § 1.183, patent owner states that information in a declaration could not have been submitted earlier. This information comprises (1) a licensing agreement executed on January 30, 2012, after the prior date for response, January 3, 2012, and (2) evidence that "Abbott Laboratories owns a Bosch machine."

Rule 183 requires consideration of all relevant facts to determine whether justice requires relief. With respect to the evidence that a licensing agreement was executed on January 30, 2012, petitioner states that such evidence is highly material to patentability because it "shows the acquiescence of others in the industry." However, the declaration provides only the bare fact that a licensing agreement has occurred. As stated at MPEP 716.03(b)(I), "evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits" (citing EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985). The petition does not provide sufficient factual underpinning as to why this newly executed licensing agreement causes an extraordinary situation in the reexamination proceeding such that the normal course of the proceeding under the existing regulations must be suspended.

With respect to the evidence that "Abbott Laboratories owns a Bosch machine," the declarant Jeff Sokal, a Senior Vice-President at Steuben Foods, Inc., states, "[u]pon information and belief, Abbott Nutrition currently uses the Bosch machine referenced in *Packaging World Magazine* article by Reynolds. Ex.2." Ex. 2 is a printout of an article having a print date of December 20, 2010. Declarant has not stated any factual source of knowledge as to the use of the Bosch machine other than via this article. To the extent that the article would be relevant, the article's availability date is given as December 20, 2010, well before patent owner's response date of January 3, 2012. Petitioner has not provided reasoning why this article, and any supporting

[1] As stated in MPEP 2266, 37 C.F.R. 1.111(a)(2) regulates entry of supplemental replies in *ex parte* reexamination.

factual statements about the use of the Bosch machine by another company, could not have been provided at an earlier date. While petitioner presents evidence that Abbott Nutrition underwent a name change, that name change occurred in 2007. Petitioner has failed to establish that this information could not have been supplied to the Office within the previous time period for response such that rule waiver is now required to accomplish that purpose.

It is also noted that the supplemental response would add additional delay to the handling of the proceeding, having the effect of permitting a reply submitted four months after the non-final Office action, taking into account the previously requested extension of time by the patent owner for the express purpose of obtaining additional evidence.

In view of the entirety of the circumstances discussed above, petitioner has failed to establish the existence of extraordinary circumstances sufficient to justify waiver of the rules under § 1.183 to permit entry of patent owner's February 3, 2011 response. Petitioner will have further opportunity in this proceeding to request entry of the aforementioned evidence in accordance with the procedures and restrictions set forth in §§ 1.550(b) and 1.116 in the normal course of the proceeding.

## CONCLUSION

1. The petition is **dismissed**.

2. The February 3, 2012 response will not be entered.

3. Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Brian E. Hanlon

Brian Hanlon
Director
Office of Patent Legal Administration

February 28, 2011

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

Himanshu Amin, LLC
127 Public Square, 57th Floor
Cleveland, OH 44114

For Patent Owner

MAILED

JUN 14 2011

CENTRAL REEXAMINATION UNIT

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

For 3rd Party Requester
90/011,366

Paul, Hastings, Janofsky & Walker LLP
875 15th Street, NW
Washington, DC 20005

For 3rd Party Requester
90/011,316

*Ex Parte* Reexamination Proceeding
Control No. 90/011,366
Filed: December 6, 2010
For: U.S. Patent No. 5,855,343

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,316
Filed: December 30, 2010
For: U.S. Patent No. 5,855,343

Reexamination proceedings control Nos. 90/011,366 and 90/011,316 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. 90/011,366 was ordered in a decision mailed December 21, 2010, granting reexamination of claims 1, 2, 5-8, 10, 14-17, and 19 appearing in US Patent No. 5,855,343. Patent owner did not file a patent owner statement. No Office action has yet been rendered in this proceeding.

Reexamination in application Control No. 90/011,316 was ordered in a decision mailed March 23, 2011 indicating that claims 1, 10, and 19 appearing in US Patent No. 5,855,343 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. 90/011,366 and reexamination control No. 90/011,316 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 only claims 1, 2, 5-8, 10, 14-17, and 19 appearing in US Patent No. 5,855,343, 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. 90/011,366 and 90/011,316 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

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. |
|---|---|---|---|---|
| 90/011,370 | 12/04/2010 | 6118976 | 155727-976EXTP | 7270 |

83619 7590 04/14/2011

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER, NJ 07921

| 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

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. |
|---|---|---|---|---|
| 90/011,428 | 01/10/2011 | 6118976 | 155727-0976EXTP2 | 9649 |

83619 7590 04/14/2011

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER, NJ 07921

| 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
IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

Date:

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011370
PATENT NO. : 6118976
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

MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

Date:

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011428
PATENT NO. : 6118976
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

(For Patent Owner)

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER NJ 07921

(For Third Party Requester)

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

| | |
|---|---|
| *In re* Arias *et alia* | : |
| Reexamination Proceeding | : DECISION *SUA SPONTE* |
| Control No. 90/011,370 | : MERGING |
| Request Deposited: December 4, 2010 | : REEXAMINATION |
| For: U.S. Patent No. 6,118,976 | : PROCEEDINGS |
| | |
| *In re* Arias *et alia* | : |
| Reexamination Proceeding | : |
| Control No. 90/011,428 | : |
| Request Deposited: January 10, 2011 | : |
| For: U.S. Patent No. 6,118,976 | : |

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. 6,118,976 (hereinafter, the '976 patent), issued to Arias *et alia*, on September 12, 2000.

2. On December 4, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '976 patent. The reexamination proceeding was assigned Control No. 90/011,370 (hereinafter, the '11370 proceeding).

3. The Reexamination Order was granted in the '11370 proceeding on January 24, 2011 finding a substantial new question of patentability (SNQP) as to claims 19 and 27.

4. On January 10, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '976 patent. The reexamination proceeding was assigned Control No. 90/011,428 (hereinafter, the '11428 proceeding).

5. The Reexamination Order was granted in the '11428 proceeding on February 7, 2011 finding a substantial new question of patentability (SNQP) as to claims 19 and 27.

**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 '11370 and '11428 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 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. 90/011,370 and 90/011,428 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,381 | 12/09/2010 | 6,121,898 | 067670-3000-US | 4153 |

7590 08/30/2011

JOHN B. MOETTELI
813 PALM DESERT DR.
GARLAND, TX 75044

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/30/2011

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
MORGAN, LEWIS & BOCKIUS, LLP (SF)
ONE MARKET SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

Date: MAILED

AUG 30 2011

CENTRAL REEXAMINATION UI

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011381
PATENT NO. : 6121898
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.: 90/011,381 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED 29 August 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 07 June 2011 which sets a two(2) month period for filing a response to the Office action, be extended by three (3) 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 fourteen (14) days 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 Sudhanshu Pathak at 571-272-5509. In his absence, calls may be directed to Mark Reinhart at 571-272-1611 or Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

| /Sudhanshu Pathak/ for 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 first request for extension of time in this proceeding. While the petition speaks to the considerations of not receiving the Office action because it was mailed to the former counsel's address. This is noted and is persuasive. However considering the other issues raised, 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 proceedings. The requirement for reasonably diligent behavior by patent owner includes a resource management. Resource management takes into account planned holidays and depositions not related to this proceeding as well as termination of previous legal counsel.

There is sufficient cause to grant-in-part the petition for extension of time.

The petition for extension of time is hereby granted-in-part for fourteen (14) days.

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

Jonathan Berall
173 Columbia Heights
Brooklyn, NY 11201

For Patent Owner

**MAILED**

Black Lowe & Graham PLLC
701 Fifth Avenue, Suite 4800
Seattle, WA 98104

For 3rd Party Requester
90/011,308

**MAR 23 2011**

**CENTRAL REEXAMINATION UNIT**

Oblon, Spivak, McClellan, Maier & Neustadt
1940 Duke Street
Alexandria, VA 22314

For 3rd Party Requester
90/011,383

*Ex Parte* Reexamination Proceeding
Control No. 90/011,308
Filed: October 29, 2010
For: U.S. Patent No. 5,827,178

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*Ex Parte* Reexamination Proceeding
Control No. 90/011,383
Filed: December 10, 2010
For: U.S. Patent No. 5,827,178

Reexamination proceedings control Nos. 90/011,308 and 90/011,383 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. 90/011,308 was ordered in a decision mailed December 16, 2010, granting reexamination of claims 1-16, all of the claims appearing in US Patent No. 5,827,178. No patent owner statement under 37 CFR 1.530(b) was filed in this reexamination proceeding. No Office action has yet been rendered in this proceeding.

Reexamination in application Control No. 90/011,383 was ordered in a decision mailed January 7, 2011, indicating that claims 1-16, all of the claims appearing in US patent No. 5,827,178 would be reexamined. No patent owner statement under 37 CFR 1.530(b) was filed in this reexamination proceeding. No Office action has yet been rendered in this proceeding.

As evidenced by the above facts, reexamination Control No. 90/011,308 and reexamination control No. 90/011,383 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 1-16, all of the claims in US patent No. 5,827,178, 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. 90/011,308 and 90/011,383 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

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. |
|---|---|---|---|---|
| 90/011,385 | 02/03/2011 | 6245254 | 15856 | 2505 |

26645 7590 10/12/2011

The Lubrizol Corporation
29400 Lakeland Blvd.
Wickliffe, OH 44092-2298

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/12/2011

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

Date: 10-12-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Peter W. Roberts
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
P.O. BOX 10064
McLean, VA 22102-8064

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011385
PATENT NO. : 6245254
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)).

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

The Lubrizol Corporation (For patent owner)
29400 Lakeland Blvd.
Wickliffe, OH 44092-2298

Peter W. Roberts (For requester)
Roberts Mlotkowski Safran & Cole, P.C.
P.O. Box 10064
McLean, VA 22102-8064

In re Stuart Corr :
*Ex Parte* Reexamination Proceeding : **DECISION GRANTING**
Control No. 90/011,385 : **PETITION UNDER**
Filed: February 3, 2011 : **37 CFR 1.137(b)**
For: U.S. Patent No. 6,245,254 :

This is a decision on the August 25, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated[1] reexamination ("the August 25, 2011 patent owner petition to revive").

The August 25, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 25, 2011 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 ...

### 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 a response under 37 CFR 1.550(b) to the June 9, 2011 Office action.

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 June 9, 2011 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 June 9, 2011 Office action set a two-month period for response. However, a response to the June 9, 2011 Office action was not filed until August 30, 2011, which was untimely. Nevertheless, for

the purpose of evaluating whether the August 25, 2011 patent owner petition to revive is a grantable petition, patent owner's submission of the August 30, 2011 Corrected Amendment and Response satisfies item (1).[2]

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 August 25, 2011, thereby satisfying item (3).

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

Accordingly, the August 25, 2011 patent owner petition to revive is **granted**.

## CONCLUSION

1. The August 25, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Jerry Johnson, of CRU Art Unit 3991, at (571) 272-1448.

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

10/11/2011

[2] This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's August 30, 2011 response as to each of the rejections set forth in the August 30, 2011 Office action or (ii) the August 30, 2011 response's compliance with formal matters; such is the examiner's province.

[3] *See*: 37 CFR 1.137(d)(3).

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. |
|---|---|---|---|---|
| 90/011,394 | 12/17/2010 | 7,777,074 | GASP-004-501 | 8722 |

54434 7590 03/30/2012

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/30/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LISA M. TREANNIE, ESQ.
MORSE, BARNES-BROWN & PENDLETON, P.C.
RESERVIOR PLACE, 1601 TRAPELO ROAD, SUITE 205
WALTHAM, MA 02451

Date: MAILED

MAR 30 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011394
PATENT NO. : 7777074
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)).

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. |
|---|---|---|---|---|
| 90/011,869 | 08/18/2011 | 7777074 | GASP-004-502 | 7260 |

54434 7590 03/30/2012

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/30/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORSE, BARNES-BROWN & PENDLETON, P.C.
ATTN: IP MANAGER RESERVOIR PLACE
1601 TRAPELO ROAD, SUITE 205
WALTHAM, MA 02451

Date: MAILED

MAR 30 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011869
PATENT NO. : 7777074
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

MAR 30 2012

CENTRAL REEXAMINATION UNIT

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

(for Patent Owner)

Morse, Barnes-Brown & Pendleton, P.C.
Reservoir Place, 1601 Trapelo Road
Suite 205
Waltham, MA 02451

(for Third Party Requester)

*In re Kramer et al*
Reexamination Proceeding
Control No.: 90/011,394
Filed: December 17, 2010
For: U.S. Patent 7,777,074

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*In re Kramer et al*
Reexamination Proceeding
Control No.: 90/011,869
Filed: August 18, 2011
For: U.S. Patent 7,777,074

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of merger of these proceedings under 37 C.F.R. 1.565(c).

**BACKGROUND**

1. United States Patent 7,777,074, issued August 17, 2010, is the subject of Reexamination Control Nos. 90/011,394 and 90/011,869.

2. A first request for reexamination, assigned Reexamination Control No. 90/011,394, was filed December 17, 2011 by Morse, Barnes-Brown & Pendleton, P.C in Waltham MA. The request urged that a substantial new question of patentability was raised by the combined teachings of Ramaswamy et al, Rajkumar et al, Petrosyan et al and USPN 4, 379,177 to McCoy.

3. Reexamination was ordered for 90/011,394 on January 25, 2011.

4. A Patent Owners' statement was received on March 25, 2011.

5. A Requester's response was received May 24, 2011.

6. A first Office action on the merits was issued on July 21, 2011.

7. A response from Patent Owner was submitted on September 21, 2011.

8. A second request for *ex parte* re-examination, assigned Reexamination Control No. 90/011,869, was filed August 18, 2011 by Morse, Barnes-Brown & Pendleton, P.C in Waltham MA. The request urged that a substantial new question of patentability was raised by Barger.

9. Reexamination was ordered for 90/011,869 on October 7, 2011. There has been no Patent Owner response.

**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. 1.565 (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 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 90/011,394 and 90/011,869 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." **In light of the fact that Patent Owner has not filed a Patent Owner's Statement within the time allowed and to facilitate the requirement of "special dispatch" the claims from the 90/011,394 proceeding will be copied into the 90/011,869 and the "housekeeping" amendment will not be necessary. The merged proceeding will be forwarded to the examiner for the issuance of a non-final Office action based on the claims as amended. A copy of the amended claims is attached herewith.**

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 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. 90/011,394 and 90/011,869 as:

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/011,394 and 90/011,869 as:

Morse, Barnes-Brown & Pendleton, P.C.
Reservoir Place, 1601 Trapelo Road
Suite 205
Waltham, MA 02451

**CONCLUSION**

Reexamination Control Nos. 90/011,394 and 90/011,869 are merged.

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

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. |
|---|---|---|---|---|
| 90/011,404 ←90009635 | 02/04/2011 | 5,861,807 | RX-1001 | 9320 |

7590 06/27/2011

| EXAMINER |
|---|

WOOD PHILLIPS VAN SANTEN CLARK & MORTIMER
500 WEST MADISON STREET
SUITE 3800
CHICAGO, IL 60661

| ART UNIT | PAPER NUMBER |
|---|---|

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

CHRISTOPHER C. DREMANN, P.C.
15015 LANCASTER HIGHWAY
CHARLOTTE, NC 28277

Date: 6-27-11

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011404 + 90/009635
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUN 27 2011

CENTRAL REEXAMINATION UNIT

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

(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
Control No. 90/009,635
Request Deposited: November 9, 2009
For: U.S. Patent No. 5,861,807

*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

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

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
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,428 | 01/10/2011 | 6118976 | 155727-0976EXTP2 | 9649 |

83619 7590 04/14/2011

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER, NJ 07921

| 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

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. |
|---|---|---|---|---|
| 90/011,370 | 12/04/2010 | 6118976 | 155727-976EXTP | 7270 |

83619 7590 04/14/2011

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER, NJ 07921

| 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

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

Date:

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011370
PATENT NO. : 6118976
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

MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

Date:

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011428
PATENT NO. : 6118976
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

(For Patent Owner)

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

AT & T LEGAL DEPARTMENT - GB
ATTN: PATENT DOCKETING
ROOM 2A- 207
ONE AT & T WAY
BEDMINSTER NJ 07921

(For Third Party Requester)

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

| | |
|---|---|
| *In re* Arias *et alia* | |
| Reexamination Proceeding | : DECISION *SUA SPONTE* |
| Control No. 90/011,370 | : MERGING |
| Request Deposited: December 4, 2010 | : REEXAMINATION |
| For: U.S. Patent No. 6,118,976 | : PROCEEDINGS |
| | |
| *In re* Arias *et alia* | : |
| Reexamination Proceeding | : |
| Control No. 90/011,428 | : |
| Request Deposited: January 10, 2011 | : |
| For: U.S. Patent No. 6,118,976 | : |

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. 6,118,976 (hereinafter, the '976 patent), issued to Arias *et alia*, on September 12, 2000.

2. On December 4, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '976 patent. The reexamination proceeding was assigned Control No. 90/011,370 (hereinafter, the '11370 proceeding).

3. The Reexamination Order was granted in the '11370 proceeding on January 24, 2011 finding a substantial new question of patentability (SNQP) as to claims 19 and 27.

4. On January 10, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '976 patent. The reexamination proceeding was assigned Control No. 90/011,428 (hereinafter, the '11428 proceeding).

5. The Reexamination Order was granted in the '11428 proceeding on February 7, 2011 finding a substantial new question of patentability (SNQP) as to claims 19 and 27.

## 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 '11370 and '11428 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 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. 90/011,370 and 90/011,428 are MERGED.

2. The reexamination files are being forwarded to the examiner for issuing an 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.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,430 | 01/11/2011 | 7585311 | | 1162 |

20995 7590 07/15/2011

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/15/2011

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

Date:

MAILED

JUL 15 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011430
PATENT NO. : 7585311
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

(Patent Owner)

MAILED

JUL 15 2011

CENTRAL REEXAMINATION UNIT

KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-4003

(Third Party Requester)

*In re* Green *et al.*
Reexamination Proceeding
Control No.: 90/011,430
Filed: January 11, 2011
For: U.S. Patent No.: 7,585,311

**DECISION**
**ON PETITION**
**UNDER 37 CFR 1.182**

This is a decision on the April 28, 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 12, 2011 and again on April 28, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. On September 8, 2009, the Office issued U.S. Patent No. 5,585,311, to Green *et al.* (the '311 patent).

2. On January 11, 2011, a third party requester filed a request for *ex parte* reexamination of the '311 patent. The request was assigned reexamination proceeding control number 90/011,430 (the '11430 proceeding).

3. On February 16, 2011, the Office issued an order granting reexamination for the '11430 reexamination proceeding.

4. On February 24, 2011, patent owner filed a waiver of right to file a patent owner statement.

5. On March 28, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '11430 proceeding.

6. On April 1, 2011, the '11430 proceeding entered the printing cycle and designated 452 status.

7. On April 12, 2011, patent owner submitted an IDS without a petition.

8. On April 28, 2011, patent owner filed the instant petition accompanied by the same IDS filed on April 12, 2011, which patent owner requests the Office to consider.

9. The '11430 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the printing cycle).

## RELEVANT LAW AND PROCEDURE

**35 U.S.C. 305 states (in pertinent part):**

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. [Emphasis added.]

**37 CFR 1.97 states (in pertinent part):**

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement ***shall*** be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits; or

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

**37 C.F.R. 1.555(a) states (in pertinent part):**

. . . Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and *should* be filed within two months of the date of the order for reexamination, *or as soon thereafter as possible.* [Emphasis added]

**MPEP 2256 states (in pertinent 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]

**MPEP 2280 states (in pertinent part):**

. . . Such individuals are *strongly encouraged* to file information disclosure statements in accordance with 37 CFR 1.98, within two months of the date of the order to reexamine, *or as soon thereafter as possible*, in order to bring the patents or printed publications to the attention of the Office.

## DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the petition for withdrawal of the present proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

The 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 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)

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC and the proceeding has entered the printing cycle. The instant petition was filed very late in the reexamination proceeding, and it fails to provide any statement as to why the submitted IDS items of information (art citations) make at least one claim unpatentable. Nor has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. Contrary to the explanation of requirements for entry and consideration of an IDS after NIRC, patent owner states the information submitted does not render any claim unpatentable.[1] Furthermore, there is no factual accounting providing a sufficient explanation as to why the information submitted could not have been submitted earlier in the reexamination proceeding. There is no showing as to when patent owner first became aware of the existence of the items of information now being submitted, and no explanation as to why the information could not have been submitted earlier. In light of this lack of a factual accounting as to why the information could not been submitted earlier, in addition to the lack of any amendment with the requisite explanation, petitioner has not satisfied the requirements for consideration of information submitted after NIRC when a proceeding has entered the print cycle. Therefore, the present petition does not satisfy the requirements for a petition submitted for considered of IDS after a NIRC has been mailed and the proceeding has entered the print 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 March 28, 2011, and the proceeding has now entered the final stages of the publication process, *i.e.* the print cycle, as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure explain why it could not have been submitted earlier, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers.

---

[1] See petition at page 2.

**Patent Owner Argument:**

In this instance, the patent owner is arguing that the prior waiver for filing a 37 CFR 1.530 statement entitles patent owner to entry of the materials at issue, because waiver of the patent owner statement permitted issuance of a NIRC closing prosecution in less than two months from the date the Office issues an order granting reexamination. However, that argument does not change the fact that, 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, which would run contrary to the statutory requirement of 35 U.S.C. 305 for special dispatch in reexamination. A patent owner that waives 37 CFR 1.530 is on notice via MPEP 2256 that if a NIRC issues, patent owner must provide the requisite showing to obtain consideration of a post NIRC IDS submission. Thus, by waiving the 37 CFR 1.530 statement patent owner assumed the risk that a NIRC closing prosecution may issue in under two months from the order date, which could affect the entry right for information.

The patent owner also argues that 37 CFR 1.555(a) does not provide an entry time period for IDS submissions in reexamination proceedings, as compared to 37 CFR 1.97 for applications. However, in view of the statutory requirement of 35 U.S.C. 305 for special dispatch in reexamination, there is no provision in the rules providing for entry of an IDS after a NIRC closes prosecution. A patent owner may resort to 37 CFR 1.182; however § 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**...(emphasis added)

In this instance, "such other requirements as may be imposed" are the MPEP 2256 requirements for the showing which patent owner must successfully provide in order to obtain consideration of a post NIRC IDS submission.

As a final point, *Hicks v. Costello*, 1903 Dec. Comm'r Pat 123, 125 (1903), addressing old Rule 213 directed to cases not specifically provided for in the rules, provided that such relief is not a mechanism for avoiding the requirements of the established rules and procedures, and is available only in extraordinary circumstances. If 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 obtain relief via the rules by filing a new request for reexamination for consideration of such reference(s).

In view of all of the above, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process. The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

**CONCLUSION**

1. The petition is dismissed as to the request to consider the IDS filed on April 28, 2011.

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. 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/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,433 | 01/14/2011 | 6,055,439 | 51020-018USRX | 5971 |

42532 7590 10/04/2011

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/04/2011

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

Date:
MAILED
OCT 04 2011
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011433
PATENT NO. : 6055439
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

(Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YOUR AVENUE, N.W.
WASHINGTON, DC 20001

(Third Party Requester)

**MAILED**

OCT 04 2011

**CENTRAL REEXAMINATION UNIT**

*In re* Helin et al.
Reexamination Proceeding
Control No.: 90/011,433
Filed: January 14, 2011
For: U.S. Patent No.: 6,055,439

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the August 10, 2011 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, information disclosure statements (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 statement filed August 10, 2011 has not been entered for consideration by the examiner.**

## BACKGROUND

1. On April 25, 2000, the Office issued U.S. Patent No. 6,055,439 to Helin *et al* (the '439 patent).
2. On January 14, 2011, a third party requester filed a request for *ex parte* reexamination of the '439 patent. The request was assigned reexamination control number 90/011,433 (the '11433 proceeding).
3. On February 14, 2011, the Office issued an order granting reexamination for the '11433 reexamination proceeding.
4. The proceeding progressed to the point where, on July 21, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '11433 proceeding.
5. On July 26, 2011, the '11433 proceeding was designated 452 status, i.e., as entering the printing cycle.
6. On August 10, 2011, patent owner filed the instant petition requesting entry and consideration of a concurrently filed IDS submission.
7. The '11433 reexamination proceeding is in the final phase of the publication process for printing the 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 proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, 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 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)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the reexamination proceeding, 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 has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. To the contrary, patent owner asserts that the information submitted does not render any of the claims in the '439 patent unpatentable.[1] Moreover, the patent owner does not provide a discussion of the substance of the information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding. Therefore, the present petition does not satisfy the requirements for a petition submitted for consideration of an IDS after a NIRC has been mailed, and the proceeding has entered the printing 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 July 21, 2011, and the proceeding has now entered the final stages of the publication process, i.e. the printing cycle as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition is dismissed as to the request for consideration of the IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted provides a sufficient basis for granting a new reexamination request as to at least one claim of the patent, the patent owner can always file a new request for reexamination for consideration of such reference(s).

---

[1] See petition at page 5.

The IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed.

**CONCLUSION**

1. The petition is dismissed as to the request for consideration of the IDS filed on August 10, 2011.

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. 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

9-27-11

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,433 | 01/14/2011 | 6,055,439 | 51020-018USRX | 5971 |

42532 7590 10/04/2011

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/04/2011

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

Date:
MAILED

OCT 04 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011433
PATENT NO. : 6055439
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

(Patent Owner)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YOUR AVENUE, N.W.
WASHINGTON, DC 20001

(Third Party Requester)

MAILED

OCT 04 2011

CENTRAL REEXAMINATION UNIT

*In re* Helin et al.
Reexamination Proceeding
Control No.: 90/011,433
Filed: January 14, 2011
For: U.S. Patent No.: 6,055,439

: **DECISION ON**
: **PETITION AND**
: **RETURNING**
: **IMPROPER PAPERS**

This is a decision on the July 27, 2011 patent owner petition under 37 CFR 1.182 to enter, and to have the examiner consider, information disclosure statements (IDS) filed on July 25, 2011 and July 26, 2011, both 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 with respect to the July 25, 2011 IDS for the reasons set forth below.

The petition is dismissed as moot with respect to the July 26, 2011 IDS. As the IDS submission is expunged from the record for the reasons set forth below, the petition is moot.

**Thus:**

**1) The IDS submission filed July 25, 2011 has not been entered for consideration by the examiner.**

**2) The IDS submission filed July 26, 2011 is improper and is expunged.**

## BACKGROUND

1. On April 25, 2000, the Office issued U.S. Patent No. 6,055,439 to Helin *et al* (the '439 patent).
2. On January 14, 2011, a third party requester filed a request for *ex parte* reexamination of the '439 patent. The request was assigned reexamination control number 90/011,433 (the '11433 proceeding).
3. On February 14, 2011, the Office issued an order granting reexamination for the '11433 reexamination proceeding.

4. The proceeding progressed to the point where, on July 21, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '11433 proceeding.

5. On July 25, 2011, patent owner filed an IDS after NIRC.

6. On July 26, 2011, the '11433 proceeding was designated 452 status, i.e., as entering the printing cycle.

7. Also on July 26, 2011, patent owner filed a second IDS after NIRC.

8. On July 27, 2011, patent owner filed the instant petition requesting entry and consideration of the July 25, 2011 and July 26, 2011 IDS submissions.

9. The '11433 reexamination proceeding is in the final phase of the publication process for printing the reexamination certificate (*i.e.* it is in the printing cycle).

## RELEVANT LAW AND PROCEDURE

### 35 U.S.C. § 305 provides (in part):

... All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (Emphasis added.)

### 37 CFR 1.535 states:

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(g) provides:

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. (Emphasis added.)

### 37 CFR 1.565(a) provides:

In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an inter partes reexamination proceeding.

### MPEP § 2254 provides, (in part):

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").

The patent owner may not file papers on behalf of the requester and thereby circumvent the intent of the *ex parte* reexamination legislation and the rules. The Court of Appeals for the Federal Circuit held in *Emerson Elec. Co. v. Davoil, Inc.*, 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996) that a federal district court does not have the authority to order a patent owner to file papers prepared by a third party in addition to the patent owner's own submission in a patent reexamination proceeding. **Such papers prepared by the third party and filed by the patent owner will not be entered**, and the entire submission will be returned to the patent owner as an inappropriate response. See MPEP § 2266 and § 2267. (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)

## MPEP § 2266 states (in part):

**The patent owner in an *ex parte* reexamination proceeding must not file papers on behalf of a third party.** 37 CFR 1.550(g). If a third party paper accompanies, or is submitted as part of a timely filed response, the response and the third party paper are considered to be an improper submission under 37 CFR 1.550(g), and **the entire submission shall be returned to the patent owner, since the Office will not determine which portion of the submission is the third party paper. The third party paper will not be considered.** The decision returning the improper response and the third party paper should provide an appropriate extension of time under 37 CFR 1.550(c) to refile the patent owner response without the third party paper. See MPEP § 2254 and § 2267. (Emphasis added)

## MPEP § 2282 provides (in part):

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

## DECISION

### I. The July 25, 2011 IDS Submission

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, for withdrawal of the present proceeding from the publication process to consider IDS papers, the IDS must be accompanied by a petition filed under 37 CFR 1.182, as explicitly pointed out in MPEP § 2282. Patent owner filed the July 25, 2011 IDS one day before the proceeding entered the printing cycle, and it was not accompanied with a petition under 37 CFR 1.182; thus, the July 25, 2011 IDS could not be a proper filing for entry and consideration of an IDS after NIRC. Patent owner had notice of the petition requirement via the MPEP and yet omitted it. Further, with only one day remaining prior to entry of the proceeding in the printing cycle, there was no time to match the IDS with the proceeding, take note of the absence of a petition, and notify patent owner prior to entry of the proceeding into the printing cycle. Patent owner later filed the instant petition requesting entry and consideration of the July 25, 2011, but the petition was not filed until after the proceeding had entered the printing cycle.

With respect to addressing an IDS accompanied by a petition after entry of the proceeding into the printing cycle, 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 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)

In the present instance, the fact situation fails to satisfy any grounds that would be analogous to those of 37 CFR 1.313(c). The instant petition was filed very late in the reexamination proceeding, 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 has patent owner filed an amendment to the claim or claims with an explanation as to how the amendment causes such claim or claims to be patentable. To the contrary, patent owner merely states that the items of information are relevant because the information was cited and relied upon by the third party requester during litigation upon the same patent that is at issue in the present proceeding.[1] Further, patent owner states in the petition that none of the references cited render any of the claims of the '439 patent unpatentable. Finally, patent owner does not provide any discussion of the substance of any of the items of information, and has not applied the teachings of the same to the claim limitations in the present reexamination proceeding. The alleged explanation of relevancy is devoid of any explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.

Furthermore, the factual accounting is insufficient to provide an explanation as to why the information could not have been submitted earlier in the reexamination proceeding. Patent owner states that on July 1, 2011, just prior to the fourth of July holiday weekend, patent owner received a document discovery production of large number of electronic pages from the requester in litigation involving the '439 patent.[2] The large number of pages were an admix of prior art documents as well as other documents produced in a single page TIFF file format. Finally patent owner noted the admix of electronic documents contained confidential markings and miss-markings. Patent owner provides an alpha listing of the steps taken and technical/legal issues involved in assessing the July 1, 2011 document production from requester.[3] Patent owner does not correlate the efforts/steps taken to review the information from the date of production receipt, July 1, 2011, to the date the IDS was submitted, July 25, 2011. Patent owner merely makes the blanket assertion that patent owner could not have practically submitted the references sooner.[4] Patent owner states that the July 25, 2011 IDS consists of alpha-numerically designated patent literature references A117-A131 and non-patent literature references C24-C52.[5] Patent

---

[1] Petition at page 5.
[2] See petition at page 3, paragraph 5.
[3] See petition at page 4, paragraph 5.
[4] See petition at page 5, last sentence of paragraph 8.
[5] See petition at page 4, paragraph 6.

owner admits on the record that patent owner was aware of patent literature references A119-121 from the initial stage of the application that issued as the '439 patent.[6] Patent owner asserts that alpha-numeric designated references A117-A131 and C24-C52 were from the July 1, 2011.[7]

Regarding references A119-121, patent owner fails to provide a satisfactory accounting as to why the references could not have been earlier submitted, as patent owner has admitted on the record to awareness of the references based upon their citation in the application that resulted in the '439 patent. Patent owner would have needed to provide a factual accounting as to why the references could not have been cited earlier from when the '11433 proceeding was ordered and not from the date of requester's document production from a related litigation proceeding. Regarding the remainder of the references from the July 25, 2011 IDS submission the factual accounting, is insufficient because patent owner has failed to provide a complete factual accounting. Patent owner includes when they became aware of the information and lists the challenges and actions that needed to be performed to review the information received on July 1, 2011. Patent owner also noted that the information was received right before the Fourth of July holiday weekend, a significant holiday in the United States that would impact upon the availability personnel to review the information for those four days. However, patent owner provided only a generalized discussion of the facts and circumstances regarding review of the information and did not provide any correlation of the facts asserted as to how it precluded submission of the IDS until July 25, 2011, a full three weeks after the Fourth of July holiday weekend was over. Therefore, without a full factual accounting as to the delay in submitting the IDS, it is not completely clear as to why it took three full weeks to submit the IDS. Thus, patent owner has failed to satisfy MPEP 2256, item (A), requirement for submission of a post NIRC IDS.

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 July 21, 2011, and the proceeding has now entered the final stages of the publication process, i.e. the print cycle as evidenced by the proceeding's 452 status. The proceeding is clearly not scheduled to come up for further action on the merits. In order to provide the requested relief, the present proceeding would need to be withdrawn from the publication process, thus significantly regressing the processing of the proceeding. This would run contrary to the statutory requirement of 35 U.S.C. 305 that "[a]ll reexamination proceedings under this section...will be conducted with special dispatch within the Office." The statutory mandate of special dispatch is based upon the public interest in providing certainty and finality as to the question of patentability raised by a request for reexamination. In view of the submission of the IDS information after termination of the prosecution in this reexamination proceeding, the failure to identify a question of patentability of the claims, and the failure to provide the requisite discussion (explanation) of the submitted art citations, the present reexamination proceeding will not be reopened at this late date to consider the proffered IDS papers. Accordingly, the petition

---

[6] Id.

[7] See petition at page 4, first sentence of paragraph 8.

is dismissed as to the request for consideration of the July 25, 2011 IDS papers. The proceeding will not be withdrawn from the publication process.

If, however, the patent owner in fact believes that one or more references submitted provides a sufficient basis for granting a new reexamination request as to at least one claim of the patent, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The July 25, 2011 IDS submitted by patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated for this reexamination proceeding, the IDS will not be considered by the examiner.

In view of the above, the petition is dismissed with respect to the July 25, 2011 IDS.

**II. The July 26, 2011 IDS Submission**

The July 26, 2011 IDS submission is improper, because upon review of the submission, it noted that the patent owner is submitting court documents from related litigation authored by the third party requester. Such a submission is an impermissible "notification" of concurrent proceedings and constitutes third party requester participation in an *ex parte* reexamination proceeding, contrary to statute. The submissions are improper under 37 CFR 1.565(a) and MPEP § 2282 because the third party documents contain impermissible third party arguments in support of a third party's action against the claims of the patent and hence constitute third party requester participation in an *ex parte* proceeding. Therefore, the submissions are improper submissions, and their inclusion on the record would violate the statutory preclusion of third party participation in an *ex parte* reexamination proceeding. The submissions are thus being expunged from the record.

To safeguard the statutory preclusion of third party participation in accordance with 35 U.S.C. 305, MPEP § 2254 provides materials that are prepared by a third party cannot obtain entry by way of the patent owner submitting them. Accordingly, the July 26, 2011 IDS submission lacks an entry right in the present reexamination proceeding because patent owner is submitting arguments made by a third party that does not have any right of entry. While the July 26, 2011 IDS submission was filed by the patent owner, patent owner's petition points to the fact that the papers were from a third party in related proceedings.[8] Patent owner expresses disagreement with the assertions made in the third party authored papers being submitted.[9] Papers that do not have an entry right due to their authorship source and argument content respectively are not entered even if submitted as a notification of concurrent proceedings. These third party authored papers contain arguments that go to the merits of the proceeding, and patent owner relies upon the third party authored papers to assert the relevance of the papers for entry and consideration after issuance of a NIRC in the '11433 proceeding.[10] Patent owner's submission of these third party papers for the relevancy of the information submitted results in improper third party participation in a reexamination proceeding, as the content of the papers is directed to the merits of the reexamination proceeding. The arguments are clearly sourced from the third party requester, who does not have a right to comment on the merits in the present *ex parte* reexamination proceeding, which is contrary the reexamination rules and the statute.

---

[8] See petition at page 4, paragraph 7.
[9] Id. at page 6.
[10] Id. at pages 5-6

Even if patent owner's submissions are treated as a petition to waive 37 CFR 1.565(a), the provisions of this rule cannot be waived, because there is no authority in the statute providing for submission of a third party paper directed to the issues of the reexamination proceeding during the examination-prosecution stage of an *ex parte* reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). To the contrary, the *ex parte* reexamination legislation made the examination-prosecution stage of a reexamination proceeding under 35 U.S.C. 302 - 307 an *ex parte* proceeding. 35 U.S.C. 305 provides (in 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. . . . (Emphasis added)
>
> The examination under the provisions of 35 U.S.C. 132 and 133 is *ex parte* examination. 35 U.S.C. 305 unequivocally requires such *ex parte* examination, and third party input (by a requester or any other party) is thus prohibited after the times for filing the statement and reply provided for by section 304. See also *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO). In *Syntex*, the court said (paragraph bridging pages 1868 & 1869):
>
> "If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, the statute specifically prohibits further participation by third-party requesters during reexamination. See 35 U.S.C. § 305 (**"[a]fter 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"**). Thus, a reexamination is conducted ex parte after it is instituted. See *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1, 5-6 n.6 (Fed. Cir.), *cert. denied*, 474 U.S. 828 (1985)." (Emphasis added in bold)

Accordingly, materials directed to the merits which are authored/prepared by a third party are precluded during the examination-prosecution stage of a reexamination proceeding, because a reexamination proceeding requested under 35 U.S.C. 302 is an *ex parte* proceeding after the expiration of the statement/reply period under 37 CFR §§ 1.530 and 1.535.

In view of the above, the July 26, 2011 IDS submission, has been reviewed only to the extent needed to find that they contain impermissible third party materials, and discussions of same, which touch upon the merits of the '11433 proceeding.

Because the July 26, 2011 IDS submission contains improper papers, the IDS submission is not being made a part of the record of the present proceeding. The July 26, 2011 IDS submission, filed for the '11433 reexamination proceeding is being expunged from the record. As the improper papers have been scanned into the electronic Image File Wrapper (IFW) the papers, the improper papers are being expunged by closing the submission documents in the IFW file of the '11433 proceeding and marking the documents "not public." They will not constitute part of the record of the present reexamination proceeding. In accordance with MPEP § 2266 all papers in the IDS submission will be expunged as the Office will not determine which portion of the submission is the third party paper. A copy of this decision will be made of record in the '11433 proceeding.

As the IDS submission is expunged, because the information submitted therein lacks a right of entry, that portion of the petition requesting entry of the July 26, 2011 IDS after NIRC is moot, and dismissed as such.

## CONCLUSION

1. The petition is dismissed as to the request for consideration of the IDS filed on July 25, 2011.

2. The July 25, 2011 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. The petition is dismissed as moot as to the request for consideration of the IDS filed on July 26, 2011.

4. The July 26, 2011 IDS submission is an improper paper, and therefore it will NOT be made a part of the record of the '11433 proceeding.

5. The July 26, 2011 IDS submission has been scanned into the electronic Image File Wrapper (IFW) of the '11433 proceeding. Thus, the scanned copies the improper papers are being expunged by closing the documents in the IFW file of the present proceeding and marking them as "not public." They will not constitute part of the record of the present reexamination proceeding.

6. The present proceeding will continue in the publication process, toward issuance of a reexamination certificate.

7. 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

9-27-11

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,435 + 90/012126 | 01/14/2011 | 5845219 | 51020-019USRX | 6688 |

42532 7590 04/18/2012

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/18/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Timothy J. May
FINNEGAN HENDERSON FARABOW, ET AL.
901 New York Ave., NW
Washington, DC 20001-4413

Date: 4-18-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011435 + 90/012126
PATENT NO. : 5845219
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**

APR 18 2012

CENTRAL REEXAMINATION UNIT

PROSKAUER ROSE LLP : (For Patent Owner)
One International Place :
Boston, MA 02110-2600 :

FINNEGAN, HENDERSON, FARABOW, : (For Third Party Requester)
GARRETT & DUNNER LLP :
901 New York Avenue, N.W. :
Washington, DC 20001-4413 :

*In re* Henriksson : DECISION *SUA SPONTE* MERGING
*Ex Parte* Reexamination Proceedings : PROCEEDINGS [37 CFR § 1.565(c)]
Control No. 90/011,435 :
Control No. 90/012,126 :
For U.S. Patent No. 5,845,219 :

This is a decision merging *sua sponte* the above identified proceedings pursuant to 37 CFR § 1.565(c).

## STATEMENT OF FACTS RELEVANT TO THE DECISION

- On 1 December 1998, US Patent No. 5,845,219 [hereinafter, "the '219 patent"] was granted to Hannu Henriksson.

- On 14 January 2011, a third party requester filed a first request for *ex parte* reexamination of the '219 patent. The Office assigned this proceeding control number 90/011,435 [hereinafter, "the '435 proceeding"].

- On 26 January 2011, the patent owner agreed to waive its right to file a patent owner's statement in the '435 proceeding.

- On 9 March 2011, the Office ordered reexamination of all claims of the '219 patent, i.e. claims 1-8, in the '435 proceeding. The Office also issued a first Office action on the merits rejecting claims 1-8 in the '435 proceeding.

- On 9 May 2011, the patent owner filed a response to the Office action, dated 14 January 2011, which included an amendment that added new claims 9-19 in the '435 proceeding.

- On 1 July 2011, the Office mailed a final Office action in the '435 proceeding, which rejected original claims 1-8 and allowed new 9-19.

- On 1 September 2011, patent owner filed a response to a final rejection in the '435 proceeding, which included new evidence and a showing of good and sufficient reasons why the evidence was necessary and not earlier presented.

- On 29 September 2011, patent owner filed a notice of appeal in the '435 proceeding.

- On 14 October 2011, the Office mailed a non-final Office action, which rejected original claims 1-8 and allowed new claims 9-19.

- On 14 December 2011, patent owner filed a response to the Office action, dated 14 October 2011, in the '435 proceeding, which amended original claims 1 and 3 and new claims 9, 10, 12, 13, and 15-19.

- On 3 February 2011, a third party requester filed a second request for *ex parte* reexamination of the '219 patent. The Office assigned this proceeding control number 90/012,126 [hereinafter, "the '126 proceeding"].

- On 6 April 2012, the Office ordered reexamination of all claims of the '219 patent, i.e. claims 1-8, in the '126 proceeding.

## RELEVANT AUTHORITY

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.

## DECISION

### I. Merger of Proceedings.

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.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings designated by control numbers 90/011,435 and 90/012,126 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 the requesters will be sent copies of all papers mailed by the Office.

## CONCLUSION

1. The *ex parte* reexamination proceedings designated by control numbers 90/011,435 and 90/012,126 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 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 Daniel Ryman, at (571) 272-3152. In the event that Daniel Ryman is unavailable, Mark Reinhart may also be contacted at (571) 272-1611.

/Daniel Ryman/

Daniel Ryman,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-3152

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. |
|---|---|---|---|---|
| 90/011,436 → 90/011650 | 01/14/2011 | 6253075 | 51020-032USRX | 6866 |

42532 7590 06/22/2011

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/22/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Paul M. Gruzo

FINNEGAN HENDERSON FARABOW ET AL.

901 New York Ave., NW

Washington, DC 20001-4413

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,436. 90011650

PATENT NO. 6253075.

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

JUN 22 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

(For Third Party Requester)

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

(For Third Party Requester)

THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

| | |
|---|---|
| *In re* Beghtol *et alia* | : |
| Reexamination Proceeding | : DECISION *SUA SPONTE* |
| Control No. 90/011,436 | : MERGING |
| Request Deposited: January 14, 2011 | : REEXAMINATION |
| For: U.S. Patent No. 6,253,075 | : PROCEEDINGS |
| | |
| *In re* Beghtol *et alia* | : |
| Reexamination Proceeding | : |
| Control No. 90/011,650 | : |
| Request Deposited: April 19, 2011 | : |
| For: U.S. Patent No. 6,253,075 | : |

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. 6,253,075 (hereinafter, the '075 patent), issued to Beghtol *et alia*, on June 26, 2001.

2. On January 14, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '075 patent. The reexamination proceeding was assigned Control No. 90/011,436 (hereinafter, the '11436 proceeding).

3. The Reexamination Order was granted in the '11436 proceeding on March 24, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-15.

4. A non-final office action was mailed on March 24, 2011 in the '11436 proceeding.

5. On May 24, 2011, Patent Owner responded to the office action in the '11436 proceeding and canceled claims 1-4 and amended claims 10, 13, and 15 (and claims dependent thereon).

6. On April 19, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '075 patent. The reexamination proceeding was assigned Control No. 90/011,650 (hereinafter, the '11650 proceeding).

7. The Reexamination Order was granted in the '11650 proceeding on April 21, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-15.

8. Patent Owner waived their right to a file a Patent Owner statement.

## 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 '11436, and '11650 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 '11436 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. 90/011,436 and 90/011,650 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
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. |
|---|---|---|---|---|
| 90/011,437 | 01/14/2011 | 6542673 | R2551399 | 7015 |

20786 7590 09/26/2011

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 09/26/2011

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
HERSHKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

Date: MAILED

SEP 26 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011437
PATENT NO. : 6542673
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

(For Patent Owner)

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

MAILED

SEP 26 2011

(For Requester) CENTRAL REEXAMINATION UNIT

HERSHKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

*In re*: Holter *et alia* :
Reexamination Proceeding :
Control No. 90/011,437 :
Request Deposited: January 14, 2011 :
For: U.S. Patent No. 6,542,673 :

This is a decision on the April 15, 2011 paper entitled "PETITION UNDER 37 CFR §§ 1.515(c) AND 1.181" requesting examination of claims 12, 14, and 24.

The petition is **dismissed as moot** for the reasons set forth below.

The order granting reexamination found a substantial new question of patentability as to claims 13 but did not find a substantial new question of patentability as to claims 12, 14, and 24. The office action mailed September 2, 2011 examined claims 12-14, 23, and 24. Accordingly, the petition is **dismissed as moot**.

## CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611

Eric Keasel
SPE, Central Reexamination Unit

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**

Wood, Phillips, Katz, Clark & Mortimer
500 W. Madison Street, Suite 3800
Chicago, Il 60601

For 3rd Party Requester
(both Requests)

**CENTRAL REEXAMINATION UNIT**

*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

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. |
|---|---|---|---|---|
| 90/011,444 | 01/18/2011 | 7,272,639 | 306-0003/RE | 9637 |

26111 7590 08/04/2011

EXAMINER

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

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 08/04/2011

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
CAPITOL CITY TECHLAW, PLLC
P.O. BOX 1210
VIENNA, VA 22183

Date:
MAILED

AUG 04 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011444
PATENT NO. : 7272639
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

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934

(For Patent Owner)

MAILED

AUG 04 2011

CENTRAL REEXAMINATION UNIT

Herman R. Heflin III
Capitol City Techlaw, P.L.L.C.
P.O. Box 1210
Vienna, VA 22180

(For 3rd Party Requester)

*In re* Levergood *et al.*
Reexamination Proceeding
Control No.: 90/011,444
Filed: January 18, 2011
For: U.S. Patent No.: 7,272,639

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

This is a decision on the July 15, 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 July 15, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. Patent number 7,272,639 (the '639 patent) issued on September 18, 2007.

2. On February 25, 2011, the Office issued an order granting a January 18, 2011 request for reexamination of claims 1, 10, 60, 65, 66, 68, 69, 78, and 79 of the '639 patent by a third party requester, which was accorded control number 90/011,444 (the '11444 proceeding).

3. The proceeding progressed until, on July 14, 2011, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed for the '11444 proceeding.

4. On July 15, 2011, patent owner filed a Supplemental IDS under § 1.555.

5. The instant petition was filed on July 15, 2011, requesting the Office to consider the July 15, 2011 Supplemental IDS.

6. On July 19, 2011, the '11444 proceeding entered the printing cycle and was designated a 452 status.

## 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

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, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256. This policy states that the submission 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.

In the present instance, the submission fails to satisfy the above-noted criteria. Although the supplemental IDS was filed before the date the proceeding entered the publication cycle (status 452), the instant petition was not filed until July 15, 2011, after a NIRC was mailed for the '11444 proceeding on July 14, 2011. Patent owner has submitted 425 documents in the information disclosure statement accompanying the instant petition. The patent owner provides a statement as to why the references could not have been submitted earlier; to wit, that the large number of documents required over four months to prepare the IDS.[1] However, the petition fails to provide an persuasive explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding, despite the fact that the IDS took four months to prepare.

Petitioner has stated that there are "four classes of documents" submitted in the IDS. These comprise documents already on the face of the '639 patent under reexamination, and documents filed in three litigation proceedings. However, petitioner has not stated why each of the 425 submitted references is relevant with respect to the claimed invention; i.e., the claim limitations, in the reexamination proceeding. It has not been explained what claim limitations are met, and what claim limitations are not. Such an explanation by patent owner is required before the Office will consider an IDS submission after a NIRC has been mailed - to provide the Office with guidance as to evaluation of the submitted citations, in order to counter-balance the statutory requirement for special dispatch. Petitioner has failed to meet the burden set forth in MPEP 2256.

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 July 14, 2011, and the proceeding has now entered the final stages of the publication

[1] Petition at 2.

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 persuasive explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding, 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 July 15, 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

August 2, 2011

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 :

DDJ

MAILED

MAR 30 2011

CENTRAL REEXAMINATION UNIT

KING & SCHICKLI, PLLC
247 North Broadway
Lexington, KY 40507

(for Patent Owner)

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(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

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(for Third Party Requester)

*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,
SPE, Art Unit 3991
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

MAILED

NOV 0 8 2011

CENTRAL REEXAMINATION UNI

KING & SCHICKLI, PLLC
247 North Broadway
Lexington, KY 40507

(for Patent Owner)

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(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

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(for Third Party Requester)

*In re Bloomer*
Reexamination Proceeding
Control No.: 90/011,454
Filed: January 21, 2011
For: U.S. Patent 6,080,330

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(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

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. |
|---|---|---|---|---|
| 90/011,457 ▸ 90011513 | 01/25/2011 | 5684863 | 6646-230A (863) | 8865 |

35554 7590 07/13/2011

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9229 SUNSET BOULEVARD
SUITE 630
LOS ANGELES, CA 90069

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

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

Date: 7-13-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

N. Chris Walters
SENNIGER POWERS, LLC
100 North Broadway, 17th Floor
St. Louis, MO 63102

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011515 → 90/011457
PATENT NO. : 5684863
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

JUL 13 2011

CENTRAL REEXAMINATION UNIT

REENA KUYPER, ESQ. : (For Patent Owner)
BYARD NILSSON, ESQ. :
9229 SUNSET BOULEVARD :
SUITE 630 :
LOS ANGELES CA 90069 :

Daniel F Drexler :
CANTOR COLBURN LLP : (For Third Party Requester)
20 CHURCH STREET :
22ND FLOOR
HARTFORD, CT 06103 :

N Chris Walters :
SENNIGER POWERS LLP : (For Third Party Requester)
100 NORTH BROADWAY :
17TH FLOOR :
ST LOUIS, MO 63102 :

*In re*: Katz : **DECISION**
*Ex Parte* Reexamination Proceeding : ***SUA SPONTE***
Control No. 90/011,457 : **MERGING**
Deposited : 25 January 2011 : **PROCEEDINGS**
For: US Patent No. 5,684,863 : **[37 CFR § 1.565(c)]**
:
*In re*: Katz :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,515 :
Deposited : 28 February 2011 :
For: US Patent No. 5,684,863 :

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

## BACKGROUND

1. On 04 November 1997 US Patent No. 5,684,863 was granted to Ronald A Katz.

2. On 25 January 2011 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,457.

3. On 31 March 2011 the Order was granted for *ex parte* reexamination in control number 90/011,457.

4. On 28 February 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,515.

7. On 29 April 2011 the Order was granted for ex parte reexamination in control number 90/011,515670.

8. There are no amendments to the claims in either control number 90/011,457 & 90/011,515.

## 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. 90/011,457 & 90/011,515 *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.

### 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. 90/011,457 & 90/011,515 *ex parte* reexamination proceedings are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

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
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. |
|---|---|---|---|---|
| 90/011,458 | 01/26/2011 | 5878753 | DGJ-00102 | 1784 |

7590 12/05/2011

TIMOTHY A. CASSIDY
DORITY & MANNING
P O BOX 1449
GREENVILLE, SC 29602-1449

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/05/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD.
BOSTON, MA 02110

Date:
MAILED
DEC 05 2011
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011458
PATENT NO. : 5878753
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)).

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

TIMOTHY A. CASSIDY
DORITY & MANNING
P O BOX 1449
GREENVILLE SC 29602-1449

(Patent Owner)

MAILED

DEC 05 2011

CENTRAL REEXAMINATION UNIT

FOLEY HOAG, LLP
PATENT GROUP
WORLD TRADE CENTER WEST
155 SEAPORT BLVD.
BOSTON, MA 02110

(Third Party requester)

*In re* Peterson *et al.*
Reexamination Proceeding
Control No.: 90/011,458
Filed: January 26, 2011
For: U.S. Patent No.: 5,878,753

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the September 22, 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 September 22, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. On March 9, 1999, the Office issued U.S. Patent No. 5,878,753, to Peterson *et al.* (the '753 patent).

2. On January 26, 2011, a third party requester filed a request for *ex parte* reexamination of the '753 patent. The request was assigned reexamination proceeding control number 90/011,458 (the '11458 proceeding).

3. On April 20, 2011, the Office issued an order granting reexamination for the '11458 reexamination proceeding.

4. On August 30, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '11458 proceeding.

5. On August 31, 2011, the '11458 proceeding entered the print cycle and was designated 452 status.

6. On September 22, 2011, patent owner filed the instant petition accompanied by an IDS, for which patent owner requests consideration by the Office.

7. On November 1, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8644th), US 5,878,753 C1.

## DECISION

The present reexamination proceeding has concluded with the issuance of *Ex Parte* Reexamination Certificate (8644th), US 5,878,753 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '753 patent. Therefore, consideration by the examiner of the proffered information 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 August 30, 2011, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (8644th), thereby divesting the Office of jurisdiction over the '753 patent. However, even had the petition been addressed prior to issuance of the certificate, the September 22, 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 the withdrawal criteria of 37 CFR 1.313(c) must 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 September 22, 2011 IDS, after issuance of a NIRC and after the '11458 proceeding had already entered the printing cycle for issuance of a reexamination certificate. The petition fails to provide a statement as to why the submitted information (an art citation) makes at least one claim unpatentable. The petition also

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 '11458 reexamination proceeding. Furthermore, the petition does not provide a factual accounting as to why the cited information could not have been submitted earlier. Patent owner has admitted on the record to have been in the midst of preparing an IDS when the Office issued a NIRC on August 30, 2011. Patent owner submitted that IDS on September 22, 2011. Outside of the short time necessary to place a call to the examiner of record, the petition provides no factual accounting of the more than three weeks taken to submit that IDS. Further, the petition does not identify when awareness of the documents listed in the September 22, 2011 IDS, e.g. U.S. Patents 3,667,479 and 3,911,932 as well as foreign court documents dated from June 16 to July 1, 2011, occurred, and to account for the time of awareness of each document until September 22, 2011 . Finally, patent owner asserts receipt of International Trade Agreement litigation documents of only one week prior to submission of the September 22, 2011 IDS. However, the litigation documents all contain proof of service certificates reflecting service upon patent owner from February to June of 2011. Therefore, patent owner did not provide a factual accounting as to why the documents could not have been submitted from the receipt of service time and not simply from the time patent owner decided to forward them to reexamination counsel. Accordingly, the present petition does not satisfy the conditions for consideration of an IDS after the proceeding had 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 September 22, 2011 IDS is dismissed.

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 '11458 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, and the proceeding 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 for consideration of the IDS filed on September 22, 2011.

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.

/Kenneth M. Schor/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,459 | 01/28/2011 | 6304715 | 375875US91RX | 5482 |

22850 7590 10/20/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/20/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

Date:

MAILED

OCT 20 2011

CENTRAL REEXAMINATION UI

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011459
PATENT NO. : 6304715
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

OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

**MAILED**

OCT 20 2011

**CENTRAL REEXAMINATION UNIT**

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

(For Third Party Requester)

*In re:* Abecassis
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,459
Deposited: January 28, 2011
For: U.S. Patent No.: 6,304,715

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on May 5, 2011 entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(3) TO VACATE *ULTRA VIRES* GRANT OF *EX PARTE* PATENT REEXAMINATION ORDER" ["the petition"] and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to vacate the April 5, 2011 Order Granting Request for *Ex Parte* Reexamination.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is the opposition filed by the third party on May 19, 2011.

The petition under 37 CFR § 1.181 is dismissed.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,304,715 issued on October 16, 2001.
- A request for *ex parte* reexamination was filed on January 28, 2011 and assigned control number 90/011,459. It requested reexamination of claims 1-10 of the '715 patent.
- An order granting reexamination of claims 1-10 was mailed May 5, 2011 with a first action on the merits. The first action was mailed with the order because the examiner determined patent owner had waived its right to file a statement under 37 CFR § 1.530.
- It was determined that patent owner had not made such waiver, therefore the first action was vacated and expunged from the record in a decision mailed May 14, 2011. The order was not disturbed other than noting as incorrect any reference as to waiver.
- On May 5, 2011, the Patent owner timely filed the instant petition.
- On May 19, 2011, the third party timely filed the opposition to the instant petition.
- Patent owner filed a statement under 37 CFR § 1.530 on June 6, 2011.
- The third party filed a response under 37 CFR § 1.535 on August 3, 2011.
- A first Office action on the merits was mailed on August 26, 2011.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

**MPEP § 2246 Decision Ordering Reexamination**

**II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION (in part):**

A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat 'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's

35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester) . . . . These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

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:

(A) the reexamination order is not based on prior art patents or printed publications;
(B) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
(C) reexamination was ordered for the wrong patent;
(D) reexamination was ordered based on a duplicate copy of the request; or
(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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

## DECISION

The Patent owner ["petitioner"] states that the Order Granting the Request for *Ex Parte* Reexamination is *ultra vires* and must be vacated. Petitioner argues that the examiner improperly construed the claims by referring to limitations that are not present in the '715 patent claims that are subject to the request. Instead, petitioner argues, reexamination was granted

based on limitations present in the parent '805 patent, which are not relevant to the claims at issue here. Petitioner therefore argues that the grant of the reexamination request is not based on the requested claims of the '715 patent, in conflict with 35 U.S.C. § 303.

Petitioner's arguments do not set forth a proper basis for vacating the Order Granting the Request. As discussed in MPEP § 2246, quoted above, there is no right to petition from an allegedly improper grant of a reexamination request, unless the grant is *ultra vires*. A petition will be entertained "[i]n cases where no discretion to grant a request for reexamination exists." MPEP § 2246(II). This is a rare situation, where the USPTO acted in "brazen defiance" of its statutory authority to grant the request. *Heinl v. Godici*, 143 F. Supp. 2d 593, 601 (E.D. Va. 2001). Section 2246 gives exemplary acts that are considered *ultra vires*; while not necessarily an exhaustive list, none are relevant here.

It should first be emphasized what the present decision is not. It is not a determination whether the examiner was correct or incorrect in his SNQ analysis. That is not properly within the scope of this decision, as such matters have been delegated to the Board. *See* Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings, 75 Fed. Reg. 36357-58 (June 25, 2010). The present decision only determines whether the examiner had discretion to order reexamination, whether the grant was *ultra vires*. For the following reasons, the examiner acted within his discretion.

Petitioner attempts to set forth brazen defiance of the statute by couching the examiner's determination as being based upon the '805 patent, rather than the '715 patent, but this is not the case. In the Order the examiner clearly analyzed the '715 patent in making his determination. His analysis was based on the original prosecution history as well as that of 90/008,933, a concluded reexamination of the '715 patent. The reasons for allowance from the '8933 proceeding, again involving the '715 patent, indicated what the examiner in that proceeding considered important to the patentability of the '715 patent claims. The examiner determined that the Arii reference raised an SNQ because it taught the very material that the prior reexamination examiner considered important when confirming the claims of the '715 patent. The grant was clearly based on the claims of the '715 patent, as the prosecution history including the reasons for allowance of those claims was explicitly considered.

Petitioner argues that the previous examiner's statement of reasons for allowance cannot unilaterally limit the claim scope, and because the critical limitation of that statement is not explicitly found in the currently requested claims the statements are not relevant to the SNQ inquiry. As pointed out in the Opposition at pp. 3-4, reasons for allowance are an important part of the prosecution history, and while they may not unilaterally limit claim scope this does not mean they are not pertinent to claim construction. It was therefore not improper for the current examiner to consider the prior reasons for allowance, even if the reasons might not show features

that are explicitly found in the claims. The prior examiner indicated what was important to patentability of the claims, and the current examiner found that Arii describes this feature.

The Director finds nothing improper with this approach, which is clearly based upon the prosecution history of the '715 patent. It does not go beyond the examiner's discretion to consider as important statements made by the examiner during the previous examination. Whether the previous examiner *might have been wrong* in what she said—which seems to be more what the petitioner is suggesting—is not germane to this issue. That would go toward whether the art, in light of those reasons for allowance, would have been important to a reasonable examiner, the critical inquiry in the SNQ analysis. Put another way, *if* the reasons for allowance were wholly incorrect, and the newly cited art is relevant *only* due to such incorrect reasons for allowance, then it *might* be the case that the newly cited art would be unimportant to a *reasonable* examiner. But that goes to the merits of the SNQ analysis, which again is not under the purview of the Director in this petition decision. All that is at issue here is whether the examiner had the discretion to make this determination, and his consideration of the Arii reference in light of the prior prosecution history was not beyond his discretion.

As the examiner has acted within his discretion in granting the request, the determination is not reviewable by petition. To the extent petitioner disagrees, this is properly addressed by argument before the examiner, and if necessary, appeal. Accordingly, the petition is dismissed.

## CONCLUSION

1. The petition under 37 CFR § 1.181 for vacating the Order as *ultra vires* is dismissed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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. |
|---|---|---|---|---|
| 90/011,459 | 01/28/2011 | 6304715 | 375875US91RX | 5482 |

22850 7590 10/27/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/27/2011

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
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER, LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

Date:

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNI

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011459
PATENT NO. : 6304715
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

OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

*In re:* Abecassis
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,459
Deposited: January 28, 2011
For: U.S. Patent No.: 6,304,715

DECISION ON PETITION

This is a decision on a petition filed by the patent owner on May 23, 2011 entitled "PETITION UNDER 37 C.F.R. § 1.182 TO INVOKE EXAMINER ASSIGNMENT POLICY" ["the petition"] and is a request to reassign this proceeding to a different examiner. As the assignment of examiners to a proceeding is a management function, the petition has been treated as a request under 37 CFR § 1.181 to invoke the supervisory authority of the Director.

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

The petition is dismissed.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,304,715 issued on October 16, 2001. The '715 patent was a divisional of U.S. Patent No. 6,208,805.

- The parent '805 patent was subject to now concluded reexamination proceeding 90/008,943, which was examined by Examiner Gagliardi.

- A request for *ex parte* reexamination was filed on January 28, 2011 and assigned control number 90/011,459. It requested reexamination of claims 1-10 of the '715 patent. The proceeding was assigned to Examiner Gagliardi.

- An order granting reexamination of claims 1-10 was mailed May 5, 2011. The order did not explicitly state that the CRU Director approved of assignment of the proceeding to Examiner Gagliardi.

- On May 23, 2011, the patent owner timely filed the instant petition.

- Patent owner filed a statement under 37 CFR § 1.530 on June 6, 2011.

- The third party filed a response under 37 CFR § 1.535 on August 3, 2011.

- A first Office action on the merits was mailed on August 26, 2011.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

**MPEP § 2236 Assignment of Reexamination**

### I. EXAMINER ASSIGNMENT POLICY

It is the policy of the Office that the CRU SPE will assign the reexamination request to an examiner different from the examiner(s) who examined the patent application. Thus, under normal circumstances, the reexamination request will not be assigned to a primary examiner or assistant examiner who was involved in any part of the examination of the patent for which reexamination is requested (e.g., by preparing/signing an action), or was so involved in the examination of the parent of the patent. This would preclude assignment of the request to an examiner who was a conferee in an appeal conference or panel review conference in an earlier concluded examination of the patent (e.g., the application for patent, a reissue, or a

prior concluded reexamination proceeding). The conferee is considered to have participated in preparing the Office action which is preceded by the conference.

**Exceptions to this general policy include** cases where the original examiner is the only examiner with adequate knowledge of the relevant technology to examine the case. In the unusual case where there is a need to assign the request to the original examiner, the assignment must be approved by the CRU Director, and the fact that such approval was given by the CRU Director must be stated by the examiner in the decision on the request for reexamination.

It should be noted that while an examiner who examined an earlier concluded reexamination proceeding is generally excluded from assignment of a newly filed reexamination, if the earlier reexamination is still ongoing, the same examiner will be assigned the new reexamination.

***

**II. CONSEQUENCES OF INADVERTENT ASSIGNMENT TO AN "ORIGINAL EXAMINER"**

Should a reexamination be inadvertently assigned to an "original examiner" (in a situation where the TC or CRU Director's approval is not stated in the decision on the request), the patent owner or the third party requester who objects must promptly file a paper alerting the Office of this fact. Any request challenging the assignment of an examiner to the case must be made within two months of the first Office action or other Office communication indicating the examiner assignment, or reassignment will not be considered. Reassignment of the reexamination to a different examiner will be addressed on a case-by-case basis. In no event will the assignment to the original examiner, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination.

## DECISION

MPEP § 2236 sets forth general policy guidelines concerning the assignment of examiners to a reexamination proceeding. Such guidelines, however, do not create any rights or duties, nor do they take away from an agency's broad discretion to assign work to its employees as it sees fit. It is for the Director of the appropriate work group, and not a party to the proceeding, to determine how the USPTO resources will be allocated to a given proceeding. While in some instances there may be evidence that assignment of a particular examiner to a proceeding

constitutes an abuse of discretion, a simple petition unsupported by specific evidence, as is the case here, is insufficient. *See In re Ovshinsky*, 24 USPQ2d 1241 (Comm'r Pat. 1992). Petitioner's only relevant argument is that the record is confused based on what has occurred in the parent case, but the Director disagrees that there is any confusion. As already discussed in the Decision mailed October 20, 2011, the examiner has properly acted within his discretion in the present proceeding and there is no evidence he is confused about what he is examining.

To the extent that patent owner's petition is a "paper alerting the Office" to the assignment of a reexamination, the Office has been so alerted. To the extent approval of the CRU Director is needed to assign a case to an examiner "who was so involved in the examination of the parent" or to any other examiner, this decision constitutes such approval. Petitioner's arguments are noted and have been considered, but they are not persuasive. No further discussion is needed or warranted, given that the MPEP only gives a party the right to notify the Office of an assignment when no CRU Director approval is in the record, and this decision constitutes approval. The MPEP furthermore does not require the Director to justify any such approval; section 2236(I) merely requires the examiner to state the fact of such approval.

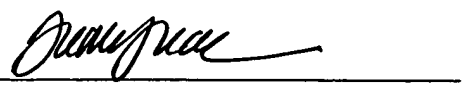
Accordingly, the petition is dismissed.

## CONCLUSION

1. The petition filed May 23, 2011 for reassigning the proceeding to a different examiner is dismissed.

2. This decision does not prevent USPTO management from assigning or reassigning this proceeding to any particular examiner consistent with the resource needs of the Office.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit

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. |
|---|---|---|---|---|
| 90/011,465 | 01/31/2011 | 7090506 | 67507-004-2Re-exam | 7897 |

65358 7590 01/26/2012

WPAT, PC
INTELLECTUAL PROPERTY ATTORNEYS
7225 BEVERLY ST.
ANNANDALE, VA 22003

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/26/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JAN 26 2012

CENTRAL REEXAMINATION UNIT

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP

901 NEW YORK AVENUE, NW

WASHINGTON, DC 20001-4413

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

REEXAMINATION CONTROL NUMBER *95/001,655*.

PATENT NUMBER *7090506*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/001,655 | 06/10/2011 | 7090506 | 67507-004-3Re-exam | 8442 |

65358 7590 01/26/2012

WPAT, PC
INTELLECTUAL PROPERTY ATTORNEYS
7225 BEVERLY ST.
ANNANDALE, VA 22003

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/26/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Harry Shubin
MILLEN WHITE ZELANO & BRANIGAN, P.C.
2200 Clarendon Blvd, Suite 1400
Arlington, VA 22201

Date: MAILED

JAN 26 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011465
PATENT NO. : 7090506
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**

JAN 26 2012

**CENTRAL REEXAMINATION UNIT**

WPAT, PC (Patent Owner)
INTELLECTUAL PROPERTY ATTORNEYS
7225 BEVERLY ST.
ANNANDALE, VA 22003

MILLEN, WHITE, ZELANO & BRANIGAN, P.C. (For 90/011,465 Requester)
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

FINNEGAN, HENDERSON, FARABOW, (For 95/001,655 Requester)
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

In re Sung et al.
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,465
Filed: January 31, 2011
For: U.S. Patent No. 7,090,506 B2

In re Sung et al.
*Inter Partes* Reexamination Proceeding
Control No.: 95/001,655
Filed: June 10, 2011
For: U.S. Patent No.: 7,090,506 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. 90/011,465 and *inter partes* reexamination proceeding No. 95/001,655 **are merged** into a single proceeding.

## BACKGROUND

1. On August 15, 2006, United States Patent Number 7,090,506 B2 ("the '506 patent") issued to Sung et al. with 23 claims.

2. On December 1, 2009, a first request for *ex parte* reexamination of claims 1-23 of the '506

patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/009,613 ("the '613 proceeding").

3. On January 31, 2011, a second request for *ex parte* reexamination of claims 1-23 of the '506 patent was filed by a third party requester and was assigned control number 90/011,465 ("the '465 proceeding").

4. The '613 proceeding progressed to the point where, on February 25, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC).

5. On April 8, 2011, *ex parte* reexamination of claims 1-23 of the '506 patent was granted in the '465 *reexamination* proceeding. No patent owner statement has been filed in the '465 reexamination proceeding, and the time for filing such a statement has expired.

6. On May 24, 2011, the '613 reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8263rd), US 7,090,506 C1. The certificate confirmed claims 1 and 4 and canceled claims 10 and 12 of United States Patent No. 6,183,366. The certificate also added new claim 24. The certificate stated that claims 5, 9, and 17 were determined to be patentable as amended, and that claims 11, 13-16, and 18-23, dependent on an amended claim, were determined to be patentable.

7. On June 10, 2011, a request for *inter partes* reexamination of claims 1-9, 11, and 13-24 of the '506 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,655 ("*the* '655 proceeding"). The request identified LG Display Co., Ltd. as the real party in interest.

8. On August 9, 2011, *inter partes* reexamination of claims 1-9, 11, and 13-24 of the '506 patent was granted in the '655 proceeding.

9. To date, no Office action has issued in either of the '465 and '655 proceedings.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the two above-captioned proceedings for overlapping claims of the same patent. One of the proceedings (the '465 proceeding) is an *ex parte* proceeding. The other proceeding (the '655 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. Therefore, consideration of merger is now ripe.

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 90/011,465 and 95/001,655 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The claims under reexamination in the '465 proceeding are the claims present in the *Ex Parte* Reexamination Certificate (8263rd), US 7,090,506 C1, a copy of which has been made of record by placing a copy of the patent, including the certificate, into the Image File Wrapper of the '465 proceeding. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the requester of the '465 *ex parte*

reexamination are governed by 37 CFR 1.510 through 1.560.[1] The examiner will conduct reexamination in the merged proceeding for claims 1-9, 11, and 13-24 of the '506 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 the date of service of the patent owner's response.

**2. Appeal Rights:**

A discussion of the *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 both proceedings. All papers issued by the Office, or filed by the patent owner and the *inter partes* 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* 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* requester should be directed:

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

by FAX to: (571) 273-9900

[1] 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).

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 '655 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 all other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

**D. Amendments:**

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

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

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

As set forth in MPEP § 2695 (which in turn references MPEP § 2295), for a reexamination proceeding, where the patent was previously reexamined and a reexamination certificate has issued for the patent, an amendment in the reexamination proceeding must be presented as if the changes made to the original patent text via the reexamination certificate are a part of the original patent. Namely, all italicized text in the certificate is considered as if the text was present without italics in the original patent. Further, any certificate text placed in brackets is considered as if it were never present in the patent at all. Although issuance of the reexamination certificate on May 24, 2011 occurred after the date of filing of the '465 request for reexamination, all amendments must be made relative to the patent specification, including the claims, and

drawings, which are currently in effect, and not relative to those in effect as of the date of filing the '465 request.

**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 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 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 the *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 the *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.

## CONCLUSION

1. *Ex parte* Reexamination Control No. 90/011,465 and *inter partes* Reexamination Control No. 95/001,655 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

January 26, 2012

| | |
|---|---|
| **Doc Code: PET.AUTO**<br>**Document Description: Petition automatically granted by EFS-Web** | PTO/SB/83<br>U.S. Patent and Trademark Office<br>Department of Commerce |

| | |
|---|---|
| Electronic Petition Request | **REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS** |
| Application Number | 90011470 |
| Filing Date | 16-Mar-2011 |
| First Named Inventor | 6655613 |
| Art Unit | 3993 |
| Examiner Name | JOSEPH KAUFMAN |
| Attorney Docket Number | TFT10680Z00010 |
| Title | FIRE-FIGHTING WATER TURRET |

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 33197

The reason(s) for this request are those described in 37 CFR:

10.40(b)(4)

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 | Mr. Arthur E. Brown Generation Unlimited |
| Address | P.O. Box 3329 |
| City | Huntington Beach |
| State | CA |
| Postal Code | 92605 |
| Country | US |

| I am authorized to sign on behalf of myself and all withdrawing practitioners. | |
|---|---|
| Signature | /DES/ |
| Name | Donald E. Stout |
| Registration Number | 34493 |

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 : May 3,2011

In re Application of :

6655613

Application No : 90011470

Filed : 16-Mar-2011

Attorney Docket No : TFT10680Z00010

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 May 3,2011

The request is **APPROVED.**

The request was signed by Donald E. Stout (registration no. 34493 ) on behalf of all attorneys/agents associated with Customer Number 33197 . All attorneys/agents associated with Cusotmer Number 33197 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 | Mr. Arthur E. Brown |
| Name2 | Generation Unlimited |
| Address 1 | P.O. Box 3329 |
| Address 2 | |
| City | Huntington Beach |
| State | CA |
| Postal Code | 92605 |
| 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

MAILED

MAR 28 2011

CENTRAL REEXAMINATION UNIT

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

MURATA MANUFACTURING COMPANY, LTD.:
C/O KEATING & BENNETT, LLP : (For Patent Owner)
1800 Alexander Bell Drive :
SUITE 200 :
Reston VA 20191 :

John Kappos :
O'MELVENY & MYERS LLP : (For Third Party
IP&T CALENDAR DEPARTMENT LA-13-A7 : Requester)
400 SOUTH HOPE STREET :
LOS ANGELES, CA 90071-2899 :

*In re*: Wada *et alia* : DECISION
*Ex Parte* Reexamination Proceeding : *SUA SPONTE*
Control No. 90/010,836 : MERGING
Deposited : 29 January 2010 : PROCEEDINGS
For: US Patent No. 6,243,254 : [37 CFR § 1.565(c)]
:
*In re*: Wada *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,473 :
Deposited : 02 February 2011 :
For: US Patent No. 6,243,254 :

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

## BACKGROUND

1. On 05 June 2001 US Patent No. 6,243,254 was granted to Wada *et alia*.

2. On 29 January 2010 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/010,836.

3. On 23 April 2010 the Order was granted for *ex parte* reexamination in control number 90/010,836.

4. On 08 September 2010 a non-final Office action was mailed in 90/010,836.

5. On 08 November 2010 an amendment and remarks were received in 90/010,836.

6. On 02 February 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,473.

7. There are no amendments to the claims in control number 90/011,473.

## 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. 90/010,836 & 90/011,473 *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. 90/010,836 & 90/011,473 *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.

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. |
|---|---|---|---|---|
| 90/011,484 | 02/10/2011 | 7,013,284 | 8457R005E | 2096 |

28164 7590 01/10/2012

ACCENTURE CHICAGO 28164
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/10/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Date: MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011484
PATENT NO. : 7013284
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Accenture Chicago 28164
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

(For Patent Owner)

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

Blakely Sokoloff Taylor & Zafman LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

(For Third Party Requester)

*In re* Guyan *et al.*
*Ex parte* Reexamination
Control No. 90/011,484
Filed: February 10, 2011
For: U.S. Patent No. 7,013,284

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

This is a decision on the patent owner petition paper entitled "PATENT OWNER'S PETITION TO EXPUNGE THE REQUEST FOR REEXAMINATION AND VACATE THE FILING DATE AND ORDER GRANTING REEXAMINATION," filed May 4, 2011, requesting that the filing date and order granting reexamination in the instant proceeding be vacated. Also considered in this decision is the third party requester's opposition paper entitled "OPPOSITION TO PATENT OWNER'S PETITION TO EXPUNGE THE REQUEST FOR REEXAMINATION AND VACTE THE FILING DATE AND ORDER GRANTING REEXAMINATION," filed May 18, 2011.

Discussion as to 37 CFR 1.4(c):

1. Regarding patent owner's request that the filing date of the instant reexamination proceeding be vacated, such request is untimely under 37 CFR 1.181(f), because it was filed more than two months after the February 10, 2011 filing date of the instant proceeding. However, on page one of the instant patent owner petition, patent owner states "[t]o the extent that entry and consideration of this petition requires suspension of the rules, suspension is requested pursuant to 37 C.F.R. § 1.183." Thus, the instant patent owner petition is effectively a petition under 37 CFR 1.183 for waiver of 37 CFR 1.181(f) to permit consideration of the request regarding the filing date of the instant proceeding. Such relief is addressed by the Office of Patent Legal Administration (OPLA).

2. As to patent owner's request that the order granting reexamination be vacated, to the extent such is a request for reconsideration of the finding of a substantial new question of patentability

(SNQ) in the order granting reexamination, such relief is addressed by the Central Reexamination Unit (CRU) Director.[1]

3. 37 CFR 1.4(c) provides that "[s]ince different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." Accordingly, the instant patent owner petition is subject to dismissal for not complying with 37 CFR 1.4(c). In the interest of equity, however, the two-month time period of 37 CFR 1.181(f) is hereby waived to the extent that the OPLA can resolve patent owner's request that the filing date of the instant reexamination proceeding be vacated.

4. The request that the order granting reexamination be vacated, to the extent such is a request for reconsideration of the finding of an SNQ in the order granting reexamination, requires a separate petition to the CRU Director under 37 CFR 1.181, and, therefore, such issue is not being resolved in this decision. If patent owner files such a petition to the CRU Director within 30 days of the mailing date of this decision, the petition would be considered timely under 37 CFR 1.181(f), as the instant petition was filed within two months of the March 4, 2011 order granting reexamination in the instant proceeding.

Summary:

The instant patent owner petition, requesting that the filing date of the instant reexamination proceeding be vacated, is **dismissed** for the reasons set forth below.

The apparent request for review of the examiner's finding of an SNQ in the order granting reexamination of the instant reexamination proceeding is not being addressed as to its substance, and patent owner may file a petition to the CRU Director, to address this matter as to its substance within 30 days of the mailing date of this decision.

## RELEVANT BACKGROUND

1. On March 14, 2006, U.S. Patent No. 7,013,284 (the '284 patent) issued to Guyan *et al.* with claims 1-22.

2. On June 19, 2008, a first request for *ex parte* reexamination of the '284 patent was filed by a third party requester, Guidewire Software, Inc. (Guidewire), which request was assigned Reexamination Control No. 90/010,201 (the '0201 proceeding).

3. On August 1, 2008, the Office ordered reexamination in the '0201 proceeding.

4. On July 17, 2009, the Office issued a non-final action in the '0201 proceeding.

5. On September 17, 2009, patent owner filed a response in the '0201 proceeding, adding new claims 23-40.

---

[1] *See, e.g.*, the instant patent owner petition at page 5.

6. On October 9, 2009, Guidewire filed a second request for *ex parte* reexamination of the '284 patent, which request was assigned Reexamination Control No. 90/010,713 (the '0713 proceeding).

7. On December 17, 2009, the Office ordered reexamination in the '0713 proceeding.

8. On February 26, 2010, the Office issued a decision merging the '0201 and '0713 proceedings (the merged proceeding).

9. On October 1, 2010, the Office issued a non-final action in the merged proceeding.

10. On February 10, 2011, Guidewire filed a third request for *ex parte* reexamination of the '284 patent, which request was assigned Reexamination Control No. 90/011,484 (the '1484 proceeding).

11. On March 4, 2011, the Office ordered reexamination in the '1484 proceeding.

12. On May 4, 2011, patent owner filed the instant petition in the '1484 proceeding.

13. On May 18, 2011, the third party requester, Guidewire, filed the instant opposition to patent owner's May 4, 2011 petition (the opposition).

## DECISION

### I. Relevant Authority

35 U.S.C. § 303(a) provides:

> 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.

37 C.F.R. § 1.510 provides in-part (emphasis added):

> (a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

*****

(d) The filing date of the request for *ex parte* reexamination is the date on which the request satisfies all the requirements of this section.

## II. Patent owner's May 4, 2011 petition

In patent owner's May 4, 2011 petition, patent owner requests that the Director expunge the request for reexamination in the '1484 proceeding and, in turn, vacate the filing date in the '1484 proceeding.[2] Patent owner asserts that it seeks "to prevent the Office from taking actions in this reexamination proceeding that exceed the Office's authority and unnecessarily expend its resources, and to prevent the Third-Party Requester from engaging in improper participation in

[2] *Id.* at page 1.

*ex parte* proceedings that may eventually be merged with this one."[3] In particular, patent owner asserts that "the Third-Party Requester has used serial *ex parte* reexamination requests as a tool and mechanism for improperly participating in the *ex parte* reexamination process and has inappropriately included in these requests attorney arguments that attempt to directly respond to arguments made in the Patent Owner's Response."[4]

Specifically, patent owner asserts that the request for reexamination in the '1484 proceeding raises improper issues unrelated to establishing SNQs and improperly comments on the co-pending *ex parte* proceedings.[5] Patent owner identifies three sections of the request for reexamination in the '1484 proceeding that it deems to be inappropriate: 1) the "Lynn's Status as Prior Art" section, 2) the "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section, and 3) the "Maintaining Certain Existing Rejections" section.[6] Patent owner asserts that the "Lynn's Status as Prior Art" section contains improper attorney arguments that attempt to rebut patent owner's arguments in the merged proceeding as to why the Lynn reference is not prior art, and the "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section contains improper arguments that attempt to respond to patent owner's evidence and arguments regarding secondary considerations in the merged proceeding and are not directed to establishing SNQs.[7] Patent owner also asserts that the "Maintaining Certain Existing Rejections" section contains improper discussion regarding which rejections from the merged proceeding the Office should or should not maintain in the '1484 proceeding.[8]

## III. Third party requester's May 18, 2011 opposition

On May 18, 2011, requester timely filed the instant opposition to patent owner's May 4, 2011 petition.[9] Requester opposes the instant patent owner petition on the grounds that no statute, rule, or MPEP guidance governing *ex parte* reexamination precludes third party requester from presenting the three sections of the request for reexamination in the '1484 proceeding identified by patent owner as allegedly being inappropriate. In particular, requester asserts, on pages 6-9 of the opposition, reasons why requester did/does not believe the content of the '1484 request for reexamination is inappropriate, for example:

(1) The "Lynn's Status as Prior Art" section is directly relevant to the new SNQ in the '1484 request for reexamination based on the combination of U.S. Patent No. 6,606,740 (Lynn) and U.S. Patent No. 5,557,515 (Abbruzzese), because the SNQ based on Lynn is related to Lynn properly qualifying as prior art in view of patent owner's declarations under 37 CFR 1.131 submitted in the merged proceeding;

---

[3] *Id.* at pages 1-2.
[4] *Id.*
[5] *Id.* at page 4.
[6] *See, id.* at pages 3-5.
[7] *Id.*
[8] *Id.* at pages 3-4 and 5.
[9] MPEP § 2246 subsection II provides that when a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester may file a single submission in opposition to the petition within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester.

(2) The "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section is germane to the detailed explanation of the pertinency and manner of applying the prior art of the SNQs in the '1484 request for reexamination because all of the SNQs in the '1484 request for reexamination are presented under 35 U.S.C. § 103; and

(3) The "Maintaining Certain Existing Rejections" section is applicable to the detailed explanation of the pertinency and manner of applying the prior art of the SNQs raised in the '1484 request for reexamination because it discusses U.S. Patent No. 5,848,271 (Caruso) and U.S. Patent No. 5,627,764 (Schutzman), which are also a basis for the new SNQs in the '1484 request for reexamination, and no statute, rule or MPEP section prohibits requester from suggesting which of the pending rejections of the merged proceeding should and should not be maintained in view of the SNQs raised in the '1484 request for reexamination.

Additionally, requester asserts that "if there is inappropriate content, the content does not rise to the level of an extraordinary situation in which justice requires the ['1484 request for reexamination] be expunged and the [order granting reexamination in the '1484 proceeding] be vacated; rather the examiner may simply ignore it."[10] Nonetheless, in the event the instant patent owner petition is not dismissed, requester "requests specificity as to which section(s) in the ['1484 request for reexamination] are objectionable so that Guidewire [requester] may remove that material and resubmit the reexamination request."[11]

## IV. Analysis and Findings

### A. The filing date of the '1484 proceeding

In order to obtain a reexamination filing date, the request papers must include the fee for requesting *ex parte* reexamination required by 37 CFR 1.510(a) and all of the parts required by 37 CFR 1.510(b). *See* 37 CFR 1.510(d) and MPEP § 2214. On February 23, 2011, the Office mailed a "Notice of Reexamination Request Filing Date," notifying the requester that the filing date of the request for reexamination in the '1484 proceeding is February 10, 2011, the date that the filing-requirements-compliant request was received.

In the instant patent owner petition, patent owner has not presented any facts establishing that the request for reexamination in the '1484 proceeding failed to satisfy the filing requirements of 37 CFR 1.510. A review of the request for reexamination in the '1484 proceeding shows that the '1484 request papers included: (1) a statement pointing out each substantial new question of patentability based on prior patents and printed publications,[12] (2) an identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested,[13] (3)

[10] Opposition at page 9.
[11] *Id.* at page 10.
[12] *See* request for reexamination in the '1484 proceeding at pages 17-38.
[13] *See id.* at pages 38-77.

a copy of every patent or printed publication relied upon or referred to,[14] (4) a copy of the entire patent for which reexamination is requested,[15] (5) a certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in 37 CFR 1.33(c),[16] and (6) the fee as set forth in 37 CFR 1.20(c)(1).[17] Because the February 10, 2011 request for reexamination in the '1484 proceeding satisfies the requirements of 37 CFR 1.510, the '1484 proceeding was properly accorded a filing date and patent owner's request to vacate the filing date of the '1484 proceeding **is dismissed**.

**B. The order granting reexamination in the '1484 proceeding**

On March 4, 2011, the Office mailed an "Order Granting/Denying Request for Ex Parte Reexamination," granting the request for reexamination in the '1484 proceeding. In the order granting reexamination, the examiner determined that the request for reexamination in the '1484 proceeding presented six SNQs based on prior art patents or publications. Specifically, the examiner states on pages 3-7 of the order that the following raise SNQs as to claims 1-22 of the '284 patent:

(A) U.S. Patent No. 6,073,109 (Flores) in view of U.S. Patent No. 5,557,515 (Abbruzzese);
(B) Flores in view of Diamond Product from Applied Systems (Exhibit D of the request for reexamination in the '1484 proceeding) in further view of Abbruzzese;
(C) Flores in view of U.S. Patent No. 5,950,169 (Borghesi) in further view of Abbruzzese;
(D) U.S. Patent No. 6,606,740 (Lynn) in view of Abbruzzese;
(E) U.S. Patent No. 5,627,764 (Schutzman) in view of Abbruzzese; and
(F) U.S. Patent No. 5,848,271 (Caruso) in view of Abbruzzese.

**C. The '1484 proceeding is requester's third request for *ex parte* reexamination**

As noted by patent owner, because the '284 patent issued from an application filed prior to November 29, 1999, *inter partes* reexamination is unavailable for the '284 patent.[18] Thus, this is not an instance where requester is attempting to use *ex parte* reexamination *to avoid* the limitations of *inter partes* reexamination, such as the estoppel provisions of 35 U.S.C. 317 (b) and 37 CFR 1.907(c). However, in the instant petition, patent owner asserts that, in filing three requests for *ex parte* reexamination of the '284 patent, "the Third-Party Requester has used serial *ex parte* reexamination requests as a tool and mechanism for improperly participating in the *ex parte* reexamination process," particularly where requester included in the request "attorney arguments that attempt to directly respond to arguments made in the Patent Owner's Response [in the merged proceeding]."[19]

---

[14] *See id.* at Exhibits B through H.
[15] *See id.* at Exhibit A.
[16] *See* certificate of service filed on February 10, 2011.
[17] *See* February 10, 2011 Electronic Acknowledgement Receipt (indicating that payment was successfully received).
[18] Patent owner petition at page 2 (stating that the '284 patent issued from an application filed May 4, 1999).
[19] *Id.*

Regarding the propriety of the instant third request for reexamination of the '284 patent, MPEP § 2242 provides that reexamination of a patent which has previously undergone a reexamination proceeding is permitted where the subsequent request independently provides an SNQ which is different from that raised in the pending reexamination for the claims in effect at the time of the determination.[20] This requirement, that a subsequent request for reexamination contain a new SNQ, provides a safeguard against harassment of the patent owner. As set forth in Section IV(B) of this decision, the examiner has found that the request for reexamination in the '1484 proceeding raises SNQs; therefore, on this record, patent owner has not demonstrated improper participation by the third party requester in filing the instant third request for *ex parte* reexamination of the '284 patent. If patent owner files a separate petition under 37 CFR 1.181 to the CRU Director for reconsideration of the examiner's finding of the SNQs (the option for doing so is discussed above), and the CRU Director determines that an SNQ does in fact exist, such an issue can ultimately be resolved at the Board of Patent Appeals and Interferences (BPAI).[21] On the other hand, if it is found that an SNQ does not exist and the Director denies the reexamination, the issue of harassment will be mooted. Barring a successful filing and granting of such a petition, however, the record shows that the examiner has found that the request for reexamination in the '1484 proceeding raises six SNQs based on prior art patents or publications as to claims 1-22 of the '284 patent.

Regarding patent owner's assertion that the request for reexamination in the '1484 proceeding raises improper issues unrelated to establishing SNQs and improperly comments on the co-pending *ex parte* proceedings,[22] as set forth in section II of this decision, patent owner identifies three sections of the request for reexamination in the '1484 proceeding it deems inappropriate: (1) the "Lynn's Status as Prior Art" section, (2) the "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section, and (3) the "Maintaining Certain Existing Rejections" section.[23]

Pursuant to 37 CFR 1.510(b), any request for reexamination must include, among other requirements, a statement pointing out each SNQ based on prior patents and printed publications and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. The request for reexamination in the '1484 proceeding includes a statement pointing out an SNQ and detailed explanation of a proposed rejection of the claims of the '284 patent based on Lynn in view of Abbruzzese.[24] Thus, in

---

[20] *See* MPEP § 2242 subsection I (stating, "However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. ... If a 'different' substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability 'affecting any claim of the patent.' See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.").

[21] *See Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings*, 75 Fed. Reg. 3657 (June 25, 2010).

[22] Patent owner petition under 37 CFR 1.183 at page 4.

[23] *See id.* at pages 3-5.

[24] *See* request for reexamination in the '1484 proceeding at page 60 *et seq.* and Exhibit M (discussing pertinency and manner of applying Lynn and Abbruzzese under 35 USC 103 to the cited prior art to claims 1-40 of the '484 patent).

discussing whether Lynn qualifies as prior art, the "Lynn's Status as Prior Art" section of the request is not inappropriate, because it includes explanations that are relevant to the pertinency and manner of applying the cited prior art (Lynn) to the claims of the '284 patent for which reexamination is requested.[25] The request for reexamination in the '1484 proceeding also includes statements pointing out SNQs based on combinations of the cited prior art and detailed explanations of proposed rejections of the claims of the '284 patent applying the cited prior art under 35 USC 103.[26] Thus, in discussing patent owner's evidence of secondary considerations, which was entered in the record of the '284 patent in the merged proceeding, the "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section of the request is not inappropriate, because it includes explanations that are relevant to the pertinency and manner of applying the cited prior art (Flores, Abbruzzese, the Diamond Reference, Borghesi, Lynn, Schutzman and Caruso) under 35 USC 103 to the claims of the '284 patent for which reexamination is requested.[27]

As set forth in MPEP 2240 subsection II, a second or subsequent request for reexamination may provide information raising an SNQ 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. This is because, when a proper basis for the second or subsequent request for reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate. In this instance, because *inter partes* reexamination is unavailable for the '284 patent, it would be a waste of resources to prevent requester from resolving issues regarding the prior art status of Lynn and addressing the evidence of record regarding secondary considerations of nonobviousness until the certificate issues in the prior, co-pending merged proceeding. Accordingly, for at least these reasons, the "Lynn's Status as Prior Art" section and the "Comments on Patent Owner's Rebuttal to Obviousness Using Evidence of Secondary Considerations" section of the request for reexamination in the '1484 proceeding are not deemed to be inappropriate.

The "Maintaining Certain Existing Rejections" section of the request for reexamination in the '1484 proceeding, however, goes beyond explanations relevant to the pertinency and manner of applying the cited prior art to the claims of the '284 patent for which reexamination is requested in that it includes arguments directed to rejections made by the examiner and patent owner's responsive arguments thereto *in the merged proceeding*.[28] Because such arguments go beyond issues that will be resolved in the '1484 proceeding, this section of the request for reexamination in the '1484 proceeding is deemed to be inappropriate. Accordingly, the examiner is directed not to consider such arguments in the '1484 proceeding.

In any event, consistent with requester's request that it be given an opportunity to remove material identified as objectionable and resubmit the reexamination request,[29] requester is given a period of 15 days from the mailing date of this decision as an opportunity to submit a

[25] *See id.* at pages 63-67.
[26] *See id.* at pages 17-36, 38-77, and Exhibits J-O.
[27] *See id.* at pages 77-79.
[28] *See id.*
[29] *See* opposition at page 10.

replacement copy of the request for reexamination in the '1484 proceeding that is identical in content to the February 10, 2011 request except for redacting the text of the "Maintaining Certain Existing Rejections" section.[30]

## CONCLUSION

1. Patent owner's May 4, 2011 petition, requesting that the filing date of the instant reexamination proceeding be vacated, is dismissed.

2. Third party requester is given a period of 15 days from the mailing date of this decision as an opportunity to submit a replacement copy of the request for reexamination in the '1484 proceeding that is identical in content to the February 10, 2011 request except for redacting the text of the "Maintaining Certain Existing Rejections" section.

3. Any questions concerning this communication should be directed to Pinchus M. Laufer, Senior Legal Advisor, at 571-272-7726 or, in his absence, to Nicole D. Haines, Legal Advisor, at 571-272-7717.

/Kenneth M. Schor/

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

01-9-2012

[30] Redacting the inappropriate content is required (versus deletion) to maintain the accuracy of any references to the pagination of the request for reexamination in the '1484 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

MAILED

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.

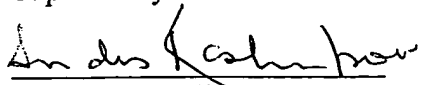
**Conduct of Proceedings**

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, SPE
Central Reexamination Unit 3993

Enclosure: Appendix – Copy of new claims 23-40.

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. |
|---|---|---|---|---|
| 90/011,488 | 03/11/2011 | 6118894 | A126.811.103 | 7673 |

7590 04/06/2012

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

MARK D. SARALINO
RENNER OTTO BOISSELLE AND SKLAR
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND, OH 44115-2191

DATE MAILED: 04/06/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MERCHANT & GOULD PC
P O BOX 2903
MINNEAPOLIS, MN 55402-0903

Date: MAILED

APR 06 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011488
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)).

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

APR 06 201

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Warren A Sklar
Renner, Otto, Boisselle & Sklar
1621 Euclid Ave., 19th Floor
Cleveland, OH 44115

(For Third Party Requester)

Robert A Kalinsky
Merchant and Gould, P.C.
PO Box 2903
Minneapolis, MN 55402

*In re* Schwartz *et al.*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,488
Filed: March 11, 2011
For: U.S. Patent No. 6,118,894

: DECISION ON
: PETITION UNDER
: 37 CFR 1.181

The paper filed by third party requester on June 24, 2011, styled as "Petition to Reconsider the Examiner's Decision to Deny Reexamination Pursuant to 37 C.F.R. § 1.515(c) and 37 C.F.R. § 1.181" is before the Director of the Central Reexamination Unit (CRU). Petitioner, the third party requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination dated May 26, 2011. 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-in-part for the reasons set forth below.

## REVIEW OF FACTS

1. U.S. Patent No. 6,118,894 (hereinafter, the '894 patent) issued on September 12, 2000.

2. On July 27, 2009, a first third party requester deposited a corrected request for *ex parte* reexamination for claims 1-22 of the '894 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,515 (hereinafter, the '515 proceeding).

3. On May 26, 2010, another third party requester deposited a request for *ex parte* reexamination of claims 1-22 of the '894 patent, and the resulting reexamination proceeding was assigned Control No. 90/009,732 (hereinafter, the '732 proceeding).

4. The '515 proceeding and the '732 proceeding were merged (hereinafter "the prior merged proceeding") and resulted in issuance of an *ex parte* reexamination certificate on May 10, 2011, confirming claims 1-22 and allowing claims 23 and 24.

5. On March 11, 2011, the instant third party requester deposited a corrected request for *ex parte* reexamination of claims 1-24 and the resulting reexamination proceeding was assigned Control No. 90/011,488.

6. On May 26, 2011, an order denying the request for reexamination for claims 1-24 was issued.

7. On June 24, 2011, the third party requester timely filed the above-mentioned petition under 37 CFR § 1.181.

## Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner erred in denying the request for reexamination because he did not consider the new evidence in support of his contention that the TCL 5050V Operations Manual (hereinafter "TCL") was prior art. Petitioner recognizes that TCL was applied in the prior merged proceeding and was eventually disqualified as prior art in the prior merged proceeding. Petitioner asserts that the current request for reexamination introduces new evidence that TCL is prior art to the claims of the '894 patent.

## 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 1-24 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 1-24 of the '894 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 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 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]

[1] Public Law 96-517, enacted on December 12, 1980.

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. 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

In response to petitioner's argument that the examiner did not consider the new evidence that TCL is prior art and thus, incorrectly concluded that TCL failed to raise a substantial new question of patentability, the Director finds that the determination to deny reexamination did not consider this new evidence that sheds new light on the technical teachings set forth in TCL. However, this new light to the technical teaching is only relevant to the claims (1-6 and 23) which had rejections based on TCL that were withdrawn because of the examiner's determination that TCL was disqualified as prior art in the prior merged proceeding. The request fails to raise a new light to the technical teachings of TCL in regard to the claims (7-22 and 24) which were found to be patentable over TCL in the prior merged proceeding because TCL failed to teach certain claim limitations. Accordingly, the decision will address these two groups of claims separately in the analysis below:

---

[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

Claims 1-6 and 23:

The instant request for reexamination includes a new declaration by Masayuki Fujii, dated February 9, 2011 (hereinafter, "the Fujii declaration"), which sets forth facts that were not present in the prior merged proceeding. Specifically, the declaration provides evidence that TCL is prior art to the claims of the '894 patent.

For purposes of determining whether or not reexamination should be granted for claims 1-6 and 23, the TCL reference is "old prior art." In order for old prior art to raise a substantial new question of patentability, the request must present evidence that provides new information about preexisting technology that may have escaped review by the examiner. In this case, the new information that fulfills this requirement is the facts establishing that the preexisting technology (TCL) is available as prior art with respect to the '894 patent in the Fujii declaration.

During the prior merged proceeding, TCL was used by the examiner to reject claims 1-6 and 23 (non-final Office action mailed November 3, 2010). These rejections were withdrawn, based on patent owner's arguments set forth in the interview summaries filed January 4, 2011 and February 4, 2011. In the interviews, patent owner argued that TCL was not prior art because it was not publicly accessible. The fact supporting patent owner's argument was the stamp "Confidential-Outside Attorneys Only" on the pages of the document submitted in the '515 proceeding[5]. Based on this evidence, the examiner in the prior proceeding concluded that TCL was not prior art.

In the instant proceeding, third party has presented further evidence that TCL was publicly accessible by at least September 25, 1991 (Fujii declaration, paragraph 3) when two copies of the manual were given to Sharp Corporation. Mr. Fujii further states that subsequent purchasers of the TCL Model 5050V were given manuals as well; although, the names of these purchasers and the sales dates are not given. In addition, third party has presented evidence that the stamp "Confidential-Outside Attorneys Only" was not placed on the manual at the time it was distributed to Sharp Corporation and other third parties; but rather, this stamp was only placed on the copy of the manual provided to Rudolph's attorney years later. These facts show that the TCL manual was not confidential and was publically accessible prior to the critical date. Thus, in accordance with the facts of this case, TCL is prior art with respect to the '894 patent.

The facts of this proceeding present TCL in a new light in that they provide new information about TCL (*i.e.* that it qualifies as prior art). This new information raises a substantial new question of patentability because the rejection of claims 1-6 and 23 was withdrawn in the prior merged proceeding based entirely on the disqualification of TCL as prior art; a disqualification that was based on evidence which did not include the new factual information provided in the Fujii declaration filed with the request for reexamination in this proceeding.

---

[5] As pointed out by requester, the copy of TCL filed in the '732 proceeding did not include this stamp, a fact which appears to have been overlooked by the examiner.

Based on the prosecution history of this case, it is clear that a reasonable examiner would have considered the information that TCL qualifies as prior art important in determining whether or not claims 1-6 and 23 are patentable. Accordingly, the determination to deny reexamination of claims 1-6 and 23 was in error based on these facts.

Claims 7-22 and 24:

In the prior merged proceeding, the examiner determined that claims 7-22 and 24 were allowable over TCL (reasons for allowance, non-final Office action mailed November 3, 2010, pages 10-11). The examiner made his finding that claims 7-22 and 24 were allowable over TCL's teachings before the question of whether or not TCL was prior art was raised by patent owner in the merged proceeding. The evidence provided by third party in the instant request does not raise a substantial new question of patentability for claims 7-22 and 24, because at the time the examiner found that these claims were allowable over TCL, the examiner considered TCL to be prior art. Thus, a reasonable examiner would not have considered the information that TCL is prior art, provided in the request for reexamination in this proceeding, important in determining whether or not claims 7-22 and 24 are patentable. Accordingly, the examiner did not err in denying the grant of reexamination of claims 7-22 and 24.

Because it is agreed that TCL raises a SNQ with respect to claims 1-6 and 23 of the '894 patent, the Petition is GRANTED-IN-PART.

## CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED-IN-PART.

2. Accordingly, the request for *ex parte* reexamination of claims 1-6 and 23 of the '894 patent is GRANTED, and reexamination is hereby ordered for claims 1-6 and 23. Reexamination is not ordered for claims 7-22 and 24 of the '894 patent.

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 Matthew Brooks Supervisory Patent Examiner, at (571) 272-8112, or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
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. |
|---|---|---|---|---|
| 90/011,513 | 02/28/2011 | 7,389,718 | 043075.0004 | 4726 |

7590 05/02/2011

GERALD CARTER
2307 DUVAL DRIVE
MONROE, LA 71201

| EXAMINER | |
|---|---|
| JASTRZAB, JEFFREY R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3993 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/02/2011 | PAPER |

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THOMAS F. BERGERT
C/O WILLIAMS MULLEN IP DOCKETING
222 CENTRAL PARK AVENUE, SUITE 1700
VIRGINIA BEACH, VA 23462

Date:

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011513
PATENT NO. : 7389718
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Larry L. Coats
1400 Cresent Green
Suite 300
Cary, NC 27518

In re Application of :
**CARTER** :
Control No. 90/011,513 : DECISION ON PETITION
Filed: February 28, 2011 : TO WITHDRAW
Attorney Docket No. 043075.0004 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 15, 2011.

The request is **APPROVED**.

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

The request was signed by Larry Coates on behalf of all attorneys of record who are associated with customer No. 01209.

All attorneys/agents associated with the Customer Number 01209 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

All future correspondence will be directed to the first named inventor Gerald Carter at the address indicated below.

There is an outstanding Office action mailed March 30, 2011 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Denise L. Boyd at 571-272-0992.

Denise L. Boyd
Paralegal Specialist
CRU 3999

cc: Gerald Carter
2307 Duval Drive
Monroe, LA 71201

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on April 15, 2011. There is no indication it was served on the Third Party Requester.

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. |
|---|---|---|---|---|
| 90/011,515 90011457 | 02/28/2011 | 5684863 | 6646-230B (863) | 5648 |

35554 7590 07/13/2011

REENA KUYPER, ESQ.
BYARD NILSSON, ESQ.
9229 SUNSET BOULEVARD
SUITE 630
LOS ANGELES, CA 90069

| 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

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

Date: 7-13-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
CANTOR COLBURN LLP
20 CHURCH STREET
22ND FLOOR
HARTFORD, CT 06103

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011457 + 90/011515
PATENT NO. : 5684863
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

JUL 13 2011

CENTRAL REEXAMINATION UNIT

REENA KUYPER, ESQ. : (For Patent Owner)
BYARD NILSSON, ESQ. :
9229 SUNSET BOULEVARD :
SUITE 630 :
LOS ANGELES CA 90069 :

Daniel F Drexler :
CANTOR COLBURN LLP : (For Third Party Requester)
20 CHURCH STREET :
22ND FLOOR
HARTFORD, CT 06103 :

N Chris Walters :
SENNIGER POWERS LLP : (For Third Party Requester)
100 NORTH BROADWAY :
17TH FLOOR :
ST LOUIS, MO 63102 :

*In re*: Katz : **DECISION**
*Ex Parte* Reexamination Proceeding : ***SUA SPONTE***
Control No. 90/011,457 : **MERGING**
Deposited : 25 January 2011 : **PROCEEDINGS**
For: US Patent No. 5,684,863 : **[37 CFR § 1.565(c)]**
:
*In re*: Katz :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,515 :
Deposited : 28 February 2011 :
For: US Patent No. 5,684,863 :

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

## BACKGROUND

1. On 04 November 1997 US Patent No. 5,684,863 was granted to Ronald A Katz.

2. On 25 January 2011 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,457.

3. On 31 March 2011 the Order was granted for *ex parte* reexamination in control number 90/011,457.

4. On 28 February 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,515.

7. On 29 April 2011 the Order was granted for ex parte reexamination in control number 90/011,515670.

8. There are no amendments to the claims in either control number 90/011,457 & 90/011,515.

## 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. 90/011,457 & 90/011,515 *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.

### 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. 90/011,457 & 90/011,515 *ex parte* reexamination proceedings are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

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
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. |
|---|---|---|---|---|
| 90/011,528 | 03/03/2011 | 6701523 | 0091-0001 | 1812 |

75563 7590 06/30/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| 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
HARRITY & HARRITY, LLP
11350 RANDOM HILLS ROAD
SUITE 600
FAIRFAX, VA 22030

Date:

MAILED

JUN 3 0 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011528
PATENT NO. : 6701523
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

ROPES & GRAY LLP : (For Patent Owner)
PATENT DOCKETING 39/361 :
1211 AVENUE OF THE AMERICAS :
NEW YORK NY 10036-8704 :

Brian E Ledell :
HARRITY & HARRITY, LLP : (For Third Party
11350 RANDOM HILLS ROAD : Requester)
SUITE 600 :
FAIRFAX, VA 22030 :

MAILED
JUN 30 2011
CENTRAL REEXAMINATION UNIT

Roland McAndrews :
FINNEGAN, HENDERSON, FARABOW, : (For Third Party
GARRETT & DUNNER LLP : Requester)
901 NEW YORK AVENUE, NW :
WASHINGTON, DC 20001-4413 :

*In re*: Hancock *et alia* : DECISION
*Ex Parte* Reexamination Proceeding : *SUA SPONTE*
Control No. 90/011,528 : MERGING
Deposited : 03 March 2011 : PROCEEDINGS
For: US Patent No. 6,701,523 B1 : [37 CFR § 1.565(c)]
:
*In re*: Hancock *et alia* :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,550 :
Deposited : 13 April 2011 :
For: US Patent No. 6,701,523 B1 :

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

## BACKGROUND

1. On 02 March 2004 US Patent No. 6,701,523 B1 was granted to Hancock *et alia*.

2. On 03 March 2011 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,528.

3. On 17 May 2011 the Order was granted for *ex parte* reexamination in control number 90/010,836.

4. On 13 April 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,550.

5. On 18 May 2011 the Order was granted for *ex parte* reexamination in control number 90/011,550.

6. There are no amendments to the claims in control number 90/011,528 & 90/011,550.

## 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. 90/011,528 & 90/011,550 *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.

### 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. 90/011,528 & 90/011,550 *ex parte* reexamination proceedings are hereby **merged**.

2. The first Office action on the merits will be mailed in due course.

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

DESIGN IP, P.C.
5100 W. TILGHMAN STREET
SUITE 205
ALLENTOWN PA 18104

(For Patent Owner)

DAVID R. YOHANNAN
KELLEY DRYE & WARREN LLP
3050 K STREET NW, SUITE 400
WASHINGTON, DC 20007

(For the '1660 Requester)

**MAILED**

**JAN 20 2012**

**CENTRAL REEXAMINATION UNIT**

In re Odd N. Oddsen, Jr.
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,535
Filed: March 4, 2011
For: U.S. Patent No. 7,100,880

In re Odd N. Oddsen, Jr.
*Inter Partes* Reexamination Proceeding
Control No.: 95/001,660
Filed: June 15, 2011
For: U.S. Patent No.: 7,100,880

**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. 90/011,535 and *inter partes* reexamination proceeding No. 95/001,660 **are merged** into a single proceeding.

## BACKGROUND

1. On September 5, 2006, United States Patent Number 7,100,880 ("the '880 patent") issued to Odd N. Oddsen, Jr. with 16 claims.

2. On March 4, 2011, patent owner filed a request for *ex parte* reexamination of claims 9 and 11 of the '880 patent and assigned control number 90/011,535 ("the '11535 proceeding").

3. On March 24, 2011, *ex parte* reexamination of claims 9 and 11 of the '880 patent was granted in the '11535 reexamination proceeding.

4. On May 24, 2011, a patent owner's statement was filed that included an amendment adding new *claims* 17-21.

5. On June 15, 2011, a request for *inter partes* reexamination of claims 9 and 11 of the '880 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,660 ("the '1660 proceeding"). The request identified Humanscale Corp. ("the 1660 requester") as the real party in interest.

6. On August 3, 2011, *inter partes* reexamination of claims 9 and 11 of the '880 patent was granted in the '1660 proceeding.

7. To date, no Office action has issued in either of the two proceedings.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '11535 proceeding) is an *ex parte* proceeding. The other proceeding (the '1660 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the patent owner has filed 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 90/011,535 and 95/001,660 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

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 statement in the '11535 *ex parte* reexamination proceeding. New claims 17-21 have been added in the '11535 *ex parte* proceeding, while the claims in the '1660 *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. Patent owner must respond to the Office action in accordance

with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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.

### 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).[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.

#### 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. 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):

---

[1] 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.

> 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 third party requester, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both files, for entry into each file.

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

| | |
|---|---|
| by Mail to: | Attn: Mail Stop "*Inter Partes* Reexam"<br>Central Reexamination Unit<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| by FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| by Hand to: | Customer Service Window<br>Attn: Central Reexamination Unit<br>Randolph Building, Lobby Level<br>401 Dulany Street<br>Alexandria, VA 22314 |
| by EFS: | Registered users may submit papers via the electronic filing system EFS-Web, at:<br><br>https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html |

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, 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.

## CONCLUSION

1. *Ex parte* Reexamination Control No. 90/011,535 and *inter partes* Reexamination Control No. 95/001,660 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 requesters' comments on that response, or (b) the expiration of the time for filing the required response and any comments requesters elect to file.

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

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

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. |
|---|---|---|---|---|
| 90/011,546 | 03/07/2011 | 6903699 | RMM-2 | 5913 |

27964 7590 11/05/2011

HITT GAINES P.C.
P.O. BOX 832570
RICHARDSON, TX 75083

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/05/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

DORITY & MANNING, P.A.

POST OFFICE BOX 1449

GREENVILLE, SC 29602-1449

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,546*.

PATENT NO. *6903699*.

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 05 2011

CENTRAL REEXAMINATION UNIT

HITT GAINES, P.C.
David H. Hitt, Esquire
P.O. Box 832570
Richardson, TX. CA 75083

(For Patent Owner)

DORITY & MANNING, P.A.
P.O. Box 1449
Greenville, SC. 29602-1449

(For Requester)

In re Porter *et alia*
Reexamination Proceeding
Control No. 90/011,546
For: U.S. Patent No. 6,903,699

: DECISION DENYING
: PETITION UNDER
: 37 CFR 1.181 AND
: 37 CFR 1.515(c)

This is a decision on the May 26, 2011 paper entitled "PETITION UNDER 37 C.F.R. §1.515 FROM DENIAL OF EX PARTE REEXAMINATION REQUEST". The petition was timely filed. No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

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

## REVIEW OF FACTS

1. U.S. Patent No. 6,903,699 (hereinafter, the '699 patent) issued on June 7, 2005 to Porter *et alia.*

2. On March 7, 2011, a request for *ex parte* reexamination was deposited by a third party requester requesting claims 1-20 of the '699 patent be reexamined. This reexamination proceeding was assigned Control No. 90/011,546 (hereinafter, the '11546 proceeding).

3. An order denying the request for *ex parte* reexamination was mailed on April 29, 2011.

4. On May 26, 2011, the present petition was filed.

## DECISION

I. Review of the Examiner's Order Denying Reexamination

Third party requester ("Petitioner") in the '11546 reexamination proceeding has petitioned seeking relief from the examiner's April 29, 2011 Order denying *ex parte* reexamination.

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo.*

Each decision by the CRU Director will conclude with the paragraph:

"This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered."

In accordance with the requirements of the reexamination statute and rules, a review of the record has been undertaken prior to the preparation of this decision. A *de novo* determination, taking into account the third party requester's position, as presented in the instant petition, has been made as to whether the March 7, 2011 request for *ex parte* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). For the reasons set forth below, the request for reexamination of the '699 patent filed in the '11546 reexamination

proceeding has been found not to present any SNQ. Therefore, the examiner's decision to deny reexamination is proper.

II. *De Novo* Review of the Request for Reexamination - Findings and Analysis

The '699 patent matured from application number 10/265,899 (the '899 application). During the prosecution of '899 application examiner rejected claims 1-6, 8-12 and 14-19 under 35 U.S.C. 103(a) as being unpatentable over Reymond (5,898,370) in view of Wolfe et al (5,847,683) stating that Reymond disclosed a communication circuit 120 coupled to an inherent electric meter circuitry (1-7), and antenna element 140 within a dielectric housing 110/160/170, coupled to the communication circuit. Wolfe was added to teach communication circuit disposed within an electric meter chassis 52 having dielectric housing 54 protruding therefrom (Fig. 3). Additionally, claims 7, 13 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Reymond modified by Wolfe et al. and further in view of Landman et al (4,795,974). Landman was added to teach a digital communication circuit as required in claims 7 and 13. Additionally claims 1, 8 and 14 were rejected for Double Patenting over US Patent No. 6,462,713.

In response applicant submitted a Terminal Disclaimer to overcome the Double Patenting rejection and argued that Reymond does not teach or suggest a communication circuit within an electric meter chassis because Reymond shows a tag assembly 210 is located on the outside of an electric meter chassis 220 (Figure 2). Reymond also does not show the antenna element in 140 as being coupled to electric meter circuitry which is located inside the chassis 220. Additionally applicant argued that Wolfe does not describe a wireless communication circuit coupled to the electric meter circuitry or an antenna element located within the dielectric housing coupled to the wireless communication circuit. Therefore, Reymond, individually or in combination with Wolfe, fails to teach the invention as recited in independent claims 1, 8 and 16.

From the prosecution history it appears that the examiner allowed the case for the following reason:

"a communication circuit within said chassis coupled to electric meter circuitry; an antenna element within said dielectric housing, said antenna element coupled to said communication circuit" as recited in independent claim 1.

Turning to the '11546 request, the section of the request entitled "STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY" (pages 2-6) sets forth requester's position that the MPEP standard. However, the discussion ignores the copending request for reexamination (Control Number 90/011,432) ((hereinafter, the '11432 proceeding), filed on January 14, 2011 and prior to the '11546 proceedings, also for the '699 patent. The teachings outlined in this section are cumulative (and in some cases, less on point) to the teachings that the Office had before it during the '11432 proceedings. The teachings of the Johnson patent (US 5,553,094) have already been considered in the '11432 proceeding in

the Non-Final Office Action dated October 31, 2011. Furthermore, The teachings of the cited references Dresselhuys, Van Orsdel, Colton, Delaney, Bush, Selph et al. and Wolfe are cumulative to the Johnson patent considered above for the rejection of claims 1, 3, 5, 8, 10-11, 16, 18, 20-44, as they all provide similar teachings of utility meter including communication circuit and antenna located within dielectric housing that protrudes from the meter as required in each of the independent claims 1, 8 and 16.

To this point, *In re Recreative Technologies Corp.* (citing the legislative history of the reexamination statute) is instructive:

> However, Congress recognized that this broad purpose must be balanced against the potential for abuse, whereby unwarranted reexaminations can harass the patentee and waste the patent life. The legislative record and the record of the interested public reflect a serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures. Thus reexamination as enacted was carefully limited to new prior art, that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462. No grounds of reexamination were to be permitted other than based on new prior art and sections 102 and 103. As explained in the legislative history, matters that were decided in the original examination would be barred from reexamination:
>
> This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar *reconsideration* of any argument already decided by the Office, whether during the original examination or an earlier reexamination.
>
> Thus the statute guarded against simply repeating the prior examination on the same issues and arguments. Commissioner Diamond explained the importance of this safeguard:
>
> [The proposed statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.
> *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806 & 214 Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Comm. on the Judiciary* , 96th Cong., 2d Sess. 594 (1980) (statement of Sidney Diamond, Cmr. of Patents & Trademarks).

It is noted that a single sentence is added to the end of the SNQ discussion of each of the three references that requester alleges raises an SNQ. These sentences refer the Office to the detailed explanation of requester's proposed rejections. However, it is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested.

Petitioner argues that the Office should analyze the other references in their proposed rejections to determine whether an SNQ is raised by those references. The Office disagrees. Accordingly, the petition is **denied**.

## SUMMARY AND CONCLUSION

1. No substantial new question of patentability affecting at least one claim of U.S. Patent No. 6,903,699 has been presented in the request filed November 8, 2010 by requester for the reasons set forth above.

2. The petition is **DENIED**.

3. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,548 ~~90/011236~~ | 03/07/2011 | 6020929 | 04299.0414-00000 | 6509 |

75563 7590 06/17/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/17/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

MAILED

6-17-11

CENTRAL REEXAMINATION UNIT

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,548.* + 90/011236

PATENT NO. *6020929.*

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

MAILED

JUN 17 2011

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

(For Third Party Requester)

Tony Chen, Chen Yoshimura LLP
255 S. Grand Ave., #215
Los Angeles, CA 90012

(For Third Party Requester)

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

*In re* Marshall *et alia*
Reexamination Proceeding
Control No. 90/011,236
Request Deposited: September 15, 2010
For: U.S. Patent No. 6,020,929

*In re* Marshall *et alia*
Reexamination Proceeding
Control No. 90/011,548
Request Deposited: March 7, 2011
For: U.S. Patent No. 6,020,929

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

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. 6,020,929 (hereinafter, the '929 patent), issued to Marshall *et alia*, on February 1, 2000.

2. On September 15, 2010, a third party requester deposited a Request for *Ex Parte* Reexamination of the '929 patent. The reexamination proceeding was assigned Control No. 90/011,236 (hereinafter, the '11236 proceeding).

3. The Reexamination Order was granted in the '11236 proceeding on November 5, 2010 finding a substantial new question of patentability (SNQP) as to claims 1, 8-13, and 20-24.

4. A non-final office action was mailed in the '11236 proceeding on January 14, 2011.

5. On April 14, 2011, Patent Owner responded to the office action in the '11236 proceeding. No claims were amended or added.

6. On March 7, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '929 patent. The reexamination proceeding was assigned Control No. 90/011,548 (hereinafter, the '11548 proceeding).

7. The Reexamination Order was granted in the '11548 proceeding on April 4, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-24.

8. Patent Owner did not waive their right to a file a Patent Owner statement. 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 '11236, and '11548 reexamination proceedings are merged. The merged proceeding will be conducted in accordance with the following guidelines and requirements.

II. Requirements for Same Amendments in All Proceedings.

Patent owner is required to maintain the same claims and specification in all merged files.

III. Conduct of Merged Proceeding.

All papers mailed by the Office will take the form of a single action which applies to all proceedings. All papers issued by the Office or filed by the patent owner will contain the identifying data for all files and will be physically entered in each reexamination file. All papers filed by the patent owner must consist of a single response, filed in each proceeding, each bearing an original signature, for entry in each file. 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. 90/011,236 and 90/011,548 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
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. |
|---|---|---|---|---|
| 90/011,548 | 03/07/2011 | 6020929 | 003597-0003-504 | 6509 |

75563 7590 02/17/2012

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011548
PATENT NO. : 6020929
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

FEB 17 2012

CENTRAL REEXAMINATION UNIT

Ropes & Gray LLP (For Patent Owner)
Patent Docketing 39/361
1211 Avenue of the Americas
New York, NY 10036-8704

Tony D. Chen (For 90/011,236 Requester)
Chen Yoshimura LLP
255 S. Grand, #215
Los Angeles, CA 90012

Finnegan, Henderson, Farabow, (For 90/011,548 Requester)
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001-4413

In re Connie T. Marshall et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,236
Filed: September 15, 2010
For: U.S. Patent No. 6,020,929

In re Connie T. Marshall et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,548
Filed: March 7, 2011
For: U.S. Patent No. 6,020,929

**DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)**

This is a decision on the November 21, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed Interview Summary and revive the present terminated[1] merged reexamination prosecution ("the November 21, 2011 petition to revive").

The November 21, 2011 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 21, 2011 petition to revive is **granted**.

[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 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 October 12, 2011.

## 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:

(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 merged proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Regarding item (1), this merged reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the October 12, 2011 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 November 21, 2011, which was untimely under the circumstances. However, for the purpose of evaluating whether the November 21, 2011 petition to revive is a grantable petition, patent owner's November 21, 2011 Examiner Interview Summary satisfies item (1).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the November 21, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the November 21, 2011 patent owner petition to revive is **granted**. Prosecution in the above-identified merged reexamination proceeding will be resumed.

## CONCLUSION

1. The November 21, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of this merged reexamination proceeding should be directed to the primary examiner, Ovidio Escalante, of Art Unit 3992, at (571) 272-7537.

---

[2] *See*: 37 CFR 1.137(d)(3).

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

February 16, 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. |
|---|---|---|---|---|
| 90/011,550 | 04/13/2011 | 6701523 | 04299.0415-00000 | 6600 |

75563 7590 06/30/2011

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

| 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
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, D.C. 20001-4413

Date:

MAILED

JUN 3 0 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011550
PATENT NO. : 6701523
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

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8704

(For Patent Owner)

Brian E Ledell
HARRITY & HARRITY, LLP
11350 RANDOM HILLS ROAD
SUITE 600
FAIRFAX, VA 22030

(For Third Party Requester)

MAILED

JUN 30 2011

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

*In re*: Hancock *et alia*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,528
Deposited : 03 March 2011
For: US Patent No. 6,701,523 B1

*In re*: Hancock *et alia*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,550
Deposited : 13 April 2011
For: US Patent No. 6,701,523 B1

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 02 March 2004 US Patent No. 6,701,523 B1 was granted to Hancock *et alia*.

2. On 03 March 2011 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,528.

3. On 17 May 2011 the Order was granted for *ex parte* reexamination in control number 90/010,836.

4. On 13 April 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,550.

5. On 18 May 2011 the Order was granted for *ex parte* reexamination in control number 90/011,550.

6. There are no amendments to the claims in control number 90/011,528 & 90/011,550.

## 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. 90/011,528 & 90/011,550 *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.

### 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. 90/011,528 & 90/011,550 *ex parte* reexamination proceedings are hereby **merged**.

2. The first Office action on the merits will be mailed in due course.

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

MAILED

AUG 02 2011

CENTRAL REEXAMINATION UNIT

Robert C. Kain, Jr.
Kain & Associates, Attorneys at Law, P.A.
900 Southeast Third Avenue, Suite 205
Ft. Lauderdale, FL 33316

For Patent Owner

James D. Petruzzi
4900 Woodway
Suite 745
Houston, TX 77056

For 3rd Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,572
Filed: March 16, 2011
For: U.S. Patent No. 6,739,016

DECISION ON PETITION
TO RE-MAIL OFFICE
ACTION

This is a decision on patent owner's paper styled "Petition To Re-Set Period for Response" filed July 28, 2011, requesting that the Office re-set the time for applicant to respond to the Office action mailed June 28, 2011, based on patent owner's failure to receive the Office action. There is no fee associated with this petition.

The petition is **granted** 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 (i.e., re-set the period for response). If adequately supported, the Office may grant such a petition and re-mail the Office action.

In support of the petition to re-set the period for response, patent owner includes a statement that patent owner did not receive the Office action in question and in support of this statement directs us to the U.S Patent and Trademark Office records, for the record shows that the Office action of June 18, 2011 that was addressed to patent owner, at the correct address of record, was returned undelivered due to insufficient postage.

In view of the above, it is clear that the patent owner did not receive the Office action of June 18, 2011, and the petition to re-set the period for reply is hereby **granted**. The Office action of June 18, 2011 is being re-mailed under separate cover, and the period for responding to that Office action (one month) is to run from new the mailing date of the action.

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, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,585 | 03/21/2011 | 7125332 | 1300-002REX | 6812 |

23935 7590 02/17/2012

KOPPEL, PATRICK, HEYBL & PHILPOTT
2815 Townsgate Road
SUITE 215
Westlake Village, CA 91361-5827

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Steven M. Greenberg
CAREY RODRIGUEZ GREENBERG & PAUL LLP
950 Peninsula Corp. Circle, Suite 2022
Boca Raton, FL 33487

Date:

**MAILED**

FEB 17 2012

**CENTRAL REEXAMINATION UNIT**

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011585
PATENT NO. : 7125332
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Koppel, Patrick, Heybl & Philpott
2815 Townsgate Road
Suite 215
Westlake Village, CA 91361-5827

(For patent owner)

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

Steven M. Greenberg, Esq.
Carey Rodriguez Greenberg et al.
950 Peninsula Corp., Circle
Suite 2022
Boca Raton, FL 33487

(For requester)

In re Michael Robert Beaver et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/011,585
Filed: March 21, 2011
For: U.S. Patent No. 7,125,332

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

This is a decision on the November 14, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated[1] reexamination ("the November 14, 2011 patent owner petition to revive").

The November 14, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The November 14, 2011 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 August 12, 2011 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.

Regarding item (1), this reexamination proceeding was terminated due to the failure to timely submit a response to the August 12, 2011 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 August 12, 2011 Office action set a two-month period for response. However, a response to the August 12, 2011 Office action was not filed until November 14, 2011, which was untimely. Nevertheless, for the purpose of evaluating whether the November 14, 2011 patent owner petition to revive is a grantable petition, patent owner's submission of the November 14, 2011 Response to Office Action satisfies item (1).[2]

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 November 14, 2011, thereby satisfying item (3).

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[3]

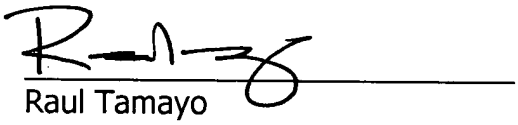
Accordingly, the November 14, 2011 patent owner petition to revive is **granted**.

## CONCLUSION

1. The November 14, 2011 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Glenn Dawson, of CRU Art Unit 3993, at (571) 272-4694.

3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

02/16/2012

[2] This decision is not directed to either (i) the persuasiveness and propriety of the arguments presented in patent owner's November 14, 2011 response as to each of the rejections set forth in the August 12, 2011 Office action or (ii) the November 14, 2011 response's compliance with formal matters; such is the examiner's province.
[3] *See*: 37 CFR 1.137(d)(3).

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. |
|---|---|---|---|---|
| 90/011,590 | 03/24/2011 | 5730650 | 370.144 | 2369 |

7590 02/28/2012

WEISS & WEISS
300 OLD COUNTRY ROAD
SUITES 251
MINEOLA, NY 11501

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203

Date: FEB 28 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011590
PATENT NO. : 5730650
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 Patent
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

(For Patent Owner)

Nixon & Vanderhye, P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203

(For Third Party Requester)

Banner & Witcoff, LTD
1100 13th Street, N.W.
Washington, D.C. 20005-4051

(Courtesy Copy)

*In re:* James L. Soper
*Ex Parte* Reexamination Proceeding
Control No. 90/011,590
Filed: March 24, 2011
For: U.S. Patent No. 5,730,650

: **DECISION DISMISSING**
: **PETITIONS UNDER**
: **37 CFR 1.181 and 1.182**
: **AND EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the May 26, 2011 patent owner petition entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on the June 9, 2011 requester petition entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on patent owner petition of June 20, 2011 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

The patent owner petitions and requester's petition are before the Office of Patent Legal Administration (OPLA) only to the extent of the relief requested with vacating the instant *ex parte* reexamination and related permanent and preliminary relief specific to the conduct of the '11590 proceeding.

The relief requested in matters not specifically connected with this proceeding is not properly directed to the Office of Patent Legal Administration.[1] 37 CFR 1.4(c) provides that "[s]ince 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." This would ordinarily result in dismissal of the petition. However, on page 2 of the May 26, 2011 petition, patent owner includes a request, under 37 CFR 1.183, for a waiver of regulations as deemed necessary. Accordingly, rule 1.4(c) is **waived** to permit consideration of the petition to the extent that it (1) requests the Office to vacate the order granting *ex parte* reexamination, terminate the reexamination proceeding, and expunge from the record the reexamination request papers filed by Mr. McConnell; and (2) requests other relief with respect to the conduct of the '11590 proceeding. The Office of Patent Legal Administration will not address the petition to the extent that it requests the Office to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of this reexamination proceeding.

## REVIEW OF THE RELEVANT FACTS

1. On March 24, 1998, U.S. Patent No. 5,730,650 was granted to James L. Soper ("the 650 patent").

2. On March 24, 2011, a request for *ex parte* reexamination of the '650 patent was submitted by a third party requester, which request was assigned control number 90/011,590 ("the '11590 proceeding").

3. On May 5, 2011, an order granting *ex parte* reexamination in the '11590 proceeding was mailed.

4.. On May 26, 2011 patent owner filed a petition under 37 CFR 1.181 and 1.182 entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

5. On June 9, 2011 requester filed an opposition petition under 37 CFR 1.181 and 1.182 entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY

[1] See Section III below.

RELIEF". This petition was accompanied by a further petition requesting leave to file the opposition petition.

6. On June 20, 2011 patent owner submitted the instant petition under 37 CFR 1.181 and 1.182 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

## RELEVANT AUTHORITY

**35 USC 302 provides:**

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

**35 U.S.C. 304 Provides:**

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

**37 CFR 1.181 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 1.182 provides:**

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

**37 CFR 1.4(c) provides:**

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

**37 CFR 1.530 provides:**

> (a)Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).
>
> (b)The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which *the* patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

**37 CFR 1.535 provides:**

> 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 § 1.540 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(g) provides**:

> 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.

## DECISION

**I. Patent owner's request to vacate the order granting reexamination and terminate proceedings.**

Patent owner's request to vacate the order granting reexamination and terminate the proceedings of the reexamination request and expunge from the record the reexamination papers and order is dismissed. Patent owner requests that the reexamination proceeding should be vacated and the reexamination papers expunged because the request contains information that was prepared by Mr. McConnell.[2] The premise behind patent owner's request is that Mr. McConnell had a long standing attorney-client relationship with the patent owner including the prosecution and/or maintenance of the '650 patent therefore he was privy to confidential information.[3]

Pursuant to 35 USC 302 "[a]ny person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title". Whatever relationship Mr. McConnell may have with patent owner has no bearing on whether he can file a reexamination under the statute. In this instance, a proper request for *ex parte* reexamination of US patent 5,730,650 was filed on March 24, 2011 based on prior art printed publications. The request for reexamination included all the elements required by the rules and met all the requirements set forth in 37 CFR 1.510(b) and MPEP 2210.[4] Additionally, a substantial new question of patentability affecting claims 1-14 in '650 patent was found by the Office and the proceedings will not be vacated but will continue, to allow the resolution of the substantial new question of patentability.[5]

---

[2] Pet. under 37 CFR 1.182 of May 26, 2011 at pages 3, 5-6.

[3] Id. at 6.

[4] MPEP 2214 states in part:

Any person, at any time during the period of enforceability of a patent, may file a request for *ex parte* reexamination by the U.S. Patent and Trademark Office of any claim of the patent based on prior art patents or printed publications. The request must include the elements set forth in 37 CFR 1.510(b) (see MPEP § 2214) and must be accompanied by the fee as set forth in 37 CFR 1.20(c)(1). If a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) may also apply; see MPEP § 2250.03. No attempt will be made to maintain a requester's name in confidence.

After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same. In some limited circumstances, such as after a final court decision where all of the claims are finally held invalid, a reexamination order may be vacated, see MPEP § 6506.

[5] In terms of the relief requested for expunging or redacting papers prepared by Mr. McClellan patent owner has not alleged that patent owner confidences were made public as part of the instant reexamination nor has patent owner identified any portions of the request that should be expunged to protect confidential information.

It is in the public interest to continue with the *ex parte* reexamination once the request for reexamination is received by the Office. 37 CFR 1.555 states that "a patent by its very nature is affected with a public interest". In the instant reexamination several patents have been cited against claims 1-14 of the '650 patent which have been determined to raise a substantial new question of patentability. Therefore the public interest is well served by allowing the reexamination proceedings to move forward until resolution of the substantial new question of patentability is reached. Therefore, the relief requested by patent owner's May 26, 2011 petition that the reexamination be vacated, the reexamination be terminated, and the associated papers be expunged from the record is **dismissed.**

**II. Patent owner's request to prevent active participation of Mr. McConnell of Nixon and Vanderhye, PC and the real parties of interest Formax, Inc. and Provisur Technologies, Inc. from further participation in the '11590 reexamination proceeding.**

The order for the instant reexamination was issued by the Office on May 5, 2011, setting a period for 2 months for patent owner to respond und 37 CFR 1.530(b). In this instance, the patent owner's period for submitting a statement under 37 CFR 1.530 expired on July 5, 2011 without the filing of such a statement.[6]

Pursuant to 37 CFR 1.535 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. But, "[i]f 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."

Requester's participation in an *ex parte* reexamination is governed by 37 CFR 1.550(g) which states that "[T]he 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". As discussed above since the patent owner did not file a statement pursuant 37 CFR 1.530, no further participation by the third party requester is allowed.

Therefore, the relief requested by patent owner's May 26, 2011 petition that third party requester be prohibited from any further participation in the instant reexamination is **dismissed as moot.**

**III. Patent owner's request to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of the '11590 reexamination proceeding.**

The May 26, 2011 patent owner petition requests that attorney Andrew S. McConnell be disqualified from appearing before the USPTO in any other matters involving the '650 patent and that the real parties of interest (Formax and Provisur) be prohibited from filing any subsequent request for reexamination of the '650 patent which contains work product by Mr. McConnell.[7] Patent owner asserts several allegations against Mr. McConnell of unethical

[6] The May 26, 2011 petition by patent owner does not constitute a submission within the meaning of 37 CFR 1.530.
[7] Pet. of May 26, 2011 at page 5.

conduct, including breaches of the attorney-client relationship and the Code of Professional Responsibility.[8]

A reexamination proceeding is an inappropriate forum for resolution of issues of attorney conflict. The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts. Therefore the instant reexamination proceeding is not the forum for resolution of the allegations raised by the patent owner against Mr. McConnell. Instead, petitioner may 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 McConnell 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 McConnell based on confidential information.[9] Since 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.[10] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts and are decided in the Office of Enrollment and Discipline of the USPTO.[11]

## IV. Patent owner's June 20, 2011 reply to third party requester's June 9, 2011 opposition petition.

On June 20, 2011, patent owner filed a reply in response to requester's June 9, 2011 opposition paper. In an *ex parte* reexamination a petition under 37 CFR 1.181 to vacate an *ultra vires* reexamination is limited to a single submission, even if an opposition thereto is filed by a third party requester.[12] Any further paper in opposition, rebuttal, or response by the patent owner is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. There is no

---

[8] Id at pages 9-23.

[9] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a registered practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

[10] 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).

[11] *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.

[12] See MPEP 2246 II which states in part "When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to both the CRU support staff and the CRU SPE to notify the Office that an opposition to the 37 CFR1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.
The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester." [Emphasis added.]

indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, patent owner's June 20, 2011 reply to opposition paper is an improper paper, and it will not be made of record in the file of the '11590 proceeding. Because patent owner's June 20, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being **expunged** by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '11590 proceeding. *See* MPEP 2267. No copy of the June 20, 2011 reply to opposition paper will be maintained of record in the Office.

## PATENT OWNER'S CORRESPONDENCE ADDRESS

**37 CFR 1.33(c) provides (emphasis added):**

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address**. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[13]

The current **correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to** 37 CFR 1.33(c) *(i.e.,* Weiss & Weiss, 300 Old Country Road, Suite 251, Mineola, NY 11501). Absent the filing of a proper change of correspondence address in the patent file, all **future correspondence in the** 90/011,590 **proceeding** will be mailed **to the current address of record for the patent owner** *(i.e.,* Weiss & Weiss, 300 Old Country Road, Suite 251, Mineola, NY 11501).

Note that the patent owner is not required to designate the same representative for the patent file and for the reexamination proceeding. In the reexamination proceeding, patent owner may appoint a practitioner of record under § 1.32, or authorize another practitioner to file a response

[13] *See* MPEP 2222 which states in part :Representative of Patent Owner: As a general rule, the attorney-client relationship terminates when the purpose for which the attorney was employed is accomplished; e.g., the issuance of a patent to the client. However, apart from the attorney-client relationship, the Office has, by regulation, 37 CFR 10.23(c)(8), made it the responsibility of every "practitioner," by virtue of his/her registration, "to inform a client or former client ... of correspondence received from the Office ... when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified." (Emphasis added.) This responsibility of a practitioner to a former client manifestly is not eliminated by withdrawing as an attorney or agent of record.

under § 1.34, but the address for receipt of correspondence from the Office must be the same as that in the patent file pursuant to § 1.33.

Patent owner has the option of filing form PTO/SB/123 (for change of correspondence address only) or form PTO/SB/81A (for power of attorney and change of correspondence address) in the patent file to establish the appropriate correspondence address. Further, patent owner may file form PTO/SB/81B in the 90/011,590 proceeding, correctly identifying a statement under 37 CFR 3.73(b), in addition to taking appropriate action in the patent file, as described above, to conform the correspondence address in the reexamination proceeding to that established in the patent.

## CONCLUSION

1. The patent owner requested relief in the petition of May 26, 2011 under 37 CFR 1.181 and 1.182 to vacate the reexamination, terminate the reexamination, and expunge papers filed by Mr. McConnell from the '11590 reexamination proceeding is **dismissed**.

2. The patent owner requested relief in the petition of May 26, 2011 that attorney McConnell and real parties of interest Formax and Provisur be prohibited from further participation in the '11590 reexamination proceeding is **dismissed as moot.**

3. The Patent owner petition of June 20, 2011 under 37 CFR 1.181 and 1.182 is **expunged** from the record of the '11590 proceeding.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

February 27, 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. |
|---|---|---|---|---|
| 90/011,591 | 03/24/2011 | 5,980,228 | 370.145 | 2440 |

7590 02/28/2012

| EXAMINER | |
|---|---|

PHILIP M. WEISS, ESQ
WEISS & WEISS
300 OLD COUNTRY ROAD
SUITE 251
MINEOLA, NY 11501

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11th FLOOR
ARLINGTON, VA 22203

Date:

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011591
PATENT NO. : 5980228
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)).

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

Andrus, Sceales, Starke & Sawall
100 East Wisconsin Avenue
Suite 1100
Milwaukee, WI 53202-4178

(For Patent Owner)

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

Nixon & Vanderhye, P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203

(For Third Party Requester)

Banner & Witcoff, LTD
1100 13th Street, N.W.
Washington, D.C. 20005-4051

(Courtesy Copy)

*In re:* James L. Soper
*Ex Parte* Reexamination Proceeding
Control No. 90/011,591
Filed: March 24, 2011
For: U.S. Patent No. 5,980,228

: **DECISION DISMISSING**
: **PETITIONS UNDER**
: **37 CFR 1.181 and 1.182**
: **AND EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the May 26, 2011 patent owner petition entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on the June 9, 2011 requester petition entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on patent owner petition of June 20, 2011 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

The patent owner petitions and requester's petition are before the Office of Patent Legal Administration (OPLA) only to the extent of the relief requested with vacating the instant *ex parte* reexamination and related permanent and preliminary relief specific to the conduct of the '11591 proceeding.

The relief requested in matters not specifically connected with this proceeding is not properly directed to the Office of Patent Legal Administration.[1] 37 CFR 1.4(c) provides that "[s]ince 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." This would ordinarily result in dismissal of the petition. However, on page 2 of the May 26, 2011 petition, patent owner includes a request, under 37 CFR 1.183, for a waiver of regulations as deemed necessary. Accordingly, rule 1.4(c) is **waived** to permit consideration of the petition to the extent that it (1) requests the Office to vacate the order granting *ex parte* reexamination, terminate the reexamination proceeding, and expunge from the record the reexamination request papers filed by Mr. McConnell; and (2) requests other relief with respect to the conduct of the '11591 proceeding. The Office of Patent Legal Administration will not address the petition to the extent that it requests the Office to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of this reexamination proceeding.

## REVIEW OF THE RELEVANT FACTS

1. On November 9, 1999, U.S. Patent No. 5,980,228 was granted to James L. Soper ("the 228 patent").

2. On March 24, 2011, a request for *ex parte* reexamination of the '228 patent was submitted by a third party requester, which request was assigned control number 90/011,591 ("the '11591 proceeding").

3. On May 5, 2011, an order granting *ex parte* reexamination in the '11591 proceeding was mailed.

4.. On May 26, 2011 patent owner filed a petition under 37 CFR 1.181 and 1.182 entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

5. On June 9, 2011 requester filed an opposition petition under 37 CFR 1.181 and 1.182 entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY

[1] See Section III below.

RELIEF". This petition was accompanied by a further petition requesting leave to file the opposition petition.

6. On June 20, 2011 patent owner submitted the instant petition under 37 CFR 1.181 and 1.182 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

## RELEVANT AUTHORITY

**35 USC 302 provides:**

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

**35 U.S.C. 304 Provides:**

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

**37 CFR 1.181 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 1.182 provides:**

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

**37 CFR 1.4(c) provides:**

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

**37 CFR 1.530 provides:**

> (a)Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).
>
> (b)The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which *the* patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

**37 CFR 1.535 provides:**

> 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 § 1.540 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(g) provides**:

> 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.

## DECISION

**I. Patent owner's request to vacate the order granting reexamination and terminate proceedings.**

Patent owner's request to vacate the order granting reexamination and terminate the proceedings of the reexamination request and expunge from the record the reexamination papers and order is dismissed. Patent owner requests that the reexamination proceeding should be vacated and the reexamination papers expunged because the request contains information that was prepared by Mr. McConnell.[2] The premise behind patent owner's request is that Mr. McConnell had a long standing attorney-client relationship with the patent owner including the prosecution and/or maintenance of the '228 patent therefore he was privy to confidential information.[3]

Pursuant to 35 USC 302 "[a]ny person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title". Whatever relationship Mr. McConnell may have with patent owner has no bearing on whether he can file a reexamination under the statute. In this instance, a proper request for *ex parte* reexamination of US patent 5,980,228 was filed on March 24, 2011 based on prior art printed publications. The request for reexamination included all the elements required by the rules and met all the requirements set forth in 37 CFR 1.510(b) and MPEP 2210.[4] Additionally, a substantial new question of patentability affecting claims 1-6 in '228 patent was found by the Office and the proceedings will not be vacated but will continue, to allow the resolution of the substantial new question of patentability.[5]

---

[2] Pet. under 37 CFR 1.182 of May 26, 2011 at pages 3, 5-6.
[3] Id. at 6.
[4] MPEP 2214 states in part:
Any person, at any time during the period of enforceability of a patent, may file a request for *ex parte* reexamination by the U.S. Patent and Trademark Office of any claim of the patent based on prior art patents or printed publications. The request must include the elements set forth in 37 CFR 1.510(b) (see MPEP § 2214) and must be accompanied by the fee as set forth in 37 CFR 1.20(c)(1). If a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) may also apply; see MPEP § 2250.03. No attempt will be made to maintain a requester's name in confidence.
After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same. In some limited circumstances, such as after a final court decision where all of the claims are finally held invalid, a reexamination order may be vacated, see MPEP § 2286.
[5] In terms of the relief requested for expunging or redacting papers prepared by Mr. McClellan patent owner has not alleged that patent owner confidences were made public as part of the instant reexamination nor has patent owner identified any portions of the request that should be expunged to protect confidential information.

It is in the public interest to continue with the *ex parte* reexamination once the request for reexamination is received by the Office. 37 CFR 1.555 states that "a patent by its very nature is affected with a public interest". In the instant reexamination several patents have been cited against claims 1-6 of the '228 patent which have been determined to raise a substantial new question of patentability. Therefore the public interest is well served by allowing the reexamination proceedings to move forward until resolution of the substantial new question of patentability is reached. Therefore, the relief requested by patent owner's May 26, 2011 petition that the reexamination be vacated, the reexamination be terminated, and the associated papers be expunged from the record is **dismissed.**

**II. Patent owner's request to prevent active participation of Mr. McConnell of Nixon and Vanderhye, PC and the real parties of interest Formax, Inc. and Provisur Technologies, Inc. from further participation in the '11591 proceeding.**

The order for the instant reexamination was issued by the Office on May 5, 2011, setting a period for 2 months for patent owner to respond und 37 CFR 1.530(b). In this instance, the patent owner's period for submitting a statement under 37 CFR 1.530 expired on July 5, 2011 without the filing of such a statement.[6]

Pursuant to 37 CFR 1.535 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. But, "[i]f 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."

Requester's participation in an *ex parte* reexamination is governed by 37 CFR 1.550(g) which states that "[T]he 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". As discussed above since the patent owner did not file a statement pursuant 37 CFR 1.530, no further participation by the third party requester is allowed.

Therefore, the relief requested by patent owner's May 26, 2011 petition that third party requester be prohibited from any further participation in the instant reexamination is **dismissed as moot.**

**III. Patent owner's request to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of the '11591 reexamination proceeding.**

The May 26, 2011 patent owner petition requests that attorney Andrew S. McConnell be disqualified from appearing before the USPTO in any other matters involving the '228 patent and that the real parties of interest (Formax and Provisur) be prohibited from filing any subsequent request for reexamination of the '228 patent which contains work product by Mr. McConnell.[7] Patent owner asserts several allegations against Mr. McConnell of unethical

[6] The May 26, 2011 petition by patent owner does not constitute a submission within the meaning of 37 CFR 1.530.
[7] Pet. of May 26, 2011 at page 5.

conduct, including breaches of the attorney-client relationship and the Code of Professional Responsibility.[8]

A reexamination proceeding is an inappropriate forum for resolution of issues of attorney conflict. The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts. Therefore the instant reexamination proceeding is not the forum for resolution of the allegations raised by the patent owner against Mr. McConnell. Instead, petitioner may 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 McConnell 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 McConnell based on confidential information.[9] Since 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.[10] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts and are decided in the Office of Enrollment and Discipline of the USPTO.[11]

## IV. Patent owner's June 20, 2011 reply to third party requester's June 9, 2011 opposition petition.

On June 20, 2011, patent owner filed a reply in response to requester's June 9, 2011 opposition paper. In an *ex parte* reexamination a petition under 37 CFR 1.181 to vacate an *ultra vires* reexamination is limited to a single submission, even if an opposition thereto is filed by a third party requester.[12] Any further paper in opposition, rebuttal, or response by the patent owner is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. There is no

---

[8] Id at pages 9-23.

[9] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a registered practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

[10] 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).

[11] *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.

[12] See MPEP 2246 II which states in part "When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to both the CRU support staff and the CRU SPE to notify the Office that an opposition to the 37 CFR1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.
The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester." [Emphasis added.]

indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, patent owner's June 20, 2011 reply to opposition paper is an improper paper, and it will not be made of record in the file of the '11591 proceeding. Because patent owner's June 20, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being **expunged** by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '11591 proceeding. *See* MPEP 2267. No copy of the June 20, 2011 reply to opposition paper will be maintained of record in the Office.

## PATENT OWNER'S CORRESPONDENCE ADDRESS

**37 CFR 1.33(c) provides (emphasis added):**

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[13]

The current **correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to** 37 CFR 1.33(c) *(i.e.,* Andrus, Sceales, Starke & Sawall, 100 East Wisconsin Avenue, Suite 1100, Milwaukee, WI 53202-4178). Absent the filing of a proper change of correspondence address in the patent file, all **future correspondence in the** 90/011,591 **proceeding** will be mailed **to the current address of record for the patent owner** *(i.e.,* Andrus, Sceales, Starke & Sawall, 100 East Wisconsin Avenue, Suite 1100, Milwaukee, WI 53202-4178).

Note that the patent owner is not required to designate the same representative for the patent file and for the reexamination proceeding. In the reexamination proceeding, patent owner may

[13] *See* MPEP 2222 which states in part :Representative of Patent Owner: As a general rule, the attorney-client relationship terminates when the purpose for which the attorney was employed is accomplished; e.g., the issuance of a patent to the client. However, apart from the attorney-client relationship, the Office has, by regulation, 37 CFR 10.23(c)(8), made it the responsibility of every "practitioner," by virtue of his/her registration, "to inform a client or former client ... of correspondence received from the Office ... when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified." (Emphasis added.) This responsibility of a practitioner to a former client manifestly is not eliminated by withdrawing as an attorney or agent of record.

appoint a practitioner of record under § 1.32, or authorize another practitioner to file a response under § 1.34, but the address for receipt of correspondence from the Office must be the same as that in the patent file pursuant to § 1.33.

Patent owner has the option of filing form PTO/SB/123 (for change of correspondence address only) or form PTO/SB/81A (for power of attorney and change of correspondence address) in the patent file to establish the appropriate correspondence address. Further, patent owner may file form PTO/SB/81B in the 90/011,591 proceeding, correctly identifying a statement under 37 CFR 3.73(b), in addition to taking appropriate action in the patent file, as described above, to conform the correspondence address in the reexamination proceeding to that established in the patent.

## CONCLUSION

1. The patent owner requested relief in the petition of May 26, 2011 under 37 CFR 1.181 and 1.182 to vacate the reexamination, terminate the reexamination, and expunge papers filed by Mr. McConnell from the '11591 reexamination proceeding is **dismissed**.

2. The patent owner requested relief in the petition of May 26, 2011 that attorney McConnell and real parties of interest Formax and Provisur be prohibited from further participation in the '11591 reexamination proceeding is **dismissed as moot.**

3. The Patent owner petition of June 20, 2011 under 37 CFR 1.181 and 1.182 is **expunged** from the record of the '11591 proceeding.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

February 27, 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. |
|---|---|---|---|---|
| 90/011,593 | 05/05/2011 | 7,207,789 | 370.147 | 2519 |

7590 02/28/2012

PHILIP M. WEISS, ESQ.
WEISS & WEISS
300 OLD COUNTRY ROAD
SUITE 251
MINEOLA, NY 11501

| EXAMINER |
|---|

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

FEB 20 12
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011593
PATENT NO. : 7207789
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)).

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: MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD.
1100 13th STREET, NW
WASHINGTON, DC 20005-4051

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011593
PATENT NO. : 7207789
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)).

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

Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

(For Patent Owner)

Nixon & Vanderhye, P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203

(For Third Party Requester)

MAILED
FEB 28 2012
CENTRAL REEXAMINATION UNIT

Banner & Witcoff, LTD
1100 13th Street, N.W.
Washington, D.C. 20005-4051

(Courtesy Copy)

*In re*:Gosz, *et al.*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,593
Filed: March 24, 2011
For: U.S. Patent No. 7,207,789

: **DECISION DISMISSING**
: **PETITIONS UNDER**
: **37 CFR 1.181 and 1.182**
: **AND EXPUNGING**
: **IMPROPER PAPER**

This is a decision on the May 26, 2011 patent owner petition entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on the June 9, 2011 requester petition entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

This is also a decision on patent owner petition of June 20, 2011 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

The patent owner petitions and requester's petition are before the Office of Patent Legal Administration (OPLA) only to the extent of the relief requested with vacating the instant *ex parte* reexamination and related permanent and preliminary relief specific to the conduct of the '11593 proceeding.

The relief requested in matters not specifically connected with this proceeding is not properly directed to the Office of Patent Legal Administration.[1] 37 CFR 1.4(c) provides that "[s]ince 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." This would ordinarily result in dismissal of the petition. However, on page 2 of the May 26, 2011 petition, patent owner includes a request, under 37 CFR 1.183, for a waiver of regulations as deemed necessary. Accordingly, rule 1.4(c) is **waived** to permit consideration of the petition to the extent that it (1) requests the Office to vacate the order granting *ex parte* reexamination, terminate the reexamination proceeding, and expunge from the record the reexamination request papers filed by Mr. McConnell; and (2) requests other relief with respect to the conduct of the '11593 proceeding. The Office of Patent Legal Administration will not address the petition to the extent that it requests the Office to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of this reexamination proceeding.

## REVIEW OF THE RELEVANT FACTS

1. On April 24, U.S. Patent No. 7,207,789 was granted to Gosz, *et al.* ("the 789 patent").

2. On March 24, 2011, a request for *ex parte* reexamination of the '789 patent was deposited by a third party requester, which was assigned control number 90/011,593 ("the '11593 proceeding"). As a consequence of a corrected submission by third party requester, the proceeding was granted a May 5, 2011, filing date.

3. On May 26, 2011 patent owner filed a petition under 37 CFR 1.181 and 1.182 entitled "EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF".

4. On June 9, 2011 requester filed an opposition petition under 37 CFR 1.181 and 1.182 entitled "REQUESTER'S OPPOSITION TO EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF". This petition was accompanied by a further petition requesting leave to file the opposition petition.

---

[1] See Section III below.

5. On June 20, 2011 patent owner submitted the instant petition under 37 CFR 1.181 and 1.182 entitled "REPLY IN SUPPORT OF EMERGENCY PETITION BY PATENT OWNER PATRIOT UNIVERSAL HOLDINGS, LLC FOR: DISQUALIFICATION OF ATTORNEY ANDREW S. MCCONNELL, VACATUR OF ORDER GRANTING REEXAMINATION REQUEST AND ORDER, AND RELATED PERMANENT AND PRELIMINARY RELIEF; AND PETITION TO ALLOW SAME".

6. On July 27, 2011, an order granting *ex parte* reexamination in the '11593 proceeding was mailed.

## RELEVANT AUTHORITY

**35 USC 302 provides:**

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

**35 U.S.C. 304 Provides:**

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

**37 CFR 1.181 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 1.182 provides:**

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

**37 CFR 1.4(c) provides:**

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

**37 CFR 1.530 provides:**

> (a)Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).
>
> (b)The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which *the* patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

**37 CFR 1.535 provides:**

> 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 § 1.540 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(g) provides**:

> 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.

## DECISION

**I. Patent owner's request to vacate the order granting reexamination and terminate proceedings.**

Patent owner's request to vacate the order granting reexamination and terminate the proceedings of the reexamination request and expunge from the record the reexamination papers and order is dismissed. Patent owner requests that the reexamination proceeding should be vacated and the reexamination papers expunged because the request contains information that was prepared by Mr. McConnell.[2] The premise behind patent owner's request is that Mr. McConnell had a long standing attorney-client relationship with the patent owner including the prosecution and/or maintenance of the '789 patent therefore he was privy to confidential information.[3]

Pursuant to 35 USC 302 "[a]ny person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title". Whatever relationship Mr. McConnell may have with patent owner has no bearing on whether he can file a reexamination under the statute. In this instance, a proper request for *ex parte* reexamination of US patent 7,207,789 was filed on May 5, 2011 based on prior art printed publications. The request for reexamination included all the elements required by the rules and met all the requirements set forth in 37 CFR 1.510(b) and MPEP 2210.[4] Additionally, a substantial new question of patentability affecting claims 1-13 in '789 patent was found by the Office and the proceedings will not be vacated but will continue, to allow the resolution of the substantial new question of patentability.[5]

---

[2] Pet. under 37 CFR 1.182 of May 26, 2011 at pages 3, 5-6.
[3] Id. at 6.
[4] MPEP 2214 states in part:
Any person, at any time during the period of enforceability of a patent, may file a request for *ex parte* reexamination by the U.S. Patent and Trademark Office of any claim of the patent based on prior art patents or printed publications. The request must include the elements set forth in 37 CFR 1.510(b) (see MPEP § 2214) and must be accompanied by the fee as set forth in 37 CFR 1.20(c)(1). If a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees under 37 CFR 1.20(c)(3) and (c)(4) may also apply; see MPEP § 2250.03. No attempt will be made to maintain a requester's name in confidence.
After the request for reexamination, including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same. In some limited circumstances, such as after a final court decision where all of the claims are finally held invalid, a reexamination order may be vacated, see MPEP § 7896.
[5] In terms of the relief requested for expunging or redacting papers prepared by Mr. McClellan patent owner has not alleged that patent owner confidences were made public as part of the instant reexamination nor has patent owner identified any portions of the request that should be expunged to protect confidential information.

It is in the public interest to continue with the *ex parte* reexamination once the request for reexamination is received by the Office. 37 CFR 1.555 states that "a patent by its very nature is affected with a public interest". In the instant reexamination several patents have been cited against claims 1-13 of the '789 patent which have been determined to raise a substantial new question of patentability. Therefore the public interest is well served by allowing the reexamination proceedings to move forward until resolution of the substantial new question of patentability is reached. Therefore, the relief requested by patent owner's May 26, 2011 petition that the reexamination be vacated, the reexamination be terminated, and the associated papers be expunged from the record is **dismissed.**

**II. Patent owner's request to prevent active participation of Mr. McConnell of Nixon and Vanderhye, PC and the real parties of interest Formax, Inc. and Provisur Technologies, Inc. from further participation in the '11593 reexamination proceeding.**

The order for the instant reexamination was issued by the Office on July 27, 2011, setting a period for 2 months for patent owner to respond und 37 CFR 1.530(b). In this instance, the patent owner's period for submitting a statement under 37 CFR 1.530 expired on September 27, 2011 without the filing of such a statement.[6]

Pursuant to 37 CFR 1.535 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. But, "[i]f 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."

Requester's participation in an *ex parte* reexamination is governed by 37 CFR 1.550(g) which states that "[T]he 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". As discussed above since the patent owner did not file a statement pursuant 37 CFR 1.530, no further participation by the third party requester is allowed.

Therefore, the relief requested by patent owner's May 26, 2011 petition that third party requester be prohibited from any further participation in the instant reexamination is **dismissed as moot.**

**III. Patent owner's request to impose limitations on Mr. McConnell, the real parties of interest, Formax, Inc. and Provisur Technologies, Inc., or any other parties in matters outside the scope of the '11593 reexamination proceeding.**

The May 26, 2011 patent owner petition requests that attorney Andrew S. McConnell be disqualified from appearing before the USPTO in any other matters involving the '789 patent and that the real parties of interest (Formax and Provisur) be prohibited from filing any subsequent request for reexamination of the '789 patent which contains work product by Mr. McConnell.[7] Patent owner asserts several allegations against Mr. McConnell of unethical

[6] The May 26, 2011 petition by patent owner does not constitute a submission within the meaning of 37 CFR 1.530.
[7] Pet. of May 26, 2011 at page 5.

conduct, including breaches of the attorney-client relationship and the Code of Professional Responsibility.[8]

A reexamination proceeding is an inappropriate forum for resolution of issues of attorney conflict. The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts. Therefore the instant reexamination proceeding is not the forum for resolution of the allegations raised by the patent owner against Mr. McConnell. Instead, petitioner may 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 McConnell 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 McConnell based on confidential information.[9] Since 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.[10] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts and are decided in the Office of Enrollment and Discipline of the USPTO.[11]

## IV. Patent owner's June 20, 2011 reply to third party requester's June 9, 2011 opposition petition.

On June 20, 2011, patent owner filed a reply in response to requester's June 9, 2011 opposition paper. In an *ex parte* reexamination a petition under 37 CFR 1.181 to vacate an *ultra vires* reexamination is limited to a single submission, even if an opposition thereto is filed by a third party requester.[12] Any further paper in opposition, rebuttal, or response by the patent owner is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. There is no

---

[8] Id at pages 9-23.

[9] SCM Corporation v. Aktieselskabet Niro Atomizer, page 96, "Disqualification of a registered practitioner in a proceeding pending before the Patent and Trademark Office is ... discretionary and is primarily the responsibility of the Commissioner.

[10] 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).

[11] *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.

[12] See MPEP 2246 II which states in part "When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester (where one is present in the reexamination proceeding) may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 305, any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to both the CRU support staff and the CRU SPE to notify the Office that an opposition to the 37 CFR1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.
The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester." [Emphasis added.]

indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, patent owner's June 20, 2011 reply to opposition paper is an improper paper, and it will not be made of record in the file of the '11593 proceeding. Because patent owner's June 20, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being **expunged** by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '11593 proceeding. *See* MPEP 2267. No copy of the June 20, 2011 reply to opposition paper will be maintained of record in the Office.

## PATENT OWNER'S CORRESPONDENCE ADDRESS

**37 CFR 1.33(c) provides (emphasis added):**

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address**. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[13]

The current **correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to** 37 CFR 1.33(c) *(i.e.,* Weiss & Weiss, 300 Old Country Road, Suite 251, Mineola, NY 11501). Absent the filing of a proper change of correspondence address in the patent file, all **future correspondence in the** 90/011,593 **proceeding** will be mailed **to the current address of record for the patent owner** *(i.e.,* Weiss & Weiss, 300 Old Country Road, Suite 251, Mineola, NY 11501).

Note that the patent owner is not required to designate the same representative for the patent file and for the reexamination proceeding. In the reexamination proceeding, patent owner may appoint a practitioner of record under § 1.32, or authorize another practitioner to file a response

[13] *See* MPEP 2222 which states in part :Representative of Patent Owner: As a general rule, the attorney-client relationship terminates when the purpose for which the attorney was employed is accomplished; e.g., the issuance of a patent to the client. However, apart from the attorney-client relationship, the Office has, by regulation, 37 CFR 10.23(c)(8), made it the responsibility of every "practitioner," by virtue of his/her registration, "to inform a client or former client ... of correspondence received from the Office ... when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified." (Emphasis added.) This responsibility of a practitioner to a former client manifestly is not eliminated by withdrawing as an attorney or agent of record.

under § 1.34, but the address for receipt of correspondence from the Office must be the same as that in the patent file pursuant to § 1.33.

Patent owner has the option of filing form PTO/SB/123 (for change of correspondence address only) or form PTO/SB/81A (for power of attorney and change of correspondence address) in the patent file to establish the appropriate correspondence address. Further, patent owner may file form PTO/SB/81B in the 90/011,593 proceeding, correctly identifying a statement under 37 CFR 3.73(b), in addition to taking appropriate action in the patent file, as described above, to conform the correspondence address in the reexamination proceeding to that established in the patent.

## CONCLUSION

1. The patent owner requested relief in the petition of May 26, 2011 under 37 CFR 1.181 and 1.182 to vacate the reexamination, terminate the reexamination, and expunge papers filed by Mr. McConnell from the '11593 reexamination proceeding is **dismissed**.

2. The patent owner requested relief in the petition of May 26, 2011 that attorney McConnell and real parties of interest Formax and Provisur be prohibited from further participation in the '11593 reexamination proceeding is **dismissed as moot.**

3. The Patent owner petition of June 20, 2011 under 37 CFR 1.181 and 1.182 is **expunged** from the record of the '11593 proceeding.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150.

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

February 27, 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. |
|---|---|---|---|---|
| 90/011,596 | 03/24/2011 | 6315921 | 91943.000687 | 4091 |

30223 7590 02/01/2012

NIXON PEABODY LLP
300 S. Riverside Plaza
16th Floor
CHICAGO, IL 60606

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/01/2012

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. |
|---|---|---|---|---|
| 90/011,596 | 03/24/2011 | 6315921 | 91943.000687 | 4091 |

30223 7590 02/01/2012

NIXON PEABODY LLP
300 S. Riverside Plaza
16th Floor
CHICAGO, IL 60606

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/01/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael J. Didas
HARTER SECREST & EMERY LLP
1600 Bausch & Lomb Place
Rochester, NY 14604-2711

Date: MAILED

FEB 0 1 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011596
PATENT NO. : 6315921
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)).

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

NIXON PEABODY LLP
300 S. RIVERSIDE PLAZA
16TH FLOOR
CHICAGO, IL 60606

(For Patent Owner)

MAILED
FEB 0 1 2012
CENTRAL REEXAMINATION UNIT

Michael J. Didas
HARTER SECREST & EMERY LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER, NY 14604-2711

(For Third Party Requester)

| | | |
|---|---|---|
| *In re*: *DelDuca et al.* | : | |
| *Ex Parte* Reexamination Proceeding | : | DECISION ON |
| Control No. 90/011,596 | : | PETITIONS UNDER |
| Deposited: March 24, 2011 | : | 37 CFR § 1.181(a)(3) |
| For: US Patent No. 6,315,921 | : | |

This is a decision on the June 13, 2011 petition, entitled "Petition to Vacate the Order Granting Ex Parte Reexamination under 37 CFR 1.181," which is requesting that the order granting reexamination is *ultra vires* and should be vacated. The patent owner's petition is treated as a petition under 37 CFR § 1.181(a)(3). The third party requester filed a paper on June 17, 2011 in opposition to the petition, which is permitted by MPEP 2246.

The petition and the opposition are before the Director of the Central Reexamination Unit.

The patent owner's June 13, 2011 petition is dismissed for the reasons set forth below.

The requester's June 17, 2011 opposition petition is granted to the extent that the June 13, 2011 petition is dismissed.

## SUMMARY OF RELEVANT FACTS

1. On November 13, 2001, U.S. Patent No. 6,315,921 ("the '921 patent") was issued to *DelDuca et al.*

2. On March 24, 2011, a request for *ex parte* reexamination was submitted by a third party requester and identified by control number 90/011,596.

3. On June 4, 2011, the order was granted for *ex parte* reexamination in control number 90/011,596.

4. On June 13, 2011, the instant patent owner petition was submitted.

5. On June 17, 2011, the requester filed an opposition to the June 13, 2011 petition.

## 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 § 2216 Substantial New Questions of Patentability** (in-part):

> Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

**MPEP § 2246 Decision Ordering Reexamination** (in-part):

> A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new

question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

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:

(A) the reexamination order is not based on prior art patents or printed publications.

**MPEP § 2258 Scope of Ex Parte Reexamination** (in-part):

**E. Affidavits or Declarations or Other Written Evidence**

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

## DECISION

The patent owner petitioner requests that the order and the reexamination proceeding be vacated. The petitioner considers the action of granting reexamination of the patent as an *ultra vires* action by the Office. Specifically, patent owner argues that the order is (1) not based on prior art patents or printed publications (e.g., it is based on the disclosure in the McKedy Declaration) and (2) is based wholly on the same question of patentability raised in a prior examination. See, e.g., pages 3-7 of the petition.

Requester opposes the petition on the grounds that the petition fails to raise any issues that are subject to review by petition; that the order is based on patents and printed publications (e.g., the McKedy Declaration is properly used to support the inherent disclosure of the references) and that the order is not based on the same questions of patentability already raised in a prior examination. See, e.g., pages 2-6 of the opposition.

The determination of whether a substantial new question of patentability (SNQ) exists is a fact-specific inquiry. Upon review of the record, the examiner followed reexamination laws and policies

in her determination that the request raises SNQs for claims 1-12 of the '921 patent. **Specifically, the order is clear that Komatsu and Yoshikawa '503, which are both U.S. patents, supply the SNQs.** For example, see page 3 of the order that states "[i]n the present instance there exists a SNQ based solely on U.S. patent No. 4,166,807 to Komatsu et al., (hereinafter referred to as 'Komatsu') and U.S. patent No. 4,127,503 to Yoshikawa et al., (hereinafter referred to as 'Yoshikawa '503')." Pages 3-4 of the June 4, 2011 order discuss the teachings of Komatsu and Yoshikawa '503 that establishes the SNQs. The order is clear that the teachings of Komatsu and Yoshikawa '503, without any improper reliance on the McKedy Declaration, supply the new technological teachings to raise the SNQs. In other words, the order is not deemed an *ultra vires* action because the order found SNQs for claims 1-12 based on U.S. patents.

Furthermore, the order is clear that the McKedy Declaration is only being used to explain the contents of Komatsu (e.g., whether the contents of Komatsu meets functional claim limitations), which is permitted by reexamination law and policies. See MPEP 2216 and 2258. See also, e.g., pages 4-7 of the request for reexamination explaining how Komatsu teaches the functional limitations. As explained in the paragraph above, the order states that the teachings of Komatsu and Yoshikawa '503 would be important to a reasonable examiner in determining the patentability of claims 1-12 of the '921 patent. See pages 3-5 of the order. To the extent that patent owner contests viability of the McKedy Declaration, patent owner can present arguments and their own evidence, during this proceeding, in support of their assertion that the McKedy Declaration should not be given any weight. The examiner will appropriately weigh all the evidence of record in her evaluation of patentability of the claims.

Therefore, the record shows that the examiner made a determination that the teachings in Komatsu and Yoshikawa '503 provided a new technical teaching pertaining to the limitations of claims 1-12 of the '921 patent, and accordingly, raised SNQs for these claims. See MPEP 2240 and 2244. In other words, the determination that SNQs were raised by the teachings of Komatsu and Yoshikawa '503 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.

Furthermore, to the extent that patent owner's arguments raise issues as to whether the SNQ is not new, these arguments will not be addressed in this decision. 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. See also MPEP 1201, which states that "... the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner

must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must show that there was no discretion to grant the reexamination.

As the petition is dismissed, there is no need to specifically discuss the substantive issues raised by the requester's opposition.

*Findings*

It is found that the order was not based wholly on a document that is not patent or printed publication. 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.

## CONCLUSION

1. The patent owner's petition under 37 CFR 1.181(a)(3) to vacate the reexamination proceeding is hereby **dismissed.**

2. The requester's June 17, 2011 opposition petition is granted to the extent that the June 13, 2011 petition is dismissed.

3. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

4. Response should be addressed as follows:

   By Mail to: Mail Stop *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://efs.uspto.gov/efile/myportal/efs-registered. 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 Deborah Jones, at (571) 272-1535.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,597 | 03/24/2011 | Susan P. Evans | 91943.000688 | 4097 |

56356 7590 01/31/2012

PACTIV CORPORATION
c/o NIXON PEABODY LLP
300 S. Riverside Plaza
16TH FLOOR
CHICAGO, IL 60606

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/31/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEPHEN B. SALAI, ESQ.
HARTER SECREST & EMERY LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER, NY 14604-2711

Date MAILED
JAN 31 2012
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011597
PATENT NO. : 6395195
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)).

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

PACTIV CORPORATION
c/o NIXON PEABODY LLP
300 S. RIVERSIDE PLAZA
16TH FLOOR
CHICAGO, IL 60606

(For Patent Owner)

MAILED
JAN 3 1 2012
CENTRAL REEXAMINATION UNIT

Michael J. Didas
HARTER SECREST & EMERY LLP
1600 BAUSCH & LOMB PLACE
ROCHESTER, NY 14604-2711

(For Third Party Requester)

| | | |
|---|---|---|
| *In re*: *Evans et al.* | : | |
| *Ex Parte* Reexamination Proceeding | : | DECISION ON |
| Control No. 90/011,597 | : | PETITIONS UNDER |
| Deposited: March 24, 2011 | : | 37 CFR § 1.181(a)(3) |
| For: US Patent No. 6,395,195 | : | |

This is a decision on the June 13, 2011 petition, entitled "Petition to Vacate the Order Granting Ex Parte Reexamination under 37 CFR 1.181," which is requesting that the order granting reexamination is *ultra vires* and should be vacated. The patent owner's petition is treated as a petition under 37 CFR § 1.181(a)(3). The third party requester filed a paper on June 17, 2011 in opposition to the petition, which is permitted by MPEP 2246.

The petition and the opposition are before the Director of the Central Reexamination Unit.

The patent owner's June 13, 2011 petition is dismissed for the reasons set forth below.

The requester's June 17, 2011 opposition petition is granted to the extent that the June 13, 2011 petition is dismissed.

## SUMMARY OF RELEVANT FACTS

1. On May 28, 2002, U.S. Patent No. 6,395,195 ("the '195 patent") was issued to *Evans et al.*

2. On March 24, 2011, a request for *ex parte* reexamination was submitted by a third party requester and identified by control number 90/011,597.

3. On June 3, 2011, the order was granted for *ex parte* reexamination in control number 90/011,597.

4. On June 13, 2011, the instant patent owner petition was submitted.

5. On June 17, 2011, the requester filed an opposition to the June 13, 2011 petition.

## 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 § 2216 Substantial New Questions of Patentability** (in-part):

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

**MPEP § 2246 Decision Ordering Reexamination** (in-part):

A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new

question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

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:

(A) the reexamination order is not based on prior art patents or printed publications.

**MPEP § 2258 Scope of Ex Parte Reexamination** (in-part):

**E. Affidavits or Declarations or Other Written Evidence**

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination, but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

## DECISION

The patent owner petitioner requests that the order and the reexamination proceeding be vacated. The petitioner considers the action of granting reexamination of the patent as an *ultra vires* action by the Office. Specifically, patent owner argues that the order is (1) not based on prior art patents or printed publications (e.g., it is based on the disclosure in the McKedy Declaration) and (2) is based wholly on the same question of patentability raised in a prior examination. See, e.g., pages 3-7 of the petition.

Requester opposes the petition on the grounds that the petition fails to raise any issues that are subject to review by petition; that the order is based on patents and printed publications (e.g., the McKedy Declaration is properly used to support the inherent disclosure of the references) and that the order is not based on the same questions of patentability already raised in a prior examination. See, e.g., pages 2-6 of the opposition.

The determination of whether a substantial new question of patentability (SNQ) exists is a fact-specific inquiry. Upon review of the record, the examiner followed reexamination laws and policies

in her determination that the request raises SNQs for claims 1-10 of the '195 patent. **Specifically, the order is clear that Komatsu and Yoshikawa '503, which are both U.S. patents, supply the SNQs.** For example, see pages 2-3 of the order that states "[i]n the present instance there exists a SNQ based solely on U.S. patent No. 4,166,807 to Komatsu et al., (hereinafter referred to as 'Komatsu') and U.S. patent No. 4,127,503 to Yoshikawa et al., (hereinafter referred to as 'Yoshikawa '503')." Pages 3-4 of the June 3, 2011 order discuss the teachings of Komatsu and Yoshikawa '503 that establishes the SNQs. The order is clear that the teachings of Komatsu and Yoshikawa '503, without any improper reliance on the McKedy Declaration, supply the new technological teachings to raise the SNQs. In other words, the order is not deemed an *ultra vires* action because the order found SNQs for claims 1-10 based on U.S. patents.

Furthermore, the order is clear that the McKedy Declaration is only being used to explain the contents of Komatsu (e.g., whether the contents of Komatsu meets functional claim limitations), which is permitted by reexamination law and policies. See MPEP 2216 and 2258. See also, e.g., pages 5-7 of the request for reexamination explaining how Komatsu teaches the functional limitations. As explained in the paragraph above, the order states that the teachings of Komatsu and Yoshikawa '503 would be important to a reasonable examiner in determining the patentability of claims 1-10 of the '195 patent. See pages 3-5 of the order. To the extent that patent owner contests viability of the McKedy Declaration, patent owner can present arguments and their own evidence, during this proceeding, in support of their assertion that the McKedy Declaration should not be given any weight. The examiner will appropriately weigh all the evidence of record in her evaluation of patentability of the claims.

Therefore, the record shows that the examiner made a determination that the teachings in Komatsu and Yoshikawa '503 provided a new technical teaching pertaining to the limitations of claims 1-10 of the '195 patent, and accordingly, raised SNQs for these claims. See MPEP 2240 and 2244. In other words, the determination that SNQs were raised by the teachings of Komatsu and Yoshikawa '503 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.

Furthermore, to the extent that patent owner's arguments raise issues as to whether the SNQ is not new, these arguments will not be addressed in this decision. 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. See also MPEP 1201, which states that "... the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner

must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must show that there was no discretion to grant the reexamination.

As the petition is dismissed, there is no need to specifically discuss the substantive issues raised by the requester's opposition.

*Findings*

It is found that the order was not based wholly on a document that is not patent or printed publication. 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.

## CONCLUSION

1. The patent owner's petition under 37 CFR 1.181(a)(3) to vacate the reexamination proceeding is hereby **dismissed.**

2. The requester's June 17, 2011 opposition petition is granted to the extent that the June 13, 2011 petition is dismissed.

3. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

4. Response should be addressed as follows:

   By Mail to: Mail Stop *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://efs.uspto.gov/efile/myportal/efs-registered. 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 Deborah Jones, at (571) 272-1535.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,598 | 03/25/2011 | Shuang Ji | 032468.0004-US05 | 4668 |

26853 7590 08/10/2011

COVINGTON & BURLING, LLP
ATTN: PATENT DOCKETING
1201 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004-2401

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 08/10/2011

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

MICHAEL A. DESANCTIS
HAMILTON DESANCTIS & CHA LLP FINANCIAL PLAZA AT UNION SQUARE
225 UNION BOULEVARD, SUITE 150
LAKEWOOD, CO 80228

Date: MAILED

AUG 10 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011598
PATENT NO. : 5623600
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

AUG 10 2011

CENTRAL REEXAMINATION UNIT

Covington & Burlington
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, DC 20004-2401

(For Patent Owner)

Michael A Desanctis
Hamilton Desanctis & Cha LLP
Financial Plaza at Union Square
225 Union Boulevard, Suite 150
Lakewood, CO 80229

(For Third Party Requester)

*In re* Ji *et al.*
*Ex Parte* Reexamination Proceeding
Control No. 90/011,598
Filed: March 25, 2011
For: U.S. Patent No. 5,623,600

: **DECISION**
: **DISMISSING PETITION**
: **UNDER §§ 1.182 AND 1.183**

This is a decision on the April 8, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO VACATE THE FILING OF *EX PARTE* REQUEST FOR REEXAMINATION CONTROL NO. 90/011,598."

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. §§ 1.182 and 1.183 is **dismissed.**

## PERTINENT BACKGROUND

- On April 22, 2007, U.S. Patent No. 5,632,600 ("the '600 patent) was issued to Ji *et al.*
- On March 25, 2011, a request for *ex parte* reexamination was filed by the third party requester, the real party in interest being Fortinet, and the resulting reexamination proceeding was assigned control number 90/001,1598 ("the '1598 proceeding").
- On April 8, 2011, the instant petition was filed.
- On May 13, 2011, the reexamination request was denied.

## PERTINENT STATUTES AND REGULATIONS

**37 C.F.R. § 1.182 provides:**

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

**37 C.F.R. § 1.183 provides:**

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

## DECISION

Patent owner petitions to vacate the filing of the *ex parte* request for the instant reexamination proceeding and requests that the examiner of a copending proceeding not be allowed access to the instant proceeding. Patent owner requests this relief on the grounds that the instant reexamination has no proper purpose under the statutes; i.e., presents no substantial new question of patentability.[1]

The instant proceeding was denied reexamination in an Office communication issued on May 13, 2011. The examiner in the instant proceeding was different than that in the copending proceeding. In view of these facts, patent owner's desired relief has occurred through the normal procedures of the Office. The instant petition is therefore moot. It is, however, pointed out that the fact that a request for reexamination does not raise a substantial new question of patentability does not provide basis for vacating a reexamination proceeding, and the proceeding papers remain of record.

Thus, the instant patent owner petition under § 1.182 is **dismissed**.

The instant petition is also filed for relief under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules.

---

[1] See petition at 4.

However, since the underlying question is moot as described above, the question of waiver under § 1.183 is not reached in this decision.

## CONCLUSION

1. The patent owner petition under §§ 1.182 and 1.183 is **dismissed.**

2. A copy of this decision will be made of record in the reexamination file.

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

/Kenneth M. Schor/

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

August 9, 2011
Kenpet8/

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

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

(For Patent Owner)

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

(For Third Party Requester)

MAILED

OCT 31 2011

CENTRAL REEXAMINATION UNIT

*In re* Feeley *et al.*
*Inter partes* Reexamination Proceeding
Control No.: 95/001,022
Filed: February 26, 2008
For: U.S. Patent No. 7,016,512

*In re* Feeley *et al.*
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,599
Filed: March 25, 2011
For: U.S. Patent No. 7,016,512

: DECISION ON
: PETITION TO
: PREVENT
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's June 10, 2011 petition entitled "PETITION UNDER 37 C.F.R. § 1.182 PRESENTING FACTS TO SUPPORT A DECISION AGAINST MERGER OF THE PRESENT CASE WITH A SUBSEQUENTLY FILED REEXAMINATION PROCEEDING" filed in *inter partes* reexamination proceeding 95/001,022. On July 8, 2011, third party requester filed an opposition entitled "REQUESTER OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.182" to patent owner's June 10, 2011 petition.

**FEE**

The Third Party Requester opposition is a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 will be charged to Requester's deposit account no. 19-0036 pursuant to the oral authorization in a voice mail message from requester's representative, Jason Eisenberg, on September 8, 2011.

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

Patent Owner's petition is granted, and the above captioned proceedings are NOT merged for the reasons set forth below.

Third party requester's opposition petition is dismissed for the reasons set forth below.

## REVIEW OF FACTS

1. On March 21, 2006, the Office issued U.S. Patent No. 7,016,512 (the '512 patent) to Feeley *et al.*

2. The '512 patent is subject to litigation in the United States District Court for the Northern District of Oklahoma, in *Hear-Wear Technologies, LLC v. Oticon Inc. et al.*, {Civil Action No. 07:CV-212-CVE-FHM}. The initial complaint was filed April 16, 2007.

3. On February 26, 2008, a request for *inter partes* reexamination of all the claims (claims 1-12) of the '512 patent was filed by third party requester (requester) K/S Hearing Instrument Manufactures Patent Partnership (HIMPP). The request was assigned Control No. 95/001,022 (the '1022 proceeding).

4. On April 22, 2008, the Office issued an order granting the '1022 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 '512 patent, claims 1-12, would be subject to reexamination.

5. On March 4, 2009, the Office issued a non-final Office action in the '1022 proceeding.

6. On March 18, 2009, the Office *sua sponte* issued a new non-final Office action in the '1022 proceeding.

7. On May 12, 2009, patent owner timely filed a response to the March 18, 2009 non-final Office action.

8. On June 11, 2009, third party requester timely filed comments after patent owner's response.

9. On June 23, 2009, patent owner filed a petition requesting expungement of third party requester's June 11, 2009 comments as improper.

10. On December 1, 2009, the Office issued a decision expunging, as improper, third party requester's June 11, 2009 comments and giving third party requester 15-days to submit proper comments.

11. On December 16, 2009, third party requester submitted corrected comments.

12. On December 23, 2009, patent owner filed a petition requesting expungement of third party requester's December 16, 2009 comments as improper.

13. On June 23, 2010, the Office issued a decision expunging as improper third party requester's December 16, 2009 corrected comments submission. Third party requester was not given another opportunity to file third party comments.

14. Also on June 23, 2010, the Office issued an Action Closing Prosecution (ACP) confirming claims 3 and 9 and rejecting as unpatentable claims 1-2, 4-8, and 10-12.

15. On March 16, 2011, the Office issued a Right of Appeal Notice (RAN) confirming claims 3 and 9 and rejecting as unpatentable claims 1-2, 4-8, and 10-12.

16. On March 25, 2011, a request for *ex parte* reexamination of claims 3 and 9 of the '512 patent was filed by Robert Sterne of the Sterne Kessler Goldstein and Fox law firm. The request was assigned Control No. 90/011,599 (the '11599 proceeding).

17. On April 14, 2011, patent owner filed a notice of appeal in the '1022 proceeding.

18. On April 15, 2011, third party requester filed a notice of appeal in the '1022 proceeding.

19. On April 18, 2011, patent owner was contacted (via counsel) and did not agree to waive the right to submit a Patent Owner's Statement under 35 U.S.C. 304 in the '11599 proceeding.

20. On May 12, 2011, the Office issued an order granting the '11599 request for *ex parte* reexamination. The order stated that claims 3 and 9 of the '512 patent, would be subject to reexamination.

21. On May 20, 2011, the Office *sua sponte* issued a new order granting the '11599 request for *ex parte* reexamination. The order stated that patent owner waived the right to submit a Patent Owner's Statement under 37 CFR 1.530. The order stated that claims 3 and 9 of the '512 patent, would be subject to reexamination.

22. On June 10, 2011, the '1022 third party requester filed a revocation of power of attorney, with a new power of attorney and change of correspondence address designating the Sterne Kessler Goldstein and Fox law firm for the '1022 proceeding.

23. Also on June 10, 2011, patent owner timely filed an appellant's brief in the '1022 proceeding. Patent owner concurrently filed the present petition to prevent merger in the '1022 proceeding.

24. On June 14, 2011, third party requester timely filed an appellant's brief in the '1022 proceeding.

25. Also on June 14, 2011, the Office issued a Notice of non-compliant brief, indicating that

patent owner's June 10, 2011 brief was non-complaint and giving patent owner one month to file a corrected brief in the '1022 proceeding.

26. On July 8, 2011, third party requester filed the present opposition petition to patent owner's June 10, 2011 petition to prevent merger, and requesting that patent owner's June 10, 2011 petition be expunged as an improper paper in the '1022 proceeding.

27. Also on July 8, 2011, patent owner filed an amended appellant's brief in the '1022 proceeding in response to the June 14, 2011 Office notice of non-compliant brief.

28. On July 14, 2011, patent owner filed a respondent's brief in response to third party requester's June 14, 2011 appellant's brief in the '1022 proceeding.

29. On August 4, 2011, third party requester filed a respondent's brief in response to patent owner's July 8, 2011 amended appellant's brief in the '1022 proceeding.

30. On August 18, 2011, the Office issued a first Office action on the merits in the '11599 proceeding rejecting claims 3 and 9 of the '512 patent.

31. On August 19, 2011, the Office issued an Examiner's Answer in the '1022 proceeding incorporating by reference all the grounds of rejection, determinations of patentability and explanations set forth in the March 16, 2011 RAN.

32. On September 16, 2011, patent owner and third party requester both filed rebuttal briefs.

33. This decision addresses patent owner's June 10, 2011 petition to prevent merger and third party requester's July 8, 2011 opposition to patent owner's request to prevent merger.

## RELEVANT AUTHORITY

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 305 states:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new

claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

35 U.S.C. 311(a) states:

IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

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

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

35 U.S.C. 317(a) states:

(a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.4(c) states:

(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 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition

seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.937(a) states:

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

37 CFR 1.989 states:

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

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
>
> Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:
>
> (1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.
>
> (1)(b) The subsequent request is an *ex parte* reexamination request. Any party

(including the patent owner) can file the subsequent *ex parte* reexamination request.

. . . .

In order for the second or subsequent request to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. See MPEP § 2640 regarding whether a substantial new question of patentability is raised by the art cited in a second or subsequent request filed while a first reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to merge the proceedings will be made by the Office of Patent Legal Administration. (OPLA). No decision on merging the reexaminations should be made until such time as reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply (if an *ex parte* reexamination is one of the proceedings).

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged *where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings.* However, **a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate** of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch." [Emphasis Added]

MPEP 2686.01 IV states:

Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, *if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the*

*second proceeding, with no delay resulting.* The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. [Emphasis Added]

MPEP 2686.01 VI states:

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the order to reexamine the second request, it will not be considered but will be returned to the party submitting the same by the OPLA. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2667.

The patent owner can file a petition to merge the proceedings at any time after the order to reexamine the second request. A requester of any of the multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the third party requesters of the reexaminations will not be considered but will be returned to that party by the OPLA. Note that the acceptance of a petition to merge the multiple proceedings at any time after the order to reexamine the second request is contrary to 37 CFR 1.939 since such acceptance can be prior to the issuance of the first Office action. Accordingly, the requirement of 37 CFR 1.939 is hereby waived to the extent that a petition for merger of a reexamination proceeding with a reexamination proceeding or with a reissue (see MPEP § 2686.03) can be submitted after the order to reexamine has been issued in all the reexamination proceedings to be merged. This waiver is made to assure merger at the earliest possible stage.

All decisions on the merits of petitions to merge multiple reexamination proceedings, where at least one of the proceedings is an *inter partes* reexamination will be made by the OPLA.

Decisions on the merits of petitions to merge multiple reexamination proceedings, where none of the proceedings is an inter partes reexamination, will be made by

the CRU Director (or by the CRU SPE, if the CRU Director delegates such to the CRU SPE); see MPEP § 2283.

## PRELIMINARY MATTER

The July 8, 2011 opposition submission is an improper submission, as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. As to the submission of an opposition to the June 10, 2011 patent owner petition and also a petition for the relief of expungement of the June 10, 2011 patent owner petition within a single paper, such is precluded by 37 CFR 1.4(c). The handling of these two matters is delegated to different braches of the Office (the Office of Patent Legal Administration and the Central Reexamination Unit). Therefore, the July 8, 2011 "opposition petition" in regards to the petition to expunge is subject to dismissal as improper. However, in the interest of special dispatch the Office *sua sponte* waives the requirements of 37 CFR 1.4(c) in this specific instance and the Office of Patent Legal Administration is addressing both matters. This waiver does not apply to any further submissions.

## DECISION

### I. Issues Raised and Relief Requested

**A. Patent Owner's June 10, 2011 Petition:** Patent owner requests the '1022 and '11599 proceedings not be merged, asserting the following: (1) The merger of the '1022 *inter partes* proceeding with the '11599 *ex parte* proceeding will only further delay the '1022 proceeding, which has been pending for over three years, contrary to the statutory mandate of special dispatch; and (2) Merger of the '1022 *inter partes* proceeding with the later filed '11599 *ex parte* circumvents 35 U.S.C. § 317(a) and 37 C.F.R. §§ 1.907, 1.989, 1.535 to undermine the integrity of *ex parte* and *inter partes* reexamination proceedings. Patent owner requests the remedy of non-merger of the two proceedings.

**B. Third Party Requester's July 8, 2011 Opposition Petition:** Third party requester opposes patent owner's petition against merger, asserting the following: (1) Patent owner is more of a source of delay relative to third party requester; and (2) Merger is appropriate pursuant to the rules and MPEP. Third party requester further requests that patent owner's June 10, 2011 petition be expunged from the record.

### II. Findings and Analysis

Reexamination of the '512 patent has been ordered in the '11599 *ex parte* proceeding and '1022 *inter partes* proceeding. Thus far, the Office has made no decision to merge the above-captioned *ex parte* and *inter partes* reexamination proceedings. In view of the patent owner's petition, a discussion will be presented (a) as to the Office's discretion with respect to whether proceedings are to be merged and (b) as to why the Office does not intend to merge the above-captioned proceedings at present.

There is no legal requirement for the Office to merge, or not to merge, pending reexamination proceedings. The determination whether to merge 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.,[1] MPEP 2686.01 IV,[2] 2283,[3] MPEP 2286.[4] In connection with this, the following is pointed out:

First, the statute is silent as to the administrative consolidation of co-pending reexamination proceedings on the same patent. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[5] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of proceedings 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.[6] Therefore, while the Office retains the authority to merge, the Office also retains the authority to not merge proceedings, where special dispatch can be better served absent merger. Given the complexities and/or particularities that would arise as a result of merger in the present instance, as well as the delay and regression of one proceeding that has already arrived at the advanced stage of being fully briefed, requester's position that merger would be in accord with special dispatch is not persuasive. Merger/non-merger

---

[1] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'" (Emphasis added).

[2] "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."

[3] "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.'"

[4] "[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.'"

[5] "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).

[6] Id.

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, and in this case the Office has decided that the statutory mandate for special dispatch is best served by not merging.[7,8]

## III. Response to Opposition Petition Arguments

**A. Propriety of Merger under the Present Circumstances.** Requester is in error that the Office can only achieve prosecution efficiency by merging the '1022 proceeding and the '11599 proceeding and that non-merger runs contrary to special dispatch. All determinations of merger are made on a case-by-case basis. The Office is in the best position to determine what will facilitate the Office's discharge of its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), because the Office is in the best position to evaluate the complications and results of merger and balance them against the benefits of merger. It is appropriate that the Office has sole discretion in this matter, because it is the Office that is charged by statute with the duty of special dispatch – not the parties. In the present proceedings, as noted in section II, the Office has determined the most efficient manner to address the issues raised in each request is to not merge. Requester's concerns regarding non-merger of the proceedings are unfounded. The '11599 proceeding is at a relatively early stage of prosecution, while the '1022 proceeding has advanced to the appeal stage, an Examiner's Answer has issued and the proceeding has been briefed. Withdrawing the '1022 proceeding from this advanced point of the appeal stage to reopen prosecution therefore is contrary to special dispatch.

**B. Party Activity.** Third party requester did nothing to minimize the consumption of Office resources in this instance. Requester did not file that request until after the April 14, 201 RAN was issued, knowing that an initial determination regarding the existence of a substantial new question of patentability would not be made for up to three months[9] and that the proceeding would not be ripe for merger consideration for at least two more months.[10] Given the advanced stage of the '1022 *inter partes* reexamination proceeding, advancement of the '1022 proceeding for an additional five months does not tend toward merger. At that stage, requester could have filed a petition for extension of time to file papers, concurrently with a notice of concurrent proceedings, to obtain the results of the decision to merge, explaining why the requester believed merger was in order. If requester could have made a sufficient showing for waiting until the

---

[7] 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."

[8] "[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.

[9] See 35 USC 303(a)

[10] See 35 USC 304 and MPEP 2686.01

after the RAN was issued, that would have avoided the Office's having to process requester and patent owner initial, responsive and rebuttal briefs along with issuance of an examiner's answer. If requester could not have made a sufficient showing, then, at that point, the issue of merger would have been resolved in the negative. Either way, the matter could have been resolved before the present stage of the proceeding. Instead, requester's actions were to file a notice of appeal and appeal brief and advance the proceeding through the entire briefing phase of appeal, actions which are contrary to requester's arguments. Thus, requester's actions and inactions have resulted in a circumstance that if the merger were now to be granted, resources on the part of the parties and the Office will be wasted.

**C. Merger does not "Undermine the Integrity" of Reexamination.** Patent owner's sweeping allegation that merger undermines the integrity of reexamination is not persuasive. The administrative act of consolidation of reexamination proceedings that is "merger," cannot and does not undermine the integrity of reexamination proceedings. A consolidation of proceedings, depending on individual situations, serves to avoid unnecessary delay and resolve issues having common questions of fact and/or law. Consolidation does not alter the statutory rights of the parties, e.g. grant participation rights to an *ex parte* requester, as to do so would constitute an *ultra vires* act. Merger, pursuant to 35 U.S.C. §§ 305 and 314(c), and in accordance with 37 CFR 1.989, is used to support the Office's statutory mandate of special dispatch, where a given situation is facilitated by merger. Accordingly, patent owner sweeping allegation that merger undermines the integrity of reexamination is not persuasive.

**D. Expungement of Patent Owner's June 10, 2011 Petition.** Requester's assertion that patent owner's June 10, 2011 is improper and must be expunged is not found to be persuasive. Requester provides only a generalized allegation that patent owner's June 10, 2011 petition is an improper paper.[11] Requester does not provide any specific basis as to why patent owner's June 10, 2011 petition constitutes an improper paper. Patent owner's June 10, 2011 petition constitutes a legitimate exercise of a party's petition rights in the present proceeding and therefore, patent owner's June 10, 2011 petition is not an improper paper. Accordingly, third party requester's petition to expunge patent owner's June 10, 2011 opposition petition is dismissed.

Further, it is noted that if the patent owner paper were to be expunged, then requester's opposition paper would likewise be expunged as an answer to a non-existent paper. In that event, no papers on the merger would exist, and the Office's prior *sua sponte* choice not to

[11] Page 2 of the July 8, 2011 Requester Opposition Petition states, "Patent Owner's rationale is not only incorrect, but Patent Owner presents reasons that are adverse to the clear language of the statutes, rules, and procedures allowing for merger as discussed above. Thus, not only does Requester believe merger of the 022 Reexam and the 599 Reexam proceedings is appropriate, but the Patent Owner's Petition should be expunged from the record of the 022 Reexam proceeding as being inappropriate."

merge would remain in place without comment from parties. Non-merger, in appropriate circumstances, is in accord with and not contrary to public policy for the reasons stated above in the previous sections. In the present instance, a decision to not merge best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), permitting the resolution of the substantial new questions raised in each proceeding, without deterring either proceeding. The discretionary Office decision that the instant proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as efficiently as possible. Accordingly, the decision is not contrary to the relevant issues of public policy identified by requester.

## CONCLUSION

1. The June 10, 2011 patent owner petition is granted.

2. The July 8, 2011 third party requester opposition petition has been considered, and the expungement aspect is dismissed.

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

/ Kenneth M. Schor/

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

10-28-11

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/011,603 | 03/28/2011 | 6,418,419 | 006119.00211 | 7725 |

7590 07/08/2011

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/08/2011

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BANNER & WITCOFF, LTD
ATTORNEYS FOR CLIENT NO. 00619
10 SOUTH WACKER DRIVE, SUITE 3000
CHICAGO, IL 60606

Date:

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011603
PATENT NO. : 6418419
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. |
|---|---|---|---|---|
| 90/011,618 | 04/29/2011 | Robert Scott Nieboer | 4672/858 | 8648 |

7590 07/08/2011

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/08/2011

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

Date: MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011618
PATENT NO. : 6418419
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UN

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

(For Patent Owner)

BANNER & WITCOFF, LTD.
ATTORNEY'S FOR CLIENT NO. 006119
10 SOUTH WACKER DRIVE SUITE 3000
CHICAGO, IL 60606

(For Third Party Requester)

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

(For Third Party Requester)

*In re* NIEBOER *et alia*
Reexamination Proceeding
Control No. 90/011,603
Request Deposited: March 28, 2011
For: U.S. Patent No. 6,418,419

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

*In re* NIEBOER *et alia*
Reexamination Proceeding
Control No. 90/011,618
Request Deposited: April 2, 2011
For: U.S. Patent No. 6,418,419

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. 6,418,419 (hereinafter, the '419 patent), issued to NIEBOER *et alia*, on July 9, 2002.

2. On March 28, 2011, a third party deposited a Request for *Ex Parte* Reexamination of the '419 patent. The reexamination proceeding was assigned Control No. 90/011,603 (hereinafter, the '11603 proceeding).

3. On April 2, 2011, a third party deposited a Request for *Ex Parte* Reexamination of the '419 patent. The reexamination proceeding was assigned Control No. 90/011,618 (hereinafter, the '11618 proceeding).

4. The Reexamination Order was granted in the '11603 proceeding on June 21, 2011.

5. The Reexamination Order was granted in the '11618 proceeding on June 21, 2011.

6. There are currently no amendments in either 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 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 90/011,603 and 90/011,618 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. 90/011,603 and 90/011,618 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/
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. |
|---|---|---|---|---|
| 90/011,604 + 95/001587 | 04/06/2011 | 6,878,358 | ASTM.160809 | 8584 |

5251 7590 07/27/2011

SHOOK, HARDY & BACON LLP
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD
KANSAS CITY, MO 64108-2613

| EXAMINER | |
|---|---|
| JOHNSON, JERRY D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3991 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/27/2011 | 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.

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

Shook, Hardy & Bacon LLP
2555 Grand Blvd.
Kansas City, MO 64108-2613

(For Patent Owner)

Reed Smith LLP
10 South Wacker Drive
Chicago, IL 60606-7507

(For the '1587 Requester)

In re Vosteen et al.
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,604
Filed: April 6, 2011
For: U.S. Patent No. 6,878,358

In re Vosteen et al.
*Inter Partes* Reexamination Proceeding
Control No.: 95/001,587
Filed: March 28, 2011
For: U.S. Patent No.: 6,878,358

**DECISION ON PETITION TO MERGE REEXAMINATION PROCEEDINGS**

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration on petition by the patent owner for consideration on merging the above proceedings.

*Ex parte* reexamination proceeding No. 90/011,604 and *inter partes* reexamination proceeding No. 95/001,587 **are merged** into a single proceeding.

## BACKGROUND

1. On April 12, 2005, United States Patent Number 6,878,358 ("the '358 patent") issued to Vosteen et al. with 16 claims.

2. On March 28, 2011, a request for *inter partes* reexamination of claims 1-16 of the '358 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,587 ("the '1587 proceeding"). The request identified Nalco Co. ("the 1587 requester") as the real party in interest.

3. On April 6, 2011, patent owner filed a request for *ex parte* reexamination of claims 1, 7 and 13 of the '358 patent and assigned control number 90/011,604 ("the '11604 proceeding"). The request included a preliminary amendment to the claims, cancelling claim 1, amending claims 2, 4-8, 12 and 14-16 and adding new claims 17-51. Claims 3, 9-11 and 13 are as originally issued.

4. On May 26, 2011, *inter partes* reexamination of claims 1-16 of the '358 patent was granted in the '1587 proceeding. An Office action was not concurrently issued.

5. On May 27, 2011, *ex parte* reexamination of claims 1, 7 and 13 of the '358 patent was granted in the '11604 reexamination proceeding. An Office action was not concurrently issued. The time period for filing a statement under 37 CFR 1.530 has lapsed with out the filing of a patent owner statement in the '11604 reexamination proceeding.

6. On June 1, 2011, patent owner filed a petition for merger in the '11604 proceeding, requesting that the '1587 and the '11604 proceedings be merged.

7. To date, no Office action has issued in either of the two proceedings.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '1604 proceeding) is an *ex parte* proceeding. The other proceeding (the '1587 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. 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 90/011,604 and 95/001,587 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

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. A proposed amendment accompanied the patent owner's request *for ex parte* reexamination. Claim 1 has been cancelled, claims 2, 4-8, 12 and 14-16 have been

amended and new claims 17-51 have been added in the '11604 *ex parte* proceeding, while the claims in the '1587 *inter partes* proceeding have not been 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. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

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.

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).[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.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02 and 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that* third *party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

---

[1] 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.

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 third party requester, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

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

| | |
|---|---|
| by Mail to: | Attn: Mail Stop "*Inter Partes* Reexam"<br>Central Reexamination Unit<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| by FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| by Hand to: | Customer Service Window<br>Attn: Central Reexamination Unit<br>Randolph Building, Lobby Level<br>401 Dulany Street<br>Alexandria, VA 22314 |
| by EFS: | Registered users may submit papers via the |

electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Patent owner and requester 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, 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.

## CONCLUSION

1. *Ex parte* Reexamination Control No. 90/011,604 and *inter partes* Reexamination Control No. 95/001,587 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 an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in all proceedings and requesters' comments on that response, or (b) the expiration of the time for filing the required response and any comments requesters elect to file.

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

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

July 25, 2011

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

(For Patent Owner)

MICHAEL P. MAZZA, LLC
686 CRESCENT BLVD.
GLEN ELYN IL 60137

(For Requester)

JOSEPH P. KRAUSE
KELLY & KRAUSE, LP
1000 JORIE BLVD, STE 144
OAK BROOK IL 60523

MAILED

JUL 25 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Yung-Chia Yu | : | |
| Reexamination Proceeding | : | |
| Control No. 90/011,613 | : | DECISION ON PETITION |
| Filed: 04/01/2011 | : | UNDER 37 CFR 1.55(c) |
| For: U.S. Patent No. RE,41060 | : | |
| Reissue of U.S. Patent No. 6,690,141 | : | |
| Attorney Docket No. 4200.006 | : | |

This is a decision on the "PETITION FOR CLAIM OF PRIORITY UNDER 37 CFR 1.55(c)," filed on June 3, 2011, which is treated as a petition, to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of priority of the filing date of foreign Taiwanese Application No. 091203710, filed on March 22, 2002.

The petition is **DISMISSED.**

The application which matured into the patent which is being reexamined was filed after November 29, 2000, and did not include a proper reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) for a reexamination proceeding, the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, **and be included in an oath or declaration (37 CFR 1.63(c)(2)) filed in the reexamination proceeding**;

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional (the Director may require additional information where there is a question whether the delay was unintentional); and

(5) the original nonprovisional application for the patent being reexamined must be filed within 12 months of the filing date of the foreign application.

The petition fails to comply with item (2) above. In this regard, a review of the file record fails to disclose that the priority information was included in an oath or declaration in compliance with 37 CFR 1.63(c)(2). *Note* MPEP 201.14.

In view of the above, an oath or declaration containing the claim for priority must be filed if applicant desires to claim priority to the foreign application noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

The petition fee of $1,410.00 has been received.

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

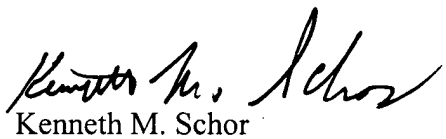
By mail:
Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

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

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

A reply may also be filed via the EFS-Web system of the USPTO.

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MICHAEL P. MAZZA, LLC
686 CRESCENT BLVD.
GLEN ELYN IL 60137

(For Requester)

JOSEPH P. KRAUSE
KELLY & KRAUSE, LP
1000 JORIE BLVD, STE 144
OAK BROOK IL 60523

MAILED

SEP 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Yung-Chia Yu | : | |
| Reexamination Proceeding | : | |
| Control No. 90/011,613 | : | DECISION ON PETITION |
| Filed: 04/01/2011 | : | UNDER 37 CFR 1.55(c) |
| For: U.S. Patent No. RE 41,060 | : | |
| Reissue of U.S. Patent No. 6,690,141 | : | |
| Attorney Docket No. 4200.006 | : | |

This is a decision on the "RENEWED PETITION UNDER 37 CFR 1.55(c)," filed on August 15, 2011, which is treated as a petition, to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of priority of the filing date of foreign Taiwanese Application No. 091203710, filed on March 22, 2002.

The petition is again **DISMISSED.**

The application which matured into the patent which is being reexamined was filed after November 29, 2000, and did not include a proper reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) for a reexamination proceeding, the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, **and be included in an oath or declaration (37 CFR 1.63(c)(2)) filed in the reexamination proceeding**;

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional (the Director may require additional information where there is a question whether the delay was unintentional); and

(5) the original nonprovisional application for the patent being reexamined must be filed within 12 months of the filing date of the foreign application.

The petition fails to comply with item (2) above. In this regard, a review of the file record fails to disclose that the priority information was properly included in an oath or declaration in compliance with 37 CFR 1.63(c)(2). *Note* MPEP 201.14.

Specifically, a review of the record reveals that a supplemental oath or declaration pursuant to 37 CFR 1.63(c)(2) was filed on August 15, 2011, which included the above-referenced prior-filed foreign application number, country, and filing date. However, the block marked "Priority Not Claimed" has been checked, indicating applicant's intent *not* to claim priority to the prior-filed foreign application.

In view of the above, an oath or declaration containing the claim for priority must be filed if applicant desires to claim priority to the foreign application noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

The petition fee of $1,410.00 has been received.

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

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

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

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

A reply may also be filed via the EFS-Web system of the USPTO.

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(For Patent Owner)

MICHAEL P. MAZZA, LLC
686 CRESCENT BLVD.
GLEN ELYN IL 60137

(For Requester)

JOSEPH P. KRAUSE
KELLY & KRAUSE, LP
1000 JORIE BLVD, STE 144
OAK BROOK IL 60523

MAILED

OCT 06 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Yung-Chia Yu | : | |
| Reexamination Proceeding | : | |
| Control No. 90/011,613 | : | DECISION ON PETITION |
| Filed: 04/01/2011 | : | UNDER 37 CFR 1.55(c) |
| For: U.S. Patent No. RE 41,060 | : | |
| Reissue of U.S. Patent No. 6,690,141 | : | |
| Attorney Docket No. 4200.006 | : | |

This is a decision on the "RENEWED PETITION UNDER 37 CFR 1.55(c)," filed on September 13, 2011, which is treated as a petition, to accept an unintentionally delayed claim under 35 U.S.C. § 119(a)-(d) for benefit of priority of the filing date of foreign Taiwanese Application No. 091203710, filed on March 22, 2002.

The petition is **GRANTED.**

The application which matured into the patent which is being reexamined was filed after November 29, 2000, and did not include a proper reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) for a reexamination proceeding, the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, and be included in an oath or declaration (37 CFR 1.63(c)(2)) filed in the reexamination proceeding;
(3) the surcharge as set forth in 37 CFR 1.17(t);
(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional (the Director may require additional information where there is a question whether the delay was unintentional); and
(5) the original nonprovisional application for the patent being reexamined must be filed within 12 months of the filing date of the foreign application.

This reexamination proceeding was filed on April 1, 2011, and is a reexamination of U.S. Patent RE41,060, which is a reissue of U.S. Patent No. 6,690,141, which issued from Application No. 10/233,828, which was filed on September 3, 2002, which is after November 29, 2000, and within 12 months of March 22, 2002 (the filing date of the foreign application to which benefit is now being claimed). On September 13, 2011, a declaration pursuant to 37 CFR 1.63 was filed which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee of $1410.00 was received with the petition. Lastly, petitioner has provided an adequate statement of unintentional delay.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 119(a)-(d) is accepted as being unintentionally delayed.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.55(c) should not be construed as meaning that this reexamination proceeding is entitled to the benefit of the prior-filed application. In order for this reexamination proceeding to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 119(a)-(d) and 37 CFR 1.55(a)(1) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this reexamination proceeding is entitled to the benefit of the earlier filing date.***

37 CFR § 1.55(c) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.55(a)(1) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §1.55(c). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

The petition fee of $1,410.00 has been received.

A corrected Filing Receipt, which includes the priority claim to the prior-filed foreign application, accompanies this decision on petition.

This reexamination proceeding is being referred to Technology Center AU 3992 for examination in due course and for consideration by the examiner of record of the foreign priority claim under 35 U.S.C. § 119(a)-(d).

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Encl: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 90/011,613 | 04/01/2011 | 3992 | 2520 | 4200.006 | 21 | 5 |

**CONFIRMATION NO. 6770**

**CORRECTED FILING RECEIPT**

35420
MICHAEL P. MAZZA, LLC
686 CRESCENT BLVD.
GLEN ELYN, IL 60137

*OC00000050097704*

Date Mailed: 10/07/2011

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

RE41,060, Residence Not Provided;
ORIGINAL CREATIONS, INC. (OWNER), NAPERVILLE, IL;
KELLY & KRAUSE, L.P. (3RD PTY. REQ.), OAK BROOK, IL;
JOSEPH P. KRAUSE, OAK BROOK, IL

**Assignment For Published Patent Application**

ORIGINAL CREATIONS, INC., NAPERVILLE, IL

**Power of Attorney:** The patent practitioners associated with Customer Number 35420

**Domestic Priority data as claimed by applicant**

This application is a REX of 11/349,522 02/08/2006 PAT R,E41,060
which is a REI of 10/233,828 09/03/2002 PAT 6,690,141

**Foreign Applications** (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)
TAIWAN 091203710 03/22/2002

**Projected Publication Date:** None, application is not eligible for pre-grant publication

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Multi-Functional Charger with Power Generating and Illumination Functions

**Preliminary Class**

320

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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. |
|---|---|---|---|---|
| 90/011,615 | 04/01/2011 | 5639738 | 44252.21520 | 7657 |

30734 7590 12/22/2011

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

| 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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Dawn C. Russell
ARENT FOX PLLC
1050 Connecticut Ave., NW
Washington, DC 20036

Date: 12-22-11

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011615
PATENT NO. : 5639738
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

DEC 22 2011

CENTRAL REEXAMINATION UNIT

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

BAKER & HOSTETLER, LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

(For Patent Owner)

DAWN C. RUSSELL
ARENT FOX, PLLC
1050 CONNECTICUT AVE., NW
WASHINGTON, D.C. 20036

(For Third Party Requester)

*In re* Falk *et al.*
Reexamination Proceeding
Control No.: 90/011,615
Filed: April 1, 2011
For: U.S. Patent No. 5,639,738

**DECISION ON PETITION UNDER 37 CFR 1.182**

This is a decision on the October 19, 2011 patent owner petition under 37 CFR 1.182 to enter, and 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 October 19, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. On June 17, 1997, U.S. Patent No. 5,639,738 (the '738 patent) was issued to Falk *et al.*

2. On April 1, 2011, a request for *ex parte* reexamination of claims 1-18 of the '738 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/011,615(the '615 proceeding).

3. On May 31, 2011, the Office issued an order granting the '615 reexamination request.

4. On September 29, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '615 proceeding.

5. On September 30, 2011, the '615 proceeding entered the printing cycle and was designated 452 status.

6. On October 19, 2011, patent owner filed the instant petition accompanied by an Information Disclosure Statement (IDS), for which patent owner requests consideration by the Office.

## 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. (Emphasis added)
Once the reexamination has entered the Reexamination Certificate publication process, pulling the proceeding from that process provides an even greater measure of delay. 37 CFR 1.313 states for an application (emphasis added):

> "(c) Once the issue fee has been paid, **the application will not be withdrawn from issue upon petition by the applicant for any reason except:**
> (1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;"

The publication process for an application occurs after the payment of the issue fee (there is no issue fee in reexamination), and thus 37 CFR 1.313(c) applies during the publication cycle for an application. Based on the statutory requirement for "special dispatch," the requirements for withdrawal of a reexamination proceeding from its publication cycle are at least as burdensome as those set forth in 37 CFR 1.313(b) and (c). **Accordingly, where a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), is made while a proceeding is in its publication cycle, the patent owner must provide an unequivocal statement as to why the art submitted makes at least one claim unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable. This is in addition** to the above-discussed (A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier. The submission of patents and printed publications must be accompanied by a petition under 37 CFR 1.182 (with petition fee) for withdrawal of the reexamination proceeding from the publication process for entry and consideration of the information submitted by patent owner. A grantable petition must provide the requisite showing discussed in this paragraph. (Emphasis added)

## DECISION

There is no issue fee in reexamination, and the present reexamination proceeding has entered the final phase of the publication process (the "printing cycle"). In a reexamination proceeding, there is no withdrawal under 37 CFR 1.313 of the proceeding from the publication process for consideration of an Information Disclosure Statement (IDS), because 37 CFR 1.313(a) applies to applications, and not to reexamination proceedings. Accordingly, in this instance, the instant petition for withdrawal of the present proceeding from the publication process, for consideration of the accompanying IDS papers, has been filed under 37 CFR 1.182.

While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC. (Emphasis added)

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 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)

In the present instance, the fact situation fails to satisfy the grounds for the entry of information after issuance of a NIRC and after the proceeding has entered the printing cycle. Specifically, there is neither a full ***factual accounting*** to explain why the information submitted could not have been submitted earlier nor a statement provided by the patent owner as to why the submitted information (citations identified in the copending litigation) renders at least one claim unpatentable. The patent owner also failed to provide an amendment to such claims along with an explanation as to how the amendment renders such claims patentable in light of the submitted prior art as applicable to the confirmed claims in the '615 reexamination proceeding. Further, patent owner does not explain in the instant petition how the references were "inadvertently" omitted from submission in the present proceeding, for the entirety of the delay. In regards to providing a factual accounting to explain why the information could not have been submitted earlier, the petitioner/patent owner only indicates that it determined on or about October 11, 2011, that the references were "inadvertently" omitted from submission. This is not a full and proper factual accounting in accordance with MPEP 2256 guidance as to why the references could not have been submitted sooner. The inadvertent omission realization of October 11, 2011 is an insufficient factual accounting for the entirety of the delay.

Namely patent owner failed to provide a factual accounting from when notice of the information arose in copending litigation, where the information was identified in the defendant's invalidity contentions, until the submission of the IDS on October 19, 2011. It is presumed that patent

owner knew of the existence of the references as early as the date of the defendant's invalidity contentions, which presumably is prior to the issuance of the September 29, 2011 NIRC.

Without a detailed and meaningful factual accounting for the entire time period of delay in the IDS submission, it is unclear as to why there would be any delay in submitting the references pre-NIRC in addition to the twenty day delay from September 29, 2011 NIRC issuance until Office receipt of the IDS submission in the '615 proceeding. Accordingly, patent owner has failed to satisfy the factual accounting requirement in MPEP 2256 for submission of a post NIRC IDS. It is noted that patent owner states in the present petition that the complete listing of the documents identified by the defendant in the copending litigation is attached thereto as Appendix A; however, such an appendix (which does not affect the present evaluation of the factual accounting requirement) was not found to be included in the instant petition.

In regards to providing an unequivocal statement as required in MPEP 2256 as to why the art submitted makes at least one claim unpatentable, the patent owner requests for waiver of this unequivocal statement requirement. This request for waiver is treated as a request to waive the requirements of MPEP 2256 to permit entry and consideration of an IDS submitted after NIRC in the '615 proceeding. Patent owner argues that this requirement be waived for "at least the reason that it has no independent basis to believe any of the listed documents makes at least one claim unpatentable." This argument constitutes an admission on the record that the information does not render at least one claim unpatentable, and therefore, the relevance requirements for entry of an IDS after NIRC are not satisfied.

In response to patent owner's argument that because the requirements cannot be satisfied - they should be waived, no authority exists for a right of entry and consideration of any post NIRC submission in a reexamination proceeding, and there is no equity for waiver to enter the information, as such would delay the proceeding contrary to the statutory requirement for the Office to use special dispatch in reexamination. Moreover, patent owner can always file a further request for reexamination, if a such is needed and appropriate to resolve issues raising a substantial new question of patentability as to the information. Stated another way, no rule exists that requires entry of and IDS submission after NIRC in a reexamination proceeding. The rules that govern patent owner's duty of disclosure, 37 CFR 1.555, and the rules that govern IDS submissions, 37 CFR 1.97, do not give patent owner an unbridled right of entry of IDS submissions. The statutes that govern *ex parte* reexamination provide the Office with a statutory mandate of special dispatch. Patent owner's argument in support of waiver of the unequivocal statement requirement is not an equitable basis to waive the requirements of MPEP 2256 to deter special dispatch and is not an extraordinary circumstance upon which relief could be granted.

Accordingly, the present petition does not satisfy the conditions for consideration of an IDS after the proceeding had entered the printing cycle, and will not be granted in contravention of the statutory mandate for special dispatch. Accordingly, the patent owner's request with regard to entry and consideration of the October 19, 2011 IDS is dismissed.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial new question of patentability as to at least one claim of the patent *different* from that raised in this proceeding, as the Office may not permit entry and consideration of these references in the '615 proceeding, the patent owner can always file a new request for reexamination for consideration of such reference(s).

The IDS submitted by the patent owner will be placed in the file, and will remain of record. However, since prosecution has been terminated, and the proceeding 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.

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 Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

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

December 19, 2011

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. |
|---|---|---|---|---|
| 90/011,617 + 13/205,235 | 04/01/2011 | Allan S. Richardson | 707846 | 8508 |

13897 7590 10/05/2011

Abel Law Group, LLP
7300 FM 2222
Bldg 1, Ste 210
Austin, TX 78730

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 10/05/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LEYDIG VOIT & MAYER, LTD, TWO PRUDENTIAL PLAZA
180 NORTH STETSON AVENUE
SUITE 1900
CHICAGO, IL 60601-6731

Date: 10-5-11

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011617 + 13/206235
PATENT NO. : 6050348
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

OCT 05 2011

CENTRAL REEXAMINATION UNIT

Abel Law Group, LLP
7300 FM 2222
Bldg 1, Ste 210
Austin, Texas 78730

(For Patent Owner)

John B. Conklin
Leydig Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6731

(For Requester)

*In re* Richardson *et al.*
Reissue Application
Application No.: 13/206,235
Filed: August 9, 2011
For: U.S. Patent No. 6,050,348

*In re* Richardson *et al.*
Reexamination Proceeding
Control No. 90/011,617
Filed: April 1, 2011
For: U.S. Patent No. 6,050,348

**DECISION MERGING REISSUE AND REEXAMINATION PROCEEDINGS**

This is a decision on patent owner's August 9, 2011 petition under 37 CFR 1.182 to merge reissue application No. 13/206,235 with reexamination proceeding number No. 90/011,617, filed in reexamination proceeding No. 90/011,617.[1]

The patent owner petition is before the Office of Patent Legal Administration.

The petition is granted,

Reissue application No. 13/206,235 and reexamination proceeding No. 90/011,617 **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.

[1]It is noted that the present petition requests merger of the 90/011,617 reexamination proceeding with a reissue application filed on August 9, 2011 for U.S. Patent No. 6,050,348. To date, the only reissue application filed for U.S. Patent No. 6, 050, 348 is reissue application No. 13/206,235, filed on August 9, 2011. Therefore, the reissue application referenced in the present petition is taken to be reissue application No. 13/206,235.

## FEES

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was processed on September 28, 2011.

## BACKGROUND

1. On April 18, 2000, United States Patent No. 6,050,348 ("the '348 patent") issued to Richardson *et al.*, with claims 1-6.

2. On April 1, 2011, a request for *ex parte* reexamination of claims 1-6 of the '348 patent was filed by a third party requester, which request was assigned Reexamination Control No. 90/011,617 ("the '617 proceeding").

3. On June 6, 2011, the Office mailed an order granting *ex parte* reexamination of claims 1-6 in the '617 proceeding.

4. On August 9, 2011, patent owner filed a reissue application for the '348 patent, which application was assigned application number 13/206,235 ("the '235 reissue application"). The reissue application included a preliminary amendment in which new claims 7-33 were added.

5. Concurrently with the filing of the reissue application, patent owner filed in the '617 proceeding a petition paper entitled "PETITION UNDER 37 CFR 1.182 TO MERGE REEXAMINATION 90/011,617 WITH REISSUE APPLICATION FILED AUGUST 9, 2011."

6. On August 17, 2011, the Office mailed a non-final Office action in the '617 proceeding, rejecting claims 1-6 of the '348 patent.

7. On September 6, 2011, a notice of the filing of the '235 reissue application was published in the *Official Gazette*.

8. An Office action on the merits has not been issued in the '235 reissue application.

## CLAIMS OF RECORD

A review of the prosecution history for the '617 reexamination proceeding reveals original patent claims 1-6 remain unamended. Thus, claims 1-6 are pending in the '617 proceeding.

A review of the '235 reissue application file reveals that new claims 7-33 have been added. Thus, claims 1-33 are pending in the '235 reissue application.

The claims of the '235 reissue application and the claims of the '617 reexamination proceeding are not identical.

## RELEVANT AUTHORITY

35 U.S.C. § 305 provides, in part:

> All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.565(d) provides, in part:

> If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings.

MPEP § 2285 provides, in part:

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both proceedings to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Accordingly, if both a reissue application and an *ex parte* reexamination proceeding are pending concurrently on a patent, a decision will normally be made (A) to merge the two proceedings or (B) to stay one of the two proceedings. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP § 2285(V) provides, in part:

> The patent owner may file a petition under 37 CFR 1.182 to merge the reissue application and the reexamination proceeding, or stay one of them because of the other, at the time the patent owner's statement under 37 CFR 1.530 is filed or subsequent thereto in the event the Office has not acted prior to that date to merge or stay.

## PATENT OWNER'S REQUEST UNDER 37 CFR 1.182 FOR MERGER

In its August 9, 2011 petition under 37 CFR 1.182 filed in the '617 reexamination proceeding, patent owner requests merger of the '617 reexamination proceeding and the '235 reissue application (proceeding).[2]

---

[2] Petition at page 2.

## DECISION

The '235 reissue application (proceeding) and the '617 reexamination proceeding are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.525 for the '617 reexamination proceeding, and the '235 reissue application has been announced in the *Official Gazette*. Accordingly, consideration of patent owner's August 9, 2011 petition under 37 CFR 1.182 for merger of the '235 reissue application and the '617 reexamination proceeding is appropriate at this time.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, and at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. 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 or not to merge the two 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 present reexamination proceeding and the '235 reissue application be merged and a joint examination be conducted.

Accordingly, patent owner's instant request under 37 CFR 1.182 for merger of the '235 reissue application and the '617 reexamination proceeding is **granted**. The examination of the '235 reissue application and the '617 reexamination proceeding will be merged as set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) is discretionary. The present merger is not an assurance that, in a future similar situation, a request for merger would be granted. 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, a request for continued examination (RCE) is not available in the '617 reexamination proceeding, and any response to the outstanding Office action (e.g., response to a final Office action) 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 the event of termination, a Notice of Intent to Issue a Reexamination Certificate will be issued cancelling all of the claims not found patentable, followed by publication of the Certificate.

### I. Merger of Proceedings

The '235 reissue application and the '617 reexamination proceeding 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

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. Patent owner's August 9, 2011 petition under 37 CFR 1.182 to merge reissue application No. 13/206,235 with reexamination proceeding number No. 90/011,617, filed in reexamination proceeding No. 90/011,617, is **granted**.

2. Reissue application No. 13/206,235 and reexamination control No. 90/011,617 **are merged** into a single proceeding.

3. 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.

4. 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.

5. **If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed.** Patent owner is put on notice that in such event, any response to the outstanding Office action (e.g., response to a final rejection) at that stage must be made based upon the fact that a request for continued examination (RCE) is not available in reexamination. Any failure to timely respond would result in the termination of the prosecution pursuant to per 37 CFR 1.550(d)

6. The present merged proceeding of the 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 '348 patent (e.g., by preparing/signing an action). See: MPEP 2236. The examiner should not issue an Office action for the present merged proceeding 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 housekeeping amendment.

7. Patent owner is reminded to serve any responses on the requester.

8. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.

9. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

P. M. Laufer

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

October 4, 2011

1. The patent owner is required to maintain identical amendments in the reissue application and the 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 file for reexamination control No. 90/011,617 shows the presence of the following live claims: original patent claims 1-6.

3. A review of reissue application No. 13/206,235 shows that original patent claims 1-6 of the '348 patent are present and that new claims 7-33 have been added.

**Accordingly, the claims 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. 13/206,235 and Control Number 90/011,617. 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 '235 reissue 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) should 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 proceeding. Each action will contain identifying data *for both of the 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 the two files, with each of the two bearing a signature. Any such response must contain identifying data *for both of the cases*, i.e, the reissue application and the reexamination proceeding. *Any such responses 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 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

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. |
|---|---|---|---|---|
| 90/011,618 | 04/29/2011 | Robert Scott Nieboer | 4672/858 | 8648 |

7590 07/08/2011

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/08/2011

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60610

Date:

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011618
PATENT NO. : 6418419
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

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. |
|---|---|---|---|---|
| 90/011,603 | 03/28/2011 | 6,418,419 | 006119.00211 | 7725 |

7590 07/08/2011

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 07/08/2011

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BANNER & WITCOFF, LTD
ATTORNEYS FOR CLIENT NO. 00619
10 SOUTH WACKER DRIVE, SUITE 3000
CHICAGO, IL 60606

Date:

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011603
PATENT NO. : 6418419
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

ANTHONY LAWS BIRCH
6915 BARRETT LANE
BETHESDA, MD 20814

(For Patent Owner)

BANNER & WITCOFF, LTD.
ATTORNEY'S FOR CLIENT NO. 006119
10 SOUTH WACKER DRIVE SUITE 3000
CHICAGO, IL 60606

(For Third Party Requester)

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

(For Third Party Requester)

*In re* NIEBOER *et alia*
Reexamination Proceeding
Control No. 90/011,603
Request Deposited: March 28, 2011
For: U.S. Patent No. 6,418,419

*In re* NIEBOER *et alia*
Reexamination Proceeding
Control No. 90/011,618
Request Deposited: April 2, 2011
For: U.S. Patent No. 6,418,419

: 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. 6,418,419 (hereinafter, the '419 patent), issued to NIEBOER *et alia*, on July 9, 2002.

2. On March 28, 2011, a third party deposited a Request for *Ex Parte* Reexamination of the '419 patent. The reexamination proceeding was assigned Control No. 90/011,603 (hereinafter, the '11603 proceeding).

3. On April 2, 2011, a third party deposited a Request for *Ex Parte* Reexamination of the '419 patent. The reexamination proceeding was assigned Control No. 90/011,618 (hereinafter, the '11618 proceeding).

4. The Reexamination Order was granted in the '11603 proceeding on June 21, 2011.

5. The Reexamination Order was granted in the '11618 proceeding on June 21, 2011.

6. There are currently no amendments in either 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 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 90/011,603 and 90/011,618 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. 90/011,603 and 90/011,618 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/
J. Harrison, SPE AU 3992
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

John B. Conklin
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, IL 60601-6780

For Patent Owner

MAILED

JUL 26 2011

CENTRAL REEXAMINATION UNIT

*Ex Parte* Reexamination Proceeding
Control No. 90/011,629
Filed: May 5, 2011
For: U.S. Patent No. 5,416,706

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the "Petition to Make Special Based on Age for Advancement of Examination Under 37 CFR 1.102(c)(1) filed May 6, 2011.

The petition is unnecessary and is dismissed as being moot.

35 USC 305 mandates that all reexamination proceedings be conducted with "special dispatch" within the Office. In view of this requirement for "special dispatch," reexamination proceedings will be "special" throughout their pendency in the Office. See MPEP § 2261. Further, section 708.01 of the MPEP, under the listing of special cases lists at (J) reexamination proceedings.

Thus as statute and policy already dictate that reexamination proceedings be handled with "special dispatch", the filing of a petition to make special under 37 CFR 1.102(c)(1) is unnecessary and the petition is hereby dismissed as being moot.

Any questions concerning 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, SPE
Central Reexamination Unit 3993

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

VOLPE AND KOENIG, P.C. : (For Patent Owner)
UNITED PLAZA :
30 SOUTH 17TH STREET :
PHILADELPHIA PA 19103 :

MAILED

JUL 22 2011

CENTRAL REEXAMINATION UNIT

Jiawei Huang :
J. C. Patents : (For Third Party
4 Venture, Suite 250 : Requester)
Irvine, CA 92618 :

THOMAS, KAYDEN, HORSTEMEYER : (For Third party
& RISLEY, LLP : Requester)
400 INTERSTATE NORTH PARKWAY SE:
SUITE 1500 :
ATLANTA, GA 30339 :

*In re*: Haas : DECISION
*Ex Parte* Reexamination Proceeding : *SUA SPONTE*
Control No. 90/011,032 : MERGING
Deposited : 14 June 2010 : PROCEEDINGS
For: US Patent No. 5,375,006 : [37 CFR § 1.565(c)]
:
*In re*: Haas :
*Ex Parte* Reexamination Proceeding :
Control No. 90/011,648 :
Deposited : 18 April 2011 :
For: US Patent No. 5,375,006 :

This is a decision merging *sua sponte*, the above identified proceedings pursuant to 37 CFR § 1.565(c).

Copied from 90011032 on 08/11/2011

# BACKGROUND

1. On 20 December 1994 US Patent No. 5,375,006 was granted to Haas.

2. On 14 June 2010 a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,032.

3. On 16 July 2010 the Order was granted for *ex parte* reexamination in control number 90/011,032.

4. On 27 October 2010 a non-final Office action was mailed in 90/011,032.

5. On 16 February 2011 an amendment and remarks were received in 90/011,032.

6. On 18 April 2011 a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,648.

7. On 07 June 2011 the Order was granted for *ex parte* reexamination in control number 90/011,648.

8. There are no amendments to the claims in control number 90/011,648.

# 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.

Copied from 90011032 on 08/11/2011

## DECISION

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the control nos. 90/011,032 & 90/011,648 *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. 90/011,032 & 90/011,648 *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:

Copied from 90011032 on 08/11/2011

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; 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

Copied from 90011032 on 08/11/2011

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. |
|---|---|---|---|---|
| 90/011,650 + 90011436 | 04/19/2011 | 6253075 | 51020-032USRX2 | 1811 |

42532 7590 06/22/2011

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 06/22/2011

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

Date:

MAILED

6-22-11

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011650 + 90011436
PATENT NO. : 6253075
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

JUN 22 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

(For Third Party Requester)

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

(For Third Party Requester)

THE MARBURY LAW GROUP, PLLC
11800 SUNRISE VALLEY DRIVE
SUITE 1000
RESTON, VA 20191

*In re* Beghtol *et alia*
Reexamination Proceeding
Control No. 90/011,436
Request Deposited: January 14, 2011
For: U.S. Patent No. 6,253,075

*In re* Beghtol *et alia*
Reexamination Proceeding
Control No. 90/011,650
Request Deposited: April 19, 2011
For: U.S. Patent No. 6,253,075

: DECISION *SUA SPONTE*
: MERGING
: REEXAMINATION
: PROCEEDINGS

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. 6,253,075 (hereinafter, the '075 patent), issued to Beghtol *et alia*, on June 26, 2001.

2. On January 14, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '075 patent. The reexamination proceeding was assigned Control No. 90/011,436 (hereinafter, the '11436 proceeding).

3. The Reexamination Order was granted in the '11436 proceeding on March 24, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-15.

4. A non-final office action was mailed on March 24, 2011 in the '11436 proceeding.

5. On May 24, 2011, Patent Owner responded to the office action in the '11436 proceeding and canceled claims 1-4 and amended claims 10, 13, and 15 (and claims dependent thereon).

6. On April 19, 2011, a third party requester deposited a Request for *Ex Parte* Reexamination of the '075 patent. The reexamination proceeding was assigned Control No. 90/011,650 (hereinafter, the '11650 proceeding).

7. The Reexamination Order was granted in the '11650 proceeding on April 21, 2011 finding a substantial new question of patentability (SNQP) as to claims 1-15.

8. Patent Owner waived their right to a file a Patent Owner statement.

## 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 '11436, and '11650 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 '11436 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. 90/011,436 and 90/011,650 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
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. |
|---|---|---|---|---|
| 90/011,665 | 05/10/2011 | 7897372 | 380530US59RX | 8249 |

22850 7590 04/13/2012

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/13/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Michael J. Twomey, Esq.
WILMERHALE/BOSTON
60 State Street
Boston, MA 02109

Date:

MAILED

APR 13 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011665
PATENT NO. : 7897372
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.: 90/011,665 |
|---|---|

MAILED

APR 13 2012

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED April 11, 2012.

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(c) – 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. TIME REQUESTED
   The amount of time requested is 1 month. This would be the second extension of time to respond to the Office action. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. See MPEP 2265 and 2665

4. FORMAL MATTERS
   Patent owner petitioner requests that the period for response be extended by the amount of time stated above for responding to the Office action mailed on January 18, 2012, which sets a 2 month period for filing a response thereto. A previous extension of time was granted for one month, which had set a response date of April 18, 2012.

   - 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.

5. DECISION (See MPEP 2265 and 2665)
   - A. ☐ Granted or ☒ Granted-in-part for 2 weeks, because petitioner properly provided a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory time period and petitioner explained why, in spite of the action taken thus far, the requested additional time is needed.
     - ☐ 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 petition is moot.
     - v. ☐ Other/comment: _____.

6. CONCLUSION: **The response to the Office Action is due on or before May 2, 2012.**

   Telephone inquiries with regard to this decision should be directed to Stephen Stein at 571-272-1544, in the Central Reexamination Unit.

| /Stephen J. Stein/ | SPE, AU-3991 |
|---|---|
| [*Signature*] | (Title) |

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. |
|---|---|---|---|---|
| 90/011,667 | 05/03/2011 | Rudolf Edgar FALK | 044252.021540 | 1097 |

30734 7590 12/21/2011

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ARENT FOX PLLC
1050 CONNECTICUT AVENUE, NW
WASHINGTON, DC 200036

Date: **MAILED**

DEC 2 1 2011

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011667
PATENT NO. : 5914322
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)).

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 gov

BAKER & HOSTETLER, LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

(Patent Owner)

**MAILED**

DEC 2 1 2011

**CENTRAL REEXAMINATION UNIT**

ARENT FOX, PLLC
1050 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

(Third Party Requester)

*In re* Falk *et al.*
Reexamination Proceeding
Control No.: 90/011,667
Filed: May 3, 2011
For: U.S. Patent No. 5,914,322

: **DECISION**
: **ON PETITION**
: **UNDER 37 CFR 1.182**

This is a decision on the October 12, 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 October 12, 2011, has not been entered for consideration by the examiner.**

## BACKGROUND

1. On June 22, 1999, the Office issued U.S. Patent No. 5,914,322, to Falk *et al.* (the '322 patent).

2. On May 3, 2011, a third party requester filed a request for *ex parte* reexamination of the '322 patent. The request was assigned reexamination proceeding control number 90/011,667 (the '667 proceeding).

3. On June 30, 2011, the Office issued an order granting reexamination for the '667 reexamination proceeding.

4. On October 4, 2011, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) for the '667 proceeding.

5. On October 12, 2011, patent owner filed the instant petition accompanied by an IDS, for which patent owner requests consideration by the Office.

6. On October 20, 2011, the '667 proceeding entered the printing cycle and was designated 452 status.

7. On November 29, 2011, the reexamination proceeding was concluded by the issuance and publication of *Ex Parte* Reexamination Certificate (8702nd), US 5,914,322 C1.

## DECISION

The present reexamination proceeding has concluded with the issuance of *Ex Parte* Reexamination Certificate (8702nd), US 5,914,322 C1. As of the issuance of the certificate, the Office was divested of jurisdiction over the '322 patent. Therefore, consideration by the examiner of the proffered information 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 October 4, 2011, and the proceeding has now resulted in issuance of *Ex Parte* Reexamination Certificate (8702nd), thereby divesting the Office of jurisdiction over the '322 patent. However, even had the petition been addressed prior to issuance of the certificate, the October 12, 2011 IDS would not have had an entry right. A discussion follows.

The October 12, 2011 IDS was submitted before the proceeding had entered the printing cycle. While there is no regulatory provision for withdrawal of a reexamination proceeding from the publication process for consideration of an IDS, the policy for withdrawal from the publication process, after the NIRC has been mailed but before the proceeding has actually entered the printing cycle, is explicitly set forth in MPEP 2256 as follows:

> ...Once the NIRC has been mailed, the reexamination proceeding must proceed to publication of the Reexamination Certificate as soon as possible. Thus, when the patent owner provides a submission of patents and printed publications, or other information described in 37 CFR 1.98(a), after the NIRC has been mailed, the submission must be accompanied by **(A) a factual accounting providing a sufficient explanation of why the information submitted could not have been submitted earlier, and (B) an explanation of the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.** This is provided via a petition under 37 CFR 1.182 (with petition fee) for entry and consideration of the information submitted after NIRC. The requirement in item (B) above is for the purpose of facilitating the Office's compliance with the statutory requirement for "special dispatch," when the requirement in item (A) above is satisfied to provide a basis for interrupting the proceeding after the NIRC.

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. In the present instance, the submission fails to satisfy both items (A) and (B), because there is not a full ***factual accounting*** to explain why the information submitted could not have been submitted earlier or an ***explanation of the relevance*** of the information submitted with respect to the **claimed invention** in the reexamination proceeding. The instant petition was filed very late in

the reexamination proceeding, and no substantive attempt is made to satisfy the guidance of MPEP 2256.

In regards to providing a factual accounting (item (A) above) to explain why the information could not have been submitted earlier, the petitioner/patent owner only states that just prior to the issuance of the NIRC, patent owner was assembling the attached IDS for submission to the present proceeding but the NIRC unexpectedly issued before the attached IDS could be filed. This is not a full and proper factual accounting in accordance with MPEP 2256 guidance. The petition does not provide a factual accounting as to why the cited information could not have been submitted earlier. Patent owner has admitted in the instant petition that the documents cited in the attached IDS came to light in the course of the copending litigation that were identified in the defendant's invalidity contentions. Therefore, patent owner knew of the existence of the references as early as the date of the defendant's invalidity contentions, which presumably is prior to the issuance of the NIRC. Patent owner needed to provide a factual accounting from when notice of the information arose in copending litigation, where the information was identified in the defendant's invalidity contentions, until the submission of the IDS on October 12, 2011.

Therefore, without a detailed and meaningful factual accounting for the entire period of delay in the IDS submission, it is unclear as to why there would be any delay in submitting the references pre-NIRC in addition to the eight day delay from October 4, 2011 NIRC issuance until Office receipt of the IDS submission in the '667 proceeding. Accordingly, patent owner has failed to satisfy the MPEP 2256, item (A), requirement for submission of a post NIRC IDS.

In regards to explaining the relevance of the submitted information (item (B) above), the patent owner makes only a broad generalization about the content of the references, stating that the listed references are purportedly relevant to the claimed invention in the reexamination proceeding as these references were identified in the defendant's invalidity contentions in the copending litigation. Such a patent owner assertion does not constitute an explanation of the relevance with respect to the claimed invention. Instead, it amounts to no more than a broad characterization of the references un-tethered to the claimed invention and instead merely identifies the source of the documents. Therefore, the patent owner has failed to satisfy the MPEP 2256, item (B) requirement for submission of a post NIRC IDS filed before the proceeding has entered the printing cycle.

Patent owner has requested waiver of the unequivocal statement requirement in MPEP 2256, which requires patent owner to unequivocally explain why the art submitted makes at least one claim unpatentable. The unequivocal statement is required when the IDS is submitted after the proceeding is in the printing cycle. However, the October 12, 2011 IDS was submitted before the present proceeding entered the printing cycle on October 20, 2011. Therefore, an unequivocal statement was not required. Accordingly, the request for waiver of the unequivocal statement requirement in MPEP 2256 is dismissed.

In summary, patent owner does not make a full factual accounting providing a sufficient explanation of why the information could not have been submitted earlier nor does patent owner explain the relevance of the information submitted with respect to the claimed invention in the reexamination proceeding.

Thus, the present petition does not satisfy the conditions for consideration of an IDS filed after a NIRC issued in a proceeding but before the proceeding has entered the printing cycle, and would

not have been granted in contravention of the statutory mandate for special dispatch. Accordingly, the petition would have been dismissed as to the request for entry and consideration of the October 12, 2011 IDS papers.

If, however, the patent owner in fact believes that one or more references submitted raises a substantial new question of patentability as to at least one claim of the patent *different* from that raised in this proceeding, as the Office may not permit entry and consideration of these references in the '667 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, and the proceeding concluded, for this reexamination proceeding, the IDS will not be considered by the examiner.

## CONCLUSION

1. The petition is dismissed.

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 Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

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

December 19, 2011

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. |
|---|---|---|---|---|
| 90/011,670 | 05/05/2011 | 7923390 | MCTGS-004Xq700 | 5181 |

207 7590 11/29/2011

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/29/2011

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
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/001,721 | 08/22/2011 | 7,923,390 | SYC0008XA | 1718 |

207 7590 11/29/2011

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 11/29/2011

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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DINSMORE & SHOHL LLP
FIFTH THIRD CENTER
ONE SOUTH MAIN STREET SUITE 1300
DAYTON, OH 45402-2023

Date:
MAILED

NOV 29 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001721
PATENT NO. : 7923390
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Weingarten, Schurgin, Gagnebin & Lebovici LLP
Ten Post Office Square
Boston, MA 02109

(For Patent Owner)

**MAILED**

NOV 29 2011

**CENTRAL REEXAMINATION UNIT**

David R. Yohannan
Kelley, Drye & Warren LLP
3050 K Street NW, Suite 400
Washington, DC 20007

(For the '95/001,721 Requester)

In re Burke et al.
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,670
Filed: May 5, 2011
For: U.S. Patent No. 7,923,390 B2

In re Burke et al.
*Inter Partes* Reexamination Proceeding
Control No.: 95/001,721
Filed: August 22, 2011
For: U.S. Patent No.: 7,923,390 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. 90/011,670 and *inter partes* reexamination proceeding No. 95/001,721 **are merged** into a single proceeding.

## BACKGROUND

1. On April 12, 2011, United States Patent Number 7,923,390 B2 ("the '390 patent") issued to Burke et al. with 28 claims.

2. On May 5, 2011, patent owner filed a request for *ex parte* reexamination of claims 1-28 of the '390 patent and was assigned control number 90/011,670 ("the '670 proceeding").

3. On June 16, 2011, *ex parte* reexamination of claims 1-28 of the '390 patent was granted in the '670 reexamination proceeding. No patent owner statement has been filed in the '670 reexamination proceeding, and the time for filing such a statement has expired.

4. On August 22, 2011, a request for *inter partes* reexamination of claims 1 and 14 of the '390 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,721 ("the '721 proceeding"). The request identified Syscom Advanced Materials as the real party in interest.

5. On November 18, 2011, *inter partes* reexamination of claims 1 and 14 of the '390 patent was granted in the '721 proceeding.

6. To date, no Office action has issued in either of the two proceedings.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '670 proceeding) is an *ex parte* proceeding. The other proceeding (the '721 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. 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 90/011,670 and 95/001,721 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

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

### 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).[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.

#### 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. 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 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.

---

[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.

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.

It is to be noted that, because the '721 *inter partes* third party requester did not propose any rejections of claims 2-13, and 15-28 in its request for reexamination, the '721 requester has no appeal rights as to those claims as they appear in the '390 patent.

**C. Papers mailed/filed:**

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

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

| | |
|---|---|
| by Mail to: | Attn: Mail Stop "*Inter Partes* Reexam"<br>Central Reexamination Unit<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| by FAX to: | (571) 273-9900<br>Central Reexamination Unit |
| by Hand to: | Customer Service Window<br>Attn: Central Reexamination Unit<br>Randolph Building, Lobby Level<br>401 Dulany Street<br>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 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, 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 requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The *inter partes* requester must identify each rejection *that was previously proposed by the inter partes 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* requester intends to contest. No new ground of rejection can be proposed by the *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 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* requester can challenge in the appellant brief.

## CONCLUSION

1. *Ex parte* Reexamination Control No. 90/011,670 and *inter partes* Reexamination Control No. 95/001,721 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Any questions concerning this communication should be directed to 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
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. |
|---|---|---|---|---|
| 90/011,674 | 05/06/2011 | 7,523,063 | 8053-17-1 (233262) | 6953 |

23117 7590 04/04/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/04/2012

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


Copied from 95000244 on 04/10/2012

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
MARK D. PASSLER
AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

Date:

MAILED

APR 04 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011674
PATENT NO. : 7523063
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)).

---

Copied from 95000244 on 04/10/2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIXON & VANDERHYE, PC
901 North Glebe Road, 11th Floor
Arlington, VA 22203

(For Patent Owner)

MAILED

APR 04 2012

CENTRAL REEXAMINATION UNIT

MARK D. PASSLER
AKERMANN SENTERFITT
P.O. BOX 3188
West Palm Beach, FL 33402-3188

(For Third Party Requester)

*In re:* Harrington *et al.*
*Ex Parte* Reexamination Proceeding
Control No.: 90/011,674
For: U.S. Patent No.: 7,523,063

DECISION ON PETITION

This is a decision on a petition filed by the Third Party Requester "petitioner" on July 29, 2011, entitled "PETITION TO THE DIRECTOR UNDER 37 CFR §§1.181 and 1.515(c) FOR REVIEW OF ORDER DENYING REQUEST FOR EX PARTE REEXAMINATION". Petitioner seeks review of the Order Denying the Request for *ex parte* Reexamination mailed June 29, 2011, which denied the request for reexamination of claims 1-46 and 51-54 of U.S. Patent 7,523,063. The petition was timely filed. No fee is required.

The petition is before the Director of the Central Reexamination Unit (CRU) for decision.

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

Copied from 95000244 on 04/10/2012

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,523,063 (hereinafter, the '063 patent) issued on April 21, 2009.
- On April 21, 2010 a first request for *ex parte* reexamination of the '063 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/010,937 (hereinafter, the '10,937 proceeding). This reexamination proceeding concluded with the issuance of a reexamination certificate on June 28, 2011.
- On May 6, 2011, the instant request for *ex* parte reexamination of the '063 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 90/011,674 (hereinafter the '11,674 proceeding).
- An order denying the request for *ex parte* reexamination in the '11,674 proceeding was mailed on June 29, 2011.
- On July 29, 2011, the present petition was filed.

## DISCUSSION

Petitioner in the '11,674 proceeding has petitioned seeking relief from the Examiner's June 29, 2011 Order denying *ex parte* reexamination for all requested claims.

### I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1-46 and 51-54 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

> A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

Copied from 95000244 on 04/10/2012

37 CFR § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable."

MPEP § 2242(I) provides, in pertinent part:

Where a second or subsequent request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under 37 CFR 1.530(d) in the ongoing pending reexamination proceeding. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Once the second or subsequent request has provided a "different" substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. The information directed to a proposed new or amended claim in the pending reexamination is addressed during the later filed reexamination (where a substantial new question is raised in the later reexamination for the existing claims in the patent), in order to permit examination of the entire patent package. When a proper basis for the subsequent reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the

Copied from 95000244 on 04/10/2012

certificate. This also prevents a patent owner from simply amending all the claims in some nominal fashion to preclude a subsequent reexamination request during the pendency of the reexamination proceeding.

MPEP § 2242(II)(A) provides, in pertinent part:

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 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 substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability 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 examination(s), in view of a material new argument or interpretation presented in the request.

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*. Each decision by the CRU Director will conclude with the paragraph:

> This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

If the petition is granted, the decision of the CRU Director should include a sentence setting a 2-month period for filing a statement under 37 CFR 1.530, the reexamination file will then be returned to the CRU Supervisory Patent Examiner (SPE) of the art unit that will handle the reexamination for consideration of reassignment to another examiner.

Copied from 95000244 on 04/10/2012

## II. Summary of Patent Prosecution History and Reexamination History of the '063 Patent

*Patent Prosecution History (10/613,319)*

The '063 patent issued on April 21, 2009 to Harrington *et al.* The relevant prosecution of the '063 patent proceeded as follows.

In response to the first office action mailed on February 8, 2007 and the interview held on June 28, 2007, the applicant canceled claims 1-188 and added new claims 189-241. The applicant subsequently filed a supplemental amendment and added new claims 242-244. The examiner subsequently issued a second office action on October 31, 2007 which, among other rejections, rejected the claims over Ausubel, Liederman and various secondary teaching references. On December 12, 2007 an interview was held in which the new matter rejections under 35 U.S.C. §§ 112 and 132 were discussed. The Applicant responded by amending the claims in order to attempt to overcome the rejections. In addition, the Applicant submitted a Rule 131 Declaration in an attempt to establish conception before Ausubel's filing date.

In response to the Applicant's response, a Notice of Allowance was mailed on May 21, 2008. The Notice of Allowance amended claims 189, 246 and 247, via examiner's amendment, by adding "displaying the official auction time", "fourth instructions that, when executed, display the official auction time" and "means for displaying the official auction time" respectively. The reasons for allowance indicated that the rejection over Ausubel was overcome based on the Rule 131 Declaration. The reasons for allowance also noted:

> Fisher, Liederman and Zandi or any combination thereof fail to teach:
> - Displaying the official auction time including time remaining.
> - Auction of interest-bearing financial instrument.
> - Requiring auction software on each computer.
> - Wherein a bid improvement is made by submitting a lower bid where the lowest bid is the best bid.
> - Modification of bids without submitting them.
> - Displaying the rank over of bids.
> - Bidder inputs an interest rate and price combination.
> - Bidder inputs and a maturity date.

On July 21, 2008, a petition to withdraw from issue was filed and was subsequently granted.

On July 31, 2008, a non-final office action was mailed and rejected various claims over Parity Reference Manual, Landes Letter and other secondary teaching references. On September 3, 2008 an interview was held in which a court decision of the Parity System was discussed. On

Copied from 95000244 on 04/10/2012

October 21, 2008, the applicant submitted a response and amendment which amended the independent claims to recite *inter alia* "providing a centralized time indication" as opposed to "displaying the official time" as previously claimed. Other dependent claims were also amendment and several claims were canceled. New claims 248-259 were also added.

On February 12, 2009 a Notice of Allowance was mailed. No comments regarding the Parity Reference Manual were noted in the Notice of Allowance. The following reasons for allowance were also noted.

Fisher, Liederman and Zandi or any combination thereof fail to teach:

- Displaying the official auction time including time remaining.
- Providing a centralized time indication and transmitting said time indication to a bidder's computer over an electronic network, displaying including displaying a transmitted time indication on the bidder's compute' display.
- Auction of interest-bearing financial instrument.
- Requiring auction software on each computer.
- Wherein a bid improvement is made by submitting a lower bid where the lowest bid is the best bid.
- Modification of bids without submitting them.
- Displaying the rank over of bids.
- Ranking the interest cost values, and displaying the interest cost values in an order determined by a ranking.
- Bidder inputs an interest rate and price combination.
- Bidder inputs a maturity date.

*Pertinent Prosecution History of '10,937 proceeding*

On April 21, 2010, an *ex parte* request for reexamination was deposited by a Third Party Requester requesting reexamination of claims 1-54 of the '063 patent.

On July 8, 2010, *ex parte* reexamination of claims 1-54 was ordered because, *inter alia* Ausubel '383, Banatre 1 and II and other prior are references presented a Substantial New Question of Patentability ("SNQ").

On November 19, 2010 a non-final office action was mailed and on December 17, 2010 an interview was held. In response, the Patent Owner submitted a declaration of Professor Lawrence M. Ausubel and claims 47 and 49 were also amended. On February 8, 2011 a final office action was mailed and on March 15, 2011 an interview was held. In response to the final office action and interview the Patent Owner canceled claims 47-50. On April 12, 2011 a Notice of Intent to Issue Reexamination Certificate was mailed.

Copied from 95000244 on 04/10/2012

In the reasons for patentability the examiner noted that in view of the prosecution history, as well as MPEP 2258, the terminology "providing a centralized time indication" is now interpreted to require providing a centralized time indication of the current official auction clock time, i.e. a built-in official auction clock that shows current centralized official auction clock time, allowing the user to keep track of how much time remains before the auction ends.

I. *De Novo* Review of the Request for Reexamination - Findings and Analysis

In accordance with the requirements of the reexamination statue and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A *de novo* determination has been made as to whether the May 6, 2011 request for *ex parte* reexamination raises at least one SNQ. This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

Asserted SNQ over Godin et al. Issue

As stated previously, the key limitation that was deemed lacking in the previous reexamination was "providing a centralized time indication of the current official auction clock time, i.e. a built-in official auction clock that shows current centralized official auction clock time". At Request pages 11-12 the third party alleges Godin shows this feature in various ways.

Among other things, a cited excerpt from Godin explains with respect to Figure 10, "[t]his screen includes a large product image 130, a brief product description shown as 132 and a detailed product description shown as 134." *Id.*, col 6, lines 21-24. "This portion of the screen is relatively constant during the auction process." *Id.*, col. 6, lines 24-25.

As noted in the Request, Godin provides not just one, but two time indications. First, as depicted in Figure 10, the date and time are prominently depicted near the top of the screen. As stated in the specification of Godin, "[i]n addition, there is the time and date at 136." *Id.*, col. 6, lines 25-26. Furthermore, Figure 10 depicts Godin's "Time Left 146" indication. *Id.*, Figure 10. "The last column 146 identifies the time remaining in the auction as being two minutes." *Id.*, col. 6, lines 33-35. Godin specifically discloses "continually updating, to each browser remaining in the auction, the current price, the quantity of the product remaining available for purchase taking into account the product indicated as purchased, and the time remaining in the auction to provide dynamic feedback to each browser." *Id.*, col. 9, lines 59-64. Further, "[t]he number of units left, the current price and the time left in the auction are frequently updated and in the last few minutes of the auction are updated at five second intervals." *Id.*, col. 6, lines 37-39.

Copied from 95000244 on 04/10/2012

Godin's teachings regarding time and date of the auction clock time which allows a user to keep track of how much time remains before the auction ends would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to the distinguishing features of the claims of the '063 patent.

The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reasons to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party statements of reasons to combine the references, show the combination of the Applied Art[1] in view of Godin would have been important to a reasonable examiner in determining patentability. Accordingly, for at least this reason, Godin raises a SNQ over the requested claims and thus, this proposal is **granted**.

Asserted SNQ over Handelman Issue

Handelman was previously cited in the Request for the '10,937 proceeding. As set forth at page 46 the '10,937 Request asserted that "Handelman '450 disclose providing a centralized time indication. Handelman '450, col. 26, lines 13-15. The Handelman system can provide "a continuous indication of the time remaining until termination of sale pricing or an auction on the screen." *Id.*

The instant '11,674 *ex parte* Request likewise asserts at page 13 that Handelman discloses providing a time indication and "[a] continuous indication of the time remaining until terminal of sale pricing or an auction may be provided on the screen, as shown in FIG. 34."

Additionally it was noted in the Request that Figure 34 of Handelman illustrates the time remaining indication in the upper right hand corner of the display screen. Specifically, as shown above, Figure 34 of Handelman depicts a "Time to End of Sale/Auction : 00 : 52 : 21." *Id.* Similarly, Figure 35 depicts a "Time to Bet : 00 ; 02: 53," and Figure 36 depicts a "Time to Lottery : 00 : 15 : 22." *Id.*, Figures 35 and 36. Thus, Handelman depicts the time remaining in the auction or other sale down to the second.

It is noted that the citations to Handelman are not presented in a different way or in new light since the same teachings relied upon in the instant Request were likewise relied upon in the previous '10,937 reexamination for establishing a substantial new question.

[1] The "Applied Art" references is comprised of the cited Ausubel '383, Fisher, van Hoff, Brown and Banatre II references and the Admissions of the Applicants/Patent Owner made during the prosecution of the'063 Patent.

Copied from 95000244 on 04/10/2012

Both citations are directed to providing a continuous indication of the time remaining until termination.

As stated previously, in the reasons for allowance during the '10,937 proceeding, the examiner noted the terminology "providing a centralized time indication", is now interpreted to require providing a centralized time indication of the current official auction clock time, i.e. a built-in official auction clock that shows current centralized official auction clock time, allowing the user to keep track of how much time remains before the auction ends. Thus, a "continuous indication of the time remaining" only shows the timing remaining it does not show the current centralized official auction clock time.

Consequently, Handelman alone or in combination with the Applied Art does not present a SNQ in a new light, or in a different way, as compared to its use in the earlier examination (90/010,937) as to the claims of the '063 patent. Accordingly, this proposal is **denied.**

Asserted SNQ over Rockoff Issue

The portions of Rockoff cited in the Request do not present this "old art" in a new light. A substantial new question of patentability 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 examination, in view of material new argument or interpretation presented in the request.

Rockoff was previously cited in the '10,937 proceeding. As set forth in the '10,937 request at page 55, Rockoff describes the use of an "auction clock" which is deemed central to the auction. Rockoff, p. 12, left col. The "auction clock" displays the current offer price. *Id.* The clock progresses to the end of the auction at a rate of time controlled by the auctioneer. Rockoff, p. 13 left col. Thus, Rockoff describes the displaying of an "auction clock" that displays the current offer price and progresses to the end of the auction at a rate controlled by the auctioneer.

The '11,674 Request likewise asserts that Rockoff discloses an "auction clock" which indicates the time remaining before the auction ends by progressing to the end of the auction at a rate of time controlled centrally by the auctioneer.

The citations to Rockoff in the instant Request are not presented in new light or differently since the same citations and teachings relied upon in the instant Request were likewise relied upon in the previous '10,937 reexamination.

Furthermore, as stated previously, in the reasons for allowance during the '10,937 proceeding, the examiner noted the terminology "providing a centralized time

Copied from 95000244 on 04/10/2012

indication", is now interpreted to require providing a centralized time indication of the current official auction clock time, i.e. a built-in official auction clock that shows current centralized official auction clock time, allowing the user to keep track of how much time remains before the auction ends. The "auction clock" of Rockoff is used for indicating the remaining time before the auction ends and thus does not show "a built-in official auction clock that shows the current centralized official auction clock time".

Consequently, Rockoff alone or in combination with the Applied Art does not present a SNQ in a new light, or in a different way, as compared to its use in the earlier examination (90/010,937) as to the claims of the '063 patent. Accordingly, this proposal is **denied.**

Asserted SNQ over Parity Brochure Issue

As stated previously, the key limitation that was deemed lacking in the previous reexamination was "providing a centralized time indication of the current official auction clock time, i.e. a built-in official auction clock that shows current centralized official auction clock time".

The Request at page 15 relies on the Parity Brochure to show this limitation. The Request alleges that Parity discloses Bidders' PCs synchronize in time to the PARITY system, assuring timely submission of bids, and municipal securities dealers may submit one or more bids until the designated closing, with only their final bids recorded. *See id.*, page 2, right col., 1st and 4th paras.

In addition, the Request says the Parity Brochure similarly explains "PARITY allows Issuers to: . . . be assured that bids are received on time, as all bidders submitting through PARITY are synchronized to the same time." *Id.*, page 3, right col. The Parity Brochure explains again, "[s]ynchronize bidders' clocks, so that all bidders are working on the same time." *Id.*, page 4, left col. As a result, "PARITY allows Dealers to:... [e]nter or change bids up to the last minute" and "[b]e sure that bids are submitted on time." *Id.*, page 4, right col.

As noted above, Parity discloses that the "Bidder's PCs synchronize in time to the PARITY system". *Id.* page 2, right col. This teaching shows the current centralized official auction clock time since the Bidder's clock is synchronized with the PARITY system.

Parity Brochure's teachings regarding synchronized bidder's clocks would be important to a reasonable Examiner in determining the patentability of the requested claims because they are relevant to the distinguishing features of the claims of the '063.

The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reasons to combine during the examination stage, but these new technical teachings,

Copied from 95000244 on 04/10/2012

along with the item matching of the references to the claims and the third party statements of reasons to combine the references, show the combination of the Applied Art in view of Parity Brochure would have been important to a reasonable examiner in determining patentability. Accordingly, for at least this reason, Parity Brochure raises a SNQ over the requested claims and thus, this proposal is **granted**.

Asserted SNQ over Parity 1994 Issue

The instant Request turns to Parity and notes that it discloses a display of the current time as well as a countdown timer display of "Time Left." Parity 1994's "Bid Entry Screen" is depicted below:

**BID ENTRY SCREEN**
(F2 option)

Time left: 12:58:18 Bid Entry Screen Mon Nov 01 1993 21:41:42 PTZ
*CITY OF TAX FREE, WASHINGTON TAX FREE WA, G.O. BONDS, 1993*

| Maturity Date | Par Value | Term Bond | Coupon | Data from BondBidder Files | |
|---|---|---|---|---|---|
| Aug 01 1993 | $ 20,000 | | 4.000 | | |
| Aug 01 1994 | $ 5,000 | | 4.000 | Par Amount: | $ 1,430,000.00 |
| Aug 01 1995 | $ 10,000 | | 4.000 | Bid Price: | $ 1,430,000.00 |
| Aug 01 1996 | $ 5,000 | | 4.000 | Tot Int Cost: | $ 357,200.00 |
| Aug 01 1997 | $ 405,000 | | 4.000 | Premium: | $ 0.00 |
| Aug 01 1998 | $ 365,000 | | 4.000 | Discount: | $ 0.00 |
| Aug 01 1999 | $ 325,000 | | 4.000 | NIC: | 4.000000% |
| Aug 01 2000 | $ 295,000 | | 4.000 | TIC to Issue Date: | 3.999948% |

Page 1 of 2 F8=Return to Issue Premium $0,000,000.00 Discount $0,000,000.00
Specs screen
F10=Save and transmit, F9=Show TIC, F7=Turn on Yield, P=Premium, D=Discount,
Use TAB, up/down/left/right, PgDn/PgUp, Home/End keys to position cursor

The Request at page 16 notes that Parity 1994's Bid Entry Screen reproduced above "is an example of the data that you will see." *Id.*, at 5. The Bid Entry Screen discloses a "countdown time," i.e., "Time left: 12:58:18." *Id.*, at 9, 5. The Bid Entry Screen also discloses the current time: "Mon Nov 01 1993 21:42:42 PTZ." *Id.* at 5.

As previously noted a substantial new question of patentability 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 examination, in view of a material new argument or interpretation presented in the request.

During the prosecution of the 10/613,319 application, the Parity Reference Manual Version 1.22 (1993) was considered and was relied upon to disclose "displaying the official auction time". Page 3 of the July 31, 2008 office action.

Copied from 95000244 on 04/10/2012

Parity 1994 is cited in the instant Request to teach of both a countdown time and the official clock time. As noted in the Request, Bid Entry Screen "is an example of the data that you will see." *Id.*, at 5. The Bid Entry Screen discloses a "countdown time," i.e., "Time left: 12:58:18." *Id.*, at 9, 5. The Bid Entry Screen also discloses the current time: "Mon Nov 01 1993 21:42:42 PTZ." *Id.* at 5. "When the time has expired - watch the countdown time and/or compare the system date/time (upper right hand comer on most screens) with the End Sale Date/Time on the Issue specifications screen - the system will beep several times as an alarm when bidding time has ended. A message will appear informing you that the results are being requested from the Parity system." *Id.*, at 9.

This teaching is different than how it was used in an earlier concluded examination of the case since it is relying upon the teachings directed to an official auction clock time which shows the current centralized auction clock time and allows the user to keep track of how much time remains before the auction ends. The previous examination (10/613,319) did not specifically address the issue of a clock which keeps "track of how much time remains before the auction ends" with respect to the Parity Reference Manual.

The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reasons to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party statements of reasons to combine the references, show the combination of the Applied Art in view of Parity 1994 would have been important to a reasonable examiner in determining patentability. Accordingly, for at least this reason, Parity 1994 raises a SNQ over the requested claims and thus, this proposal is **granted**.

## CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted-in-part. Accordingly, the request for *ex parte* reexamination of claims 1-46 and 51-54 of the '063 patent is granted. Those claims will be reexamined.

2. The decision is final and nonappealable. See 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

3. An examiner will be assigned to this ordered reexamination proceeding pursuant to MPEP 2248, and the proceeding will be forwarded to this examiner for further action.

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

Copied from 95000244 on 04/10/2012

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).

**Waiver of Patent Owner Statement Period:** 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. This will permit reexamination of the proceeding to proceed pursuant to 37 CFR 1.550(a).

**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(e), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner in AU 3992, at (571)272-3152 or to the undersigned at (571) 272-0700.

Irem Yucel, Director
Central Reexamination Unit

Copied from 95000244 on 04/10/2012

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. |
|---|---|---|---|---|
| 90/011,678 | 05/06/2011 | David H. Gelfand | 18842-US10 | 8261 |

22829 7590 04/11/2012

Roche Molecular Systems, Inc.
4300 Hacienda Drive
Pleasanton, CA 94588

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/11/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JEFFREY B. OSTER
8339 SE 57th STREET
MERCER ISLAND, WA 98040

Date: MAILED

APR 11 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011678
PATENT NO. : 5804375
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.: 90/011,678 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED April 6, 2012.

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(c) – 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. TIME REQUESTED
   The amount of time requested is ___1 month__. This would be the second extension of time to respond to the Office action. Second or subsequent requests for extensions of time or requests for more than 1 month will be granted only in extraordinary situations. See MPEP 2265 and 2665

4. FORMAL MATTERS
   Patent owner petitioner requests that the period for response be extended by the amount of time stated above for responding to the Office action mailed on January 19, 2012, which sets a 2 month period for filing a response thereto. A previous extension of time was granted for one month, which had set a response date of February 14, 2012.

   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.

5. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for 2 weeks, because petitioner properly provided a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory time period and petitioner explained why, in spite of the action taken thus far, the requested additional time is needed.
      ☐ 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 petition is moot.
      v. ☐ Other/comment: _____.

6. CONCLUSION: **The response to the Office Action is due on or before May 3, 2012.**

   Telephone inquiries with regard to this decision should be directed to Stephen Stein at 571-272-1544, in the Central Reexamination Unit.

| /Stephen J. Stein/ | SPE, AU-3991 |
|---|---|
| [*Signature*] | (Title) |

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. |
|---|---|---|---|---|
| 90/011,678 ~~13/176476~~ | 05/06/2011 | David H. Gelfand | 18842-US10 | 8261 |

22829 7590 04/17/2012

Roche Molecular Systems, Inc.
4300 Hacienda Drive
Pleasanton, CA 94588

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JEFFREY B. OSTER
8339 SE 57th STREET
MERCER ISLAND, WA 98040

Date: 4-17-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011678 + 13/176476
PATENT NO. : 5804375
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)).

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

APR 17 2012

CENTRAL REEXAMINATION UNIT

Roche Molecular Systems, Inc. (For Patent Owner)
4300 Hacienda Drive
Pleasanton, CA 94588

Jeffrey B. Oster (For Third Party Requester)
8339 SE 57th Street
Mercer Island, WA 98040

| | | |
|---|---|---|
| In re David H. Gelfand et al. | : | |
| *Ex Parte* Reexamination Proceeding | : | |
| Control No.: 90/011,678 | : | |
| Filed: May 6, 2011 | : | DECISION DISMISSING |
| For: U.S. Patent No. 5,804,375 | : | PETITION FOR |
| | : | MERGER OF |
| In re David H. Gelfand et al. | : | REEXAMINATION |
| Reissue Application | : | (37 CFR 1.182) |
| Application No.: 13/176,476 | : | |
| Filed: July 5, 2011 | : | |
| For: U.S. Patent No. 5,804,375 | : | |

This is a decision on patent owner's "Petition To Merge *Ex Parte* Reexamination And Reissue Application (37 C.F.R. § 1.182 & MPEP 2285(V))" filed February 15, 2012, in both the above-identified *ex parte* reexamination proceeding and the above-identified reissue application ("the February 15, 2012 petition").

The February 15, 2012 petition is before the Office of Patent Legal Administration for decision.

Petitioner patent owner's Deposit Account No. 14-1437 has been charged the $400.00 petition fee under 37 CFR 1.17(f) for filing the present 37 CFR 1.182 petition, in view of the authorization to do so at page 6 of the February 15, 2012 petition.

The petition is **dismissed**.

## REVIEW OF SALIENT FACTS

1. U.S. Patent No. 5,804,375 (the '375 patent) issued on September 8, 1998.

2. A request for *ex parte* reexamination was filed by a third party requester ("requester") on May 6, 2011, and assigned control No. 90/011,678 ("the '678 proceeding").

3. Patent owner filed an application for reissue of the '375 patent on July 5, 2011. The reissue application was assigned serial no. 13/176,476 ("the '476 reissue application").

4. Patent owner filed a Preliminary Amendment in the '476 reissue application on July 6, 2011. The July 6, 2011 amendment included amendments to both the specification and claims of the '375 patent.

5. Reexamination was ordered in the '678 reexamination proceeding on July 20, 2011.

6. A non-final Office action was mailed in the '678 reexamination on January 19, 2012.

7. Patent owner filed, on March 5, 2012, a petition under 37 CFR 1.550(c) for a one-month extension of time in the '678 reexamination proceeding. The Office granted the petition on March 9, 2012, thereby extending the time for responding to the January 19, 2012 Office action to April 19, 2012.

8. Patent owner filed, on April 6, 2012, a petition under 37 CFR 1.550(c) for an additional one-month extension of time in the '678 reexamination proceeding. The Office granted-in-part the petition on April 11, 2012, extending the time for responding to the January 19, 2012 Office action by an additional two weeks to May 3, 2012.

## DECISION

A. Relevant Statutes, Regulations and Practice

35 U.S.C. § 305 provides, in part:

> All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.565(d) provides, in part:

> If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will usually be made to merge the two proceedings or to suspend one of the two proceedings.

MPEP § 2285 provides, in part [emphasis added]:

> The general policy of the Office is that a reissue application examination and an *ex parte* reexamination proceeding will not be conducted separately at the same time as to a particular patent. ... The decision as to whether the proceedings are to be merged, or which proceeding **(if** any**)** is to be stayed is made in the Office of Patent Legal Administration (OPLA).
>
> *
>
> *
>
> The decision on whether to merge the proceedings or stay a proceeding will be made on a case-by-case basis based upon the status of the various proceedings. The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings. ...
>
> *
>
> *
>
> ... Where identical amendments are not present in both files at the time merger is ordered, the patent owner will be required to submit an appropriate "housekeeping" amendment placing the same amendments in both proceedings. ...

B. Findings and Analysis

As explained at MPEP § 2285, the decision on whether to merge a reissue application examination and an *ex parte* reexamination proceeding is made on a case-by-case basis and is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings.

At this time, merger of the '678 reexamination proceeding and the '476 reissue application does not facilitate the orderly operation of the Office.

For example, where identical amendments are not present in both files at the time merger is ordered, the patent owner is required to submit an appropriate "housekeeping" amendment placing the same amendments in both proceedings. See MPEP § 2285(IV). A review of the '476 reissue application reveals a July 6, 2011 preliminary amendment containing amendments to both the specification and claims of

the '375 patent. On the other hand, a review of the '678 reexamination proceeding reveals, that thus far, no amendments have been proposed therein. Because identical amendments are not currently present in both files, a decision to merge would need to set a time period for patent owner to submit a "housekeeping" amendment. Such a time period would be in addition to, and separate from, the time period for patent owner to respond to the January 19, 2012 Office action in the '678 reexamination proceeding. The existence of two different time periods for taking action in the same proceeding would not facilitate the orderly operation of the Office.

Accordingly, the February 15, 2012 petition seeking merger of the '678 reexamination proceeding and the '476 reissue application is **dismissed**.

Once patent owner has filed a response to the January 19, 2012 Office action in the '678 reexamination proceeding, the Office may consider, *sua sponte*, whether the '678 reexamination proceeding and the '476 reissue application should be merged under 37 CFR 1.565(d). The nature of patent owner's response to the January 19, 2012 Office action will be a factor in determining whether to merge. For example, a factor supporting merger would exist if patent owner amends in response to the Office action, and the amendments are identical to the amendments contained in the July 6, 2011 preliminary amendment in the '476 reissue application.[1] On the other hand, a factor contrary to merger may exist, in view of the statutory mandate to conduct a reexamination proceeding with special dispatch, if patent owner responds to the Office action in a manner that (i) does not amend identically to the July 6, 2011 preliminary amendment and (ii) places the proceeding in condition for issuance of a reexamination certificate by making all pending claims patentable. See 35 U.S.C. § 305.

Additionally, patent owner may choose to file a renewed petition[2] for merger after a response to the January 19, 2012 Office action has been filed. Any such renewed petition must explain, in detail, why merger is merited.

## CONCLUSION

1. The February 15, 2012 petition seeking merger of the '678 reexamination proceeding and the '476 reissue application is **dismissed**.

2. Patent owner may file a renewed petition requesting merger of the '476 application to reissue the '375 patent with the '678 reexamination proceeding, only after a

[1] It could be equally favorable to merger if patent owner in addition to filing a response to the Office action files a concomitant preliminary amendment in the '476 reissue application to make identical the specification and claims of both proceedings.

[2] Patent owner is reminded of the current practice which automatically dissolves the merger upon filing of an RCE.

response has been filed to the January 19, 2012 Office action in the '678 reexamination proceeding.

3. Telephone inquiries relating to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

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

April 16, 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. |
|---|---|---|---|---|
| 90/011,679 | 05/09/2011 | 69700695 | KYO-003 Re-Exam | 1280 |

26161 7590 09/08/2011

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

| 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

MAILED

Date: SEP 08 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GOODWIN PROCTER LLP
135 COMMONWEALTH DRIVE
MENLO PARK, CA 94025-1105

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011679
PATENT NO. : 6970695
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.: 90/011,679 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED on 08/31/2011.

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 07/12/2011, 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 attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. 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.

/Sudhanshu C. Pathak/ for Mark Reinhart — SPE, Art Unit 3992

[*Signature*] — (Title)

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

Glenn Patent Group
3475 Edison Way, Suite L
Menlo Park, CA 94025

| | | |
|---|---|---|
| In re Application of | : | |
| **Murveit** | : | |
| Control No. 90/011,682 | : | DECISION ON PETITION |
| Filed: May 10, 2011 | : | TO WITHDRAW |
| Attorney Docket No. 10010-220REX2 | : | 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 5, 2011.

The request is **APPROVED**.

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

The request was signed by Joseph R. Weatherbee on behalf of all attorneys of record who are associated with customer No. 22862.

All attorneys/agents associated with the Customer Number 22862 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

Telephone inquiries concerning this decision should be directed to Sharon S. Hoppe at 571-272-1586.

/Sharon Hoppe/
Paralegal Specialist
CRU

cc: Wolf, Greenfield & Sacks, P.C.
600 Atlantic Ave.
Boston, MA 02210

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on 08/05/11].

Doc Code: PET.POA.WDRW
Document Description: Petition to withdraw attorney or agent (SB83)

PTO/SB/83 (11-08)
Approved for use through 11/30/2011. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

| | |
|---|---|
| Application Number | 90/011,682 |
| Filing Date | 05-10-2011 |
| First Named Inventor | Hy Murveit |
| Art Unit | 3992 |
| Examiner Name | Fred O. Ferris III |
| Attorney Docket Number | 10010-220REX2 |

**To: Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

Please withdraw me as attorney or agent for the above identified patent application, and

[ ] all the practitioners of record;

[ ] the practitioners (with registration numbers) of record listed on the attached paper(s); or

[X] the practitioners of record associated with Customer Number: 22862

**NOTE:** The immediately preceding box should only be marked when the practitioners were appointed using the listed Customer Number.

The reason(s) for this request are those described in 37 CFR :

| | | | |
|---|---|---|---|
| [ ] 10.40(b)(1) | [ ] 10.40(b)(2) | [ ] 10.40(b)(3) | [ ] 10.40(b)(4) |
| [ ] 10.40(c)(1)(i) | [ ] 10.40(c)(1)(ii) | [ ] 10.40(c)(1)(iii) | [ ] 10.40(c)(1)(iv) |
| [ ] 10.40(c)(1)(v) | [ ] 10.40(c)(1)(vi) | [ ] 10.40(c)(2) | [ ] 10.40(c)(3) |
| [ ] 10.40(c)(4) | [X] 10.40(c)(5) | [ ] 10.40(c)(6) Please explain below: | |

The matter has been transferred to: Wolf, Greenfield & Sacks, P.C. (Customer No. 23628)

## Certifications

***Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.***

1. [X] I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.

2. [X] I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.

3. [X] I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:



This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

PTO/SB/83 (11-08)
Approved for use through 11/30/2011. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

**Complete the following section only when the correspondence address will change.** *Changes of address will only be accepted to an inventor or an assignee that has properly made itself of record pursuant to 37 CFR 3.71.*

Change the correspondence address and direct all future correspondence to:

A. [X] The address of the inventor or assignee associated with Customer Number: 23628

***OR***

B. [ ] Inventor or Assignee name

| | | | |
|---|---|---|---|
| Address | | | |
| City | State | Zip | Country |
| Telephone | | Email | |

I am authorized to sign on behalf of myself and all withdrawing practitioners.

| | | | |
|---|---|---|---|
| Signature | | | |
| Name | Joseph R. Weatherbee | Registration No. | 64,810 |
| Address | 3475 Edison Way, Suite L | | |
| City | Menlo Park | State CA | Zip 94025 | Country US |
| Date | August 5, 2011 | Telephone No. | 650-474-8400 |

*NOTE:* ***Withdrawal is effective when approved rather than when received.***



This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

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. |
|---|---|---|---|---|
| 90/011,685 | 05/11/2011 | 6001858 | 2920493-000002 | 2852 |

84331 7590 02/28/2012

Baker Donelson Bearman, Caldwell & Berkowitz, PC
920 Massachusetts Ave, NW
Suite 900
Washington, DC 20001

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Patrick C. Woolley
POLSINELLI SHUGHART PC
700 W. 47th Street, Suite 1000
Kansas City, MO 64112-1802

Date:
MAILED
FEB 28 2012
CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011685
PATENT NO. : 6001858
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

BAKER DONELSON BEARMAN, CALDWELL & BERKOWITZ, PC
920 MASSACHUSETTS AVE, NW
SUITE 900
WASHINGTON DC 20001

(For Patent Owner)

Patrick C. Woolly
POLSINELLI SHUGHART PC
700 W. 47TH ST., SUITE 1000
KANSAS CITY, MO 64112-1802

(For Third Party Requester)

| | | |
|---|---|---|
| *In re*: *Sirinyan et al.* | : | |
| *Ex Parte* Reexamination Proceeding | : | DECISION ON |
| Control No. 90/011,685 | : | PETITION UNDER |
| Deposited: May 11, 2011 | : | 37 CFR § 1.181(a)(3) |
| For: US Patent No. 6,001,858 | : | |

This is a decision on the August 8, 2011 petition, entitled "Petition under 37 C.F.R. § 1.181 to Vacate the Order Granting Reexamination," which is requesting that the order granting reexamination is *ultra vires* and should be vacated. The patent owner's petition is treated as a petition under 37 CFR 1.181(a)(3).

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

The patent owner's August 8, 2011 petition is dismissed for the reasons set forth below.

## SUMMARY OF RELEVANT FACTS

1. On December 14, 1999, U.S. Patent No. 6,001,858 ("the '858 patent") was issued to *Sirinyan et al.*

2. On May 11, 2011, a request for *ex parte* reexamination was submitted by a third party requester and identified by control number 90/011,685.

3. On June 29, 2011, the order was granted for *ex parte* reexamination in control number 90/011,685.

4. On August 8, 2011, the instant patent owner petition was submitted.

## 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.

**35 U.S.C. 254 Certificate of correction of Patent and Trademark Office mistake.**

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

**37 CFR 1.515 Determination of the request for *ex parte* reexamination.**

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. ***The examiner's determination will be based on the claims in effect at the time of the determination***, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination. (Emphasis added).

**MPEP § 2246 Decision Ordering Reexamination** (in-part):

> A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. There is no right to petition such a finding after a request for reexamination is granted even if the finding of a substantial new question is based on reasons other than those urged by the requester (or based on less than all the grounds urged by the requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.
>
> 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:
>
> (A) the reexamination order is not based on prior art patents or printed publications.
> (B) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
> (C) reexamination was ordered for the wrong patent;
> (D) reexamination was ordered based on a duplicate copy of the request....

## DECISION

The patent owner petitioner requests that the order and the reexamination proceeding be vacated. The petitioner considers the action of granting reexamination of the patent as an *ultra vires* action by the Office. Specifically, patent owner argues that the order relies upon erroneous claim language present in the patent. Patent owner filed a copy of a request for a certificate of correction, filed on August 5, 2011, in the patent file. See, e.g., pages 1-2 of the petition.

The determination of whether a substantial new question of patentability (SNQ) is based on the claims in effect at the time of the determination. See 37 CFR 1.515(a). Upon review of the record for the '858 patent, the request for a certificate of correction was filed on August 5, 2011 and was published on December 6, 2011. A certificate of correction is not part of the patent until it is published. See 35 USC 254. Therefore, the certificate of correction was not considered as part of

the original patent until December 6, 2011. The determination that ordered reexamination occurred on June 29, 2011, over five months prior to when the certificate of correction became part of the patent file. Therefore, the order was not in error, as asserted in the petition, because the certificate of correction was not part of the patent until after the determination was made. In addition, the petition made no showing that the examiner relied upon the "erroneous" claim language in the determination to order reexamination. Upon review of the order, the determination to grant reexamination does not solely rely on claim 1 having the word "optionally" in the phrase "and additional solvent." Specifically, the order discusses other claim limitations as the basis for the SNQs, such as having teachings relevant to the limitation of "a solvent selected from the group consisting of benzyl alcohols and optionally substituted pyrrolidones." See, e.g., pages 5-6 of the order. Therefore, even if the claims in effect at the time of the determination included the changes in the certificate of correction, the petition fails to show that the order granting reexamination was without basis. For these reasons, the order is not deemed an *ultra vires* action.

The record shows that the examiner made a determination that the teachings in cited prior art provided a new technical teaching pertaining to the limitations of claims 1-3 of the '858 patent, and accordingly, raised SNQs for these claims. See MPEP 2240 and 2244. In other words, the determination that SNQs were raised by the teachings of the cited prior art 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.

For these reasons, patent owner has presented insufficient support for the contention that the order was an *ultra vires* action on the part of the Office. As discussed further below, the patent owner must have shown that the Office was without authority to grant a request for reexamination. In other words, the petition must show that there was no discretion to grant the reexamination.

*Findings*

It is found that the order was not based erroneous claim language. In other words, the order was based on the claims in effect at the time of the determination. 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.

## CONCLUSION

1. The patent owner's petition under 37 CFR 1.181(a)(3) to vacate the reexamination proceeding is hereby **dismissed.**

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action. Reexamination will proceed based upon the claims as modified by the December 6, 2011 certificate of correction.

3. Response should be addressed as follows:

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

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

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

   By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered. 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 Yücel, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DOCKET CLERK
KELLY & KRAUSE, LP
1000 JORIE BOULEVARD, SUITE 144
OAK BROOK, IL 60523

MAILED

NOV 09 2011

CENTRAL REEXAMINATION UNIT

In re Application of :
**ENMEI, TOSHIHARU** :
Control No. 90/011,691 : DECISION ON PETITION
Filed: May 13, 2011 : TO WITHDRAW
Attorney Docket No. 340164-00004 : 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), previously filed November 08, 2011 and resubmitted on November 9, 2011.

The request is **APPROVED**.

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

The request was signed by Joseph P. Krause on behalf of all attorneys of record who are associated with customer No. 98749.

All attorneys/agents associated with the Customer Number 98749 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

There is an outstanding Office action mailed November 07, 2011 that requires a reply from the applicant.

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

/Volpe for/

Mark Reinhart
Supervisory Patent Examiner
CRU 3992

cc: ADC TECHNOLOGY INC.
MEISHIN BLDG. 7F, 20-19, NICHIK 1-CHOME
NAGOYA, NAKA-KU, JAPAN
460-0003

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. |
|---|---|---|---|---|
| 90/011,693 | 05/16/2011 | 7,567,361 | 340164-00004 | 1070 |

29393 7590 11/10/2011

ESCHWEILER & ASSOCIATES, LLC
NATIONAL CITY BANK BUILDING
629 EUCLID AVE., SUITE 1000
CLEVELAND, OH 44114

| EXAMINER | |
|---|---|
| POKRZYWA, JOSEPH R | |
| ART UNIT | PAPER NUMBER |
| 3992 | |
| MAIL DATE | DELIVERY MODE |
| 11/10/2011 | PAPER |

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KATTEN MUCHIN ROSENMAN LLP
(C/O PATENT ADMINSTRATOR)
2900 K STREET NW, SUITE 200
WASHINGTON, DC 20007-5118

Date:

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011693
PATENT NO. : 7567361
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

**KELLY & KRAUSE**
**1000 JORIE BLVD.**
**SUITE 144**
**OAK BROOK, IL 60523**

| | | |
|---|---|---|
| *In re* Application of | : | |
| **ENMEI,** Nagoya | : | |
| Control No. 90/011,693 | : | DECISION ON PETITION |
| Filed: May 16, 2011 | : | TO WITHDRAW |
| Attorney Docket No. 4210.003 | : | 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 November 4, 2011.

The request is **moot** because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to KELLY & KRAUSE, LLP has been revoked by the assignee of the patent application on November 4, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Denise L. Boyd at 571-272-0992.

Denise L. Boyd
Paralegal
CRU 3999

cc: ESCHWEILER & ASSOCIATES, LLC
NATIONAL CITY BANK BUILDING
629 EUCLID AVE., SUITE 1000
CLEVELAND, OHIO 44114

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

McDermott Will & Emery LLP
600 13th Street NW
Washington, DC 20005-3096

For Patent Owner

MAILED

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

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. |
|---|---|---|---|---|
| 90/011,704 + 90/012012 | 05/23/2011 | 6,246,400 | R3111606A | 9609 |

40401 7590 02/23/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SHOOK, HARDY & BACON LLP
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BLVD.
KANSAS CITY, MO 64108-2613

Date: 2-23-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011704 + 90/012082
PATENT NO. : 6246400
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

MAILED

FEB 23 2012

CENTRAL REEXAMINATION UNIT

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

Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314 : (For Patent Owner)

Kathleen D. Fitterling
Shook Hardy & Bacon LLP, IP DEPT
2555 Grand Blvd.
Kansas City, MO 64108-2613 : (For Third Party Requester)

*In re* Bush
*Ex Parte* Reexamination Proceedings
Control No. 90/012,082
Control No. 90/011,704
For U.S. Patent No. 6,246,400 : 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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,246,400 [hereinafter "the '400 patent"] was granted to Bush on 12 June 2001.

- On 23 May 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,704 [hereinafter "the '11704 proceeding"].

- On 27 June 2011, the Office issued an order granting *ex parte* reexamination of claims 1-54 in the '11704 proceeding.

- On 13 October 2011 a non-final Office action on the merits was mailed rejecting claims 1-6, 8-9, 11, 13-16, 18-28, 30-38 and 40-54 and confirming claims 7, 10, 12, 17, 29 and 39.

- On 13 December 2011, patent owner filed a response to the non-final Office action in the '11704 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 31 January 2012 the examiner mailed a final rejection maintaining the rejection of the claims.

- On 09 January 2012, the same third party requester filed a new request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/012,082 [hereinafter "the '12082 proceeding"].

- On 17 February 2012, the Office issued an order granting *ex parte* reexamination of claims 7, 29 and 39 in the '12082 proceeding.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/012,082 and 90/011,704 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. Both files will be maintained as separate, complete files.

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 proceedings 90/012082 and 90/011704 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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 Alexander Kosowski at (571)272-3744, or, in the event that Alexander Kosowski is unavailable, to Mark Reinhart at (571)272-1611, both of whom are Supervisory Patent Reexamination Specialists in the Central Reexamination Unit, Art Unit 3992.

/Alexander Kosowski/

Alexander Kosowski,
Supervisory Patent Reexamination Specialist,
AU 3992,
Central Reexamination Unit
571-272-3744

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,707
Filed: May 23, 2011
For: U.S. Patent No. 6,386,324

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), October 11, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be confidential material.

The petition is **DISMISSED**.

Petitioner requests that confidential material submitted in a sealed envelope on October 11, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte*

Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

It is noted, however, that the petitions are deficient because they lack items (A) through (D) listed above.

If patent owner still wishes to have the material in question expunged, a renewed petition should be promptly filed or, shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process) the mailing of the NIRC. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

NOV 29 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,707
Filed: May 23, 2011
For: U.S. Patent No. 6,386,324

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed November 18, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on October 11, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,707
Filed: May 23, 2011
For: U.S. Patent No. 6,386,324

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed December 20, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on December 20, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,708
Filed: May 23, 2011
For: U.S. Patent No. 6,401,871

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), October 11, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be confidential material.

The petition is **DISMISSED**.

Petitioner requests that confidential material submitted in a sealed envelope on October 11, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte*

Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

It is noted, however, that the petitions are deficient because they lack items (A) through (D) listed above.

If patent owner still wishes to have the material in question expunged, a renewed petition should be promptly filed or, shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process) the mailing of the NIRC. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

NOV 29 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,708
Filed: May 23, 2011
For: U.S. Patent No. 6,401,871

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed November 18, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on October 11, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,708
Filed: May 23, 2011
For: U.S. Patent No. 6,401,871

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed December 20, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on December 20, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,709
Filed: May 23, 2011
For: U.S. Patent No. 6,364,061

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), October 11, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be confidential material.

The petition is **DISMISSED**.

Petitioner requests that confidential material submitted in a sealed envelope on October 11, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte*

Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

It is noted, however, that the petitions are deficient because they lack items (A) through (D) listed above.

If patent owner still wishes to have the material in question expunged, a renewed petition should be promptly filed or, shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process) the mailing of the NIRC. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

NOV 29 2011

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,709
Filed: May 23, 2011
For: U.S. Patent No. 6,364,061

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed November 18, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on October 11, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

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

Otis Elevator Company
Intellectual Property Department
10 Farm Springs
Farmington, CT 06032

For Patent Owner

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

Stroock & Stroock & Lavan LLP
180 Maiden Lane
New York, NY 10038

3d Party Requester

*Ex Parte* Reexamination Proceeding
Control No. 90/011,709
Filed: May 23, 2011
For: U.S. Patent No. 6,364,061

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the renewed petition under 37 CFR 1.59(b), filed December 20, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelop on December 20, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination

proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

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, SPE
Central Reexamination Unit 3993

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

NOV 0 8 2011

CENTRAL REEXAMINATION UNI

KING & SCHICKLI, PLLC
247 North Broadway
Lexington, KY 40507

(for Patent Owner)

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(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

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(for Third Party Requester)

*In re Bloomer*
Reexamination Proceeding
Control No.: 90/011,454
Filed: January 21, 2011
For: U.S. Patent 6,080,330

CRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

(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

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. |
|---|---|---|---|---|
| 90/011,731 | 06/21/2011 | 7,815,725 | 859.1_R | 3014 |

33072 7590 02/28/2012

KAGAN BINDER, PLLC
SUITE 200, MAPLE ISLAND BUILDING
221 MAIN STREET NORTH
STILLWATER, MN 55082

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DENNIS G. LAPOINTE
LAPOINTE LAW GROUP, PL
P.O. BOX 1294
TARPON SPRINGS, FL 34688-1294

Date: MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011731
PATENT NO. : 7815725
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)).

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. |
|---|---|---|---|---|
| 90/011,983 | 10/27/2011 | 7,815,725 | Sasol SA-14 | 1215 |

33072 7590 02/28/2012

KAGAN BINDER, PLLC
SUITE 200, MAPLE ISLAND BUILDING
221 MAIN STREET NORTH
STILLWATER, MN 55082

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

C. JAMES BUSHMAN
1001 West Loop South
Suite 810
HOUSTON, TX 77027

Date:

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011983
PATENT NO. : 7815725
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

KAGAN BINDER, PLLC
221 Main Street North
Maple Island Building, Suite 200
Stillwater, MN 55082

(for Patent Owner)

Dennis G. Lapointe
LAPOINTE LAW GOUP, PL
PO Box 1294
Tarpon Springs, FL 34688-1294

(for first Third Party Requester)

*In re Reinke et al.*
Reexamination Proceeding
Control No.: 90/011,731
Filed: June 21, 2011
For: U.S. Patent 7,815,725 B2

C. JAMES BUSHMAN
5581 San Felipe
Suite 975
Houston, TX 77057

(for second Third Party Requester)

*In re Reinke et al.*
Reexamination Proceeding
Control No.: 90/011,983
Filed: October 27, 2011
For: U.S. Patent 7,815,725 B2

**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 7,815,725 issued October 19, 2010, is the subject of Reexamination Control Nos. 90/011,731 and 90/011,983.

2. A first request for reexamination, assigned Reexamination Control No. 90/011,731 ('731 proceeding), was filed June 21, 2011 by first Third Party Requester. The request urged that a substantial new question of patentability of claims 1, 6 and 7 was raised by the newly cited references that either disclose the claimed composition or are so close as to establish a case of obviousness.

3. Reexamination was ordered for claims 1, 6 and 7 for 90/011,731 on August 12, 2011.

4. A first non-final Office action on the merits was issued on December 1, 2011 in the '731 proceeding.

5. Patent Owner filed an amendment and response in the '731 proceeding on January 23, 2012.

6. A second request for re-examination, assigned Reexamination Control No. 90/011,983 ('983 proceeding) was filed on October 27, 2011 by second Third Party Requester. The request urged that a substantial new question of patentability of claims 1-4 and 9-18 was raised by the newly cited references that either disclose the claimed composition or are so close as to establish a case of obviousness.

7. Reexamination was ordered for all claims in the second request on December 22, 2011.

8. No Office action has been issued in the 90/011,983 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 90/011,731 and 90/011,983 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 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. 90/011,731 and 90/011,983 as:

KAGAN BINDER, PLLC
221 Main Street North
Maple Island Building, Suite 200
Stillwater, MN 55082

A copy of all correspondence from the USPTO will be served on the Third Party Requesters at the addresses listed in Reexamination Control Nos. 90/011,731 and 90/011,983 as:

Dennis G. Lapointe (first Third Party Requester)
LAPOINTE LAW GOUP, PL
PO Box 1294
Tarpon Springs, FL 34688-1294

C. JAMES BUSHMAN (second Third Party Requester)
5581 San Felipe
Suite 975
Houston, TX 77057

**CONCLUSION**

Reexamination Control Nos. 90/011,731 and 90/011,983 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

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. |
|---|---|---|---|---|
| 90/011,736 | 06/10/2011 | 6427078 | 51020-012USC1RX | 7141 |

42532 7590 01/27/2012

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/27/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Bryan C. Diner
FINNEGAN HENDERSON FARABOW ET AL.
901 New York Avenue, NW
Washington, DC 20001-4413

Date:

MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011736
PATENT NO. : 6427078
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

Robert S. Mayer
PROSKAUER ROSE LLP
One International Place
Boston, MA 02110-2600

(For Patent Owner)

MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 New York Avenue, N.W.
Washington, DC 20001-4413

(For Third Party Requester)

Tracy W. Druce
NOVAK, DRUCE & QUIGG LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

*In re* Wilska et alia
*Ex Parte* Reexamination Proceedings
Control No. 90/011,736
Control No. 90/011,883
For U.S. Patent No. 6,427,078

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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,427,078 [hereinafter "the '078 patent"] was granted to Wilska et al. on 30 July 2002.

- On 10 June 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,736 [hereinafter "the '11736 proceeding"].

- On 5 August 2011, patent owner agreed to waive Patent Owner's Statement in the '11736 proceeding.

- On 12 August 2011, the Office issued an order granting *ex parte* reexamination of claims 1-3, 5, 6, 8, 17, 18, 29, 34, 69, and 73 in the '11736 proceeding along with a non-final Office action on the merits.

- On 11 October 2011, patent owner filed a response to the non-final Office action in the '11736 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 30 August 2011, a second third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,883 [hereinafter "the '11883 proceeding"].

- On 9 September 2011, patent owner agreed to waive Patent Owner's Statement in the '11883 proceeding.

- On 25 October 2011, the Office issued an order granting *ex parte* reexamination of claims 1-3, 6, 8, 17, 18, and 73 in the '11883 proceeding along with a non-final Office action on the merits.

- On 27 December 2011, patent owner filed a response to the non-final Office action in the '11883 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/011,736 and 90/011,883 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. Both files will be maintained as separate, complete files.

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 proceedings 90/011,736 and 90/011,883 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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, or, in the event that Mark Reinhart is unavailable, to Daniel Ryman at (571)272-3152, both of whom are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAMES O"SULLIVAN
12TH FLOOR, RUTTONJEE HOUSE
11 DUDDELL STREET
HONG KONG HK HONG KONG

(For Patent Owner)

MAILED

SEP 08 2011

CENTRAL REEXAMINATION UNIT

ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DRIVE-SUITE 101
ELLICOTT CITY MD 21043

(For Third Party Requester)

In re Application of: CHIH-CHING HSIEN
Application No. 90/011,738
Filed: June 13, 2011
For: WRENCH

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation of the Patent Owner filed June 13, 2011.

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.

The request filed June 30, 2011, meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address for the Patent Owner 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.

Alicia Kelley-Collier
Patent Reexamination Specialist
Central Reexamination Unit
(571) 272-6059

cc: CHIH-CHING HSIEN
NO. 367, PEI YANG RD., FENG YUAN
TAICHUNG TW TAIWAN

§ 10.40 Withdrawal from employment.

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see § § 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

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. |
|---|---|---|---|---|
| 90/011,752 | 06/20/2011 | 5,954,902 | 20264.0002.000000 | 2425 |

30764 7590 03/08/2012

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
12275 EL CAMINO REAL, SUITE 200
SAN DIEGO, CA 92130

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/08/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: 3-8-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011752
PATENT NO. : 5954902
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.:90/011,752 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED March 2, 2012.

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 1, 2012, 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 A response to the outstanding Office action is due on or before April 30, 2012.

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit.

| /Deborah Jones/ | SPE, Art Unit 3991, CRU |
|---|---|
| [*Signature*] | (Title) |

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

PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

(Patent Owner)

**MAILED**

**APR 16 2012**

**CENTRAL REEXAMINATION UNIT**

*In re Wootten, Jr.*
Reexamination Proceeding
Control No.: 90/011,779
Filing Date: June 30, 2011
For: U.S. Patent No.: 6,799,341

: **DECISION**
: **DISMISSING**
: **PETITIONS**

The above-mentioned reexamination proceeding is before the Director of the Central Reexamination Unit, after receipt of three April 2, 2012 patent owner petitions, entitled "Petition under 37 C.F.R. § 1.181 to the Director Requesting Entry of Amendments to Claims Pursuant to 37 C.F.R. § 1.116;" "Petition under 37 C.F.R. § 1.181 to the Director Requesting Entry of Amendments to Specification Pursuant to 37 C.F.R. § 1.116;" and "Petition under 37 C.F.R. § 1.181 to the Director Requesting Entry of Amendments to Drawings Pursuant to 37 C.F.R. § 1.116." The three petitions are requesting that the March 22, 2012 amendments to the claims, specification, and drawings be entered into the proceeding record.

The patent owner's petitions are dismissed as moot.

## DECISION

As pointed out, the patent owner filed three April 2, 2012 petitions, which are petitions requesting entry of the March 22, 2012 amendments to the claims, specification, and drawings. On April 3, 2012, the Office mailed an advisory action that indicated that the March 22, 2012 amendments to the claims, specification, and drawings are entered into the proceeding record for purposes of appeal. See the continuation sheet of the advisory action mailed April 3, 2012. Therefore, the relief requested by the three April 2, 2012 petitions under 37 CFR 1.181 has already been given by the April 3, 2012 advisory action. Thus, the three April 2, 2012 petitions under 37 CFR 1.181 are moot, and hereby, dismissed.

## CONCLUSION

1. The three April 2, 2012 petitions under 37 CFR 1.181 are dismissed as moot.

2. Telephone inquiries related to this decision should be directed Eileen Lillis, Supervisory Patent Examiner, at (571) 272-6928, or Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, 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. |
|---|---|---|---|---|
| 90/011,784 | 07/28/2011 | 7,693,993 B2 | 3048.17USREX2 | 3001 |

24113 7590 02/09/2012

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/09/2012

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

| ***Decision on Petition for Extension of Time in Reexamination*** | Control No.: 90/011,784 |
|---|---|

MAILED

FEB 09 2012

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 01 February 2012.

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 01 December 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 _____, 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 absence, calls may be directed to Sudhanshu C Pathak at 571-272-5509 in the Central Reexamination Unit.

/Mark Reinhart/
[*Signature*]

SPRS, 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 an interview scheduled outside the time for response to the Non-Final Office action mailed on 01 December 2012. There is no accounting as to what diligence was exercised in the two month response period as well as why the interview could not have been earlier scheduled. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as timely response to an Office action on the merits.

On balance, the patent owner has not provided "sufficient cause" for granting an extension of time.

The petition for extension of time is hereby dismissed.

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. |
|---|---|---|---|---|
| 90/011,784 | 07/28/2011 | 7,693,993 B2 | 3048.17USREX2 | 3001 |

24113 7590 04/13/2012

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/13/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Patterson Thuente Christensen Pedersen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

APR 13 2012
CENTRAL REEXAMINATION UNIT

In re John Kitrick B. Sheets et al. :
*Ex Parte* Reexamination Proceeding : **DECISION GRANTING**
Control No. 90/011,784 : **PETITION UNDER**
Filed: July 28, 2011 : **37 CFR 1.137(b)**
For: U.S. Patent No. 7,693,993 :

This is a decision on the February 22, 2012 petitions under 37 CFR 1.137(b), 1.182, and 1.550(e)(2) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination, as supplemented by the March 6, 2012 paper titled "Supplemental Proposed Amendment and Response By Patent Owner Under 37 CFR 1.530(d) (collectively "the supplemented February 22, 2012 petition to revive").

The supplemented February 22, 2012 petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The supplemented February 22, 2012 petition to revive is **granted**.

The February 10, 2012 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 December 1, 2011 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 Supplemented 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 December 1, 2011 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 December 1, 2011 Office action set a two-month period for response. However, a compliant response to the December 1, 2011 Office action was not filed until March 6, 2012, which was untimely. Nevertheless, for the purpose of evaluating whether the supplemented February 22, 2012 petition to revive is a grantable petition, patent owner's submission of the March 6, 2012 Supplemental Proposed Amendment and Response By Patent Owner Under 37 CFR 1.530(d) satisfies item (1).[1]

Patent owner has been charged the $1,860.00 petition fee, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) was submitted as part of the supplemented February 22, 2012 petition, thereby satisfying item (3).

The present proceeding is a reexamination proceeding; thus, the petition does not require a terminal disclaimer.[2]

Accordingly, the supplemented February 22, 2012 petition to revive is **granted**.

The February 10, 2012 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 December 1, 2011 Office action is **withdrawn**.

## CONCLUSION

1. The supplemented February 22, 2012 petition under 37 CFR 1.137(b) is **granted**.

2. The February 10, 2012 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 December 1, 2011 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 March 6, 2012 Proposed Amendment and Response as to each of the rejections set forth in the December 1, 2011 Office action or (ii) the March 6, 2012 Proposed Amendment and 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

04/09/2012

| | |
|---|---|
| **Doc Code: PET.AUTO**<br>**Document Description: Petition automatically granted by EFS-Web** | PTO/SB/83<br>U.S. Patent and Trademark Office<br>Department of Commerce |

| | |
|---|---|
| Electronic Petition Request | **REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS** |
| Application Number | 90011847 |
| Filing Date | 04-Aug-2011 |
| First Named Inventor | Alan Drizen |
| Art Unit | 3991 |
| Examiner Name | |
| Attorney Docket Number | 033083.0009-US05 |
| Title | TOPICAL DRUG PREPARATIONS |

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 20529

The reason(s) for this request are those described in 37 CFR:

10.40(b)(4)

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 | GLYCOBIOSCIENCES INC. |
| Address | 129 MAIN STREET SOUTH |
| City | GEORGETOWN, ONTARIO |
| State | |
| Postal Code | L7G 3E5 |
| Country | CA |

| I am authorized to sign on behalf of myself and all withdrawing practitioners. | |
|---|---|
| Signature | /Tanya E. Harkins/ |
| Name | Tanya E Harkins |
| Registration Number | 52993 |

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 : August 23,2011

In re Application of :

Alan Drizen

Application No : 90011847

Filed : 04-Aug-2011

Attorney Docket No : 033083.0009-US05

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 August 23,2011

The request is **APPROVED.**

The request was signed by Tanya E Harkins (registration no. 52993 ) on behalf of all attorneys/agents associated with Customer Number 20529 . All attorneys/agents associated with Cusotmer Number 20529 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 GLYCOBIOSCIENCES INC.
Name2
Address 1 129 MAIN STREET SOUTH
Address 2
City GEORGETOWN, ONTARIO
State
Postal Code L7G 3E5
Country CA

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

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

VAN OPHEM & VANOPHEM, PC
REMY J VANOPHEM, PC
51543 VAN DYKE
SHELBY TOWNSHIP, MI 48316-4447

(For Patent Owner)

**MAILED**

**APR 16 2012**

**CENTRAL REEXAMINATION UNIT**

PRICE HENEVELD LLP
695 KENMOOR SE
P O BOX 2567
GRAND RAPIDS MI 49501

(Courtesy Copy)

MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA, FIFTH FLOOR
720 WATER STREET
TOLEDO, OHIO 43604

(For Requester)

*In re Chase*
Control No. 90/011,849
Filed: August 5, 2011
For: U.S. Patent No. 5,597,213

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181**

The paper filed by requester on November 21, 2011, styled as "Petition to Reconsider The Examiner's Decision To Deny Reexamination Pursuant To 37 CFR 1.181 and 37 CFR 1.515(c)," is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Determination Denying Request for *Ex Parte* Reexamination, dated October 21, 2011. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the cited references.

The November 21, 2011 petition is denied for the reasons set forth below.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 5,597,213 (hereinafter, the '213 patent) issued on January 28, 1997.

2. On March 3, 2009, a third party requester, Hayes Lemmerz International, Inc., filed a request for *ex parte* reexamination of claims 11-13, 20, 24, and 25 of the '213 patent. The resulting reexamination proceeding was assigned Control No. 90/009,422 (hereinafter, the '422 proceeding). The request was based on the following prior art references:

- U.S. Patent No. 3,726,566 to Beith et al. ("Beith")
- Japanese Patent Publication No. 3-136901 to Takahashi ("Takahashi")
- German Patent Publication No. 4321057 to Chase ("Chase DE '057"), corresponding to U.S. Pat. No. 5,636,906 ("Chase '906")
- U.S. Patent No. 3,517,968 to Tully et al. ("Tully")
- U.S. Patent No. 5,368,370 to Beam ("Beam")

3. On May 1, 2009, an order granting reexamination of claims 11-13, 20, 24, and 25 was mailed. The order granted reexamination based upon a new teaching of "at least one void being present between said overlay and said outboard surface of said wheel" raised by Beith, Takahashi, Tully, and Chase DE '057.

4. On June 12, 2009, the patent owner filed a statement under 37 CFR 1.530.

5. On August 12, 2009, the requester filed comments on the patent owner's statement. The comments addressed claim interpretation, including the "permanently secure" limitation (see pages 4-12 of the comments). Specifically, the requester commented on the disclosure of Chase '213, and how the teachings of Beith, Takahashi, Chase DE '057, Tully, and Beam apply to this limitation. See pages 8-12 of the comments.

6. On February 5, 2010, the Office mailed a first Office action, which contained rejections of claims 11-13, 20, 24, and 25 based on Beith, Takahashi, and Chase DE '057.

7. The prosecution in the '422 proceeded. On June 10, 2011, the Board of Patent Appeals and Interferences (BPAI) issued a decision that reversed the examiner's rejections based on Beith and Chase DE '057.

8. On August 5, 2011, the same third party requester deposited a second request for *ex parte* reexamination, and the resulting reexamination proceeding was assigned Control No. 90/011,849 (hereinafter, the '849 proceeding). Reexamination was requested for claims 11-13, 20, 24, and 25 of the '213 patent. ). The request was based on the following prior art references:

- Beith
- Chase DE '057
- Tully

9. On August 17, 2011, a Notice of Reexamination Request Filing Date was mailed in the '849 proceeding.

10. On August 19, 2011, a Notice of Intent to Issue an *Ex Parte* Reexamination Certificate was mailed in the '422 proceeding. Claims 11-13, 20, 24, and 25 were confirmed.

11. On October 4, 2011, the reexamination certificate was published in the '422 proceeding.

12. On October 21, 2011, a determination denying the request for reexamination for claims 11-13, 20, 24, and 25 was mailed in the '849 proceeding.

13. On November 21, 2011, the third party requester filed the above-mentioned petition under 37 CFR § 1.181 in the '849 proceeding.

## Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges ten grounds for which petitioner feels the examiner erred in not finding that a substantial new question of patentability (SNQ) exists. In support of their showing that the examiner's finding that the references cited do not present a substantial new question of patentability is unreasonable, the petitioner advances the following grounds to be reviewed:

1. Whether the Examiner erred by incorrectly applying the Board' s claim construction relating to the "capability" of the adhesive alone to permanently secure, with or without additional fastening means;
2. Whether the Examiner erred by interpreting the term "curable adhesive" of Chase '213 to be a single adhesive, precluding an "additional" second adhesive;
3. Whether the Examiner erred by failing to properly apply the correct interpretation standards (i.e. implicit teachings and an obviousness determination) and failing to consider the declaration evidence of Joseph Guzek or explain how the declaration fails to rebut a *prima facie* case;
4. Whether the Examiner erred by concluding that Tully Fig. 3 always requires a mechanical snap-in retention at the outer lip and that, therefore, Tully does not disclose an "all adhesive" embodiment;
5. Whether the Examiner erred by not considering evidence that the specific Tully adhesive and pattern is alone "capable" of permanently securing, with or without the mechanical snap-in retention;
6. Whether the Examiner erred by concluding that Chase '906 requires the fastener to always be used in combination with adhesive to permanently secure and therefore does not teach using adhesive alone;
7. Whether the Examiner erred by concluding the two adhesive embodiment of Chase '906 (i.e., adhesive replaces the fastener 40 + adhesive 30) does not meet the Chase '213 claims;

8. Whether the Examiner erred by not considering evidence that the specific Chase '906 adhesive and pattern is alone "capable" of permanently securing, with or without the fastener 40
9. Whether the Examiner erred by concluding that Beith Fig. 3 discloses that all adhesive can be eliminated and that the mechanical securing means can be used alone;
10. Whether the Examiner erred by not considering evidence that the specific Beith adhesive and pattern is alone "capable" of permanently securing, with or without the additional fastening means (gripping lip 43).

In summary, petitioner's arguments rely upon establishing a "new light" to the "old prior art" references of Beith, Chase DE '507, and Tully in order to support a substantial new question of patentability.

## 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 11-13, 20, 24, and 25 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 11-13, 20, 24, and 25 of the '213 patent. The review will not consider evidence or proposed rejections not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition such as the supplemental Guzek declaration first filed with 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.

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.**

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 states that:

> No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

---

[1] Public Law 96-517, enacted on December 12, 1980.

> The decision denying the request will then indicate, 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.
>
> The examiner should also, in 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**

The request fails to raise a substantial new question of patentability based on the Tully, Chase DE '057, and Beith references that is different from patentability issues raised in the prior prosecution proceedings.

The request for reexamination, dated August 5, 2011, stated that a substantial new question of patentability (SNQ) existed for claims 11-13, 20, 24, and 25 of the '213 patent based upon Tully, Chase DE '057, and Beith references, which are the same references cited in the request in the '422 reexamination proceeding. As previously mentioned, the CRU Director's review of the reexamination request on petition is *de novo* review of the request dated August 5, 2011. The request for reexamination did not contain the supplemental Guzek declaration first filed with the petition or the proposed obviousness rejection based on Tully alone. Accordingly, as such evidence or proposed rejection was not before the examiner because it was not of record in the request for reexamination, such evidence or proposed rejection will not be considered during this *de novo* review. Each ground raised by the petition will be addressed below.

The legal standard for granting a request for reexamination is stated above in section II. 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." MPEP 2216 specifically states:

> "It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested."

In other words, the consideration under 35 U.S.C. 303 of a request for reexamination is limited to prior art patents and printed publications. See MPEP 2244 and 2258. Therefore, the focus of a SNQ inquiry is the asserted teachings of the prior art references.

Upon review of the request, the SNQ analysis is provided on pages 39-43 of the request. Page 39 of the request recognizes that a second request for reexamination must present a different substantial new question of patentability in order for the second request to be granted. Pages 40-43 of the request explain the requester's asserted new technical teaching of the "old prior art" references of Tully, Chase DE '507, and Beith. The requester's asserted new technical teaching relies upon asserted new "implicit" teachings found in of the "old prior art" references of Tully, Chase DE '507, and Beith. As will be discussed in further detailed below, this showing fails to raise a SNQ for claims 11-13, 20, 24, and 25 of the '213 patent.

A. Grounds 1 and 2: Claim Interpretation

Petitioner alleges that the examiner incorrectly read a further limitation in the BPAI's construction of the permanently secure limitation. Specifically, petitioner argues that the BPAI only required that the adhesive alone must be capable of permanently securing, but not that it must do so without the presence of an additional fastening means. See pages 10-11 of the petition. Petitioner also alleges that the examiner erred by incorrectly interpreting the term "curable adhesive" to be a single adhesive. See page 11 of the petition.

The explanation of the requester's asserted new technical teachings does not explicitly include claim construction of the permanently secured limitation except for reference to the "Board's narrower BRI ruling." In the determination that denied reexamination, the examiner substantially quoted from the BPAI's June 10, 2011 decision in the '422 proceeding. In particular, the examiner quoted sections of the fact finding and claim construction of the permanently secured limitation. See, e.g., pages 4-5 of the determination. Upon review of the records, the examiner appropriately identified the patentability issues raised and answered in the prior reexamination proceeding. The BPAI decision is clear that its claim construction of the permanently secured limitation is that adhesive alone must be capable of permanently securing the overlay to the wheel. See pages 9 and 10 of the BPAI decision in the '422 proceeding. Moreover, in their discussion regarding Beith and Chase[2], the decision is clear that the presence

[2] The BPAI decision identifies "Chase '906." However, the rejection being appealed was based on

of any mechanical fastener providing part of the permanently secured function or the absence of a clear teaching that the adhesive alone is capable of providing permanent attachment does not meet the permanently secured limitation as interpreted by the BPAI. See pages 10 and 11 of the June 10, 2011 BPAI decision in the '422 proceeding. In addition, requester addressed the issues of the permanently secured limitation and the application of Tully, Chase DE '507 and Beith to this limitation in their comments to the patent owner's statement on pages 4-12 in the August 12, 2009 paper in the '422 proceeding. In other words, the record of the '422 proceeding is clear that substantially the same patentability issues (e.g., whether Chase DE '507, Tully, and Beith teach the permanently secured limitation) was considered and decided in favor of the patent owner. In regard to the assertion that the examiner erred by incorrectly interpreting the term "curable adhesive" to be a single adhesive, as stated above, a review of the records finds that the issue of whether Chase DE '507 teaches the permanently secured limitation was already raised and answered in the '422 proceeding. Specifically, the BPAI addressed Chase's teaching of replacing the mechanical fastener 40 with an adhesive. See page 11 and FF14 of the BPAI decision in the '422 proceeding. The BPAI found this teaching insufficient to teach the permanently secured limitation because Chase does not disclose whether the adhesive used to replace the mechanical fastener was permanent or in what manner the adhesive would be applied. While the statement spanning pages 10-11 of the determination denying reexamination may not be artfully stated, this statement does not alter the fact that the BPAI already considered and answered the same patentability issue. In other words, the primary issue to be determined is whether the second request raised new substantial patentability issues, and not whether the examiner accurately summarized the analysis of the BPAI in the prior '422 proceeding.

Upon review, the determination denying reexamination was consistent with the claim construction in the BPAI decision in its finding that Tully, Chase DE '507 and Beith fail to raise a SNQ. Specifically, the examiner correctly found that Tully, Chase DE '507, and Beith do not teach the permanently secured limitation because none of the references contain a clear teaching that the adhesive alone is capable of providing permanent attachment for the reasons that will be further discussed below. In addition, the determination denying reexamination correctly concluded that the substantially the same issues were raised and answered in the '422 proceeding. The Guzek Declaration, as discussed in subsections below, fails to support requester's SNQ assertions.

B. Ground 3: The Guzek Declaration

Petitioner generally alleges that the examiner applied improper claim construction and improperly failed to consider the Guzek declaration. See pages 11-12 of the petition.

Petitioner's arguments for this ground focus on their assertion that the prior prosecution failed to consider the "implicit" disclosure of the cited prior art, and does not explicitly address claim

---

Chase DE '507 and used Chase '906 as an English-language equivalent as noted in footnote 1 on page 3 of the BPAI decision. Therefore, it is assumed that the BPAI decision meant to refer to Chase DE '507 as the basis for the rejection, using Chase '906 as a translation for Chase DE '507.

interpretation or the Guzek declaration. As will be discussed in further detailed below, the requester's assertion that "implicit" teachings found in of the "old prior art" references of Tully, Chase DE '507, and Beith raise new technical teachings is not sufficient to establish a SNQ. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. See MPEP 2112. Therefore, consideration of "implicit" teachings is applicable to an anticipation analysis, and is not reserved for only an obviousness analysis, as argued by petitioner. In summary, the record does not support petitioner's assertion that the prior examination proceedings failed to consider "implicit" teachings because the record shows that the same patentability issues and the same portions of the same references were considered in the prior '422 proceeding.

Subsection A above addressed the claim interpretation issues.

The Guzek declaration will be discussed to answer arguments raised in the subsections below. Generally, the Guzek declaration was filed to support a *prima facie* showing of obviousness, which is not an issue that is decided until after it is determined whether an SNQ is raised in order to confer jurisdiction to the Office to order reexamination. See MPEP 2240, which states "[a] determination as to patentability/unpatentability of the claims is not made in the decision on the request; rather, this determination will be made during the examination stage of the reexamination proceedings if reexamination is ordered." As stated above, the request asserts SNQs on page 39-43 of the request, but fails to mention the Guzek declaration to support the asserted SNQs, except for a single citation on page 43 of the request. It is also noted that the petition clearly applies the Guzek declaration as evidence to support a *prima facie* case of unpatentability. See Issue 3 on pages 5 and 6. As stated above, the Guzek declaration will be addressed further below.

C. Grounds 4 and 5: Tully

Petitioner alleges that the examiner incorrectly determined that Tully's Figure 3 embodiment requires a mechanical snap-in fastener (Ground 4) and failed to consider the Guzek declaration (Ground 5). See pages 12-25 of the petition.

The record is clear that Tully was cited in the first request for reexamination in the '422 proceeding and that an order determined that Tully raised a SNQ. The record is also clear that patent owner presented arguments against the application of Tully in the patent owner's statement filed on June 12, 2009. The record also shows that requester (petitioner) commented on patent owner's statement on August 12, 2009 and specifically addressed the teachings of Tully in regard to the permanently secured limitation, as discussed above.

The determination denying reexamination in the '849 proceeding found that (1) Tully requires use of a mechanical fastener and (2) Tully's teaching are essentially cumulative to Beith's and Chase's teachings, which the BPAI determined fail to meet the permanently secured limitation. For these reasons, the determination held that Tully fails to raise a SNQ.

Upon review of the record, the examiner properly determined that Tully failed to raise a SNQ. The evidence and explanation, as set forth in the request dated August 5, 2011, simply does not support ordering a request for reexamination. Tully, as presented in the August 5, 2011 request, does not present sufficient evidence to show a new technical teaching that was not already considered in the prior '422 proceeding. As stated above, the teachings of Chase and Beith were extensively considered and applied in a rejection in a previous examination. The claims of the '213 patent were confirmed when the BPAI made specific findings that Chase and Beith did not teach the permanently secured limitation. Tully's teaching of adhesive bead 52 is not enough to create a new light or new information compared to the teachings of Beith and Chase, which are pre-existing technology already considered. Specifically, Tully's teaching of adhesive bead 52 does not replace the mechanical snap-in fastener as evidence by Figures 2 and 3, which both show flange 36, outer edge 38, and outwardly flared edge 40 that form the "snap-in" arrangement (see column 2 lines 55-58). In addition, bead 50 "... having good sealing qualities and resiliency after curing," or ring 32 in the alternatively embodiment provide to a compression-friction type seal, which is a mechanical fastener. See column 3 lines 25-30 of Tulley. Even if petitioner's interpretation of the disclosure in column 3 lines 47-51 of Tully is correct, Tully requires the mechanical compression fit provided by bead 50 (or ring 32). For these reasons, the examiner correctly determined that Tully's teachings required a mechanical fastener in addition to adhesive to provide a permanent attachment. Therefore, Tully's teachings of using both an adhesive and a mechanical fastener to provide permanent attachment is substantially similar to Beith's teachings, which were raised and considered during the previously examination.

In the petition, requester argues that Tully's disclosure in column 3 lines 15-52 supports their assertion that Figure 3 is an "all-adhesive" embodiment. Specifically, petitioner cites to the phrase "[i]n a similar manner" in column 3 line 31 of Tully and interprets it as meaning that bead 52 replaces the snap-fit assembly of flange 36, 40 and edge 38. However, it is more plausible that the transition phase is stating that bead 52 is similar to bead 50, which is a bead of a resilient adhesive material. Petitioner also argues that the sentence in column 3 lines 47-51 of Tully (quoted on page 16 of the petition) means that bead 52 replaces the snap-fit assembly of flange 36, 40 and edge 38. However, as discussed above, Figure 3 clearly shows the same "snap-fit" arrangement. Therefore, it is consistent to interpret this sentence, as the examiner did, that it is a teaching that the bead 52 is used in conjunction with, and not as a substitute for, the "snap-in" arrangement.

In regard to the Guzek declaration, as discussed above in subsection B, the SNQ showing did not explicitly invoked or cite to the Guzek declaration for support for this asserted SNQ. In addition, the Guzek declaration is replete with opinion evidence and conclusions as to the ultimate legal evaluation of patentability. See, for example, paragraphs 13-22, 25-28, 31, 32, and 35. In other words, the Guzek declaration goes beyond merely explaining the contents of the cited references, as permitted by the policy set forth in MPEP 2216, but instead attempts to expand the disclosure of the references by importing the declarant's opinion. See MPEP 716.01(c). Specifically, the Guzek declaration does more than merely explain terms disclosed in the patents or presenting

objective, factual evidence as to the knowledge and skill of one of ordinary skill in the art at the time the invention was made. For example, the Guzek declaration fails to provide any objective, factual evidence that Tully teaches an "all-adhesive" embodiment that is sufficient to raise a "new" and "substantial" question of patentability. Paragraphs 25 and 27 conclude that Figure 3 of Tully shows an "all-adhesive" attachment, but the declaration fails to provide any facts to support such a conclusion. However, as discussed in the paragraph above, the disclosure of Tully shows the same "snap-in" arrangement in both Figures 2 and 3. Therefore, the conclusions drawn in the Guzek declaration that Figure 3 of Tully is an "all-adhesive" embodiment are not supported by the disclosure of Tully. In addition, reexamination laws require that the new technical teaching to support a SNQ must be found in a patent or printed publication. In other words, the new technical teaching must be found in Tully, Beith, or Chase and not in a declaration, which is not a printed publication, or the declaration must present the references in a new light. As explained above, the Guzek declaration did not present the teachings of Tully in a new light. For these reasons, the examiner did not err in not explicitly addressing the Guzek declaration.

As stated above, this decision will not address the supplemental Guzek declaration, arguments based on such newly filed evidence, or the new proposed obviousness rejection based on Tully because they were not present in the request for reexamination.

Accordingly, the limited teachings of Tully are not sufficiently clear to rise to the level where a reasonable examiner would consider these teachings important in light of the entire record of the previous examinations. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, because Tully, as presented in the August 5, 2011 request, does not provide a new light or a new technical teaching, a request for reexamination cannot be granted based on Tully.

D. Grounds 6-8: Chase DE '057 (using Chase '906 as an English language equivalent)

Petitioner alleges that the examiner incorrectly determined that Chase requires a mechanical fastener (Ground 6), and applied improper claim construction to "curable adhesive" (Ground 7) and the permanently secured limitation (Ground 8). See pages 25-36 of the petition.

Chase DE '057 was considered and applied in a rejection during the prosecution of '422 proceeding. Specifically, the teachings of Chase DE '057, as translated using Chase "906, were applied against the claims in a rejection and the rejection was overcome by arguments. The request for reexamination, dated August 5, 2011, also relies upon substantially the same teachings of Chase DE '057 to establish a substantial new question of patentability. The request asserts that certain "implicit" disclosures of Chase DE '057 raise a SNQ. Specifically, the

request states that the prior examination never considered Chase's implicit teaching that adhesive alone is capable of permanently securing. See page 41 of the request.

Upon review, the request for reexamination relies upon (1) the similarity of structure between fastener 40 in Chase DE '057 and fastener 220a in the '213 patent; (2) the disclosure of permanent adhere by adhesive 30 in column 8 lines 3-7; and (3) the disclosure of the "two-adhesive" embodiment where an adhesive may be used in place of fastener 40. See pages 41-42 of the request. The October 21, 2011 determination found that BPAI already considered and addressed each of the three allegedly new "implicit" disclosures. See pages 10-11 of the determination.

Upon review of the record, the examiner properly determined that Chase DE '057 failed to raise a SNQ. The evidence and explanation, as set forth in the request dated August 5, 2011, simply does not support ordering a request for reexamination. Chase DE '057, as presented in the August 5, 2011 request, does not present sufficient evidence to show a new technical teaching that was not already considered in the prior '422 proceeding. As stated above, the teachings of Chase and Beith were extensively considered and applied in a rejection in a previous examination. The claims of the '213 patent were confirmed when the BPAI made specific findings that Chase and Beith did not teach the permanently secured limitation. Upon review of the BPAI decision, the BPAI considered the disclosure of the '213 patent in its construction of the permanently secured limitation, including the meaning of temporary securing mechanisms. See, e.g., pages 5-6 of the decision. Therefore, the record shows that the BPAI considered the disclosure of the temporary fastener in the '213 patent. See FFs 12, 13, and 15 on page 8 and page 11. Specifically, the BPAI recognized that the '213 taught the use of a temporary fastener or other fasteners, but held that the "recited curable adhesive alone must be capable of permanently securing the overlay to the wheel." See the last sentence on page 9 of the BPAI decision. In other words, the temporary adhesive taught in the '213 patent is not the "recited curable adhesive" but may be used in combination with the "recited curable adhesive." Therefore, the presence of a temporary adhesive taught in the disclosure of the '213 patent fails to raise any "new" and "substantial" questions of patentability. The decision also considered the disclosure of "permanent adhere." Finally, the record shows that the BPAI considered the disclosure of the "two adhesive" embodiment. See FF 14 on page 8 and page 11. In addition, as mentioned above, express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under **35 U.S.C. 102** or 103. See MPEP 2112. Therefore, consideration of "implicit" teachings is applicable to an anticipation analysis, and is not reserved for only an obviousness analysis, as argued by petitioner. 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**. See, e.g., pages 27-28 of the petition. In this case, the record shows that requester petitioner is requesting reexamination based the same patentability issues based on Chase DE '057 that were already decided in favor of the patent owner. In other words, the request fails to show any "new" and "substantial" questions of patentability that has not already been raised and answered in the prior examination.

In the petition, requester argues that the translated claim 1 of Chase DE '507 supports their assertion that Chase DE '507 only requires an adhesive and not any mechanical fastening means. However, claim 1 is an open-ended claim, which does not exclude the use of a mechanical fastening means. In addition, claim 1 does not state that the adhesive alone permanently attaches the panel to the wheel. Finally, the disclosure of Chase DE '507 must be read as a whole, as understood by one skilled in the art at the time the invention was made. Therefore, the fact that the inventor chose not to claim a mechanical fastening means in claim 1 is not determinative of the issue. In fact, the BPAI decision in the '422 proceeding recognized that Chase taught an embodiment in which fastener 40 is replaced by an adhesive and still determined that this teaching was not sufficient to meet the permanently secured limitation of the '213 patent claims. See also subsection A, which addressed arguments pertaining to the claim construction.

In regard to the Guzek declaration, as discussed above in subsection B, the SNQ showing did not explicitly invoked or cite to the Guzek declaration for support. In addition, the Guzek declaration is replete with opinion evidence and conclusions as to the ultimate legal evaluation of patentability. See, for example, paragraphs 35, 36, 38-40, 42, 43, and 46. As discussed above in subsection C, the Guzek declaration goes beyond merely explaining the contents of the cited references, as permitted by the policy set forth in MPEP 2216, but instead attempts to expand the disclosure of the references by importing the declarant's opinion. See MPEP 716.01(c). Specifically, the Guzek declaration does more than merely explaining terms disclosed in the patents or presenting objective, factual evidence as to the knowledge and skill of one of ordinary skill in the art at the time the invention was made. For example, the Guzek declaration fails to provide objective, factual evidence that is sufficient to raise a "new" and "substantial" question of patentability. As discussed above, the record is clear that the prior '422 proceeding thoroughly considered the teachings of Chase DE '507 (and Chase '906) as applied to the permanently secured limitation. The Guzek declaration only provides a different opinion on issues already decided in the prior examination. In addition, reexamination laws require that the new technical teaching to support a SNQ must be found in a patent or printed publication. In other words, the new technical teaching must be found in Tully, Beith, or Chase and not in a declaration, which is not a printed publication, or the declaration must present the references in a new light. As explained above, the Guzek declaration did not present the teachings of Chase DE '507 in a new light. For these reasons, the examiner did not err in finding that Chase DE '507 failed to raise a SNQ.

As stated above, this decision will not address the supplemental Guzek declaration or arguments based on such newly filed evidence because they were not present in the request for reexamination.

Accordingly, the request fails to bring a new light to the previously considered teachings of Chase DE '507. In other words, the request does not present a new light to Chase DE '507 that rises to the level where a reasonable examiner would consider these teachings important in light of the entire record of the previous examinations. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to

raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, because Chase DE '507, as presented in the August 5, 2011 request, does not provide a new light or a new technical teaching, a request for reexamination cannot be granted based on Chase DE '507.

E. Grounds 9 and 10: Beith

Petitioner alleges that the examiner incorrectly determined that Beith's teaching regarding the use of the adhesive (Ground 9), and applied improper claim construction to the permanently secured limitation (Ground 10). See pages 26-47 of the petition.

Beith was considered and applied in a rejection during the prosecution of '422 proceeding. Specifically, the teachings of Beith were applied against the claims in a rejection and the rejection was overcome by arguments. The request for reexamination, dated August 5, 2011, also relies upon substantially the same teachings of Beith to establish a substantial new question of patentability. The request asserts that certain "implicit" disclosures of Beith raise a SNQ. Specifically, the request states that the prior examination never considered Beith's implicit teaching that adhesive alone is capable of permanently securing. See pages 42-43 of the request.

Upon review, the request for reexamination relies upon Beith's disclosure that (1) the "implicit" disclosure that the adhesive alone is capable of permanently securing the panel; and (2) the lag bolt and nut means 18 function in "the usual manner" as new teachings that the BPAI did not consider in the determination that Beith did not teach the permanently secured limitation. See pages 42-43 of the request. The October 21, 2011 determination found that (1) the "implicit" disclosure was not sufficient to raise a SNQ because it was not consistent with the explicit teachings of Beith; and (2) BPAI's decision on did not hinge on the function of the lug bolts. See page 12 of the determination. The determination concluded that the request failed to present the teachings of Beith in a new light or present any substantial new patentability issues that were not already addressed in the '422 proceeding.

Upon review of the record, the examiner properly determined that Beith failed to raise a SNQ. The evidence and explanation, as set forth in the request dated August 5, 2011, simply does not support ordering a request for reexamination. Beith, as presented in the August 5, 2011 request, does not present sufficient evidence to show a new technical teaching that was not already considered in the prior '422 proceeding. As stated above, the teachings of Chase and Beith were extensively considered and applied in a rejection in a previous examination. The claims of the '213 patent were confirmed when the BPAI made specific findings that Chase and Beith did not teach the permanently secured limitation. Upon review of the BPAI decision, the BPAI considered the disclosure of Beitch in regard to the permanently secured limitation. See, e.g., pages 6-8 and 10 of the decision. Specifically, the BPAI recognized that Beith's teaching of the adhesive will permanently fix the wheel cover to the wheel in discussing Figure 3. See FFs 6

and 9 and page 10 of the decision. However, the BPAI decided that this teaching was not sufficient to teach the permanently secured limitation of the claims of the '213 patent. In addition, the discussion on page 10 does not rely on the lug bolt 18 performing any function that is outside its usual manner of functioning. Therefore, the record shows that the BPAI considered the disclosure that the adhesive alone is capable of permanently securing the panel in its decision that Beith failed to teach the permanently secure limitation, which did not rely upon the lug bolt 18 performing any function except its usual function. In addition, as mentioned above, express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under **35 U.S.C. 102** or 103. See MPEP 2112. Therefore, consideration of "implicit" teachings is applicable to an anticipation analysis, and is not reserved for only an obviousness analysis, as argued by petitioner. 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**. See, e.g., page 39 of the petition. In this case, the record shows that requester petitioner is requesting reexamination based the same patentability issues based on Beith that were already decided in favor of the patent owner. In other words, the request fails to show any "new" and "substantial" questions of patentability that has not already been raised and answered in the prior examination.

In the petition, requester argues the examiner misconstrued Beith's disclosure regarding the phrase "without placing adhesive therebetween" in column 5 lines 55-60. However, the examiner's interpretation is consistent with the BPAI decision that used this disclosure (FF 8 on page 7 of the BPAI decision) as support for the following statement: "Indeed, Beith further discloses that should the gripping lips of the wheel cover (the multiple flanged portion) be tightly nested with the tire mounting rim of the wheel, then the adhesive may be eliminated." See page 10 of the BPAI decision. Specifically, as mentioned by the examiner in the determination denying reexamination, the BPAI found that Beith teaches that "... if multi-flanged tire mounting rim 21 and multiple flanged portion 50 next tightly together, an authentically appearing and sounding wheel structure 11 can be obtained without placing adhesive 48 therebetween." See FF 8 on page 7 of the BPAI decision. Whether or not "all" of the adhesive is eliminated is not determinative of the SNQ inquiry. The critical question is whether the issue of Beith's teachings in regard to the permanently secured limitation has been considered. Upon review of the '422 proceeding, the record clearly shows that this patentability issued has been raised and answered in favor of the patent owner. Therefore, the request is asking, in essence, for a review of the basis for the BPAI decision in the prior '422 reexamination proceeding. Such a request is clearly outside the scope of reexamination. In addition, the BPAI decision recognized the teachings regarding the lug bolt 18, but did not solely rely upon the lug bolts as the only mechanical fastener. Specifically, as mentioned by the examiner in the determination denying reexamination, the BPAI found that the adhesive "... together with the gripping lips of the wheel cover permanently and rigidly fix the wheel cover to the wheel." See FF 5 on page 6 of the BPAI decision. Therefore, the BPAI determined that Beith teaches a mechanical fastener other than the lug bolts 18. Furthermore, the BPAI decision cited to column 6 lines 1-32 in FF 6 that includes the disclosure that "... these additional lips 49 and 51 grip respectively the edges of

the hub aperture 16 and each lug bolt aperture 17 of the wheel 13 and, thereby, further aid in fixing the wheel cover 12 to the wheel 13. See column 6 lines 13-16 of Beith. In other words, Beith contains an explicit disclosure that the lug bolts aid in fixing the wheel cover to the wheel. Therefore, the record clearly shows that this patentability issued has been raised and answered in favor of the patent owner. See also subsection A, which addressed arguments pertaining to the claim construction.

In regard to the Guzek declaration, as discussed above in subsection B, the declaration is replete with opinion evidence and conclusions as to the ultimate legal evaluation of patentability. See, for example, paragraphs 56-58 and 60. As discussed above in subsection C, the Guzek declaration goes beyond merely explaining the contents of the cited references, as permitted by the policy set forth in MPEP 2216, but instead attempts to expand the disclosure of the references by importing the declarant's opinion. See MPEP 716.01(c). Specifically, the Guzek declaration does more than merely explaining terms disclosed in the patents or presenting objective, factual evidence as to the knowledge and skill of one of ordinary skill in the art at the time the invention was made. For example, the Guzek declaration fails to provide objective, factual evidence that is sufficient to raise a "new" and "substantial" question of patentability. As discussed above, the record is clear that the prior '422 proceeding thoroughly considered the teachings of Beith as applied to the permanently secured limitation. The Guzek declaration only provides a different opinion on issues already decided in the prior examination. In addition, reexamination laws require that the new technical teaching to support a SNQ must be found in a patent or printed publication. In other words, the new technical teaching must be found in Tully, Beith, or Chase and not in a declaration, which is not a printed publication, or the declaration must present the references in a new light. As explained above, the Guzek declaration did not present the teachings of Beith in a new light. For these reasons, the examiner did not err in finding that Beith failed to raise a SNQ.

As stated above, this decision will not address the supplemental Guzek declaration or arguments based on such newly filed evidence because they were not present in the request for reexamination.

Accordingly, the request fails to bring a new light to the previously considered teachings of Beith. In other words, the request does not present a new light to Beith that rises to the level where a reasonable examiner would consider these teachings important in light of the entire record of the previous examinations. In accordance with the legislative history of legislation concerning reexamination, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. Accordingly, because Beith, as presented in the August 5, 2011 request, does not provide a new light or a new technical teaching, a request for reexamination cannot be granted based on Beith.

In summary, the request dated August 5, 2011 does not support ordering a request for reexamination for the above-mentioned reasons. The determination to deny the request for reexamination is consistent with the legislative history as discussed above. Petitioner can still avail themselves of the *ex parte* reexamination proceeding, if petitioner can formulate a request that brings forth some new technological information that was not consider in a previous examination.

As explained in the determination denying reexamination, 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.

## CONCLUSION

1. Given the facts involved in this proceeding, the request for *ex parte* reexamination of claims 11-13, 20, 24, and 25 of the '213 patent was properly denied by the examiner.

2. Accordingly, the PETITION is DENIED.

3. This decision is final and nonappealable. 35 USC 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

4. Telephone inquiries related to this decision should be directed to Eileen Lillis, Supervisory Patent Examiner, at (571) 272-6928, or Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Central Reexamination Unit

| | |
|---|---|
| **Doc Code: PET.AUTO**<br>**Document Description: Petition automatically granted by EFS-Web** | PTO/SB/83<br>U.S. Patent and Trademark Office<br>Department of Commerce |

| | |
|---|---|
| Electronic Petition Request | **REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS** |
| Application Number | 90011850 |
| Filing Date | 08-Aug-2011 |
| First Named Inventor | 7219902 |
| Art Unit | 3993 |
| Examiner Name | SARA CLARKE |
| Attorney Docket Number | 9279.222 |
| Title | Flexible Travel Bag with Integrated Support to Protect Bag from Wear |

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 87457

The reason(s) for this request are those described in 37 CFR:

10.40(c)(5)

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 | Jeffrey C. Herold, West Coast Trends |
| Address | 17811 Jamestown Lane |
| City | Huntington Beach |
| State | CA |
| Postal Code | 92647 |
| Country | US |

| I am authorized to sign on behalf of myself and all withdrawing practitioners. | |
|---|---|
| Signature | /Edward J Marshall/ |
| Name | Edward J Marshall |
| Registration Number | 45395 |

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 : October 19,2011

In re Application of :

7219902

Application No : 90011850

Filed : 08-Aug-2011

Attorney Docket No : 9279.222

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 October 19,2011

The request is **APPROVED.**

The request was signed by Edward J Marshall (registration no. 45395 ) on behalf of all attorneys/agents associated with Customer Number 87457 . All attorneys/agents associated with Cusotmer Number 87457 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 | Jeffrey C. Herold, West Coast Trends |
| Name2 | |
| Address 1 | 17811 Jamestown Lane |
| Address 2 | |
| City | Huntington Beach |
| State | CA |
| Postal Code | 92647 |
| 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

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. |
|---|---|---|---|---|
| 90/011,859 | 08/13/2011 | 7878909 | AMER-0010 | 1055 |

101952 7590 03/23/2012

Osborne Law LLC
33 Habitat Lane
Cortlandt Manor, NY 10567

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/23/2012

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. |
|---|---|---|---|---|
| 90/011,915 | 09/22/2011 | 7878909 | 010006-003 | 1042 |

101952 7590 03/23/2012

Osborne Law LLC
33 Habitat Lane
Cortlandt Manor, NY 10567

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WINSTEAD PC
P.O. BOX 50784
DALLAS, TX 75201

Date: MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011859
PATENT NO. : 7878909
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Daphne L. Burton
BURTON IP LAW GROUP
2029 Century Park East, Suite 1400
Los Angeles, CA 90067

Date:

MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011915
PATENT NO. : 7878909
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John W. Osborne
OSBORNE LAW LLC
33 Habitat Lane
Cortlandt Manor NY 10567

(For Patent Owner)

MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

Jeffrey A. Tinker
WINSTEAD PC
P.O. Box 50784
Dallas, TX 75201

(For Third Party Requester)

Daphne L. Burton
BURTON IP LAW GROUP
2029 Century Park East; Suite 1400
Los Angeles, CA 90067

(For Third Party Requester)

*In re* Kessman et al.
*Ex Parte* Reexamination Proceedings
Control No. 90/011,859
Control No. 90/011,915
For U.S. Patent No. 7,878,909

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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,878,909 [hereinafter "the '909 patent"] was granted to Kessman et al. on 01 February 2011.

- On 13 August 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,859 [hereinafter "the '11859 proceeding"].

- On 29 September 2011, patent owner did not agree to waive Patent Owner's Statement in the '11859 proceeding.

- On 24 October 2011, the Office issued an order granting *ex parte* reexamination of claims 1-26 in the '11859 proceeding.

- On 22 December 2011, patent owner filed a Patent Owner's Statement in response to the order in the '11859 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 22 February 2012, the first third party timely filed comments to Patent Owner's Statement in the '11859 proceeding.

- On 22 September 2011, a second third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,915 [hereinafter "the '11915 proceeding"].

- On 07 October 2011, patent owner did not agree to waive Patent Owner's Statement in the '11915 proceeding.

- On 10 November 2011, the Office issued an order granting *ex parte* reexamination of claims 1-26 in the '11915.

- On 06 January 2012, patent owner filed a Patent Owner's Statement in response to the order in the '11915 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 06 March 2012, the second third party requester timely filed comments to patent owner's statement in the '11915 proceeding.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/011,859 and 90/011,915 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. Both files will be maintained as separate, complete files.

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 proceedings 90/011,859 and 90/011,915 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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 Matt Brooks at (571) 272-8112, or, in the event that Matt Brooks is unavailable, to Daniel Ryman at (571)272-3152, both of whom are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Matthew Brooks/

_____

Matthew Brooks,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-8112

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. |
|---|---|---|---|---|
| 90/011,869 | 08/18/2011 | 7777074 | GASP-004-502 | 7260 |

54434 7590 03/30/2012

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/30/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORSE, BARNES-BROWN & PENDLETON, P.C.
ATTN: IP MANAGER RESERVOIR PLACE
1601 TRAPELO ROAD, SUITE 205
WALTHAM, MA 02451

Date:

MAILED

MAR 30 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011869
PATENT NO. : 7777074
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)).

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. |
|---|---|---|---|---|
| 90/011,394 | 12/17/2010 | 7,777,074 | GASP-004-501 | 8722 |

54434 7590 03/30/2012

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/30/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LISA M. TREANNIE, ESQ.
MORSE, BARNES-BROWN & PENDLETON, P.C.
RESERVIOR PLACE, 1601 TRAPELO ROAD, SUITE 205
WALTHAM, MA 02451

Date: **MAILED**

MAR 30 2012

**CENTRAL REEXAMINATION UNIT**

## EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011394
PATENT NO. : 7777074
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

MAR 30 2012

CENTRAL REEXAMINATION UNIT

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

(for Patent Owner)

Morse, Barnes-Brown & Pendleton, P.C.
Reservoir Place, 1601 Trapelo Road
Suite 205
Waltham, MA 02451

(for Third Party Requester)

*In re Kramer et al*
Reexamination Proceeding
Control No.: 90/011,394
Filed: December 17, 2010
For: U.S. Patent 7,777,074

DECISION MERGING
REEXAMINATION
PROCEEDINGS

*In re Kramer et al*
Reexamination Proceeding
Control No.: 90/011,869
Filed: August 18, 2011
For: U.S. Patent 7,777,074

The above noted reexamination files are before the Director of the Central Reexamination Unit for consideration of merger of these proceedings under 37 C.F.R. 1.565(c).

**BACKGROUND**

1. United States Patent 7,777,074, issued August 17, 2010, is the subject of Reexamination Control Nos. 90/011,394 and 90/011,869.

2. A first request for reexamination, assigned Reexamination Control No. 90/011,394, was filed December 17, 2011 by Morse, Barnes-Brown & Pendleton, P.C in Waltham MA. The request urged that a substantial new question of patentability was raised by the combined teachings of Ramaswamy et al, Rajkumar et al, Petrosyan et al and USPN 4, 379,177 to McCoy.

3. Reexamination was ordered for 90/011,394 on January 25, 2011.

4. A Patent Owners' statement was received on March 25, 2011.

5. A Requester's response was received May 24, 2011.

6. A first Office action on the merits was issued on July 21, 2011.

7. A response from Patent Owner was submitted on September 21, 2011.

8. A second request for *ex parte* re-examination, assigned Reexamination Control No. 90/011,869, was filed August 18, 2011 by Morse, Barnes-Brown & Pendleton, P.C in Waltham MA. The request urged that a substantial new question of patentability was raised by Barger.

9. Reexamination was ordered for 90/011,869 on October 7, 2011. There has been no Patent Owner response.

**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. 1.565 (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 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 90/011,394 and 90/011,869 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." **In light of the fact that Patent Owner has not filed a Patent Owner's Statement within the time allowed and to facilitate the requirement of "special dispatch" the claims from the 90/011,394 proceeding will be copied into the 90/011,869 and the "housekeeping" amendment will not be necessary. The merged proceeding will be forwarded to the examiner for the issuance of a non-final Office action based on the claims as amended. A copy of the amended claims is attached herewith.**

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 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. 90/011,394 and 90/011,869 as:

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy.
Suite 101
Tempe, AZ 85281

A copy of all correspondence from the USPTO will be served on the third party requester at the address listed in Reexamination Control Nos. 90/011,394 and 90/011,869 as:

Morse, Barnes-Brown & Pendleton, P.C.
Reservoir Place, 1601 Trapelo Road
Suite 205
Waltham, MA 02451

**CONCLUSION**

Reexamination Control Nos. 90/011,394 and 90/011,869 are merged.

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

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. |
|---|---|---|---|---|
| 90/011,882 | 08/29/2011 | 7103380 | | 2099 |

20995 7590 03/19/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/19/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: 3-19-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011882
PATENT NO. : 7103380
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.:90/011,882 |
|---|---|

1. THIS IS A DECISION ON THE PETITION FILED 03/15/2012.

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 01/23/2012, 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 **fifteen (15) days**, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☒ Other/comment: see attached comments.
   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 Sudhanshu C. Pathak at 571-272-5509. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/ SPRS, CRU 3992
[*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. 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.

This is the first request for extension of time in this proceeding. While the Petition speaks to the consideration of the concurrent pending litigation, this is noted and is not persuasive. The requirement for reasonably diligent behavior by patent owner includes resource management. Resource management takes into account planned holidays, vacations and other business related issues not related to this reexamination proceeding. The petition further speaks to the consideration of meeting with the inventor and to provide declarations, this is persuasive in-part. The petition states that the Patent Owner has already reviewed the Supplemental Office Action and put together a response strategy, and would like the inventor to provide feedback and sign declarations. Thus there is sufficient cause to grant-in-part the petition for extension of time. The petition for extension of time is hereby **granted-in-part** for fifteen (15) days.

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. |
|---|---|---|---|---|
| 90/011,882 | 08/29/2011 | 7103380 | | 2099 |

20995 7590 04/17/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET

FIFTY-THIRD FLOOR

HOUSTON, TX 77002

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,882*.

PATENT NO. *7103380*.

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**

APR 17 2012

**CENTRAL REEXAMINATION UNIT**

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

| | | |
|---|---|---|
| In re Application of | : | |
| **Ditzik** | : | |
| Control No. 90/011,882 | : | DECISION ON PETITION |
| Filed: August 29, 2011 | : | TO WITHDRAW |
| Attorney Docket No. DITZIK.003X1 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 5, 2012.

The request is **APPROVED**.

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

The request was signed by James F. Herkenhoff on behalf of all attorneys of record who are associated with customer No. 20995.

All attorneys/agents associated with the Customer Number 20995 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

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

Telephone inquiries concerning this decision should be directed to Sharon S. Hoppe at 571-272-1586.

/Sharon Hoppe/
Paralegal Specialist
CRU

cc: Novak Druce & Quigg, LLP
(NDQ REEXAMINATION GROUP)
1000 Louisiana Street, 53 Floor
Houston, TX 77002

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on 04/05/12.

Doc Code: PET.POA.WDRW
Document Description: Petition to withdraw attorney or agent (SB83)

PTO/SB/83 (11-08)
Approved for use through 11/30/2011. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

| | |
|---|---|
| Application Number | 90/011,882 |
| Filing Date | August 29, 2011 |
| First Named Inventor | Richard J. Ditzik |
| Art Unit | 3992 |
| Examiner Name | Andrew Nalven |
| Attorney Docket Number | DITZIK.003X1 |

**To: Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

Please withdraw me as attorney or agent for the above identified patent application, and

- ☐ all the practitioners of record;
- ☐ the practitioners (with registration numbers) of record listed on the attached paper(s); or
- ☑ the practitioners of record associated with Customer Number: 20995

**NOTE:** The immediately preceding box should only be marked when the practitioners were appointed using the listed Customer Number.

The reason(s) for this request are those described in 37 CFR :

| | | | |
|---|---|---|---|
| ☐ 10.40(b)(1) | ☐ 10.40(b)(2) | ☐ 10.40(b)(3) | ☑ 10.40(b)(4) |
| ☐ 10.40(c)(1)(i) | ☐ 10.40(c)(1)(ii) | ☐ 10.40(c)(1)(iii) | ☐ 10.40(c)(1)(iv) |
| ☐ 10.40(c)(1)(v) | ☐ 10.40(c)(1)(vi) | ☐ 10.40(c)(2) | ☐ 10.40(c)(3) |
| ☐ 10.40(c)(4) | ☐ 10.40(c)(5) | ☐ 10.40(c)(6) Please explain below: | |

## Certifications

***Check each box below that is factually correct. WARNING: If a box is left unchecked, the request will likely not be approved.***

1. ☑ I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment.

2. ☑ I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled.

3. ☑ I/We have notified the client of any responses that may be due and the time frame within which the client must respond.

Please provide an explanation, if necessary:



This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

PTO/SB/83 (11-08)
Approved for use through 11/30/2011. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

**Complete the following section only when the correspondence address will change.** *Changes of address will only be accepted to an inventor or an assignee that has properly made itself of record pursuant to 37 CFR 3.71.*

Change the correspondence address and direct all future correspondence to:

A. [✓] The address of the inventor or assignee associated with Customer Number: 27058

***OR***

| | |
|---|---|
| B. [ ] Inventor or Assignee name | |
| Address | |

| | | | |
|---|---|---|---|
| City | State | Zip | Country |
| Telephone | | Email | |

I am authorized to sign on behalf of myself and all withdrawing practitioners.

| | | | |
|---|---|---|---|
| Signature | | | |
| Name | James F. Herkenhoff | Registration No. | 51241 |
| Address | 12790 El Camino Real | | |
| City San Diego | State CA | Zip 92130 | Country US |
| Date | April 5, 2012 | Telephone No. | 858-707-4000 |

*NOTE:* ***Withdrawal is effective when approved rather than when received.***



This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

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. |
|---|---|---|---|---|
| 90/011,883 | 08/30/2011 | 6,427,078 B1 | 51020-012USC1RX2 | 3478 |

42532 7590 01/27/2012

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 01/27/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011883
PATENT NO. : 6427078
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

Robert S. Mayer
PROSKAUER ROSE LLP
One International Place
Boston, MA 02110-2600

(For Patent Owner)

MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 New York Avenue, N.W.
Washington, DC 20001-4413

(For Third Party Requester)

Tracy W. Druce
NOVAK, DRUCE & QUIGG LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

*In re* Wilska et alia
*Ex Parte* Reexamination Proceedings
Control No. 90/011,736
Control No. 90/011,883
For U.S. Patent No. 6,427,078

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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,427,078 [hereinafter "the '078 patent"] was granted to Wilska et al. on 30 July 2002.

- On 10 June 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,736 [hereinafter "the '11736 proceeding"].

- On 5 August 2011, patent owner agreed to waive Patent Owner's Statement in the '11736 proceeding.

- On 12 August 2011, the Office issued an order granting *ex parte* reexamination of claims 1-3, 5, 6, 8, 17, 18, 29, 34, 69, and 73 in the '11736 proceeding along with a non-final Office action on the merits.

- On 11 October 2011, patent owner filed a response to the non-final Office action in the '11736 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 30 August 2011, a second third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,883 [hereinafter "the '11883 proceeding"].

- On 9 September 2011, patent owner agreed to waive Patent Owner's Statement in the '11883 proceeding.

- On 25 October 2011, the Office issued an order granting *ex parte* reexamination of claims 1-3, 6, 8, 17, 18, and 73 in the '11883 proceeding along with a non-final Office action on the merits.

- On 27 December 2011, patent owner filed a response to the non-final Office action in the '11883 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/011,736 and 90/011,883 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. Both files will be maintained as separate, complete files.

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 proceedings 90/011,736 and 90/011,883 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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, or, in the event that Mark Reinhart is unavailable, to Daniel Ryman at (571)272-3152, both of whom are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Mark Reinhart/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Decision Date : November 15,2011

In re Application of :

6120804

Application No : 90011899

Filed : 12-Sep-2011

Attorney Docket No : 033083.0009-US08

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 November 15,2011

The request is **APPROVED.**

The request was signed by Tanya E. Harkins (registration no. 52993 ) on behalf of all attorneys/agents associated with Customer Number 20529 . All attorneys/agents associated with Cusotmer Number 20529 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 | Kevin Drizen |
| Name2 | Glycobiosciences |
| Address 1 | 129 Main Street South |
| Address 2 | |
| City | Georgetown Ontario |
| State | |
| Postal Code | L7G 3E5 |
| Country | CA |

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

| | |
|---|---|
| **Doc Code: PET.AUTO**<br>**Document Description: Petition automatically granted by EFS-Web** | PTO/SB/83<br>U.S. Patent and Trademark Office<br>Department of Commerce |

| | |
|---|---|
| Electronic Petition Request | **REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS** |
| Application Number | 90011899 |
| Filing Date | 12-Sep-2011 |
| First Named Inventor | 6120804 |
| Art Unit | 3991 |
| Examiner Name | SHARON TURNER |
| Attorney Docket Number | 033083.0009-US08 |
| Title | TOPICAL DRUG PREPARATIONS |

◉ Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number: 20529

The reason(s) for this request are those described in 37 CFR:

10.40(b)(4)

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 | Kevin Drizen Glycobiosciences |
| Address | 129 Main Street South |
| City | Georgetown Ontario |
| State | |
| Postal Code | L7G 3E5 |
| Country | CA |

| I am authorized to sign on behalf of myself and all withdrawing practitioners. | |
|---|---|
| Signature | /Tanya E. Harkins/ |
| Name | Tanya E. Harkins |
| Registration Number | 52993 |

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. |
|---|---|---|---|---|
| 90/011,915 | 09/22/2011 | 7878909 | 010006-003 | 1042 |

101952 7590 03/23/2012

Osborne Law LLC
33 Habitat Lane
Cortlandt Manor, NY 10567

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/23/2012

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. |
|---|---|---|---|---|
| 90/011,859 | 08/13/2011 | 7878909 | AMER-0010 | 1055 |

101952 7590 03/23/2012

Osborne Law LLC
33 Habitat Lane
Cortlandt Manor, NY 10567

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WINSTEAD PC
P.O. BOX 50784
DALLAS, TX 75201

Date: MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011859
PATENT NO. : 7878909
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Daphne L. Burton
BURTON IP LAW GROUP
2029 Century Park East, Suite 1400
Los Angeles, CA 90067

Date:

MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011915
PATENT NO. : 7878909
ART UNIT : 3993

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

John W. Osborne
OSBORNE LAW LLC
33 Habitat Lane
Cortlandt Manor NY 10567

(For Patent Owner)

MAILED

MAR 23 2012

CENTRAL REEXAMINATION UNIT

Jeffrey A. Tinker
WINSTEAD PC
P.O. Box 50784
Dallas, TX 75201

(For Third Party Requester)

Daphne L. Burton
BURTON IP LAW GROUP
2029 Century Park East; Suite 1400
Los Angeles, CA 90067

(For Third Party Requester)

*In re* Kessman et al.
*Ex Parte* Reexamination Proceedings
Control No. 90/011,859
Control No. 90/011,915
For U.S. Patent No. 7,878,909

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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,878,909 [hereinafter "the '909 patent"] was granted to Kessman et al. on 01 February 2011.

- On 13 August 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,859 [hereinafter "the '11859 proceeding"].

- On 29 September 2011, patent owner did not agree to waive Patent Owner's Statement in the '11859 proceeding.

- On 24 October 2011, the Office issued an order granting *ex parte* reexamination of claims 1-26 in the '11859 proceeding.

- On 22 December 2011, patent owner filed a Patent Owner's Statement in response to the order in the '11859 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 22 February 2012, the first third party timely filed comments to Patent Owner's Statement in the '11859 proceeding.

- On 22 September 2011, a second third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,915 [hereinafter "the '11915 proceeding"].

- On 07 October 2011, patent owner did not agree to waive Patent Owner's Statement in the '11915 proceeding.

- On 10 November 2011, the Office issued an order granting *ex parte* reexamination of claims 1-26 in the '11915.

- On 06 January 2012, patent owner filed a Patent Owner's Statement in response to the order in the '11915 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 06 March 2012, the second third party requester timely filed comments to patent owner's statement in the '11915 proceeding.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/011,859 and 90/011,915 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. Both files will be maintained as separate, complete files.

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 proceedings 90/011,859 and 90/011,915 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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 Matt Brooks at (571) 272-8112, or, in the event that Matt Brooks is unavailable, to Daniel Ryman at (571)272-3152, both of whom are Supervisory Patent Examiners in the Central Reexamination Unit, Art Unit 3992.

/Matthew Brooks/

Matthew Brooks,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-8112

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. |
|---|---|---|---|---|
| 90/011,983 | 10/27/2011 | 7,815,725 | Sasol SA-14 | 1215 |

33072 7590 02/28/2012

KAGAN BINDER, PLLC
SUITE 200, MAPLE ISLAND BUILDING
221 MAIN STREET NORTH
STILLWATER, MN 55082

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

C. JAMES BUSHMAN
1001 West Loop South
Suite 810
HOUSTON, TX 77027

Date:

**MAILED**

FEB 28 2012

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011983
PATENT NO. : 7815725
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)).

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. |
|---|---|---|---|---|
| 90/011,731 | 06/21/2011 | 7,815,725 | 859.1_R | 3014 |

33072 7590 02/28/2012

KAGAN BINDER, PLLC
SUITE 200, MAPLE ISLAND BUILDING
221 MAIN STREET NORTH
STILLWATER, MN 55082

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/28/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DENNIS G. LAPOINTE
LAPOINTE LAW GROUP, PL
P.O. BOX 1294
TARPON SPRINGS, FL 34688-1294

Date: **MAILED**

FEB 28 2012

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011731
PATENT NO. : 7815725
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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

FEB 28 2012

CENTRAL REEXAMINATION UNIT

KAGAN BINDER, PLLC
221 Main Street North
Maple Island Building, Suite 200
Stillwater, MN 55082

(for Patent Owner)

Dennis G. Lapointe
LAPOINTE LAW GOUP, PL
PO Box 1294
Tarpon Springs, FL 34688-1294

(for first Third Party Requester)

*In re Reinke et al.*
Reexamination Proceeding
Control No.: 90/011,731
Filed: June 21, 2011
For: U.S. Patent 7,815,725 B2

C. JAMES BUSHMAN
5581 San Felipe
Suite 975
Houston, TX 77057

(for second Third Party Requester)

*In re Reinke et al.*
Reexamination Proceeding
Control No.: 90/011,983
Filed: October 27, 2011
For: U.S. Patent 7,815,725 B2

**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 7,815,725 issued October 19, 2010, is the subject of Reexamination Control Nos. 90/011,731 and 90/011,983.

2. A first request for reexamination, assigned Reexamination Control No. 90/011,731 ('731 proceeding), was filed June 21, 2011 by first Third Party Requester. The request urged that a substantial new question of patentability of claims 1, 6 and 7 was raised by the newly cited references that either disclose the claimed composition or are so close as to establish a case of obviousness.

3. Reexamination was ordered for claims 1, 6 and 7 for 90/011,731 on August 12, 2011.

4. A first non-final Office action on the merits was issued on December 1, 2011 in the '731 proceeding.

5. Patent Owner filed an amendment and response in the '731 proceeding on January 23, 2012.

6. A second request for re-examination, assigned Reexamination Control No. 90/011,983 ('983 proceeding) was filed on October 27, 2011 by second Third Party Requester. The request urged that a substantial new question of patentability of claims 1-4 and 9-18 was raised by the newly cited references that either disclose the claimed composition or are so close as to establish a case of obviousness.

7. Reexamination was ordered for all claims in the second request on December 22, 2011.

8. No Office action has been issued in the 90/011,983 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 90/011,731 and 90/011,983 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 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. 90/011,731 and 90/011,983 as:

KAGAN BINDER, PLLC
221 Main Street North
Maple Island Building, Suite 200
Stillwater, MN 55082

A copy of all correspondence from the USPTO will be served on the Third Party Requesters at the addresses listed in Reexamination Control Nos. 90/011,731 and 90/011,983 as:

Dennis G. Lapointe (first Third Party Requester)
LAPOINTE LAW GOUP, PL
PO Box 1294
Tarpon Springs, FL 34688-1294

C. JAMES BUSHMAN (second Third Party Requester)
5581 San Felipe
Suite 975
Houston, TX 77057

**CONCLUSION**

Reexamination Control Nos. 90/011,731 and 90/011,983 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.

Déborah Jones
SPE, Art Unit 3991
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

BRIAN ROFFE, ESQ
8170 MCCORMICK BOULEVARD
SUITE 223
SKOKIE, IL 60076-2914

(For Patent Owner)

MAILED

FEB 21 2012

CENTRAL REEXAMINATION UNIT

Rickard K. DeMille
BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO, IL 60610

(For Third Party Requester)

| | | |
|---|---|---|
| *In re Breed et al.* | : | DECISION ON PETITION |
| *Ex Parte* Reexamination Proceeding | : | TO VACATE ORDER GRANTING |
| Control No.: 90/012,015 | : | REEXAMINATION |
| For: U.S. Patent No. 6,942,248 | : | |

This is a decision on the February 8, 2012 petition filed by the patent owner under 37 CFR 1.181 entitled "Petition under 37 C.F.R. 1.181(a)(3)" [hereinafter "petition"]. The petition requests that the Office vacate the order granting the reexamination proceeding as *ultra vires* because the Office has exceeded its statutory authority by granting this reexamination premised on references that it deems and designates as "old" art (or cumulative "old" art).

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The petition is dismissed for the reasons set forth below.

## REVIEW OF RELEVANT FACTS

1. On September 13, 2005, the Office granted U.S. Patent No. 6,942,248 [hereinafter "the '248 patent"] to Breed et al.

2. On November 27, 2006, a third party requester filed a request for *ex parte* reexamination. The Office assigned the resulting reexamination proceeding control number 90/008,351 [hereinafter "the '351 proceeding"].

3. On January 4, 2007, the Office ordered that the patent be reexamined in the '351 proceeding, finding that the requester had raised a substantial new question of patentability as to claims 1-6, 8, 11-14, 16, 19, 24, 32, 37, 44, and 46 based on U.S. Patent 5,482,314 to Corrado et al. ("Corrado"); U.S. Patent No. 5,222,761 to Kaji et al. ("Kaji"); U.S. Patent No. 5,605,348 to Blackburn et al. ("Blackburn"); and U.S. Patent No. 5,074,583 to Fujita et al. ("Fujita").

4. On October 11, 2007, the same third party requester filed a request for *inter partes* reexamination of claims 1-18 of the '248 patent. The Office assigned the resulting reexamination proceeding control number 95/001,012 [hereinafter "the '012 proceeding"].

5. On January 9, 2008, the Office ordered that the patent be reexamined in the '012 proceeding, finding that the requester had raised a substantial new question of patentability as to claims 7 and 15 based, in part, on Corrado; U.S. Patent No. 5,330,226 to Gentry et al. ("Gentry"); Kaji; Blackburn; U.S. Patent No. 4,624,329 to Ishikawa et al. ("Ishikawa"); and U.S. Patent No. 5,274,584 to Krogmann. ("Krogmann").

6. On February 20, 2008, the '351 *ex parte* proceeding and the '012 *inter partes* proceedings were merged [hereinafter "the merged proceedings"].

7. On May 9, 2008, the Office issued a non-final action in the merged proceeding, which rejected claims 1-8, 11-16, 19, 24, 32, 37, 44, 46, and 48-51.

8. Prosecution advanced and, on August 20, 2009, patent owner filed an appeal brief in the merged proceeding appealing the rejection of claims 1-8, 11-16, 19, 24, 32, 37, 44, 46, and 48-71.

9. On September 28, 2010, the Board of Patent Appeals and Interferences [hereinafter "the Board"] issued a decision in the merged proceeding which affirmed rejections pertaining

to claims 7, 15, 19, 24, 32, 37, 44, 46, and 48-71 and reversed all rejections pertaining to claims 1-6, 8, 11-14, and 16.

10. On June 17, 2011, in response to the Board's decisions, the Office issued a Notice of Intent to Issue a Reexamination Certificate (NIRC) which canceled claims 7, 15, 19, 24, 32, 37, 44, 46, and 48-71 and confirmed claims 1-6, 8, 11-14, and 16 as patentable.

11. On August 23, 2011, the reexamination certificate for the merged proceedings published.

12. On November 18, 2011, the same third party requester filed a request for *ex parte* reexamination. The Office assigned the resulting reexamination proceeding control number 90/012,015 [hereinafter "the '015 proceeding"].

13. On December 8, 2011, the Office ordered that the patent be reexamined in the '015 proceeding, finding that the requester had raised a substantial new question of patentability as to claims 1-6, 8, 11-14, and 16.

14. On February 8, 2012, patent owner filed the petition to vacate.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

**35 USC 303 Determination of issue by Director, states in part:**

(a) 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.

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable.

**MPEP 2242(I) Substantial New Question of Patentability, states in part:**

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a

> decision on the merits involving the claim. It is not necessary that a "prima facie" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim.

(emphasis in original).

**MPEP 2242(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, states in part:**

> 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 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 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 substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability 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 examination(s), in view of a material new argument or interpretation presented in the request.

**MPEP 2246(II) Petition to Vacate the Order, states in part:**

> A substantive determination by the Director of the USPTO to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by the courts until a final agency decision in the reexamination proceeding has issued. See *Joy Mfg. Co. v. Nat 'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F. Supp.2d 593 (E.D.Va. 2001). Note further the decision of Patlex Corp. v. Quigg, 680 F. Supp. 33, 35, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his or her discretion and not subject to judicial review until a final agency decision on the reexamination proceeding has issued). Accordingly, neither the patent owner nor the requester has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted.

. . .

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).

As to (E) above, the decision of *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996) is to be noted. See the discussion in MPEP § 2242 subsection II.A. as to the criteria for vacating a reexamination order in view of the decision.

## DECISION ON PETITION TO VACATE

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding as not raising a proper substantial new question of patentability (SNQ). The procedure for such a petition is provided for in MPEP 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.

Patent owner contends that the order for reexamination of the '248 patent is *ultra vires* and must be vacated. See page 1 of the petition which incorporates by reference the arguments on pages 3-15 of the patent owner's statement. Patent owner argues that none of the cited references raise a substantial new question of patentability because the references or substantially similar teachings were already considered in a prior examination.

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 Board 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 Board along with an appeal of any rejections. Therefore, in order to preserve the right to have the Board review of the SNQ

issue, a patent owner should first request reconsideration of the SNQ determination by the examiner.

The notice also clarifies that a petition under 37 CFR 1.181(a)(3) to vacate an *ex parte* reexamination order as "*ultra vires*" will be granted only in the extremely rare situation where the USPTO acted in "brazen defiance" of its statutory authorization in granting the order. *See Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Proceedings*, 75 FR at 36357 n.1 (citing *Heinl v. Godici*, 143 F.Supp. 2d 593, 601-02 (E.D. Va. 2001) (the exhaustion and final agency action requirements are excused only when an agency acts in "brazen defiance" of its statutory authorization)); *also see Philip Morris, Inc. v. Block*, 755 F.2d 368, 370 (4th Cir. 1985). In other words, an agency action is not *ultra vires* simply because the action is incorrect; rather, agency action is *ultra vires* when the agency patently misconstrues a statute, disregards a specific and unambiguous statutory directive, or violates a specific command of a statute. *See Hunter v. FERC*, 527 F. Supp. 2d 9, 17 n.6 (D.D.C. 2007) (citing *Griffith v. FLRA*, 842 F.2d 487, 493 (D.C. Cir. 1988)); *see also Leedom v. Kyne*, 358 U.S. 184, 188 (1958) (the narrow exception for judicial review before a final agency decision applies only when the agency had acted "contrary to a specific prohibition" in a statute that was "clear and mandatory"); *Physicians Nat'l House Staff Ass'n v. Fanning*, 642 F.2d 492, 496 (D.C. Cir. 1980) (to invoke judicial review before a final agency action, "an error of fact or law is insufficient; the [agency] must have acted without statutory authority"). Petitioner must show that the Office was without authority to order reexamination. Accordingly, this decision only needs to determine that the Office has the authority to order the reexamination. In other words, this decision will only ascertain that the examiner did not patently misconstrue a statute, disregard a specific and unambiguous statutory directive, or violate a specific command of a statute in his determination that a SNQ is raised for at least one patent claim. It is not a review as to whether the examiner correctly analyzed the merits for each ground addressed in the order. As stated above, such matters have been delegated to the Board.

Upon review, the order granted reexamination based on the following grounds:

1. A SNQ as to claims 1-6 and 11-14 based on Corrado.
2. A SNQ as to claims 8 and 16 based on Corrado in view of Kaji.
3. A SNQ as to claims 11-13 based on U.S. Patent No. 6,942,249 to Norton ("Norton").
4. A SNQ as to claim 16 based on Norton in view of Kaji.
5. A SNQ as to claims 1-6 and 11-14 based on Gentry in view of Blackburn and Krogmann.
6. A SNQ as to claims 8 and 16 based on Gentry in view of Blackburn, Krogmann, and Kaji.
7. A SNQ as to claims 11-14 based on Gentry in view of Blackburn.
8. A SNQ as to claim 16 based on Gentry in view of Blackburn and Kaji.
9. A SNQ as to claims 1-6 and 11-14 based on Ishikawa in view of Blackburn and Krogmann.

10. A SNQ as to claims 8 and 16 based on Ishikawa in view of Blackburn, Kaji, and Krogmann

See pages 9-18 of the order. As recognized by the order, many of the references were considered "old art" since these references had been used in the merged proceeding. In fact, the Norton reference was the only newly cited reference for which a SNQ was found. Thus, the order granting reexamination was based primarily on old art. However, "[i]n 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 that is based exclusively on that old art." MPEP 2242(II)(A) (citing to Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002)). "For example, a substantial new question of patentability 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 examination(s), in view of a material new argument or interpretation presented in the request." *Id.*

In this case, this old art is being presented in a new way as compared with its use in the earlier examinations with respect to claims 1-6, 8, 11-14 and 16 of the '248 patent. Specifically, the following were the SNQs/proposed rejections presented in the request in the '351 proceeding:

1. Claims 1-6 and 11-14 are unpatentable under 35 USC 102(b) by Corrado.
2. Claims 8 and 16 are unpatentable under 35 USC 103(a) by Corrado in view of Kaji.
3. Claims 19, 24, 32, and 27 are unpatentable under 35 USC 103(a) by Blackburn in view of Kaji.
4. Claims 44 and 36 are unpatentable under 35 USC 103(a) by Blackburn in view of Fujita.

See the November 27, 2006 request.

The following were the SNQs asserted in the request in the '012 proceeding.

1. A substantial new question of patentability with regard to claims 1-18 over the GB 2,289,332 patent to Breed et al.
2. A substantial new question of patentability with regard to claims 1-8 and 11-16 over the SAE Paper 940527 to Breed et al.
3. A substantial new question of patentability with regard to claims 1-6 and 11-15 over U.S. Patent No. 5,702,123 to Takahashi et al.
4. A substantial new question of patentability with regard to claims 1-4 and 11-15 over U.S. Patent No. 5,454,591 to Mazur et al.
5. A substantial new question of patentability with regard to claims 6, 7 and 15 over Takahashi et al. in view of U.S. Patent No. 5,031,154 to Watanabe.
6. A substantial new question of patentability with regard to claims 8 and 16 over Takahashi et al. in view of U.S. Patent No. 5,222,761 to Kaji et al. as well as Mazur et al. in view of Kaji et al.
7. A substantial new question of patentability with regard to claims 1-6 and 11-15 over U.S. Patent No. 5,330,226 to Gentry et al. in view of the Turbell Paper.

8. A substantial new question of patentability with regard to claims 1-6 and 11-15 over U.S. Patent No. Gentry et al. in view of U.S. Patent No. 5,605,348 to Blackburn et al.
9. A substantial new question of patentability with regard to claims 6, 7, and 15 over Gentry et al. in view of the Turbell Paper and U.S. Patent No. 5,247,584 to Krogmann as well as Gentry et al. in view of Blackburn et al. and Krogmann.
10. A substantial new question of patentability with regard to claims 8 and 16 over Gentry et al. in view of the Turbell Paper and Kaji et al. as well as Gentry et al. in view Blackburn et al. and Kaji et al.
11. A substantial new question of patentability with regard to claims 1-6 and 11-15 over U.S. Patent No. 4,625,329 to Ishikawa et al. in view of the Turbell Paper.
12. A substantial new question of patentability with regard to claims 1-6 and 11-15 over Ishikawa et al. in view of Blackburn et al.
13. A substantial new question of patentability with regard to claims 6, 7 and 15 over Ishikawa et al. in view of the Turbell Paper and Krogmann as well as Ishikawa et al. in view of Blackburn et al. and Krogmann.
14. A substantial new question of patentability with regard to claims 8 and 16 over Ishikawa et al. in view of the Turbell Paper and Kaji et al. as well as Ishikawa et al. in view of Blackburn et al. and Kaji et al.

For example, the '351 proceeding and the '012 proceeding did not present SNQs and/or proposed rejections for claims 1-6 and 11-14 based on Gentry in view of Blackburn and *Krogmann* and claims 8 and 16 based on Gentry in view of Blackburn, *Krogmann*, and Kaji, as asserted in the '015 proceeding. See SNQ L and M listed on page 3 of the December 8, 2011 order. The '012 proceeding presented SNQs for claims 1-6 and 11-14 based on Gentry in view of Blackburn and claims 8 and 16 based on Gentry in view of Blackburn and Kaji. See SNQs 8 and 10 listed above. Therefore, the records are clear that the specific combinations of Gentry in view of Blackburn and Krogmann as applied to claims 1-6 and 11-14 and Gentry in view of Blackburn, Krogmann, and Kaji as applied to claims 8 and 16 were not considered in prior examinations. *In re Recreative* holds that "[a] second examination, on the identical ground that had been previously raised and overcome, is barred." 38 USPQ2d at 1777 (emphasis added). *See also,* MPEP 2246(II). Since the rejections of claims 1-6 and 11-14 based on Gentry in view of Blackburn and claims 8 and 16 based on Gentry in view of Blackburn and Kaji were not raised and overcome during prosecution of the merged proceeding or the original examination, the fact that these asserted SNQs are based solely on old art does not preclude this old art from raising a new question of patentability in the current proceeding.

Furthermore, upon review of the record in the '015 proceeding, it is clear that the examiner properly followed reexamination laws and policies in his analysis in the order granting reexamination. The order clearly shows that the examiner reviewed the past examination records and appropriately applied the laws and policies. See, e.g., pages 4-7. For example, for the SNQs for claims 1-6 and 11-14 based on Gentry in view of Blackburn and claims 8 and 16 based on

Gentry in view of Blackburn and Kaji, the order provided an analysis of the asserted SNQs. Specifically, the examiner found that Krogmann provided a teaching relevant to the use of a neural network for classifying objects on the basis of signals from a plurality of different sensors. See page 13 of the order. This teaching is relevant to the claimed analyzing means of independent claims 1 and 11 of the '248 patent. More importantly, this teaching is relevant to the "obtain[ing] an identification of the contents of the seat" limitation found to be missing from Gentry in the September 28, 2010 decision. See page 18 of the decision. Claims 2-6, 8, 13, 14, and 16 depend on either claim 1 and 11, and therefore, would contain the analyzing means limitation. For this reason, the order found that the combination of Gentry, Blackburn, and Krogmann or Gentry, Blackburn, Krogmann, and Kaji raised a new light to the "old art" references. The explanation provided in the order puts the determination of ordering reexamination squarely within the examiner's discretion. In other words, the record is clear that the examiner did not patently misconstrue a statute, disregard a specific and unambiguous statutory directive, or violate a specific command of a statute in his determination that a SNQ is raised for claims 1-6, 8, 11, 13, 14, and 16 of the '248 patent. The ultimate review of the merits of the examiner's determination in the Office will be by the Board. Accordingly, the Office is authorized to order reexamination of claims 1-6, 8, 11-14, and 16 of the '248 patent.

Patent owner further asserts that the fact that the examiner or the requester could have raised the proposed rejections for claims 1-6 and 11-14 based on Gentry in view of Blackburn and claims 8 and 16 based on Gentry in view of Blackburn and Kaji supports their argument that no SNQ was raised. See pages 8-9 of the petition. Petitioner's argument is not persuasive because *ex parte* reexamination laws do not contain the estoppel provisions as in *inter partes* reexamination. As discussed above, the existence of a substantial new question of patentability is all that is required by 35 USC 303 to authorize the ordering of reexamination. See 35 USC 303(a).

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**.

## CONCLUSION

1. The patent owner's petition under 37 CFR 1.181 to vacate the reexamination proceeding is hereby **dismissed.**

2. The '015 reexamination proceeding will be returned to the examiner to respond to the statement filed by the patent owner on February 8, 2012 in due course.

3. Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, SPE AU 3993, at (571) 272-4361.

Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting 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. |
|---|---|---|---|---|
| 90/012,082 + 90/011704 | 01/09/2012 | 6246400 | R3111606B | 9639 |

40401 7590 02/23/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-23-12

Kathleen D. Fitterling
SHOOK HARDY & BACON LLP, IP DEPT.
2555 Grand Blvd.
Kansas City, MO 64108-2613

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90012082 + 90/011704
PATENT NO. : 6246400
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

MAILED

FEB 23 2012

CENTRAL REEXAMINATION UNIT

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

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

(For Patent Owner)

Kathleen D. Fitterling
Shook Hardy & Bacon LLP, IP DEPT
2555 Grand Blvd.
Kansas City, MO 64108-2613

(For Third Party Requester)

*In re* Bush
*Ex Parte* Reexamination Proceedings
Control No. 90/012,082
Control No. 90/011,704
For U.S. Patent No. 6,246,400

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).

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,246,400 [hereinafter "the '400 patent"] was granted to Bush on 12 June 2001.

- On 23 May 2011, a first third party requester filed a request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/011,704 [hereinafter "the '11704 proceeding"].

- On 27 June 2011, the Office issued an order granting *ex parte* reexamination of claims 1-54 in the '11704 proceeding.

- On 13 October 2011 a non-final Office action on the merits was mailed rejecting claims 1-6, 8-9, 11, 13-16, 18-28, 30-38 and 40-54 and confirming claims 7, 10, 12, 17, 29 and 39.

- On 13 December 2011, patent owner filed a response to the non-final Office action in the '11704 proceeding, which did not contain a proposed amendment of any of the claims under reexamination.

- On 31 January 2012 the examiner mailed a final rejection maintaining the rejection of the claims.

- On 09 January 2012, the same third party requester filed a new request for *ex parte* reexamination. The resulting reexamination proceeding was assigned control number 90/012,082 [hereinafter "the '12082 proceeding"].

- On 17 February 2012, the Office issued an order granting *ex parte* reexamination of claims 7, 29 and 39 in the '12082 proceeding.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.565(c) provides:

> 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 and publication of a single certificate under § 1.570.

## DECISION

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.

### I. Merger of Proceedings.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings 90/012,082 and 90/011,704 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. Both files will be maintained as separate, complete files.

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 proceedings 90/012082 and 90/011704 are hereby **merged**.

2. The proceedings are returned to the examiner in charge of the proceedings for further action.

3. Any 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 EFS-Web, at **https://efs.uspto.gov/efile/myportal/efs-registered**. 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 Alexander Kosowski at (571)272-3744, or, in the event that Alexander Kosowski is unavailable, to Mark Reinhart at (571)272-1611, both of whom are Supervisory Patent Reexamination Specialists in the Central Reexamination Unit, Art Unit 3992.

/Alexander Kosowski/

Alexander Kosowski,
Supervisory Patent Reexamination Specialist,
AU 3992,
Central Reexamination Unit
571-272-3744

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. |
|---|---|---|---|---|
| 90/012,103 | 01/24/2012 | 5,689,094 | 393532US71RX | 3997 |

20995 7590 04/17/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:

**MAILED**

APR 17 2012

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90012103
PATENT NO. : 5689094
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. |
|---|---|---|---|---|
| 90/011,395 | 12/21/2010 | 5689094 | INVNT.006RX | 3751 |

20995 7590 04/17/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/17/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

W. Todd Baker, Esq.
OBLON SPIVAK ET AL.
1940 Duke Street
Alexandria, VA 22314

Date:

**MAILED**

APR 17 2012

**CENTRAL REEXAMINATION UNIT**

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90011395
PATENT NO. : 5689094
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

APR 17 2012

CENTRAL REEXAMINATION UNIT

KNOBBE MARTENS OLSON & BEAR LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

(For Patent Owner)

W. TODD BAKER
OBLON, SPIVAK, MCCLELLAND:
MAIER & NEUSTADT LLP
1940 Duke Street
Alexandria, VA 22314

(For Third Party Requester)

*In re* Friedli et alia
*Ex Parte* Reexamination Proceedings
Control No. 90/011,395
Control No. 90/012,103
For U.S. Patent No. 5,689,094

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).

## REVIEW OF RELEVANT FACTS

1. On 18 November 1997 US Patent No 5,689,094 was granted to Friedli *et alia*.

2. On 21 December 2010, a first request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/011,395.

3. On 21 January 2011, the Order was granted for *ex parte* reexamination in control number 90/011,395.

4. On 21 April 2011, a non-final Office action was mailed in 90/011,395.

5. On 09 June 2011, an amendment and remarks were received in 90/011,395.

6. On 21 September 2011, a second non-final Office action was mailed in 90/011,395.

7. On 21 November 2011, a second amendment and remarks were received in 90/011,395.

8. On 25 January 2012, the USPTO mailed a 'Notice of Defective Paper in Ex Parte Reexamination' (Form PTOL-475) in 90/011,395.

9. On 02 February 2012, a third amendment and remarks were received in 90/011,395.

10. On 24 January 2012, a second request for *ex parte* reexamination was submitted by a third party requester identified by control number 90/012,103.

8. On 10 February 2012 the Order was granted for ex parte reexamination in control number 90/012,103.

9. There are no amendments to the claims in control number 90/012,103.

## 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. 90/011,395 & 90/012,103 *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. 90/011,395 & 90/012,103 *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 Supervisory Patent Reexamination Specialist (SPRS) Andrew J. Fischer, at (571) 272-6779. In

the event that Andrew J. Fischer is unavailable, please contact SPRS Mark Reinhart at (571) 272-1611. Any SPRS in Art Unit 3992 may also be contacted.

Andrew J. Fischer,
Supervisory Patent Reexamination Specialist, Art Unit 3992,
Central Reexamination Unit
571-272-6779

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. |
|---|---|---|---|---|
| 90/012,126 ▸ 90/011435 | 02/03/2012 | 5845219 | 51020-019USRX2 | 1499 |

42532 7590 04/18/2012

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/18/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: 4-18-12

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90012126 → 90/011435
PATENT NO. : 5845219
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**

APR 18 2012

CENTRAL REEXAMINATION UNIT

PROSKAUER ROSE LLP : (For Patent Owner)
One International Place :
Boston, MA 02110-2600 :

FINNEGAN, HENDERSON, FARABOW, : (For Third Party Requester)
GARRETT & DUNNER LLP :
901 New York Avenue, N.W. :
Washington, DC 20001-4413 :

*In re* Henriksson : DECISION *SUA SPONTE* MERGING
*Ex Parte* Reexamination Proceedings : PROCEEDINGS [37 CFR § 1.565(c)]
Control No. 90/011,435 :
Control No. 90/012,126 :
For U.S. Patent No. 5,845,219 :

This is a decision merging *sua sponte* the above identified proceedings pursuant to 37 CFR § 1.565(c).

## STATEMENT OF FACTS RELEVANT TO THE DECISION

- On 1 December 1998, US Patent No. 5,845,219 [hereinafter, "the '219 patent"] was granted to Hannu Henriksson.

- On 14 January 2011, a third party requester filed a first request for *ex parte* reexamination of the '219 patent. The Office assigned this proceeding control number 90/011,435 [hereinafter, "the '435 proceeding"].

- On 26 January 2011, the patent owner agreed to waive its right to file a patent owner's statement in the '435 proceeding.

- On 9 March 2011, the Office ordered reexamination of all claims of the '219 patent, i.e. claims 1-8, in the '435 proceeding. The Office also issued a first Office action on the merits rejecting claims 1-8 in the '435 proceeding.

- On 9 May 2011, the patent owner filed a response to the Office action, dated 14 January 2011, which included an amendment that added new claims 9-19 in the '435 proceeding.

- On 1 July 2011, the Office mailed a final Office action in the '435 proceeding, which rejected original claims 1-8 and allowed new 9-19.

- On 1 September 2011, patent owner filed a response to a final rejection in the '435 proceeding, which included new evidence and a showing of good and sufficient reasons why the evidence was necessary and not earlier presented.

- On 29 September 2011, patent owner filed a notice of appeal in the '435 proceeding.

- On 14 October 2011, the Office mailed a non-final Office action, which rejected original claims 1-8 and allowed new claims 9-19.

- On 14 December 2011, patent owner filed a response to the Office action, dated 14 October 2011, in the '435 proceeding, which amended original claims 1 and 3 and new claims 9, 10, 12, 13, and 15-19.

- On 3 February 2011, a third party requester filed a second request for *ex parte* reexamination of the '219 patent. The Office assigned this proceeding control number 90/012,126 [hereinafter, "the '126 proceeding"].

- On 6 April 2012, the Office ordered reexamination of all claims of the '219 patent, i.e. claims 1-8, in the '126 proceeding.

## RELEVANT AUTHORITY

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.

## DECISION

### I. Merger of Proceedings.

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.

In accordance with 37 C.F.R. § 1.565(c), the *ex parte* reexamination proceedings designated by control numbers 90/011,435 and 90/012,126 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 the requesters will be sent copies of all papers mailed by the Office.

## CONCLUSION

1. The *ex parte* reexamination proceedings designated by control numbers 90/011,435 and 90/012,126 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 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 Daniel Ryman, at (571) 272-3152. In the event that Daniel Ryman is unavailable, Mark Reinhart may also be contacted at (571) 272-1611.

/Daniel Ryman/

_____

Daniel Ryman,
Supervisory Patent Examiner,
AU 3992,
Central Reexamination Unit
571-272-3152

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. |
|---|---|---|---|---|
| 90/012,149 | 02/17/2012 | 6779118 | R1341006C | 4719 |

40401 7590 03/20/2012

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 03/20/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Jerry Turner Sewell

1803 Broadway, Apt. 301

Nashville, TN 37203-2731

# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/012,149*.

PATENT NO. *6779118*.

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)).

| Order Granting / Denying Request For Ex Parte Reexamination | Control No. | Patent Under Reexamination |
|---|---|---|
| | 90/012,149 | 6779118 |
| | Examiner | Art Unit |
| | JOHN HOTALING | 3992 |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--***

The request for *ex parte* reexamination filed *17 February 2012* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO/SB/08, c)☐ Other: _____

1. ☐ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☒ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

a) ☒ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester ( if third party requester )

***ORDER DENYING EX PARTE REEXAMINATION***

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

*"2240 (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. **>However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination**. The decision on the second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.515(a)). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 303. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination."

An Ex Parte Reexamination request was proposed on 2/17/12 requesting that claims 2-7, 9-14, 16-24, 26, and 27 are obvious over He et al in view of Zenchelsky and Admitted Prior Art. The proposed SNQ stems from a Board decision in a concurrent pending Reexamination proceeding 90/009301. The request appears to allege an SNQ based on issues currently pending before the office. While the claims in the pending reexamination appear to have been amended and a NIRC is pending, these claims have not yet published. Therefore the request appears to be premature and not clearly based on the claims in effect at the time of the request as required by MPEP 2240 (II).

Hence, there appears to be no new SNQ over and above that currently pending before the office. Accordingly, the request is denied.

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

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

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.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/John M Hotaling II/
Primary Examiner
Central Reexamination Unit
AU 3992
(571) 272 4437

Conferees:

/FOF/
Alexander Kosowski
*Supervisor*
*Art Unit 3992*

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

United States Patent and Trademark Office

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

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNI

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

*In re* Dahlstrom et al.
*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

**DECISION**
**DISMISSING PETITION**
**UNDER § 1.182**

*In re* Dahlstrom et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED EXAMINATION."

The patent owner petition is before the Office of Patent Legal Administration.

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

## PERTINENT BACKGROUND

- On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

- On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

- On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-11, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was used in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also used in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

- On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

- On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317. Reexamination was ordered on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

- On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

- Prosecution progressed until, on April 29, 2010, a Right of Appeal Notice was issued by the Office.[2] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were also listed as being rejected.

- On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, and

---

[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request.

[2] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and reopening of prosecution in 2009. The full details are not included here, but may be found in the instant petition at pages 3-7, as well in the Office decision dismissing patent owner's petition under § 1.181, mailed on the same date herewith.

refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office action mailed on June 2, 2010.

- On May 28, 2010, patent owner filed a Notice of Appeal.
- On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.
- On July 28, 2010, patent owner filed an appellant's brief.
- On October 5, 2010, the Office issued an Examiner's Answer.
- On November 5, 2010, patent owner filed the following papers:
    - A rebuttal brief in response to the October 5, 2010 Examiner's Answer.
    - The instant petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION."
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

## PERTINENT STATUTES AND REGULATIONS

**35 U.S.C. § 314 provides, in pertinent part:**

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

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

**37 C.F.R. § 1.182 provides:**

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

## DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[3] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Furthermore, where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the statutory mandate of 35 U.S.C. § 314(c), stating that "all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Therefore, any Office decision granting continuation of prosecution in a

---

[3] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution after full briefing at the appeal stage to enter four newly presented declarations under 37 C.F.R. § 1.131 as well as "narrowing amendments to further clarify the invention."[4] Patent owner seeks relief under the provisions of March 2005 Notice discussed above. Patent owner's plea for relief is grounded in the position that entry of the declarations would remove the Rhodes '809 patent from prior art status, thereby overcoming the rejections based upon that patent, and furthermore, that the claim amendments proposed with the petition would overcome the rejections of record.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a new issue arising at, or subsequent to, the close of prosecution in the proceeding. In this case, the record is to the contrary. It is apparent from the prosecution history that the issue for which the amendment and evidence submissions are stated to address arose in the initial Office action of April 4, 2002. In this first Office action on the merits of the proceeding, the examiner presented a rejection based on the disclosure of the Rhodes '809 patent. Patent owner petitioner responded to the rejections based upon Rhodes in patent owner's response to the first Office action on the merits, including claim amendments, but no submissions of evidence. Thus, patent owner had the opportunity to address this issue prior to the closing of prosecution. In view of the abovementioned facts, and of advanced stage of the proceeding, reopening prosecution for entry of § 1.131 affidavits, claim amendments, and new claims would cause the Office to sanction entry of amendments and evidence which patent owner had earlier opportunities to properly submit in the proceeding. Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the instant petition will not be granted.

Furthermore, to the extent that patent owner petitioner is contending that any action by the examiner in the proceeding has been improper, the proper avenue for seeking relief from improper closure of prosecution in an *inter partes* reexamination is through supervisory review under § 1.181. Patent owner is concurrently seeking identical relief (e.g., to remove the Rhodes '809 patent as prior art through § 1.131 declarations) via such a petition under § 1.181, filed on May 24, 2010. As the relief for which patent owner seeks has been provided for elsewhere in the regulations, relief under § 1.182 would be inappropriate under the facts and circumstances of this proceeding.[5]

Therefore, the instant patent owner petition is **dismissed**.

## CONCLUSION

1. The patent owner petition is **dismissed.**

[4] Petition at 1.

[5] Note that a situation which is covered by § 1.181 does not become "not provided for" merely because the § 1.181 petition is dismissed or denied by the Office.

2. A copy of this decision will be made of record in the reexamination file.

3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

November 22, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

United States Patent and Trademark Office

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

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

*In re* Dahlstrom et al.
*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

*In re* Dahlstrom et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

**DECISION DISMISSING PETITION UNDER § 1.183**

This is a decision on the November 5, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 is **dismissed.**

## PERTINENT BACKGROUND

- On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

- On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

- On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-11, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was used in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also used in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

- On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

- On July 3, 2002, third party requester filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317. Reexamination was ordered on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

- On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

- Prosecution progressed until, on April 29, 2010, a Right of Appeal Notice was issued by the Office.[1] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were also listed as being rejected.

- On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, and refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office action mailed on June 2, 2010.

- On May 28, 2010, patent owner filed a Notice of Appeal.

---

[1] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and reopening of prosecution in 2009. The full details are not included here, but may be found in the instant petition at pages 3-7, as well in the Office decision dismissing patent owner's petition under § 1.181, mailed on the same date herewith.

- On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.

- On July 28, 2010, patent owner filed an appellant's brief.

- On October 5, 2010, the Office issued an Examiner's Answer.

- On November 5, 2010, patent owner filed the following papers:

    - A rebuttal brief in response to the October 5, 2010 Examiner's Answer.

    - A petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION."

    - The instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

## PERTINENT REGULATIONS

**37 C.F.R. § 1.183 provides:**

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

**37 C.F.R. § 1.181(f) provides, in pertinent part:**

> The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

**37 C.F.R. § 41.64(a) provides:**

> (a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

## DECISION

The instant petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules. Such relief may not involve waiver of any statutory requirement.

Patent owner petitioner filed the instant petition to request that the jurisdiction over the proceeding not pass to the Board upon completion of the file, as provided for in 37 C.F.R. § 41.64, until patent owner's petition has been acted upon. Petitioner states that this request be granted because (1) petitioner is attempting to advance prosecution of the reexamination proceeding and (2) petitioner has "limited options" as to actions available, since neither refiling under §§ 1.53(b) or 1.53(d), nor the RCE procedure under § 1.114 is available to the patent owner petitioner.[2]

Patent owner petitioner requests that jurisdiction not pass to the Board until patent owner's petition under § 1.182 has been acted upon. On the same date herewith, that petition has been acted upon, and a decision dismissing that petition has been mailed. Patent owner petitioner's desired outcome has therefore occurred, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition is **dismissed**.

## CONCLUSION

1. The patent owner petition is **dismissed.**

2. A copy of this decision will be made of record in the reexamination file.

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

Robert A. Clarke
Deputy Director
Office of Patent Legal Administration

November 22, 2010

[2] Petition at 9. Petitioner's additional remarks at pages 7-8 appear to be a "cut-and-paste" of arguments presented in the cofiled petition under § 1.182, and do not address the merits of the relief requested in the instant petition.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 12/22/2010

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 12/22/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

DEC 22 2010

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

For Patent Owner

MAILED

DEC 2 2 2010

CENTRAL REEXAMINATION UNIT

Eugene J. Bernard Ph.D. Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

For Requester

*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002

*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002

For: US Patent No. 6,319,526

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed May 24, 2010 to request the declarations of Donald Dahlstrom, William Aimutis and James Wiegand, submitted January 29, 2010, be entered onto the record and to considered by the Examiner

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for consideration.

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

## REVIEW OF FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed I the '003 proceeding.

4. On June 3, 2002, Patent Owner filed a non-compliant response to the Office action.

5. On July 3, 2002, Requester filed comments on Patent Owner's response.

6. On July 3, 2002, a request for *ex parte* reexamination was filed by the same requester, which proceeding was assigned control no. 90/006,317.

7. On July 9, 2002, Patent Owner filed a corrected amendment in the '003 proceeding.

8. On August 20, 2002 reexamination was ordered in the '6317 proceeding.

9. On January 30, 2003, the '003 and '6317 proceedings were merged.

10. The merged proceeding progressed to the point of mailing a Notice of Intent to Issue Reexamination Certificate on August 28, 2006 in which claims 1-14 and 16-163 were canceled.

11. On September 19, 2006, Patent Owner filed a petition under 37 CFR 1.182 requesting withdrawal of the cancellation of claims 1-14 and 16-163 and requesting entry and consideration of Patent Owner's late response and amendment accompanying the instant petition.

12. On October 27, 2006, a decision dismissing the petition and granting *sua sponte* relief by withdrawal of the NIRC in the merged proceeding. The proposed amendment accompanying the petition was NOT in compliance with 37 CFR 1.530.

13. On June 23, 2007, an Action Closing Prosecution (ACP) was mailed.

14. On July 26, 2007, Patent Owner filed comments after ACP accompanied by a proposed amendment.

15. Also on July 26, 2007, Patent Owner filed a petition requesting waiver of 37 CFR 1.951 as to patent owner's one opportunity to file comments. (Dismissed 9/27/2007)

16. On August 24, 2007, Requester filed comments after ACP.

17. On January 29, 2008, Patent Owner filed a reissue application of the '526 patent. The Office assigned the application USSN 12/011,746.

18. On April 1, 2008, a Right of Appeal Notice (RAN) was issued noting the Patent Owner's amendment submitted after ACP was not entered due to failure to comply with amendment entry criteria set forth in 37 CFR 1.953 and 1.116.

19. On April 30, 2008. Patent Owner filed a Notice of Appeal.

20. On July 23, 2008, Patent Owner filed a petition under 37 CFR 1.137(b) for entry of late papers accompanied by an Appellant Brief.

21. Also on July 23, 2008, Patent Owner submitted a petition under 1.183 requesting entry of an amendment attached thereto. (Dismissed October 25, 2008)

22. On September 3, 2008, the Office issued a decision granting the revival of the merged reexamination proceeding.

23. On October 3, 2008, Requester filed a respondent brief.

24. On February 23, 2009, an Examiner's Answer was mailed.

25. On March 23, 2009, Patent Owner filed a rebuttal brief.

26. On April 8, 2009, the Office issued a Notice of Defective Paper to Patent Owner. The Notice indicated the Appellant's brief as too long and including an insufficient evidence appendix.

27. On April 22, 2009, a corrected Appellant Brief was submitted.

28. On May 12, 2009, Requester filed a respondent brief.

29. On July 8, 2009, the Office issued a second Notice of Defective Paper to Patent Owner. The Notice indicated the Appellant failed to argue the rejections of the claims on appeal.

30. On August 6, 2009, Patent Owner resubmitted the Appellant Brief.

31. On August 20, 2009, requester resubmitted a respondent brief.

32. On August 31, 2009, Patent Owner filed a petition under 37 CFR 1.183 to permit entry of a concurrently filed declaration under 37 CFR 1.131, which was granted on November 4, 2009.

33. On September 28, 2009, the Office issued an Examiner's Answer.

34. On October 28, 2009, Patent Owner filed a rebuttal brief.

35. On October 29, 2009, the Office issued a Notice of Defective Rebuttal Brief.

36. On November 3, 2009, Patent Owner resubmitted the rebuttal brief.

37. On November 17, 2009, Requester filed a response to the declaration entered by the November 4, 2009 decision.

38, On November 24, 2009, Requester filed a request for an oral hearing.

39. On December 17, 2009, the Office mailed a second ACP.

40. On January 29, 2010, Patent Owner filed a response to the second ACP along with declarations of Dahlstrom, Aimutis and Wiegand under 37 CFR 1.131. On the same day, Patent Owner filed a petition under 37 CFR 1.183 in regard to the Aimutis declaration, which was dismissed on March 25, 2010.

41. On February 25, 2010, Requester filed comments in response to the ACP and Patent Owners response.

42. On April 29, 2010, the Office mailed a second Right of Appeal Notice (RAN), which denied entry of the declarations filed on January 29, 2010.

43. On May 24, 2010, the Patent Owner filed a request for reconsideration of the March 25, 2010 decision, which was dismissed on June 2, 2010, and the instant petition under 37 CFR 1.181.

44. Prosecution has proceeded to the issuance of an Examiner's Answer on October 5, 2010 and the submission of a Rebuttal Brief on November 5, 2010.

## DECISION

The present petition under 37 CFR 1.181 requests that the declarations of Dahlstrom, Aimutis and Wiegand under 37 CFR 1.131, submitted on January 29, 2010, (hereinafter "the declarations") and the new evidence cited in the January 29, 2010 response be entered into the record and considered by the Examiner. The patent owner (petitioner) states that the examiner erred in deciding not to enter the declarations because the declarations were submitted in response to the examiner's response to the earlier-filed declaration by Clint Garoutte (hereinafter "the Garoutte declaration") in the second ACP and that the examiner erred in requiring signatures of the inventors on the declarations. See pages 4-11 of the petition. The petitioner also states that the examiner erred in not entering the January 29, 2010 response because the cited evidence could not have been presented earlier because it was cited in response to new arguments raised in the appeal. See, e.g., pages 11-12 of the petition. The petitioner requests the following relief:

1. Clarification of the requirement regarding who can sign a declaration filed under 37 CFR 1.131;
2. Vacatur of the RAN and reopening of prosecution, or alternatively, issuance of another ACP with consideration of declarations that meet the requirements set forth in the March 25, 2010 decision; or
3. Requirement for the examiner to enter and consider the declarations.

See pages 12-13 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the declarations and response filed January 29, 2010, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

> It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.
>
> Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.
>
> In view of the fact that the patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner cannot file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

The second RAN, mailed April 29, 2010, sets forth specific reasons why the post-ACP declarations and response were not entered into the proceeding record. See pages 8-10 of the RAN. Specifically, the examiner explained that the declarations and the response introduced new issues and evidence that would require further consideration beyond a

nominal review. Furthermore, the examiner stated that the patent owner did not show good and sufficient reasons why the declarations and evidence were not earlier presented. Therefore, the examiner properly provided and explained the "undue burden" as stated in MPEP 2673. For these reasons, the examiner followed Office procedures and policies in consideration of the post-ACP response and evidence. Accordingly, the examiner did not abuse his discretion by the decision to not enter the post-ACP declarations and response filed January 29, 2010.

In the petition, petitioner argues that the examiner erred in holding that only the inventors can sign a declaration under 37 CFR 1.131 in the ACP dated December 17, 2009, and therefore, patent owner should be given an opportunity to file a declaration after the Office provides clarification of the requirements. See pages 4-6 of the petition. First, it is respectfully pointed out that patent owner received such clarification in the decision dated March 25, 2010. Second, the examiner's alleged error in requiring a petition under 37 CFR 1.183 was just one of the reasons why the Garoutte declaration (and not the declarations filed January 29, 2010) was ineffective. The Garoutte declaration is entered into the record, and therefore, patent owner can address on appeal any reason why the examiner found the Garoutte declaration to be ineffective, including the requirement as to who can sign the declaration. Third, even if the examiner did mistakenly "require" that only the inventors can sign a declaration under 37 CFR 1.131 and the patent owner imputed this "requirement" to future declarations, this alleged error is not dispositive. As explained in the paragraph above, the examiner gave proper reasons (e.g., undue burden in significant consideration of late-filed declarations and evidence without a showing of why such evidence was not earlier presented) for not entering the post-ACP declarations and the response, which was in accordance with Office policies and procedures. In other words, the examiner showed why entry of the post-ACP declarations and response would be an undue burden as required by 37 CFR 1.116, and such showing was not reliant on the issue of whether the patent owner can sign a declaration under 37 CFR 1.131. See pages 8-10 of the RAN. Therefore, the record shows that the examiner properly determined that the post-ACP declarations and response should not be entered.

In regard to the petitioner's arguments that the post-ACP declarations and response were improperly denied entry, the record shows that there was opportunities for patent owner to submit declarations and evidence. Specifically, this proceeding was filed on January 8, 2002 and has had a long prosecution history as evident from the statement of facts above. The first rejection based on U.S. Patent No. 6,120,809 to Rhodes ("Rhodes '809"), which is the primary reference used in the rejections and the reference the declarations attempt to disqualify as prior art, was first made on April 4, 2002. Another non-final Office action containing rejections based on Rhodes '809 was mailed on February 16, 2005 and a first ACP containing rejections based on Rhodes '809 has mailed on June 26, 2007. In summary, rejections based on Rhodes '809 have been consistently set forth in Office actions since April of 2002. Therefore, patent owner has had time to provide declarations and evidence under 37 CFR 1.131 to swear behind the Rhodes '809 patent prior to the filing of the January 29, 2010 declarations. More importantly, this proceeding has already been withdrawn from appeal once for consideration of the Garoutte declaration filed under 37 CFR 1.131 and supporting evidence. See the November 4, 2009 decision,

which resulted in the withdrawal of the appeal and the issuance of the second ACP on December 17, 2009. The record clearly shows that patent owner's late filing of a declaration and evidence under 37 CFR 1.131 pertaining to the Rhodes '809 patent, while justified by a showing in the August 31, 2009 petition under 37 CFR 1.183, has already significantly delayed prosecution in this proceeding.

The instant petition states that patent owner believes that they provided the required showing and evidence in the Garoutte declaration. See, e.g., pages 7-8 of the petition. Such arguments may be raised on appeal and as such, are not issues that can be addressed by petitions. See MPEP 1201. Patent owner then states that the declarations of January 29, 2010 were filed to address the deficiencies noted by the examiner regarding the Garoutte declaration in the second ACP. However, the examiner is required to state reasons why the Garoutte declaration is not effective under Office policies and procedures. See MPEP 715 et seq. This requirement to inform the patent owner of the reasons why a declaration under 37 CFR 1.31 is ineffective is not an invitation to file yet another declaration or a promise to consider future declarations or evidence. As stated above, patent owner may present arguments that the Garoutte declaration and its supporting evidence are sufficient on appeal. Therefore, patent owner is not without remedy even if the post-ACP declarations and evidence are not entered into the record. Thus, the petition does not present a persuasive reason why the need for the declarations and evidence could not have been earlier anticipated. As pointed out by the examiner in the second RAN, the request for entry of the post-ACP declarations and evidence fails for want of a persuasive explanation of why the post-ACP declarations and evidence cited in the response are necessary and were not earlier presented.

A further delay in the prosecution of the reexamination proceeding resulting from the practice of continually allowing the petitioner patent owner to perfect declarations filed under 37 CFR 1.131 within the confines of the reexamination proceeding must be weighed against the statutory mandate for special dispatch for reexamination proceedings (35 U.S.C. 305 and 314(c)). On balance, for the reasons discussed above, the record does not support entry of the post-ACP declarations and response that would result in further delay in the instant reexamination proceeding, and would be clearly against the statutory requirement for special dispatch in this instance.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP declarations and response should not be entered, and issued a RAN in the interest of "special dispatch." As stated above, there has already been significant delays in the prosecution for this reexamination proceeding. Therefore, any further delays in advancing prosecution are clearly against the statutory mandate of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP declarations and response. Accordingly, the patent owner's petition is denied as to the request to enter the declarations and response dated January 29, 2010, vacate the second RAN, reopen prosecution, and/or issue a new ACP. In regard to the request to provide clarification of the requirements for declarations filed under 37 CFR 1.131, petitioner patent owner should review MPEP 715.04, which clearly sets forth who

can sign a declaration under 37 CFR 1.131 and the corresponding requirements. See also the March 24, 2010 decision, which also sets forth clarification of the requirements.

**Conclusion**

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP declarations and evidence, vacating the RAN dated April 29, 2010, reopening of prosecution or issuing a new ACP in this reexamination proceeding is denied.

2. Response may be submitted as follows:

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

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

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

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

3. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 271-01535.

/Deborah Jones/
Deborah Jones, SPE Art Unit 3991
Central Reexamination Unit

can sign a declaration under 37 CFR 1.131 and the corresponding requirements. See also the March 24, 2010 decision, which also sets forth clarification of the requirements.

**Conclusion**

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP declarations and evidence, vacating the RAN dated April 29, 2010, reopening of prosecution or issuing a new ACP in this reexamination proceeding is denied.

2. Response may be submitted as follows:

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

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

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

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

3. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 271-01535.

Irem Yucel
Director, Tchnology 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. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 02/17/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 02/17/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 02/17/2011

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

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

For Patent Owner

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

Eugene J. Bernard Ph.D. Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

For Requester

*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002

*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002

For: US Patent No. 6,319,526

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the third party Requester's petition filed June 4, 2010 to request that the jurisdiction of the proceeding be transferred to the Board of Patent Appeals and Interferences (BPAI) for a decision on the appeal. The petition is treated as a petition under 37 CFR 1.181.

The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for consideration.

The petition is dismissed as moot for the reasons set forth below.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,319,526 issued to Dahlstrom et al on November 20, 2001.

2. On January 8, 2002, a request for *inter partes* reexamination of the '526 patent was filed by a third party requester, which proceeding was assigned control no. 95/000,003.

3. On April 4, 2002, reexamination was ordered and a non-final Office action was mailed I the '003 proceeding.

4. On July 3, 2002, a request for *ex parte* reexamination was filed by the same requester, which proceeding was assigned control no. 90/006,317.

5. On August 20, 2002 reexamination was ordered in the '6317 proceeding.

6. On January 30, 2003, the '003 and '6317 proceedings were merged.

7. The merged proceeding progressed to the point of appeal. On April 30, 2008, Patent Owner filed a Notice of Appeal.

8. On July 23, 2008, Patent Owner filed a petition under 37 CFR 1.137(b) for entry of late papers accompanied by an Appellant Brief.

9. Also on July 23, 2008, Patent Owner submitted a petition under 1.183 requesting entry of an amendment attached thereto. (Dismissed October 25, 2008)

10. On October 3, 2008, Requester filed a respondent brief.

11. On February 23, 2009, an Examiner's Answer was mailed.

12. On March 23, 2009, Patent Owner filed a rebuttal brief.

13. On April 8, 2009, the Office issued a Notice of Defective Paper to Patent Owner. The Notice indicated the Appellant's brief as too long and including an insufficient evidence appendix.

14. On April 22, 2009, a corrected Appellant Brief was submitted.

15. On May 12, 2009, Requester filed a respondent brief.

16. On July 8, 2009, the Office issued a second Notice of Defective Paper to Patent Owner. The Notice indicated the Appellant failed to argue the rejections of the claims on appeal.

17. On August 6, 2009, Patent Owner resubmitted the Appellant Brief.

18. On August 20, 2009, requester resubmitted a respondent brief.

19. On August 31, 2009, Patent Owner filed a petition under 37 CFR 1.183 to permit entry of a concurrently filed declaration under 37 CFR 1.131, which was granted on November 4, 2009.

20. On September 28, 2009, the Office issued an Examiner's Answer.

21. On October 28, 2009, Patent Owner filed a rebuttal brief.

22. On October 29, 2009, the Office issued a Notice of Defective Rebuttal Brief.

23. On November 3, 2009, Patent Owner resubmitted the rebuttal brief.

24. On November 17, 2009, Requester filed a response to the declaration entered by the November 4, 2009 decision.

25. On November 24, 2009, Requester filed a request for an oral hearing.

26. On December 17, 2009, the Office mailed a second ACP.

27. On January 29, 2010, Patent Owner filed a response to the second ACP along with declarations of Dahlstrom, Aimutis and Wiegand under 37 CFR 1.131. On the same day, Patent Owner filed a petition under 37 CFR 1.183 in regard to the Aimutis declaration, which was dismissed on March 25, 2010.

28. On February 25, 2010, Requester filed comments in response to the ACP and Patent Owners response.

29. On April 29, 2010, the Office mailed a second Right of Appeal Notice (RAN), which denied entry of the declarations filed on January 29, 2010.

30. On May 24, 2010, the Patent Owner filed a request for reconsideration of the March 25, 2010 decision, which was dismissed on June 2, 2010, and the instant petition under 37 CFR 1.181. This petition was denied on December 22, 2010.

31. On June 4, 2010, the Requester filed the instant petition requesting the prosecution in this proceeding be advanced.

32. Prosecution has proceeded to the issuance of an Office communication on February 3, 2011 that states that the reexamination proceeding is being forwarded to the BPAI for decision on the appeal.

## DECISION

The instant petition, which is treated as a petition under 37 CFR 1.181, requests that the jurisdiction of the proceeding be transferred to the Board of Patent Appeals and Interferences (BPAI) for a decision on the appeal. As pointed out, the Office mailed communication on February 3, 2011 that states that the reexamination proceeding is being forwarded to the BPAI for decision on the appeal. Therefore, the relief requested by the June 4, 2010 petition has already been given by the February 2, 2011 communication. Thus, Requester's June 4, 2010 petition is moot and hereby dismissed.

## CONCLUSION

1. The petition dated June 4, 2010 is dismissed as moot.

2. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 271-01535.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 04/12/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED
APR 12 2011
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 04/12/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 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

Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:

MAILED

APR 12 2001

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

APR 12 2011

CENTRAL REEXAMINATION UNIT

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

*In re* Dahlstrom et al.
*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

**DECISION**
**DENYING PETITION**
**UNDER § 1.182**

*In re* Dahlstrom et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the February 22, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR RECONSIDERATION."

On April 11, 2011, jurisdiction over the proceeding was transferred to the Office of Patent Legal Administration by the Board of Patent Appeals and Interferences for treatment of the February 22, 2011 patent owner petition. The patent owner petition is now before the Office of Patent Legal Administration for decision.

The petition is granted to the extent that the previous decision has been reconsidered, but **denied as to the underlying relief requested**.

## PERTINENT BACKGROUND

1. On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

2. On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

3. On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-111, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was applied in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also applied in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

4. On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

5. On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317 ("the '6317 proceeding"). Reexamination was ordered for the '6317 proceeding on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

6. On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

7. Prosecution continued, until on November 4, 2009, after an Examiner's Answer had been issued, the Office granted a petition filed August 31, 2009 for extraordinary relief under 37 C.F.R. § 1.183 to enter a declaration under § 1.131 by Clint Garoutte, "[b]ased on the facts and circumstances of the present case." This reopened prosecution of the proceeding.

8. On December 17, 2009, an Action Closing Prosecution ("ACP") was mailed, in which the declaration under § 1.131 by Clint Garoutte was considered on the merits but found to be unpersuasive as to the establishment of invention prior to the Rhodes '809 reference. The reexamination proceeding, which had been fully briefed by all parties and ready for docketing at the Board of Patent Appeals and Interferences prior to the November 4, 2009 decision, was reopened by this ACP.

---

[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request. *Inter partes* reexamination was likewise requested "by Leprino Foods Company, through its attorneys," as stated in the Jan. 8, 2002 request.

9. On January 29, 2010, patent owner again petitioned for extraordinary relief under 37 C.F.R. § 1.183. This petition requested relief from the requirements of § 1.131 declaration; in particular, to permit a party under § 1.47 to sign the declaration.[2] This petition was dismissed in a March 25, 2010 Office decision stating that extraordinary relief was not appropriate where an alternative relief; i.e., submission of the § 1.131 declaration by the assignee, was available.[3]

10. On April 29, 2010, a Right of Appeal Notice was issued by the Office.[4] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were listed as being rejected. The Right of Appeal Notice refused entry, pursuant to 37 C.F.R. § 1.116, to the January 29, 2010 declaration under § 1.131 as failing to provide good and sufficient reason why that declaration was not earlier presented.

11. On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including those submitted on January 29, 2010, that had been refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office decision mailed on June 2, 2010.

12. On May 28, 2010, patent owner filed a Notice of Appeal.

13. On June 4, 2010, third party requester filed a petition under § 1.182 requesting that the appeal proceed directly to the Board of Patent Appeals and Interferences.

14. On July 28, 2010, patent owner filed an appellant's brief.

15. On October 5, 2010, the Office issued an Examiner's Answer.

16. On November 5, 2010, patent owner filed the following papers:

    a. A rebuttal brief in response to the October 5, 2010 Examiner's Answer.

    b. A petition entitled "PETITION UNDER 37 CFR § 1.182 FOR REQUEST FOR CONTINUED REEXAMINATION." This petition requested entry of claim amendments and declarations under 37 C.F.R. § 1.131 by Clint Garoutte, James Weigand, William Aimutis, and Donald Dahlstrom.

---

[2] § 1.131 states that it may be submitted by either an inventor, the patent owner or a party qualified under § 1.47.
[3] § 1.131 states that it may be submitted by a patent owner.
[4] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and the aforementioned reopening of prosecution in 2009. The full details are not included here, but may be found in pages 2-7 of the instant patent owner petition.

c. A petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR REQUEST TO DELAY APPEAL PROCEEDINGS BEFORE THE BOARD UNTIL PATENT OWNER'S 37 CFR § 1.182 PETITION HAS BEEN ACTED UPON."

17. On December 22, 2010, the Office issued decisions dismissing the November 5, 2010 petitions under §§ 1.182 and 1.183, and a decision denying the May 24, 2010 petition under § 1.181.

18. On February 3, 2011, the Office noted the November 5, 2010 patent owner's rebuttal brief, and forwarded the proceeding to the Board of Patent Appeals and Interferences for decision on the appeal.

19. On February 9, 2011, the Board of Patent Appeals and Interferences docketed the appeal as no. 2011-005022.

20. On February 22, 2011, patent owner filed the following papers:

a. A petition requesting reconsideration of the denial of the December 22, 2010 decision denying the May 24, 2010 petition under § 1.181.

b. The instant petition requesting reconsideration of the December 22, 2010 decision dismissing the November 5, 2010 petition under § 1.182.

c. A petition requesting delaying of the appeal proceedings until the instant reconsideration petition has been acted upon.

## PERTINENT STATUTES AND REGULATIONS

**35 U.S.C. § 314 provides, in pertinent part:**

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

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

**37 C.F.R. § 1.182 provides:**

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

## DECISION

1. The Instant Situation Does Not Justify Reopening of Prosecution

A. Background

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is pending."[5] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution (ACP) in an *inter partes* reexamination proceeding or after a final rejection in an *ex parte* reexamination proceeding. A petition under § 1.182 may provide relief for a situation that is "not specifically provided for" in the regulations.[6]

By filing such a petition, the patent owner could, in limited situations, obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection (*ex parte* reexamination), or after an ACP (*inter partes* reexamination). This relief was made available via a 37 CFR § 1.182 petition, in appropriate circumstances. The 37 CFR § 1.182 petition will be referred to hereinafter as "the § 1.182 petition."

To qualify for relief of this nature, the § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define and reduce the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition

---

[5] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.
[6] 37 C.F.R. § 1.182 (2004).

should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined/reduced for appeal or issuance of a reexamination certificate.

Where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be considered taking into account the statutory mandate of 35 U.S.C. § 314(c), stating that "all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding must further the resolution of the substantial new questions of patentability raised in the proceeding with special dispatch.

In this instance, the patent owner petitioned, on November 5, 2010, for reopening of prosecution after a full briefing at the appeal stage, in order to enter (a) four newly presented declarations under 37 C.F.R. § 1.131 and (b) "narrowing amendments to further clarify the invention."[7] Patent owner seeks such relief under the provisions of March 2005 Notice discussed above. Patent owner's plea for relief is grounded on the position that entry of the declarations would remove the Rhodes '809 patent from prior art status, thereby overcoming the rejections based upon that patent, and furthermore, that the claim amendments proposed with the petition would overcome the rejections of record.

In an Office decision issued on December 22, 2010, the November 5th petition was dismissed. It was pointed out in that decision that the issue for which the amendment and evidence submissions are stated to address arose in the initial Office action of April 4, 2002. In view of the previous ability of the patent owner to submit relevant affidavits and claim amendments, and the advanced stage of the proceeding, reopening prosecution for entry of § 1.131 affidavits, claim amendments, and new claims was found not to be consistent with the Office's requirement to handle reexamination proceedings with special dispatch. Furthermore, it was explained that, to the extent that patent owner petitioner is contending that an action taken by the examiner has been improper, the proper avenue for seeking relief from improper closure of prosecution in an *inter partes* reexamination is through supervisory review under § 1.181.

Upon reconsideration, the instant situation is again found not to justify a continuation of the reexamination proceeding through reopening of the lengthy prosecution thus far to consider the new affidavits, new amended claims, and new claims submitted on November 5, 2010.

B. Patent Owner Proposes to Amend the Claims for the First Time

With respect to the submission of new and amended claims for entry via the instant petition, patent owner has presented no colorable justification for the delay in submission of new and amended claims at this stage of the proceeding, more than nine years from the initial filing of the request for *inter partes* reexamination, and after patent owner's filing of a notice of appeal on May 28, 2010, patent owner's filing of an appellant's brief on July 28, 2010, and the issuance of an examiner's answer on October 5, 2010. The new and amended claims proposed to be entered

[7] Petition at 1.

and considered by the examiner were not occasioned by any new ground of rejection recently made in the reexamination or by a newly raised issue, but rather, are in response to the original issues raised in the initial Office action of April 4, 2002. Patent owner has had numerous occasions to enter such amended and new claims as a matter of right, and additional occasions for entry upon a showing of good and sufficient reasons why the amendment was necessary and was not earlier presented.

Since patent owner has had previous opportunities under the rules to enter the requested submission, the Office will not act now, to provide relief for "situations not specifically provided for," to regress the proceeding and delay the resolution of the substantial new question of patentability for which the instant *inter partes* reexamination was ordered in 2002. Such action by the Office to reopen prosecution for further consideration of new issues occasioned by entry of new and amended claims would not be consistent with the Office's mandate to handle *inter partes* reexamination with "special dispatch" as set forth in 35 U.S.C. §§ 304 and 314(c).

C. Patent Owner Had Prior Opportunity to Submit § 1.131 Declarations

As a further basis for this decision, patent owner has also had previous occasions to enter an affidavit such as that submitted on November 5, 2010. Prosecution was reopened on November 4, 2009 for that exact purpose. This reopening occurred when the Office granted a petition for extraordinary relief under 37 C.F.R. § 1.183 to enter a declaration under § 1.131 by Clint Garoutte, after substantial examination/prosecution, including an Examiner's Answer, had already occurred. Since patent owner has had at least one previous opportunity under the rules to enter the requested affidavit, the Office will not act now, to provide relief for "situations not specifically provided for" in its rules, to further delay the resolution of the substantial new question of patentability for which the instant *inter partes* reexamination was ordered in 2002. Such action by the Office to reopen prosecution for additional evidence, after patent owner has had prior opportunity to present such evidence, would not be consistent with the Office's mandate to handle *inter partes* reexamination with "special dispatch" as set forth in 35 U.S.C. §§ 304 and 314(c).

Clearly, reopening prosecution for additional evidence and amended and new claims would severely set back a proceeding already regressed once, and filed and ordered in the first half of 2002, and the equities do not favor the Office taking such action.

2. Petitioner's Arguments in the Instant Petition are Not Persuasive

In the instant petition, patent owner alleges error in the December 22, 2010 decision denying extraordinary relief based upon the following: (1) grant of a § 1.183 petition in November 2009 to enter a § 1.131 submission is inconsistent with denial of such relief now; (2) actions of the patent examiner "thwarted" consideration of the earlier § 1.131 submission; (3) entry of the instant § 1.131 submission would further prosecution and not delay it by removing the Rhodes reference as prior art; (4) the narrowing claim amendments could not have been provided earlier; (5) the ineffectiveness of patent owner's prior counsel should not be held against patent owner; and (6) common sense and fairness dictate that the requirement for special dispatch not trump substantive review of evidence.

First, the November 2009 reopening of prosecution provided a limited measure of relief for a specific set of facts. The November 2009 decision provided for entry of the August 31, 2009 Garoutte declaration and attached Exhibits A-P. The decision weighed the facts and circumstances existing at that time and provided for a single instance in which a specific declaration and attached exhibits would be entered. However, that decision did not provide for open-ended continuation of proceedings until such time as patent owner would decide that it had submitted a declaration that it was satisfied with. Nor did it "make [] events prior to November 2009 irrelevant to the special dispatch requirement" as alleged by petitioner. Further, the November 2009 decision did not, in any way, contemplate entry of narrowing claim amendments (that could have been submitted long ago) as are proposed for entry in the instant petition - entry of which would require significant further examination/prosecution.

The December 22, 2010 decision from which petitioner seeks reconsideration, and the present decision, clearly take into account the request for entry of the newly proposed amendment as well as the newly submitted § 1.131 evidence (which would result in significant delay if prosecution were reopened as requested) when evaluating whether the proposed submissions could have been proposed at an earlier date in accordance with special dispatch. The decisions take into account the extended prosecution which began in November 2001 and has already been delayed through the granting of extraordinary relief to enter § 1.131 evidence in 2009. The decisions also take into account the fact that the proceeding is currently docketed for appeal.

The instant petition under § 1.182 seeks a measure of relief not provided for under the existing rules, and which is subject to careful consideration of all of the relevant facts and circumstances in the proceeding. As detailed above, the facts and circumstances as they currently exist are not the same as had existed in November 2009, at the time the Office previously took the extraordinary measure of waiving rules to permit entry of evidence under § 1.131. The grant of relief at that time addressed the events that gave rise to the extraordinary circumstances, and extinguished the prior events as a basis to rely upon for further unrelated relief. The instant situation is not one where patent owner is unable to enter newly found evidence; rather, it is one where patent owner is seeking to continue an already prolonged prosecution until patent owner can, if possible, place in front of the Office a § 1.131 affidavit and a set of claims that patent owner is satisfied with. However, the rules governing the instant proceeding do not contemplate unlimited attempts to submit evidence and claim revision/addition; rather, the rules indicate that any amendment or evidence filed after prosecution is closed will be entered only under good and sufficient reasons why the amendment and evidence are necessary and not earlier presented. The rules are designed to provide an orderly procedure that can be relied upon by all parties, and that is not lightly set aside through waiver, or circumvented through reopening of prosecution.[8] Therefore petitioner's argument is not persuasive that relief to regress the proceeding must again be granted merely because similar relief was previously granted, upon different facts and circumstances.

---

[8] *In re Sivertz*, 227 USPQ 255 (July 23, 1985) (citing *Myers v. Feigelman*, 455 F.2d 586, 601, 172 USPQ 580, 584 (CCPA 1972) (stating "the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules")).

Second, petitioner alleges that the examiner erred in failing to ensure consideration of § 1.131 evidence. However, any question of error in actions taken by an examiner is addressable through petition under § 1.181. Relief under § 1.182 is unavailable where the situation is addressed elsewhere in the regulations.[9] Patent owner is in fact concurrently seeking review of the examiner's actions via such a petition seeking reconsideration of the decision denying relief under § 1.181, filed on February 22, 2011. Since the question of examiner error is specifically provided for by § 1.181, relief directed to asserted examiner error is not available under § 1.182. Therefore, petitioner's argument based upon examiner error is not persuasive.

Third, petitioner alleges that entry of the instant § 1.131 submission would further prosecution and not delay it by removing the Rhodes reference as prior art. However, there is no certainty as to whether entry of the § 1.131 submission would act to remove the Rhodes reference as prior art. A previous § 1.131 submission entered into the proceeding through the November 2009 decision granting relief under § 1.183 failed to result in removal of the Rhodes reference as prior art. Therefore, any such benefit to the furtherance of prosecution is merely speculative. Furthermore, the petition does not allege with specificity how entering the proposed narrowing amendments would further prosecution rather than delay prosecution. Therefore, such argument is not persuasive.

Fourth, petitioner alleges that the narrowing claim amendments could not have been provided earlier because "[p]rior counsel failed to see a key distinction between the Rhodes reference and claims as granted and that are currently under reexamination."[10] As stated in the December 22, 2010 decision, this issue arose in the initial Office action of April 4, 2002 – nearly nine years ago. Failure of the patent owner, or its designated agent, to appreciate the relevance of claim revision and certain evidence is not a good and sufficient cause for its entry at such a late point in an already extended prosecution.

Fifth, petitioner alleges that prior counsel was ineffective in failing to recognize potential narrowing amendments and in submitting declarations under § 1.131 which were found not persuasive. To the extent that this is alleged, the petitioner patent owner selected the prior counsel and agreed to be represented in all matters in front of the Office by that counsel. As stated in *Link v. Wabash R. Co.*:[11]

> There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent.

Moreover, in *Huston v. Ladner*, the Federal Circuit held that it was not an abuse of discretion for the Office to hold (in an inter partes proceeding) that the alleged negligence of applicant's

---

[9] § 1.182 states that it is directed to "[a]ll situations not specifically provided for in the regulations of this part."
[10] Petition at 15.
[11] *Link v. Wabash R. Co.*, 370 U.S. 626, 633-34 (1962).

original was not good cause to justify submitting additional evidence.[12] A "bad judgment, inexperience, or lack of competence" by an attorney in an interference proceeding was found to be properly chargeable to the patent applicant.[13]

For this reason, patent owner's argument that patent owner is not accountable for the acts of prior counsel is not persuasive.

Finally, petitioner argues that common sense and fairness dictate that the requirement for special dispatch not trump substantive review of evidence. The prior decision dismissing continued prosecution of the proceeding before the examiner, and the present decision, have applied common sense in the interest of fairness and equity to all parties affected by the *inter partes* reexamination (including the requester and the public which await resolution of the substantial new questions of this proceeding, and the Office which does not have endless resources), and find that patent owner has been presented sufficient prior opportunities to present the desired amendments and § 1.131 evidence.

Common sense would recognize that despite patent owner's allegations about the ability of prior counsel, it is the patent owner who would reasonably be expected to be in possession of any factual information pertinent to a question of prior invention under § 1.131. In view of the fact that the Rhodes '809 reference was first presented in a rejection on April 4, 2002, and that prosecution has afforded numerous opportunities for patent owner to enter revised/new claims and evidence submissions, including the extraordinary waiver permitting entry of § 1.131 evidence in November of 2009, patent owner is deemed to have had fair opportunity to enter the desired evidence. While a petition under § 1.182 may provide relief for an extraordinary situation otherwise not provided for in the rules, this "applies only where other rules are inapplicable and is not intended as a means for evading the requirements of other rules."[14] Patent owner may not now seek to evade or delay compliance with the requirements of § 1.131 through a petition under § 1.182. To the extent that patent owner's previous counsel's actions are relied upon to show a need for further opportunity for action by the patent owner, the previous counsel's actions are evidence that prior opportunities existed for entry of such evidence, and that patent owner, and/or owner's designated representative, chose not to take such opportunities.

Common sense and fairness would also recognize that all parties are entitled to rely upon the ordinary rules governing the course of a proceeding, which could not be expected to be delayed *ad infinitum* through continuous submissions of new evidence.[15] As pointed out, the question of fairness must also be considered with regard to the *inter partes* requester and the public, for whom resolution of the questions of patentability has been delayed due in part to extraordinary measures granted to patent owner to ensure that pertinent evidence be entered into the proceeding.

---

[12] *Huston v. Ladner*, 973 F.2d 1564, 1566-67 (Fed. Cir. 1992).
[13] *Id.*
[14] *Hicks v. Costello*, 1903 Dec. Comm'r Pat 123, 125 (1903), 103 O.G. 1163 (December 23, 1902) (discussing Rule 213, which is the precursor of current 37 C.F.R. § 1.182),
[15] *See, e.g., In re Sivertz*, 227 USPQ 255 (July 23, 1985).

3. Summary

The above facts, while analyzed individually, have been evaluated in their totality to determine whether circumstances exist to justify granting reopening of prosecution to enter patent owner's desired evidence submission. As pointed out above, patent owner has been afforded fair opportunity to present any desired evidence, including evidence as to prior invention as desired in the instant petition.

Additionally, patent owner is concurrently seeking identical relief (e.g., to remove the Rhodes '809 patent as prior art through § 1.131 declarations) via such a petition seeking reconsideration of the decision denying relief under § 1.181, filed on February 22, 2011. As the relief for which patent owner seeks has been provided for elsewhere in the regulations, relief under § 1.182 would be inappropriate under the facts and circumstances of this proceeding.[16]

Therefore, the petition is granted to the extent that the previous decision has been reconsidered, but denied as to the underlying relief requested.

## CONCLUSION

1. The petition requesting reconsideration of the December 22, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

2. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review upon entry of a final decision by the Board of Patent Appeals and Interferences. See MPEP 1002.02.

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

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

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

April 11, 2010
Kenpet/RCR/IP/

[16] Note that a situation which is covered by § 1.181 does not become "not provided for" merely because the § 1.181 petition is dismissed or denied by the Office.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 04/12/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 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

**DO NOT USE IN PALM PRINTER**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
EUGENE J. BERNARD
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111

Date:
MAILED
APR 12 2011
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000003
PATENT NO. : 6319526
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 04/12/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 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
Eugene J. Bernard
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

Date:
MAILED

APR 12 2011

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90006317
PATENT NO. : 6319526
ART UNIT : 3900

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

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

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

APR 12 2011

CENTRAL REEXAMINATION UNIT

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 1500
50 SOUTH SIXTH STREET
MINNEAPOLIS MN 55402-1498

(For Patent Owner)

Eugene J. Bernard, Ph.D., Esq.
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCADERO CENTER, 8TH FLR
SAN FRANCISCO, CA 94111

(For Third Party Requester)

*In re* Dahlstrom et al.
*Inter Partes* Reexamination Proceeding
Control No. 95/000,003
Filed: January 8, 2002
For: U.S. Patent No. 6,319,526 B1

**DECISION**
**DENYING PETITION**
**UNDER § 1.181**

*In re* Dahlstrom et al.
*Ex Parte* Reexamination Proceeding
Control No. 90/006,317
Filed: July 3, 2002
For: U.S. Patent No. 6,319,526 B1

This is a decision on the February 22, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.181 REQUEST FOR RECONSIDERATION," which is being treated as a petition under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the December 22, 2010 decision of the Director of Technology Center 1600, who oversees the Central Reexamination Unit, which decision denied patent owner's request for entry and consideration of a declaration and supporting evidence submitted January 29, 2010.

On April 11, 2011, jurisdiction over the proceeding was transferred to the Office of Patent Legal Administration by the Board of Patent Appeals and Interferences for treatment of the February 22, 2011 patent owner petition. The patent owner petition is now before the Office of Patent Examination Policy for decision.

The petition to overturn the December 22, 2010 decision of the TC 1600 Director is granted to the extent that the previous decision has been reconsidered, and is **denied as to the underlying relief requested**.

## PERTINENT BACKGROUND

1. On November 20, 2001, U.S. Patent No. 6,319,526 ("the '526 patent) was issued to Dahlstrom *et al.*, having 113 claims.

2. On January 8, 2002, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Leprino Foods Company, and the resulting reexamination proceeding was assigned control number 95/000,003 ("the '003 proceeding").

3. On April 4, 2002, reexamination was ordered for claims 1-14, 16-33, 35-59, 61-69, 89-111, and 113 of the '526 patent. On the same date, an Office action was mailed, rejecting claims 1-14, 16-33, 35-39, 61-69, 89-111, and 113. In this Office action, U.S. Patent 6,120,809 to Rhodes ("Rhodes '809") was applied in anticipation rejections of claims 1-4, 7-14, 16-22, 25-29, 31, 32, 35, 36, 38, 40-48, 51, 62-69, 89-92, and 95-101; the Rhodes '809 patent was also applied in obviousness rejections of claims 5, 6, 10, 12-4, 23-25, 30, 33, 37, 39, 45-47, 49, 50, 52-59, 61, 65, 68, 89, 93, 94, 102-111, and 113.

4. On June 3, 2002, patent owner filed a response to the April 4, 2002 Office action, including amendments to claims 26, 36, 52, and 89, cancellation of claim 15, and addition of claims 114-163. The response included a discussion of the disclosure of the Rhodes '809 patent. Third party requester comments were filed on July 3, 2002.

5. On July 3, 2002, the same third party requester[1] filed a request for *ex parte* reexamination of claims 1-113 of the '526 patent, and the resulting reexamination proceeding was assigned control number 90/006,317 ("the '6317 proceeding").. Reexamination was ordered for the '6317 proceeding on August 20, 2002 for claims 1-14, 16-69, and 89-113 of the '526 patent.

6. On January 30, 2003, the Office merged the '003 and '6317 reexamination proceedings.

7. Prosecution continued, until on November 4, 2009, after an Examiner's Answer had been issued, the Office granted a petition filed August 31, 2009 for extraordinary relief under 37 C.F.R. § 1.183 to enter an accompanying declaration under § 1.131 by Clint Garoutte, "[b]ased on the facts and circumstances of the present case."

8. On December 17, 2009 an Action Closing Prosecution ("ACP") was mailed, in which the declaration under § 1.131 by Clint Garoutte was considered on the merits but found to be unpersuasive as to the establishment of invention prior to the Rhodes '809 reference. The

[1] *Ex parte* reexamination was requested "by Leprino Foods Company, through its attorneys," as stated in the June 3, 2002 request. *Inter partes* reexamination was likewise requested "by Leprino Foods Company, through its attorneys," as stated in the Jan. 8, 2002 request.

reexamination proceeding, which had been fully briefed by all parties and ready for docketing at the Board of Patent Appeals and Interferences prior to the November 4, 2009 decision, was reopened by this ACP.

9. On January 29, 2010, patent owner filed a response to the second ACP along with a declaration under § 1.131 signed by two of the three named inventors.

10. On January 29, 2010, patent owner again petitioned for extraordinary relief under 37 C.F.R. § 1.183. This petition requested relief from the requirements of § 1.131 declaration; in particular, to permit a party under § 1.47 to sign the declaration.[2] This petition was dismissed in a March 25, 2010 Office decision stating that extraordinary relief was not appropriate where an alternative relief; *i.e.*, submission of the § 1.131 declaration by the assignee, was available.[3]

11. On April 29, 2010, a Right of Appeal Notice was issued by the Office.[4] Claims 1-14, 16-103, 114-123, and 125-136 were listed as being under reexamination in the proceeding. All of the claims under reexamination in the proceeding were listed as being rejected. The Right of Appeal Notice refused entry, pursuant to CFR § 1.116(e), to the January 29, 2010 declaration under § 1.131 as failing to provide good and sufficient reason why that declaration was not earlier presented.

12. On May 24, 2010, patent owner filed petitions under § 1.181 and § 1.183 for the purpose of requesting entry of declarations, including that submitted on January 29, 2010, that had been refused entry in the Right of Appeal Notice of April 29, 2010. Patent owner's May 24, 2010 petition under § 1.183 was dismissed in an Office decision mailed on June 2, 2010.

13. On December 22, 2010, the Office issued decisions dismissing the November 5, 2010 petitions under §§ 1.182 and 1.183, and a decision denying the May 24, 2010 petition under § 1.181.

14. On February 22, 2011, patent owner filed the following papers:

    a. The instant petition requesting reconsideration of the denial of the December 22, 2010 decision denying the May 24, 2010 petition under § 1.181.
    b. A petition requesting reconsideration of the December 22, 2010 decision dismissing the November 5, 2010 petition under § 1.182.
    c. A petition requesting delaying of the appeal proceedings until the instant reconsideration petition has been acted upon.

---

[2] § 1.131 states that it may be submitted by either an inventor, the patent owner or a party qualified under § 1.47.

[3] § 1.131 states that it may be submitted by a patent owner.

[4] The lengthy prosecution of the merged reexamination proceeding from January 2003 through April 2010 included, *inter alia*, issuance of a NIRC and its subsequent withdrawal in 2006, revival of the proceeding in September 2008 subsequent to a late-filed patent owner appellant's brief, appeal and full briefing by the parties in 2008-2009, and the aforementioned reopening of prosecution in 2009. The full details are not included here, but may be found in pages 2-7 of the instant patent owner petition.

## PERTINENT STATUTES AND REGULATIONS

### 35 U.S.C. § 314 provides, in pertinent part:

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

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

### 37 C.F.R. § 1.116(e) provides:

An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), **may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented**. (Emphasis added).

### 37 C.F.R. § 1.181 provides in part:

(a) Petition may be taken to the Director:

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

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

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

## DECISION

Petitioner (patent owner) seeks intervention by the Director to reverse the December 22, 2010 decision of the Technology Center (TC) Director of TC 1600, who oversees the CRU (which

decision denied patent owner's May 14, 2010 petition). Petitioner seeks this intervention on the grounds that the declaration and supporting evidentiary exhibits provided on January 29, 2009 were entitled to entry under the rules. Accordingly, petitioner seeks entry and consideration of the declaration and supporting exhibits submitted (January 29, 2010), after the issuance of the December 17, 2009 Action Closing Prosecution.

For the Director to intervene, petitioner must show that the December 22, 2010 decision by the TC 1600 Director was made in clear error. A petition under 37 CFR § 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). The TC 1600 Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of error. A review of the record indicates that the TC 1600 Director did not abuse her discretion, or act in an arbitrary and capricious manner, in the petition decision of December 22, 2010. The record establishes that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Petitioner has therefore not provided a showing of clear error.

1. The January 29, 2010 Submission Was Properly Refused Entry

Patent owner is requesting evidence to be entered and considered after an action closing prosecution (ACP) in an *inter partes* reexamination proceeding. The rules of practice provide that such evidence "may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented." Absent such a showing, the non-entry of such evidence is fully in accordance with the rules of practice.

Petitioner attempts to show that this declaration was submitted as early as possible by arguing that patent owner did not have the opportunity to file a § 1.131 declaration prior to August 2009 because the evidence was newly discovered at that time. Petitioner asserts that this was acknowledged by the Office via its grant of the petition under § 1.183 to enter that evidence. It is argued that, as a consequence of that asserted acknowledgment on the part of the Office, the filing of the new declaration in January 2010, in response to the Office action apprising patent owner of the deficiencies of the Garoutte declaration could not have been provided earlier. Petitioner asserts that any delay was therefore strictly attributable to the time that the Office used to review the Garoutte declaration.

The flaw in this line of reasoning is that, although the insufficiency of a response to an Office action may give rise to good and sufficient reason why a further response is needed, it does not provide good and sufficient reason as to why the better response was not provided in the first instance. This can be illustrated by considering the natural consequence of such reasoning. If an Office finding that a prior submission is not persuasive would amount to "good and sufficient reason," then 37 CFR § 1.116(e) would be a nullity, since the only time further evidence is adduced is where the examiner is maintaining a rejection of claims.[5]

[5] While there may be a rare exception in an *inter partes* reexamination to address requester rebuttal evidence or argument (even where the examiner finds the requester rebuttal evidence or argument insufficient to address patent

Patent owner provides no argument that would establish that the information and evidence supplied with the January 29, 2010 declaration could not have been supplied earlier. The prior entry of the "Garoutte" declaration (via the November 4, 2009 decision) through granting of extraordinary relief was based in part on patent owner's representations that the *existence of the documentary evidence was newly discovered at a late date despite extensive ongoing efforts to uncover any evidence*. However, in this instance, no evidence or argument is put forward to explain why the new declaration and the additional evidentiary exhibit could not have been provided earlier – *i.e.*, with the August 2009 submission.

The record is clear that patent owner has not provided good and sufficient reasons why the evidence was not presented earlier. The bulk of patent owner's arguments address reasons why the evidence is being submitted (*i.e.*, why it is believed to be "necessary") but does not address why the evidence was not presented ***earlier***. For the above reasons, the January 19, 2010 submission was properly refused entry.

2. The December 22, 2010 Decision Was Not In Error

Patent owner alleges error in the December 22, 2010 decision based upon the following: (1) review of the § 1.131 declaration (and supporting Exhibit Q) would not have constituted more than a nominal review; (2) the § 1.131 declaration could not have been earlier presented by former counsel; (3) the prior grant of a § 1.183 petition in November 2009 to enter a § 1.131 submission is inconsistent with not allowing the later filed § 1.131 submission to be entered (as the time delay was attributable to the Office reviewing the § 1.131 submission that was entered by that decision); and (4) fairness and equity dictate that the statutory requirement for "special dispatch" not trump substantive review of evidence.

With respect to the first allegation of error, patent owner's arguments directed to the amount of review the examiner would find necessary to evaluate the new declaration and evidence do not provide a reason as to why this evidence was not submitted earlier. It is however noted that this new declaration is not merely curing informalities such as an improper signature or failure to provide the hortatory language regarding loss of rights and 18 U.S.C. § 1001. The December 17, 2009 action closing prosecution (ACP) pointed out significant substantive evidentiary shortcomings in the "Garoutte" declaration that the January 19, 2010 declaration and evidence were provided to address. This would, by its very nature, require careful and detailed consideration by the examiner to determine whether the evidence taken in conjunction with the statements in the declaration is adequate to establish a date of invention that is earlier than the prior art date of the applied Rhodes reference. Regardless of the amount of review required, however, arguments directed to the necessary amount of review do not address the requirement under 37 CFR 1.116 that the "the affidavit or other evidence is necessary and was not earlier presented," and are thus not persuasive.

The second and third allegations of error relate to the timing aspects of the January 29, 2010

---

owner's initial evidence, but patent owner wishes to enter further evidence as insurance *re* future review of the patent), 37 CFR 1.116(e) applies to *ex parte* applications and reexaminations, where there is never such an exception, and 37 CFR 1.116(e) must be interpreted in terms of all proceedings to which it applies.

submission. As explained below, these arguments do not show error in the TC 1600 Director's decision.

With respect to the second allegation of error, patent owner's argument - that previous counsel could not have presented this new declaration earlier because previous counsel thought the previously submitted "Garoutte" § 1.131 declaration was adequate and were not yet apprised of the insufficiency of the first submission - is not persuasive. Insofar as the Garoutte declaration was legally inadequate to establish prior invention, the misapprehension by previous counsel of what proof is required to establish prior invention by the named inventors does not redound to patent owner's benefit. As stated in *Link v. Wabash R. Co.*:[6]

> There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent.

Moreover, in *Huston v. Ladner*, the Federal Circuit held that it was not an abuse of discretion for the Office to hold (in an *inter partes* proceeding) that the alleged negligence of applicant's original was not good cause to justify submitting additional evidence.[7] A "bad judgment, inexperience, or lack of competence" by an attorney in an interference proceeding was found to be properly chargeable to the patent applicant.[8]

For this reason, patent owner's argument - that patent owner is not accountable for the acts of prior counsel - is not persuasive.

With respect to the third allegation of error, patent owner's argument that the new submission was promptly presented in response to being informed of the shortcomings of the prior filing does not establish that the refusal to enter the submission was improper. As discussed above, although the insufficiency of a response to an Office action may gives rise to good and sufficient reason why a further response is needed, it does not provide good and sufficient reason as to why the better response was not provided in the first instance. No evidence or argument is put forward to explain why the new declaration and the additional evidentiary exhibit could not have been provided earlier – *i.e.*, with the August 2009 submission (for which prosecution was reopened). Therefore, patent owner's argument that the submission merits entry because it overcomes the shortcomings of the prior filing is not persuasive.

With respect to the fourth allegation of error, patent owner's arguments with respect to fairness, equity, and the loss of patent rights have no bearing on the determination of whether the examiner (and TC 1600 Director) acted correctly when refusing entry of the evidence after close of prosecution. Such considerations affect whether waiver of the rule or other relief should be granted and are considered under § 1.182 and/or § 1.183, and a companion petition to such effect has in fact been filed by patent owner.

---

[6] *Link v. Wabash R. Co.*, 370 U.S. 626, 633-34 (1962).
[7] *Huston v. Ladner*, 973 F.2d 1564, 1566-67 (Fed. Cir. 1992).
[8] *Id.*

The consequences argued by patent owner, namely loss of patent rights, as supporting a finding of error in the previous decision denying relief under § 1.181 are merely general consequences of any rejection that is maintained. Such an argument fails because (a) it does not provide good and sufficient reasons why the evidence was not presented earlier, and (b) such a reading of the rule would result in evidence always being entered into the record for consideration – thus eviscerating the entire rule and creating a set of iterations (finding of evidence not persuasive followed by the next effort at providing a persuasive document) which would not be limited.

For the reasons set forth above, the record establishes that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Petitioner has therefore not provided a showing of clear error. Therefore, the petition is granted to the extent that the previous decision has been reconsidered, but is **denied as to the underlying relief requested**.

## CONCLUSION

1. The petition requesting reconsideration of the December 22, 2010 decision is granted only to the extent that the December 22, 2010 decision of the TC 1600 Director has been fully reconsidered, but is denied with respect to making any change therein. The petition is denied as to the underlying relief requested.

2. A review of the record indicates that the TC 1600 Director acted in accordance with stated Office policy in denying the petition of May 24, 2010.

3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review upon entry of a final decision by the Board of Patent Appeals and Interferences. See MPEP 1002.02.

4. A copy of this decision will be made of record in the reexamination file.

5. Any further correspondence with respect to this matter should be addressed as follows:

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

6. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726, or, in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Robert W. Bahr
Senior Patent Counsel
Acting Associate Commissioner for
Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 95/000,003 | 01/08/2002 | 6319526 | 01473.302300 | 4575 |

25763 7590 04/13/2011

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 04/13/2011

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
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. |
|---|---|---|---|---|
| 90/006,317 | 07/03/2002 | 6319526 | 01473.302800 | 9581 |

25763 7590 04/13/2011

| EXAMINER | |
|---|---|

DORSEY & WHITNEY LLP - MINNEAPOLIS
INTELLECTUAL PROPERTY PRACTICE GROUP (MP-23)
ATTENTION: PATENT PROSECUTION DOCKETING DEPARTMENT
50 SOUTH SIXTH STREET, SUITE 1500
MINNEAPOLIS, MN 55402-1498

| ART UNIT | PAPER NUMBER |
|---|---|

DATE MAILED: 04/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

*Inter Partes* LEPRINO FOODS CO.
v.
LAND O' LAKES, INC.

---

Appeal 2011-005022
Reexamination Control No. 95/000,003 & 90/006,317
Patent No. 6,319,526
Technology Center 3900

---

**DECISION ON PETITIONS**

This is a decision on the "Petition under 37 C.F.R. § 1.183 for Request to Delay Appeal Proceedings before the Board until Patent Owner's 37 C.F.R. § 1.181 Petition for Reconsideration has been Acted Upon" of February 22, 2011 ("Petition #1") and a decision on the "Petition under 37 C.F.R. § 1.183 for Request to Delay Appeal Proceedings before the Board until Patent Owner's 37 C.F.R. § 1.182 Petition for Reconsideration has been Acted Upon" of February 22, 2011 ("Petition #2") in merged *Inter Partes* Reexamination Control No. 95/000,003 &

90/006,317. The petition fees of $400 pursuant to 37 C.F.R. §1.17(f) have been charged to petitioner's deposit account on February 22, 2011, for each petition.

A review of the record reveals that a decision on both the "Petition under 37 C.F.R. §1.181 For Request for Reconsideration" and the "Petition under 37 C.F.R. §1.182 For Request for Reconsideration" of February 22, 2011, was mailed on April 12, 2011. Upon the mailing of such petitions decisions, jurisdiction over this merged *Inter Partes* Reexamination proceeding immediately reverted back to the Board of Patent Appeals and Interferences. Since the petitions in question have been decided, Petitions #1 and #2 are **dismissed as moot.**

## CONCLUSION

Petitions #1 and #2 are DISMISSED.

James T. Moore
Acting Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498

COUNSEL FOR THIRD PARTY REQUESTER:

Eugene J. Bernard
TOWNSEND & TOWNSEND AND CREW LLP
Two Embarcadero Center
San Francisco, CA 94111