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OFFICE OF PETITIONS

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In re Sembonmatsu et al.	:	
***Inter partes* Reexamination Proceeding**	:	
Control No.: 95/000,006	:	**ON PETITION**
Filed: December 4, 2002	:	
For: U.S. Patent No.: 6,357,595	:	

This is a decision on patent owner's petition filed August 20, 2010 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director of Technology Center 1600 (Technology Center Director), dated June 24, 2010, which refused to compel the entry of either the amendment filed April 25, 2007, or the amendment filed June 3, 2008. This is also a decision on patent owner's request for a corrected decision on petition filed July 22, 2010.

SUMMARY

The July 22, 2010 request for the Office to issue a corrected decision on petition to replace the decision issued on June 24, 2010, is **dismissed as moot** in view of the petition filed August 20, 2010.

The petition to overturn the decision of the Technology Center Director dated June 24, 2010 is being taken as a petition under 37 CFR 1.183 to waive the rules and permit entry of an amendment, and is **granted in part** and **dismissed in part**, as follows:

A. The refusal to enter the amendments of April 25, 2007 and June 23, 2008, will not be disturbed.

B. In the interest of equity, the 37 CFR 41.77(b)(1) proscription on addressing matters other than those of the new ground of rejection is being waived to the extent that an amendment presenting a claim change *re* the rejection of claim 16 under 35 U.S.C. 112 affirmed by the Board will be entered.

C. Also in the interest of equity, the patent owner is being given one (1) month from the mail date of this decision in which patent owner may file a replacement amendment as provided below in this decision.

BACKGROUND

1. U.S. Patent No. 6,357,595 (hereinafter, the '595 patent) issued on March 19, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/000,006, was filed by a third party requester on December 4, 2002.

3. *Inter partes* reexamination was ordered for the '006 reexamination proceeding on February 6, 2003. On the same day, a non-final Office action was mailed in the '006 reexamination proceeding. The Office action rejected all the claims based upon U.S. Patent No. 5,791,486 to Brahmbhatt (hereinafter "Brahmbhatt").[1]

4. The patent owner filed a response to the non-final Office action on April 7, 2003. The response included proposed amendments to claim 1, cancelled claims 12-15, and added a new independent claim 16.

5. The third party requester filed comments on May 7, 2003, responsive to the patent owner's response, and proposed an additional ground of rejection based on the embodiment shown in Figure 17 of Brahmbhatt.

6. On October 7, 2003, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party requester comments. The ACP continued to adopt the same grounds of rejections, as set forth in the February 6, 2003 Office action, for the pending claims and included new claim 16 in rejection of claims 1, 2 and 5-11 as being anticipated by Brahmbhatt. The Office action did not adopt the newly proposed rejection of claims 1-16 based on the embodiment shown in Figure 17 of Brahmbhatt.

7. On November 7, 2003, patent owner submitted comments pursuant to 37 CFR 1.951(a) but did not make any further proposed claim amendments.

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[1] To be more specific, claims 3 and 4 were rejected over a combination of Brahmbhatt with another reference.

8. On December 10, 2003, the third party requester submitted comments pursuant to 37 CFR 1.951(b).

9. On March 2, 2004, the Office issued a Right of Appeal Notice (RAN), which maintained the same rejections as set forth in the ACP.

10. On March 30, 2004, the patent owner filed a Notice of Appeal.

11. On May 28, 2004, the patent owner filed an Appeal Brief

12. On June 28, 2004, the third party requester filed a respondent brief.

13. On December 9, 2004, the Office mailed the Examiner's Answer.

14. On January 10, 2005, the patent owner filed a rebuttal brief to the Examiner's Answer.

15. On March 26, 2007, the Board of Appeals and Interferences (BPAI) issued a decision, which affirmed-in-part the examiner's grounds of rejection and, pursuant to 37 CFR 41.77(b), issued a new ground of rejection of claims 1, 2, 5-11 and 16 based upon the embodiment shown in Figure 17 of Brahmbhatt. The BPAI decision also entered new grounds of rejection for claims 3 and 4 over Figure 17 of Brahmbhatt in view of Murphy

16. On April 25, 2007, the patent owner elected to reopen prosecution before the examiner by filing, pursuant to 37 CFR 41.77(b), a proposed amendment to claims 1, 4, 6, 8-11, and 16 and added new claims 17-29.

17. On May 25, 2007, the third party requester filed comments pursuant to 37 CFR 41.77(c).

18. On May 19, 2008, the Office issued a notification that the amendment of April 25, 2007 is not entered because it is not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of May 25, 2007 is not entered. The notification set a time period of 15 days to refile the amendment in compliance with 37 CFR 41.77(b)(1).

19. On June 3, 2008, the patent owner filed, pursuant to 37 CFR 41.77(b), an amendment, which cancelled claims 1-11 and 16 and added new claims 17-40.

20. On July 2, 2008, the third party requester filed comments pursuant to 37 CFR 41.77(c).

21. On September 15, 2008, the Office issued a notification that the amendment of June 3, 2008 was not entered because it was not compliant with 37 CFR 41.77(b)(1) and also indicated that the third party comments of July 2, 2008 were not entered. The notification also stated that

pursuant to 37 CFR 41.77(f), jurisdiction of the reexamination proceeding was being returned to the BPAI.

22. On November 17, 2008, the patent owner filed a petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the amendment of April 25, 2007 or the amendment of June 3, 2008 be entered.

23. On December 2, 2008, the third party requester filed an opposition in response to the November 17, 2008 petition.

24. On December 15, 2008, the BPAI returned the reexamination proceeding to the Central Reexamination Unit to address minor informalities pertaining to the signing of information disclosure statements and to address the patent owner petition under 37 CFR 1.181 filed November 17, 2008.

25. On January 22, 2009, the patent owner petition under 37 CFR 1.181 to enter the amendment after decision of the BPAI was denied by the Director of the Central Reexamination Unit.

26. On February 23, 2009, two petitions addressing the entry of amendments after decision of the BPAI were filed, including a petition under 37 CFR 1.181 requesting reconsideration of the petition decision of January 22, 2008 and a petition under 37 CFR 1.183.

27. On May 19, 2009, the petition under 37 CFR 1.183 was dismissed by the Office of Patent Legal Administration as premature.

28. On June 24, 2010, the petition under 37 CFR 1.181 requesting reconsideration of the petition decision of January 22, 2008 was denied by the Director of Technology Center 1600.

29. The instant petition was filed August 20, 2010, requesting reconsideration of the June 24, 2010 decision.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 41.77(b) states in part:

> When the Board makes a new ground of rejection, the owner, within one month from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

> (1) Reopen prosecution. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

37 CFR 1.111(b) states:

> In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

MPEP 714.04 states:

> In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should not be allowed. See 37 CFR 1.111 and MPEP § 714.02.
>
> An amendment failing to point out the patentable novelty which the applicant believes the claims present in view of the state of the art disclosed by the references cited or the objections made may be held to be not fully responsive and a time period set to furnish a proper reply if the statutory period has expired or almost expired (MPEP § 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

MPEP 714.16(e) states in part:

> The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under 37 CFR 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the application if the application is a paper file.

MPEP 2682(II)(B) states:

> If the patent owner elects to proceed before the examiner, the patent owner must take action within the one month period for response which will be set in the Board's decision. Extensions of time under 37 CFR 1.956 are available to extend the period. 37 CFR 41.77(g). The extension(s) may not, however exceed six months from the Board's decision. When the patent owner submits a response pursuant to 37 CFR 41.77(b)(1), prosecution and examination will then be carried out under 37 CFR 41.77(c) through 37 CFR 41.77(f). Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). The patent owner may also submit evidence or a showing of facts under 37 CFR 1.131 or 1.132, as may be appropriate. Argument without either amendment (of the claims so rejected) or the submission of evidence or a showing of facts (as to the claims so rejected) can result only in the examiner's determination to maintain the Board's rejection of the claims, since the examiner is without authority to find the claims patentable unless the claims are amended or unless the rejection is overcome by a showing of facts not before the Board. The new ground of rejection raised by the Board does not "reopen the prosecution" (under 37 CFR 41.77(b)(1) and 37 CFR 41.77(c) through 37 CFR 41.77(f) *except as to that subject matter to which the new rejection was applied.* Accordingly, any amendment or showing of facts not directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered.

DECISION

Petitioner seeks reversal of the Technology Center Director's decision of June 24, 2010, on the grounds that the amendment filed April 25, 2007, in response to the New Ground of Rejection entered by the Board in the decision dated March 26, 2007 complied with 37 CFR 41.77 and MPEP 2682(II)(B). Specifically, petitioner argues that patent owner amended the claims specifically to overcome the New Grounds of Rejection set forth in the Board Decision and petitioner further argues that at least pages 11-13 of the amendment provide a discussion of the New Grounds of Rejection, the changes made to the claims in view of the New Grounds of Rejection, and why the changes are patentable over the Brahmbhart reference for both independent claims 1 and 16. (See petition at page 4.) Petitioner additionally argues that patent owner added dependent claims 17-29 and stated that these claims obtain more varied protection for the invention, and that while patent owner used the language "varied protection", such language is not dispositive of whether the amendments are in response to the New Grounds of Rejection. (Id.) Petitioner further contends that claims 17-29 depend from and include all of the limitations of either independent claim 1 or claim 16, including the language added to claims 1

and 16 to overcome the New Grounds of Rejection and thus, claims 17-29 each include language added in response to the New Grounds of Rejection to overcome the New Grounds of Rejection. (See Petition at page 5.) Therefore, petitioner believes that the denial of entry of the amendment is arbitrary and capricious. Additionally, petitioner states that the requirements of MPEP 2682(II)(B) have been met in view of the discussion provided on pages 11-13 of the amendment and further states that MPEP2682(II)(B) does not require specific arguments why each and every claim is amended to overcome the New Grounds of Rejection.

On April 25, 2007, patent owner filed an amendment and response under 37 CFR 41.77(b)(1) to the decision of the Board. The amendment, in addition to making changes to independent claims 1 and 16 and certain dependent claims, in an effort to overcome the art applied in the New Grounds of Rejection, included further a change to claim 16 to overcome the affirmed rejection under 35 U.S.C. 112, second paragraph and further added new dependent claims for obtaining a "more varied protection for the invention". On May 19, 2008 a NOTICE OF INFORMAL AMENDMENT UNDER 37 CFR 41.77(b)(1) was issued by the Office, notifying patent owner that the response of patent owner on April 25, 2007 would not be entered because the response went beyond merely amending claims rejected to overcome the New Grounds of Rejection. [2] The Notice cited the identified change to claim 16, made for overcoming the affirmed rejection under 35 U.S.C. 112, second paragraph, and the adding of dependent claims 17-29, for providing a more varied protection for the invention, as not being directed to the subject matter to which the new rejection was applied. On June 3, 2008, patent owner filed a replacement amendment which cancelled all of the previous claims, *i.e.*, claims 1-11 and 16, and added new claims 17-40 which effectively presented claims exactly as set forth in the amendment filed April 25, 2007. On September 15, 2008, patent owner was notified that the amendment of June 3, 2008 would not be entered as being informal with respect to the requirement of 37 CFR 41.77(b)(1).

As the language of 37 CFR 41.77(b)(1) is similar to that of 37 CFR 41.50(b)(1) [3] in that both rules state that a response requesting reopening of prosecution must be an amendment of claims so rejected or new evidence relating to the claims so rejected, or both, it would be appropriate to look to MPEP 1214.01 for further guidance on the reopening of prosecution after the Board enters a New Grounds of Rejection. Furthermore, both MPEP 2682(II)(B) and MPEP 1214.01 rely upon *Ex parte Burrowes* and *Ex parte Comstock* for determination as to whether or not an amendment submitted is "an appropriate amendment." MPEP 1214.04 states: (1) an amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board; (2) an amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected

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[2] The Office notice stated: "The amendment filed by patent owner goes beyond merely amending claims rejected to overcome the new grounds of rejection of the Board. The amendment also adds new dependent claims 17-29 for obtaining a "more varied protection for the invention" (see Remarks, 4/25/06, page 17), and further amends claim 16 in order to overcome an affirmed rejection thereof under 35 U.S.C. 112, second paragraph (see Remarks, page 16)."

[3] 37 CFR 41.50(b) provides the appellant with various options in response to a new ground of rejection entered by the Board in *ex parte* proceedings.

claims, is not appropriate; (3) the new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied, if the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution.

It is understood that the BPAI (in affirming the 35 U.S.C. 112 rejection of claim 16), at page 38 of its March 26, 2007 decision, does in fact state:

> "Although we think that Patent Owners meant to claim 'said second wall surface extending.., in a direction away from said bottom surface,' as evidenced by the proposed amendment, claim 16 is indefinite as it stands."

However, 37 CFR 41.77(b)(1) states:

> "The owner may file a response requesting reopening of prosecution before the examiner. Such a response <u>must be</u> either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both." [Emphasis added]

And, MPEP 2682(II)(B) states:

> Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims, *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923).

<u>I. Addressing the amendment revision to overcome the rejection of claim 16 under 35 U.S.C. 112, second paragraph that was affirmed by the Board:</u>

The April 25, 2007 and June 3, 2008 amendment revisions both include an amendment of claim 16 to overcome the rejection under 35 U.S.C. 112, second paragraph affirmed by the Board. This amendment was purposefully provided to overcome the affirmed rejection (see petitioner's remarks on page 16 of the amendment filed April 25, 2007). Accordingly, the amendment was not specifically directed to that subject matter to which the new rejection was applied and its overcoming of the affirmed rejection has not been shown or argued to have been merely incidental to overcoming the new ground of rejection. As the April 25, 2007 and June 3, 2008

amendment revisions both include an amendment to overcome a rejection affirmed by the BPAI, they are not "appropriate amendments" under 37 CFR 41.77(b)(1). Therefore, entry of the April 25, 2007 and June 3, 2008 amendments was appropriately refused for failing to comply with 37 CFR 41.77(b)(1).

In order to address the BPAI's finding which was not directed to its new ground of rejection, patent owner could have filed a 37 CFR 1.183 petition to waive the 37 CFR 41.77(b)(1) proscription on addressing matters other than those of the new ground of rejection, directed solely to the claim change *re* the rejection of claim 16 under 35 U.S.C. 112. Patent owner, however, chose to file petitions under 37 CFR 1.181 and 37 CFR 1.183, both petitions addressing all grounds of refusing entry of the amendment. The 37 CFR 1.183 petition was dismissed as premature, since patent owner asserted it was entitled to relief under 37 CFR 1.181 for all the entry issues. Subsequent to the dismissal of the petition under 1.183, the petition under 37 CFR 1.181 was denied. At that point, patent owner included the "112-correction" issue in its renewed 37 CFR 1.181 petitions, and continued to argue that it is entitled, by right, to entry of the claim change *re* the rejection of claim 16 under 35 U.S.C. 112. However, the rule is clear to the point that patent owner is not so-entitled.[4]

In the interest of equity, however:

(A) The present petition is taken as a petition for waiver of the rules under 37 CFR 1.183; and
(B) The 37 CFR 41.77(b)(1) proscription on addressing matters other than those of the new ground of rejection is hereby waived to the extent that an amendment presenting a claim change *re* the rejection of claim 16 under 35 U.S.C. 112 will be entered.

II. Addressing the amendment addition of new claim limitations not directed to the 35 U.S.C. 112 rejection:

Both the April 25, 2007 and June 3, 2008 amendments include newly presented claims and neither amendment presents arguments pointing out the specific distinctions believed to render the claims patentable over the applied reference. Petitioner did state a conclusion in the June 3, 2008 amendment that "...new claims 29-40 recite additional structures that are not disclosed in Brahmbhatt." However, 37 CFR 1.111(b) states that a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. It is noted that June 3, 2008 amendment, at page 17, states:

[4] *Comstock* is directly on point, holding that the case is not reopened for consideration of claims that were presented after final rejection and refused entry by the examiner.

> "Moreover, Patentee respectfully submits that claims 18 and 27-29 (which essentially correspond to previously presented claims 2 and 9-11 are patentable at least because of their dependency from claim 1.
> "Likewise, Patentee respectfully that new dependent claims 29-40 are patentable at least because of their dependency from claim 17 or claim 28. Moreover, new claims 29-40 recite additional structures that are neither taught nor suggested in Brahmbhart."

To the extent that such may be argued to "present arguments pointing out the specific distinctions believed to render the claims... patentable over any applied references" under 37 CFR 1.111(b), it does not present argument as to the specific limitations added via claims 18 and 27-40, but relies on claims 17 and 28. More importantly, it shows that the limitations added via claims 18 and 27-40 are not directed to overcoming the new ground of rejection, but rather to rounding out coverage, since claims 18 and 27-40 do not rely on their own limitations to overcome the new ground of rejection. MPEP 2682(II)(B) states that "[u]nder 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). But here the limitations added via claims 18 and 27-40 are not even asserted to be separate bases for overcoming the new ground of rejection. Therefore, entry of the April 25, 2007 and June 3, 2008 amendments were appropriately refused for failing to comply with the rules.

Turning to what took place regarding the April 25, 2007 and June 3, 2008 amendments:

The showing of record is that petitioner was noticed, on May 19, 2008, that the amendment of April 25, 2007 was not entered as it amended a claim to overcome an affirmed rejection and failed to provide reasons pointing out the distinction believed to render newly presented claims patentable over the reference. Petitioner responded to the notice with an amendment of June 3, 2008 which failed to cure the deficiencies set forth in the May 19, 2008 notice. As petitioner failed to avail himself of the opportunity to correct the deficiencies in the April 25, 2007 amendment, the amendment of June 3, 2008 was not entered. Now, petitioner patent owner contends it has not received due process. Also, in an earlier petition patent owner urged the amendment should be entered in part to provide relief needed. As petitioner was appropriately noticed and given an opportunity to correct the deficiencies, due process has been received. Furthermore, petitioner would have no reasonable expectation that any amendment would be entered in part, absent a showing of an extraordinary situation. See MPEP 716.16(e), *supra*.

Notwithstanding the above discussion, in the interest equity, patent owner will be given one opportunity to set forth argument as to each of the specific limitations added via any new claims, as set forth in the next section of this decision.

II. Further opportunity to file a replacement amendment:

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to compel the entry of the amendments filed April 25, 2007 and June 23, 2008 is not shown to be in clear error. Accordingly, the refusal to enter the amendments of April 25, 2007 and June 23, 2008, will not be disturbed.

However, the patent owner is given one (1) month from the mail date of this decision in which patent owner may file a replacement amendment as follows:

A. The amendment would re-present the previously proffered claim revision addressing the rejection of claim 16 under 35 U.S.C. 112. Argument directed to how the amendment cures the rejection of claim 16 under 35 U.S.C. 112 must be included.

B. The amendment would re-present the previously proffered new claim limitations, specifically pointing out, for each new claim limitation (aside from the limitations dealing with the 35 U.S.C. 112 rejection, dealt with in A. above), how the language of each new limitation added via the amendment patentably distinguishes the claims from the references applied in the new grounds of rejection. Any claim containing a new claim limitation that is not accompanied by a separate explanation of how that new limitation patentably distinguishes the claims from the references will be an improperly presented claim resulting in the refusal to enter the entire amendment.

If the patent owner files a noncompliant amendment in response to this decision, the submission will not be considered, and the proceeding will progress without any further opportunity to submit another replacement amendment; such a noncompliant submission would not be considered a *bona fide* attempt to respond and advance prosecution in this *inter partes* reexamination proceeding

CONCLUSION

1. A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of June 24, 2010. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion. Accordingly, the petition under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Technology Center Director must be **denied**.

2. In the interest of equity, the petition to overturn the decision of the Technology Center Director dated June 24, 2010 is being taken as a petition under 37 CFR 1.183 to waive the rules and permit entry of an amendment, and is **granted in part** as stated in the next item, and **dismissed in part** as stated in item 4 below.

3. The 37 CFR 41.77(b)(1) proscription on addressing matters other than those of the new ground of rejection **is waived to the extent that** an amendment presenting a claim change *re* the rejection of claim 16 under 35 U.S.C. 112 will be entered.

4. The refusal to enter the amendments of April 25, 2007 and June 23, 2008, will not be disturbed, however, the patent owner **is given one (1) month from the mail date of this decision** in which patent owner may file a replacement amendment as set fourth in part III of this decision above. If the patent owner files a noncompliant amendment in response to this decision, the submission will not be considered, and the proceeding will progress without any further opportunity to submit another replacement amendment.

5. Telephone inquiries concerning this decision should be directed to Kenneth Schor at (571) 272-7710.

Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

8-15-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 09/30/2010

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED

SEP 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000038
PATENT NO. : 6527941
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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SEP 30 2010

CENTRAL REEXAMINATION UNIT

In re: Andersen *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/000,038 Deposited: 27 FEBRUARY 2004 For: U.S. Patent No.: 6,527,941	: : : : :	DECISION *SUA SPONTE* VACATING ACTION CLOSING PROSECUTION AND EXPUNGING PAPERS

REVIEW OF RELEVANT FACTS

1. On June 19, 2009, the Board of Patent Appeals and Interferences mailed a decision in this proceeding including new grounds of rejection under 37 CFR 41.77(b).
2. On July 20, 2009, patent owner filed an amendment to the claims under 41.77 CFR (b)(1).
3. On August 19, 2009, third-party requester filed a response to the amendment.
4. On September 18, 2009, the examiner in this proceeding mailed a paper styled "Action Closing Prosecution".

DECISION

Prosecution following decision of the BPAI in inter partes reexamination proceedings is governed by 37 CFR 41.77 (d)-(f), which state:

(d) Following any response by the owner under paragraph (b)(1) of this section and any written comments from a requester under paragraph (c) of this section, the proceeding will be remanded to the examiner. The statement of the Board shall be binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. The examiner will consider any owner response under paragraph (b)(1) of this section and any written comments by a requester under paragraph (c) of this section and issue a determination that the rejection is maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the owner or any requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, the owner and any requesters may file a reply to the comments. No requester reply may address the comments of any other requester reply. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20 (b)(1) and (2), respectively, which must accompany the comments or reply.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the proceeding will be returned to the Board which shall reconsider the matter and issue a new decision. The new decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn.

Accordingly, the action mailed September 18, 2009 should have been styled a "Determination under 37 CFR 41.77(d)" rather than an "Action Closing Prosecution". 37 CFR 41.77(e) specifies options for responses for patent owner and third party requester that are not identical to the options for response to ACP. Accordingly, the responses subsequent to the paper of September 18, 2009 will not be treated as responses under 37 CFR 41.77(e).

Accordingly, the Action Closing Prosecution of September 18 is **vacated** and **will be closed from the record**.

Patent owner papers of 10/8/2009, 10/15/2009, 11/18/09, and 1/5/2010, and third party requester papers of 12/15/2009, **will also be closed from the record**.

A determination under 37 CFR 41.77(d) will follow. For convenience of the parties, the substance (e.g. treatment of claims and rejections) of that determination is identical to the substance of the paper mailed September 18, 2009; however, the options for response are not identical.

CONCLUSION

1. The "Action Closing Prosecution" of September 18, 2009 is **vacated and closed**, and all papers subsequent to that paper, are hereby **expunged from the record and closed**. This is without prejudice[1] to resubmission of the content of those papers in an appropriate response to a determination under 37 CFR 41.77(d).

2. A determination of the examiner under 37 CFR 41.77(d) will follow.

3. Telephone inquiries related to this decision should be directed to D. Jones, Supervisory Patent Examiner, at (571) 272-1535 or in her absence to the undersigned at (571) 272-3838.

__/gmorse/_____
Gregory A. Morse
Director, Central Reexamination Unit

[1] Note that the petition decision of December 28, 2009 denied entry of papers to the record; this decision does not change the previous determination that the relevant papers lacked a right of entry.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 11/18/2010
WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,038	02/27/2004	6527941	

EXAMINER
DIAMOND, ALAN

ART UNIT	PAPER
3991	

ALEX R. SLUZAS
PAUL & PAUL
2900 TWO THOUSAND MARKET STREET
PHILADELPHIA, PA 19103

DATE MAILED:

11/18/10

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CENTRAL REEXAMINATION UN

EMILY R. WHELAN
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60 STATE STREET
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(For Patent Owner)

ALEX R. SLUZAS
PAUL AND PAUL
2000 MARKET STREET
SUITE 2900
PHILADELPHIA, PA 19103

(For Third Party Requester)

In re Andersen et al.	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,038	: **ON PATENT OWNER'S**
Filed: February 27, 2004	: **PETITION UNDER 1.182/1.183**
For: U.S. Patent No. 6,527,941	:

This is a decision on the November 1, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182/1.183."

The patent owner petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

PERTINENT BACKGROUND

- On March 4, 2003, U.S. Patent Number 6,527,941 B1 was issued to Andersen *et al.*, having thirteen (13) claims therein.

- On February 27, 2004, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,038 ("the '038 proceeding").

- On May 4, 2004, the Office issued an order in the '038 reexamination proceeding granting *inter partes* reexamination of the '941 patent. The order was accompanied by a first Office action on the merits of the reexamination proceeding. This Office action included, *inter alia*, rejection of claims 1, 3, 5, 7, 9, 10, and 12 as obvious over "JP '275", rejection of claims 1, 3, 5, and 7 over "the Mauthoor thesis," and rejection of claims 1-3, 5-7, 9, 11, and 12 as obvious over "the Andersen '198 Patent in view of Mauthoor."

- On August 4, 2004, patent owner filed a reply responsive to the May 4, 2004 Office action. Claims 1-4 were canceled, and claims 6-14 were retained in their original form. The reply

further included a declaration from Terrell Andersen, a co-inventor of the '941 patent, which included arguments as to whether the claimed ranges in the '941 patent demonstrated "unexpectedly superior properties" with respect to the Mauthoor reference.[1] The reply included arguments based upon "the showing of unexpectedly superior results . . . claimed in the '941 patent" with respect to the JP '275 reference, the Mauthoor reference, and the Andersen reference in view of the Mauthoor reference.[2]

- On August 31, 2004, third party requester filed comments pursuant to 37 C.F.R. § 1.947, including a declaration by Rodney Williams which addressed certain points raised by the Andersen declaration of August 4, 2004.

- On December 14, 2005, the Office issued an Action Closing Prosecution (ACP) in the '038 reexamination. In this action, the examiner withdrew the rejection of claims 1, 3, 5, 7, 9, 10, and 12 as obvious over "JP '275", the rejection of claims 1, 3, 5, and 7 over "the Mauthoor thesis," and the rejection of claims 1-3, 5-7, 9, 11, and 12 as obvious over "the Andersen '198 Patent in view of Mauthoor." The ACP confirmed the patentability of claims 5-7 and 9-12.

- On January 17, 2006, patent owner filed a reply to the ACP, including cancellation of claims 1-4, 8, and 13. Third party requester filed comments on February 10, 2006.

- The appeal process commenced with the filing of a notice of appeal by third party requester on June 8, 2006.

- The appeal process continued until, on June 19, 2009, the Board of Patent Appeals and Interferences issued a decision (1) reversing the examiner as the examiner's refusal to reject the appealed claims, and (2) entering new grounds of rejection based upon findings of obviousness of the claimed invention over JP '275, Mauthoor, and the combined teachings of Andersen and Mauthoor.[3] The Board's reversal of the examiner relied, in part, on a finding of error in the examiner's determination that sufficient evidence of unexpected results had been presented to overcome the examiner's initial rejections based upon the abovementioned references.[4]

- On July 20, 2009, the patent owner requested that prosecution be opened to address the new grounds of rejection entered by the Board, and requested entry of claim amendments and new evidence. The patent owner stated that the Board erroneously asserted that unexpected results were not shown to establish the criticality for the claimed ranges. The patent owner

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[1] Andersen declaration at page 5.
[2] Patent Owner Reply of August 4, 2004, at pages 11, 19, and 23.
[3] Claims 5, 7, 9, 10, and 12 are rejected over JP '275; claims 6 and 11 are rejected over the combined teachings of JP '275 and Andersen; claims 5, 7, 10, and 12 are rejected over Mauthoor; and claims 5-7, 9, 11, and 12 are rejected over the combined teachings of Andersen and Mauthoor. Rejections based upon the written description requirement were entered on claims 14-19.
[4] See Decision of the Board of Patent Appeals and Interferences, Appeal No. 2008-005575, June 19, 2009, at 33-34.

cited a previously entered Declaration by Dr. Andersen and contemporaneously submitted Declarations by Mr. Gutwald, Dr. Williston and Dr. Andersen for that proposition.[5]

- On September 18, 2009, the Office issued a new ACP; however, that paper was vacated and expunged from the record as *ultra vires* in a petition decision mailed on September 30, 2010.

- On September 30, 2009, the Office issued an Examiner's Determination under 37 C.F.R. 41.77(d), including, *inter alia*, rejection of claims 5, 7, 9, 10, 12, 14, 16-19, and 21-23 as obvious over "JP '275," rejection of claims 6, 11, and 15 as obvious over "JP '275 in view of Anderson;" rejection of claims 5, 7, 12, 14, 16-19, and 21-23 over "the Mauthoor thesis," and rejection of claims 5-7, 9, 11, 12, 14-19, and 21-23 as obvious over "the Andersen '198 Patent in view of Mauthoor."

- On November 1, 2010, patent owner submitted the following documents:

1. Comments under 37 C.F.R. §41.77(e) alleging, *inter alia*, unexpected results based upon the Williford, Gutwald, and Andersen Declarations filed on July 20, 2009.
2. The instant petition under §§ 1.182/1.183 requesting entry of a Declaration by Gregory Mischler, first submitted on November 18, 2009, in response to the Board's decision on June 19, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.183 states:

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

[5] See Patent Owner Reply of July 20, 2009, at 13-14, 16, and 22.

DECISION

The instant November 1, 2010 patent owner paper sets forth a petition under 37 C.F.R. §§ 1.182 and 1.183 requesting continued prosecution for entry and consideration of an affidavit under § 1.132 by Gregory Mischler, addressing issues of secondary considerations of nonobviousness; in particular, evidence of unexpected results of the invention set forth in the patent claims. Petitioner alleges that such a petition is necessary because either (1) § 1.116 forbids entry of evidence in an *inter partes* reexamination following a Right of Appeal notice, thus requiring rule waiver under § 1.183, or (2) no rule permits or forbids such entry following action by the Board of Appeals pursuant to § 41.77, thus requiring relief not otherwise provided for under the regulations, and therefore petitionable under 1.182.

In light of this, patent owner, in his petition of November 1, 2010, alleges that the Mischler declaration is now required to be entered because the declaration addresses the Board's "specific requests . . . for experimental data comparing the JP '275, Mauthoor, and Andersen references to material made as described in the patent," which appeared for the first time in the Board decision of June 19, 2009. Patent owner alleges that the Mischler declaration could not have been submitted at an earlier date since the experimental data took more than four months to prepare, and thus could not have been submitted earlier than the November 19, 2009 date at which it was submitted to the Office.

1. The Mischler Declaration

With respect to the Mischler declaration, patent owner states that it responds to issues first raised in the July 19, 2009 Board of Appeals decision, and would clarify and reduce issues on appeal. However, the obviousness rejections being addressed were first made much earlier in the prosecution; i.e., in the May 4, 2004 non-final Office action. These issues of obviousness, for which evidence of unexpected results would be an appropriate traversal, existed from the very first Office action on the merits. Patent owner had full opportunity to present any and all secondary considerations of nonobviousness following the May 4, 2004 first Office action on the merits. Indeed, patent owner did present affidavits directed to unexpected results in response to the May 4, 2004 action in the form of the Andersen declaration submitted on August 4, 2004. Additional affidavits directed towards unexpected results were submitted on July 20, 2009, in the form of the Williford, Gutwald, and (second) Andersen Declarations.

In view of the numerous previous submissions by the patent owner on secondary considerations of nonobviousness, including unexpected results as compared to the references currently applied to reject the claims, there is no support for a contention that patent owner had no previous opportunity to present the type of evidence now desired entry under the instant petitions. Reopening the prosecution to consider this evidence submission, would cause the Office to sanction the patent owner's unnecessary delay in presenting the Mischler declaration in this proceeding. This is particularly true for evidentiary submissions, in which there is clear notice in MPEP 2272 that evidence submissions should be filed before final action. Such action by the Office would be contrary to the Office's requirement that "all *inter partes* reexaminations, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." The Board of Appeal's reversal of the examiner's refusal to

maintain that original rejection therefore does not provide basis for entry of the declaration at this stage.

Furthermore, patent owner's reference to the 90/006,955 proceeding, which is on a different patent (U.S. 6,638,401), is not relevant to entry of evidence in the instant proceeding. Patent owner suggests that the Mischler declaration was submitted in both proceedings, and should therefore be entered in both proceedings to ensure uniformity. However, it is noted that while issues may be similar in related cases, claims in different patents are required to be patentably different, and will ultimately stand upon their own merits.

The decision to permit entry of the Mischler declaration in the '6955 proceeding was based upon careful considerations of the facts and circumstances in that proceeding. While the instant petition in the '038 proceeding stated that the Mischler declaration was triggered by the Board's June 19, 2009 decision,[6] the corresponding petition for entry of the Mischler declaration in the '6955 proceeding was stated to be triggered by "specific requests made by the examiner in the final Office action (citing the Board in a related reexamination '038)."[7] In the '6955 proceeding, the examiner, in the final Office action of June 5, 2009, reinstated rejections over JP '275, Mauthoor, and Anderson that were previously withdrawn in the December 7, 2006 final Office action.

Unlike the situation in the instant proceeding, the issue of "unexpected results" in the '6955 proceeding was discussed very little, if at all, prior to the examiner's June 5, 2009 final Office action. This "unexpected results" issue was taken entirely from the proceedings in the '038 reexamination, in which this issue was discussed at length in declarations submitted after the first action and after the ACP. In the '6955 proceeding, in which "unexpected results" was unexpectedly drawn into the proceeding through the examiner's reference to the '038 proceeding. In the '6955 proceeding, rule waiver was permitted to allow new evidence to be entered to address an issue *newly raised* in a new <u>non-final</u> Office action.[8]

In contrast, in the instant '038 proceeding, the "unexpected results" issue was thoroughly discussed throughout the '038 reexamination proceeding. Viewed in the context of the entire prosecution of the '038 reexamination, the statements by the Board as to the insufficiency of the prior evidence to demonstrate "unexpected results" were not intended as a request for patent owner to present further evidence at that point. The Board did not remand the case to the examiner, specifically requesting further evidence of unexpected results; the Board instead reversed the examiner's refusal to enter certain grounds of rejection. The statement by the Board did not request new evidence, but merely communicated to patent owner that the multitude of

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[6] November 1, 2010 petition at 3 (stating "The Mischler Declaration responds to specific requests made by the Board in its June 19, 2009 decision.")

[7] *Ex parte* reexamination No. 90/006,955, December 17, 2009 patent owner petition at 4.

[8] Rule waiver was required because the patent owner alleged, and presented supporting evidence, that the evidence to address the issue newly raised in the non-final rejection could not be gathered and submitted prior to the close of prosecution, thus requiring rule waiver for its entry. Note that in that same decision, rule waiver was refused for other declarations in which the issues were raised prior to the final Office action. *Ex parte* reexamination No. 90/006,955, June 11, 2010, Office decision at 5.

evidence and argument previously presented in the proceeding to support a finding of "unexpected results" was not persuasive.

Therefore, entry of the declaration at this stage would not, in view of the entirety of the facts and circumstances in this proceeding, comport with the statutory requirement of special dispatch. For this reason, the reexamination proceeding will not be reopened for consideration of the Mischler declaration.

CONCLUSION

- The petition is **dismissed**.
- The time for third party requester to reply to patent owner's November 1, 2010 comments continues to run for a period of one month from the date of service of the comments in response to the examiner's determination, as set forth in 37 C.F.R. § 41.77(e); i.e., through December 1, 2010.
- A copy of this decision will be made of record in the reexamination file.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

November 17, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,038	02/27/2004	6527941	1428620.00003US1	2250

23483 7590 03/30/2011

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ALEX R. SLUZAS, ESQ.
PAUL AND PAUL
2900 TWO THOUSAND MARKET STREET
PHILADELPHIA, PA 19103

Date:
MAILED
MAR 3 0 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000038
PATENT NO. : 6527941
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

ALEX R. SLUZAS
PAUL AND PAUL
2000 MARKET STREET
SUITE 2900
PHILADELPHIA, PA 19103

(For Third Party Requester)

In re Andersen et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,038
Filed: February 27, 2004
For: U.S. Patent No. 6,527,941

DECISION ON RECONSIDERATION OF DECISION ON PETITION UNDER §§ 1.182/1.183

This is a decision on the January 18, 2011 patent owner petition entitled "Request for Reconsideration."

On March 29, 2011, the instant reexamination proceeding remanded by the Board of Patent Appeals and Interferences to Patents to "Patents" for treatment of the January 18, 2011 patent owner petition. The patent owner petition is now before the Office of Patent Legal Administration for decision.

The petition is **granted**. The procedure following entry of the declaration by Gregory Mischler, as submitted with the patent owner petition of November 1, 2010, will be as set forth in sections 2-4 of the Conclusion section of this decision.

PERTINENT BACKGROUND

1. On March 4, 2003, U.S. Patent Number 6,527,941 B1 was issued to Andersen *et al.*, having thirteen (13) claims therein.

2. On February 27, 2004, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,038 ("the '038 proceeding").

3. On May 4, 2004, the Office issued an order in the '038 reexamination proceeding granting *inter partes* reexamination of the '941 patent. The order was accompanied by a first Office action on the merits of the reexamination proceeding. This Office action included, *inter alia*, rejection of claims 1, 3, 5, 7, 9, 10, and 12 as obvious over "JP '275," rejection of claims 1, 3, 5, and 7 over "the Mauthoor thesis," and rejection of claims 1-3, 5-7, 9, 11, and 12 as obvious over "the Andersen '198 Patent in view of Mauthoor."

4. On August 4, 2004, patent owner filed a response to the May 4, 2004 Office action. Claims 1-4 were canceled, and claims 6-14 were retained in their original form. The response further included a declaration from Terrell Andersen, a co-inventor of the '941 patent, which included a showing as to whether the claimed ranges in the '941 patent demonstrated "unexpectedly superior properties" with respect to the Mauthoor reference.[1] The response included arguments based upon "the showing of unexpectedly superior results . . . claimed in the '941 patent" with respect to the JP '275 reference, the Mauthoor reference, and the Andersen reference in view of the Mauthoor reference.[2]

5. On August 31, 2004, third party requester filed comments pursuant to 37 C.F.R. § 1.947, including a declaration by Rodney Williams which addressed certain points raised by the August 4, 2004 Andersen declaration.

6. On December 14, 2005, the Office issued an Action Closing Prosecution (ACP) in the '038 reexamination. In this action, the examiner withdrew the rejection of claims 1, 3, 5, 7, 9, 10, and 12 as obvious over "JP '275," the rejection of claims 1, 3, 5, and 7 over "the Mauthoor thesis," and the rejection of claims 1-3, 5-7, 9, 11, and 12 as obvious over "the Andersen '198 Patent in view of Mauthoor." The ACP confirmed the patentability of claims 5-7 and 9-12.

7. On January 17, 2006, patent owner filed a response to the ACP, including cancellation of claims 1-4, 8, and 13. Third party requester then filed comments on February 10, 2006.

8. The appeal process commenced with the filing of a notice of appeal by third party requester on June 8, 2006.

9. The appeal process continued until, on June 19, 2009, the Board of Patent Appeals and Interferences (the Board) issued a decision (1) reversing the examiner as the examiner's refusal to reject the appealed claims, and (2) entering new grounds of rejection based upon findings of obviousness of the claimed invention over JP '275, Mauthoor, and the combined teachings of Andersen and Mauthoor.[3] The Board's reversal of the examiner

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[1] Andersen declaration at page 5.

[2] Patent Owner Reply of August 4, 2004, at pages 11, 19, and 23.

[3] Claims 5, 7, 9, 10, and 12 are rejected over JP '275; claims 6 and 11 are rejected over the combined teachings of JP '275 and Andersen; claims 5, 7, 10, and 12 are rejected over Mauthoor; and claims 5-7, 9, 11, and 12 are rejected over the combined teachings of Andersen and Mauthoor. Rejections based upon the written description requirement were entered on claims 14-19.

relied, in part, on a finding of *error in the examiner's determination that sufficient evidence of unexpected results had been presented* to overcome the examiner's initial rejections based upon the abovementioned references.[4]

10. On July 20, 2009, the patent owner requested that prosecution be reopened under 37 C.F.R. §41.77(b)(1) to address the new grounds of rejection entered by the Board, and requested entry of claim amendments and new evidence. The patent owner stated that the Board erroneously found that unexpected results were not shown to establish the criticality for the claimed ranges. The patent owner cited a previously entered Declaration by Dr. Andersen and contemporaneously submitted Declarations by Mr. Gutwald, Dr. Williston and Dr. Andersen for that proposition.[5]

11. On September 18, 2009, the Office inadvertently issued a new ACP leading to the following sequence of events:
    a. On October 8, 2009, patent owner requested a one month extension of time to provide the results of experimental testing. Third party requester filed a paper opposing such extension on October 15, 2009.
    b. On October 16, 2009, the Office granted the patent owner's request for the extension of time, extending the time to file a response until November 18, 2009.
    c. On October 29, 2009, third party requester filed a paper seeking modification or withdrawal of the September 18, 2009 ACP and a reversal of the October 16, 2009 Office decision.
    d. On November 18, 2009, patent owner filed an opposition to third party requester's October 29, 2009 petition. On the same date, patent owner filed a timely amendment and response to the September 18, 2009 ACP, including submission of a Declaration by Gregory Mischler.
    e. On December 28, 2009, the Office issued a decision refusing entry of the October 15, 2009, October 29, 2009, and November 18, 2009 papers.
    f. On September 30, 2010, the September 18, 2009 ACP was vacated and expunged from the record as *ultra vires* in a petition decision. This decision closed (expunged) from the record the patent owner's November 18, 2009 submission of the Declaration by Gregory Mischler.

12. On September 30, 2010, the Office issued an Examiner's Determination under 37 C.F.R. § 41.77(d), including, *inter alia*, rejection of claims 5, 7, 9, 10, 12, 14, 16-19, and 21-23 as obvious over "JP '275," rejection of claims 6, 11, and 15 as obvious over "JP '275 in view of Anderson;" rejection of claims 5, 7, 12, 14, 16-19, and 21-23 over "the Mauthoor thesis," and rejection of claims 5-7, 9, 11, 12, 14-19, and 21-23 as obvious over "the Andersen '198 Patent in view of Mauthoor."

13. On November 1, 2010, patent owner submitted the following documents:

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[4] See Decision of the Board of Patent Appeals and Interferences, Appeal No. 2008-005575, June 19, 2009, at 33-34.
[5] See Patent Owner Reply of July 20, 2009, at 13-14, 16, and 22.

a. Comments under 37 C.F.R. § 41.77(e) alleging, *inter alia*, unexpected results based upon the Williford, Gutwald, and Andersen Declarations filed on July 20, 2009.
b. A petition under §§ 1.182/1.183 requesting entry of a Declaration by Gregory Mischler, first submitted on November 18, 2009, in response to the Board's decision on June 19, 2009.

14. On November 18, 2010, an Office decision dismissing patent owner's November 1, 2010 petition was issued.

15. On December 1, 2010, third party requester submitted comments under 37 C.F.R. § 41.77(e).

16. On December 10, 2010, the Board of Patent Appeals and Interferences issued a docketing notice notifying the parties that the application has been received and assigned Appeal No: 2011-002860.

17. On January 18, 2011, patent owner submitted the instant paper entitled "Request for Reconsideration."

18. On March 29, 2011, the Board issued a decision remanding the present proceeding to "Patents."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.77 states, in pertinent part:

. . .

(b) Should the Board reverse the examiner's determination not to make a rejection proposed by a requester, the Board shall set forth in the opinion in support of its decision a new ground of rejection; or should the Board have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. Any decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, **the owner, within one month from the date of the decision, must exercise one of the following two options** with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) Reopen prosecution. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) Request rehearing. The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) Where the owner has filed a response requesting reopening of prosecution under paragraph (b)(1) of this section, any requester, within one month of the date of service of the owner's response, may once file comments on the response. Such written comments must be limited to the issues raised by the Board's opinion reflecting its decision and the owner's response. Any requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20 (b)(1) and (2), respectively, which must accompany the comments or reply.

(d) Following any response by the owner under paragraph (b)(1) of this section and any written comments from a requester under paragraph (c) of this section, the proceeding will be remanded to the examiner. The statement of the Board shall be binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. The examiner will consider any owner response under paragraph (b)(1) of this section and any written comments by a requester under paragraph (c) of this section and issue a determination that the rejection is maintained or has been overcome.

(e) **Within one month of the examiner's determination pursuant to paragraph (d) of this section, the owner or any requester may once submit comments in response to the examiner's determination.** Within one month of the date of service of comments in response to the examiner's determination, the owner and any requesters may file a reply to the comments. No requester reply may address the comments of any other requester reply. Any requester that had not previously filed an appeal or cross appeal and

is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 41.20 (b)(1) and (2), respectively, which must accompany the comments or reply.

(f) **After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the proceeding will be returned to the Board which shall reconsider the matter and issue a new decision.** The new decision is deemed to incorporate the earlier decision, except for those portions specifically withdrawn.

(g) **The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956 of this title when the owner is responding under paragraph (b)(1) of this section.** The time period set forth in paragraph (b) of this section may not be extended when the owner is responding under paragraph (b)(2) of this section. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

(Emphasis added)

DECISION

A patent owner petition filed on November 1, 2010 sought entry of an affidavit by Gregory Mischler "before the proceeding is returned to the Board for consideration under 37 C.F.R. § 41.77(f)."[6] However, the proceeding was returned to the Board under § 41.77(f) following the December 1, 2010 submission of comments by the third party requester under § 41.77(e). The Board docketed the appeal on December 10, 2010. The instant reconsideration petition was filed on January 18, 2010, over one month after the appeal was docketed by the Board. The instant petition seeks entry of the affidavit into the record for consideration by the Board.[7] The petition is taken as seeking entry of the Mischler declaration before the examiner as a delayed submission under § 41.77(b)(1), where the delay was caused by extraordinary circumstances.

The instant January 18, 2011 patent owner petition sets forth a request for reconsideration of the Office decision dismissing a November 1, 2010 petition under 37 C.F.R. §§ 1.182 and 1.183 requesting entry and consideration of an affidavit under § 1.132 by Gregory Mischler, addressing issues of secondary considerations of nonobviousness; in particular, evidence of unexpected results of the invention set forth in the patent claims. The November 1, 2010 petition alleged that such relief is necessary because § 1.116 forbids entry of evidence in an *inter partes* reexamination following a Right of Appeal notice, thus requiring rule waiver under § 1.183. The petition alleged, in the alternative, that no rule permits or forbids such entry following action by the Board pursuant to § 41.77, thus requiring relief not otherwise provided for under the regulations, and therefore petitionable under § 1.182.

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[6] November 1, 2010 patent owner petition, at 2.
[7] January 18, 2011 patent owner petition at 2.

Patent owner, in the instant petition of January 18, 2011, alleges that "(1) the Examiner reversed his first and only rejection under 35 USC § 103 in view of the Andersen Declaration, so there was no need to produce the comparative data prior to the Board's new rejection, (2) after the new rejection from the Board, it was impossible to generate comparative data in one month to submit with the Patent Owner's request to reopen prosecution,"[8] (3) patent owner did not have a full opportunity to present data addressing secondary considerations of nonobviousness, (4) admitting the data would not cause unnecessary delay, (5) entry of the data is necessary and comports with special dispatch, and (6) the data responds to a Board's request for such data. Patent owner states that the prior Office decision was incorrectly decided because "it rests on the unfair determination that Patent Owner should have undertaken the extensive and costly efforts required to generate the data presented in the Mischler Declaration, despite the fact that *prior to the Board's new rejection, the examiner found the claims non-obvious based on the evidence already of record.*"[9]

In the prior Office decision of November 18, 2010, the declaration was refused entry primarily on the ground that:

> [T]he obviousness rejections being addressed were first made much earlier in the prosecution; i.e., in the May 4, 2004 non-final Office action. These issues of obviousness, for which evidence of unexpected results would be an appropriate traversal, existed from the very first Office action on the merits. Patent owner had full opportunity to present any and all secondary considerations of nonobviousness following the May 4, 2004 first Office action on the merits. Indeed, patent owner did present affidavits directed to unexpected results in response to the May 4, 2004 action in the form of the Andersen declaration submitted on August 4, 2004.

In view of the instant petition, petitioner's argument that the Mischler declaration was solely responsive to the new grounds of rejection set forth in the June 19, 2009 Board decision has been reconsidered. In the instant situation, petitioner had submitted the Andersen declaration on August 4, 2004 to provide evidence of secondary considerations of nonobviousness – evidence that the examiner found persuasive to withdraw the obviousness rejections, and to find those claims allowable, in the next action, an Action Closing Prosecution. The claims remained as deemed to be allowable until the June 19, 2009 Board decision applied new grounds of rejection to the previously allowable claims.

In the instant situation, the new rejection made in the June 19, 2009 Board decision provided for the patent owner to submit new evidence pursuant to § 41.77(b)(1). Therefore, any evidence filed by the patent owner subsequent to the Board decision is viewed in light of this distinct right for patent owner to provide new evidence after a new ground of rejection in a Board decision. The submission of the Mischler declaration should be viewed accordingly. Patent owner has, in the instant petition, provided compelling reasons why the declaration, responsive to the Board decision,[10] was not submitted within the one month period provided by § 41.77(b)(1).[11]

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[8] January 18, 2011 patent owner petition at 2.
[9] January 18, 2011 patent owner petition at 2.
[10] Mischler declaration of November 18, 2009, point 5, at 2.
[11] *See, e.g.*, January 18, 2011 patent owner petition at 6-7.

In view of the above, the previous decision has been reconsidered, and the relief sought by petitioner is **granted** to the extent that the Mischler declaration is entered into the file for consideration by the Board. As this declaration is considered to be a part of patent owner's response under 37 C.F.R. § 41.77 (b)(1), the proceeding will be regressed to a stage representing the completion of the § 41.77 (b)(1) response. Third party requester, within one month of the mailing date of this decision, may once file comments on the completed patent owner's response. Such written comments must be strictly limited to the issues as affected by the Mischler declaration.

The Opposition Paper Has No Right Of Entry

With respect to the February 2, 2011 requester paper opposing patent owner's petition under 37 C.F.R. § 1.182, neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the third party requester to file an opposition to, or comment on, the patent owner's request for reconsideration of an Office decision dismissing a patent owner petition requesting waiver of the rules for entry of a declaration. Such a request is **not** a response to an "Office action on the merits." Rather, it goes to an issue that goes to formal requirements and is a matter within the discretion of the Office in balancing the equities as to the "special dispatch" requirement and the needs of a specific situation. Stated differently, as pointed out above, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to waive the rules. The latter is clearly a matter within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the reconsideration of a decision dismissing a petition that requests waiver of the rules for entry of a declaration. No mechanism has been provided for the third party requester to file a paper, such as the present paper. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

Such a third party requester's opposition is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is also not permitted as a submission of written comments to a patent owner's response to an Office action, since such third party written comments were the subject of a separate paper filed on December 1, 2010. Third party requester's opposition to patent owner's reconsideration request for waiver of the rules to enter a declaration is therefore not enterable into the record.

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office,[12] the consideration of a request for reconsideration of a decision dismissing a petition for waiver of the rules is clearly within the Office's jurisdiction, and the Office may exercise its discretion to grant such relief. Therefore, the requester's opposition to patent owner's request for continued reexamination is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

In view of the above, the opposition is refused entry as an improper paper.

Pursuant to 37 C.F.R. § 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's opposition, filed on February 2, 2011 to the patent owner's request for reconsideration filed on January 18, 2011 does, not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the third party requester. Rather, the requester's paper opposing patent owner's request for revival is being expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. The patent owner's reconsideration petition is **granted**.

2. The November 18, 2009 declaration by Mischler, submitted with the November 1, 2010 patent owner petition, is entered into the file. The proceeding is regressed such that this declaration forms the completion of patent owner's response under 37 C.F.R. § 41.77 (b)(1).

3. **Third party requester, within one month of the mailing date of this decision, may once file comments on the completed patent owner response. Such written comments must be strictly limited to the issues as affected by the Mischler declaration**.

4. Following third party requester's comments, the reexamination will proceed according to § 41.77(d)-(f).

5. The February 2, 2011 requester opposition petition paper is refused entry, as it is an improper paper. The opposition petition paper is not enterable into the record of the

[12] Compare the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act. Such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding.

present reexamination proceeding, because such a submission is not authorized by the reexamination statute or the regulations promulgated under the statute.

6. Because the opposition petition paper was previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

7. Any inquiry concerning 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

March 29, 2011
Kenappeal/decisions/entry issues/

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MCDERMOTT WILL & EMERY LLP
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WASHINGTON DC 20005-3096

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NOV 12 2010

OFFICE OF PETITIONS

Applicant: Jeffrey SCHENKEL, et al.
REEXAMINATION Control No.: 95/000,051
Patent Number: 6,518,733
Issue Date: February 11, 2003

: DECISION ON REQUEST FOR
: CALCULATION of PATENT
: TERM ADJUSTMENT IN VIEW OF
: WYETH

The Patentee's Request for Recalculation filed April 23, 2010, is **DISMISSED**.

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

Or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,070	01/07/2005	6553611	06337/8200569-000	9512

70813 7590 12/17/2010

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/17/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Peter C. Schechter
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

Date: MAILED
DEC 17 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000070
PATENT NO. : 6553611
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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GOODWIN PROCTER LLP
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WASHINGTON, DC 20001

(For Patent Owner)

MAILED

DEC 17 2010

CENTRAL REEXAMINATION UNIT

Peter C. Schechter
EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

(For Requester)

In re Huebsch et al.
Reexamination Proceeding
Control No.: 95/000,070
Filing Date: January 7, 2005
For: U.S. Patent No.: 6,553,611

: DECISION
: DISMSSING
: PETITION

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a May 3, 2010 patent owner petition, filed under 37 CFR § 1.181 to invoke supervisory authority to examine newly proposed claims 13-29 and deem the Action Closing Prosecution, dated March 2, 2010, as premature.

The patent owner's petition is dismissed as moot.

BACKGROUND

1. U.S. Patent No. 6,553,611 (hereinafter, the '611 patent) issued on April 29, 2003.

2. On January 7, 2005, a request for *inter partes* reexamination of the '611 patent was filed. The request was assigned Control No. 95/000,070 (the '070 proceeding).

3. On March 15, 2005, *inter partes* reexamination was ordered for the '070 proceeding. On the same day, a non-final Office action was mailed in the '070 proceeding.

4. Prosecution continued and on March 2, 2010, the Office mailed an Action Closing Prosecution (ACP). The ACP refused consideration of newly proposed claims 13-29 due to a determination that the amendment did not comply with 35 U.S.C. 305.

5. On May 3, 2010, patent owner filed the present petition, which is a petition under 37 CFR 1.181 to invoke supervisory authority to examine newly proposed claims 13-29 and deem the Action Closing Prosecution, dated March 2, 2010, as premature. On the same day, patent owner filed a response to the ACP.

6. On May 28, 2010, third party requester filed comments on patent owner's response and the March 2, 2010 ACP.

7. On October 28, 2010, the Office mailed a corrected ACP, in which newly proposed claims 13-29 were considered and addressed in the action. This ACP also considered and addressed the May 3, 2010 patent owner's response and the May 28, 2010 third party requester's comments.

DECISION

As pointed out, on May 3, 2010, the patent owner filed a petition, which is a petition under 37 CFR 1.181 to invoke supervisory authority to examine newly proposed claims 13-29 and deem the Action Closing Prosecution, dated March 2, 2010, as premature. However, the Office mailed a corrected ACP on October 28, 2010, and the corrected ACP considered and addressed the newly proposed claims 13-29 as well as the May 3, 2010 patent owner's response and the May 28, 2010 third party requester's comments. Therefore, the relief requested by the May 3, 2010 petition has already been given by the October 28, 2010 ACP. Thus, the patent owner's May 3, 2010 petition is moot, and hereby dismissed.

CONCLUSION

1. The May 3, 2010 patent owner's petition under 37 CFR § 1.181 is dismissed as moot.

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

Irem Yücel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,070	01/07/2005	6553611	06337/8200569-000	9512

58249 7590 06/14/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

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

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Date: MAILED
JUN 14 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000070
PATENT NO. : 6553611
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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JUN 14 2011
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(For Third Party Requester)

In re Huebsch *et al.*	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,070	: **GRANTING PETITION**
Filed: January 7, 2005	: **UNDER § 1.183**
For: U.S. Patent No. 6,553,611 B2	:

This is a decision on the April 14, 2011 third party requester petition entitled "Petition to the Director under 37 C.F.R. § 1.183 for Amendment of the Claims Following a Right of Appeal Notice in an *Inter-Partes* Reexamination."

The third party requester 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 an amendment is **granted** to the extent specified below.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

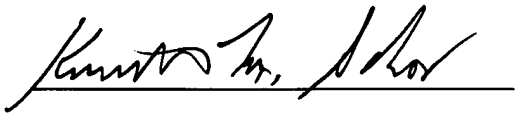
The present third party requester petition for waiver of the rules to permit entry of an amendment to the claims correcting a "minor typographical error" was filed on April 14, 2011, simultaneously with the filing of a Notice of Appeal, and one month after the March 14, 2011 issuance of the Right of Appeal Notice. Requester filed the instant petition under 37 C.F.R. § 1.183 to "suspend the provision of [37] C.F.R. § 1.953(c) prohibiting amendments following a Right of Appeal Notice." The amendment proposes to change "the bar filter" to "the bag filter" in claims 28 and 29. The examiner requested such a change in the Right of Appeal Notice of March 14, 2011, at page 4, and in the Action Closing Prosecution of October 28, 2010, at page 4.

Under the current facts and circumstances of the proceeding, waiver of § 1.953(c) is granted under 37 C.F.R. § 1.183 to the extent that third party requester's amendment accompanying the instant petition is entered into the file. The amendment addresses an objection to claims 28 and 29, and does not touch the rejections of the claims, which are currently under appeal. For that reason, no additional briefing time is necessary, and the current time periods for submission of appellant's briefs remain unaffected by this decision.

CONCLUSION

1. The third party requester petition filed April 14, 2011 for waiver of the rules to permit entry of an amendment filed with the petition is **granted to the extent stated above.**

2. 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

June 9, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,105	08/17/2005	6387499	0149-053349	8686

28289 7590 01/06/2011

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PITTSBURGH, PA 15219

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-6-11

JIAWEI HUANG
JC PATENTS
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000105
PATENT NO. : 6387499
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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The Webb Law Firm, P.C.
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MAILED
JAN 06 2011
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Jiawei Huang
JC Patents
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Irvine, California 92618

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/000,105
Filed: August 17, 2005
For: U.S. Patent No. 6,387,499

DECISION DISMISSING PETITION FOR MERGER OF *INTER PARTES* REEXAMINATION AND REISSUE APPLICATION

This is a decision on patent owner's "PETITION UNDER 37 C.F.R. § 1.182," filed November 1, 2010 ("the petition under 37 CFR 1.182"), requesting merger of the 95/000,105 *inter partes* reexamination proceeding with reissue application no. 12/916,902.

The patent owner petition is before the Office of Patent Legal Administration.

The $400.00 petition fee pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was paid on November 2, 2010.

The petition is dismissed, for the reasons set forth herein.

BACKGROUND

1. On May 14, 2002, United States Patent No. 6,387,499 ("the '499 patent") issued to Sohma *et al.* with claims 1-9.

2. On August 17, 2005, a request for *inter partes* reexamination of claims 1-9 of the '499 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,105 ("the '105 proceeding").

3. On October 18, 2005, the Office mailed an order granting *inter partes* reexamination in the '105 proceeding of claims 1-9 of the '499 patent, concurrently with a non-final Office action on the merits.

4. The '105 proceeding progressed to the point where, on September 30, 2010, the Board of Patent Appeals and Interferences (BPAI) issued a decision affirming the examiner's rejection of claims 2 and 7-9 of the '499 patent.

5. On November 1, 2010, patent owner filed a reissue application for the '499 patent, which application was assigned application number 12/916,902 ("the '902 reissue application"). The reissue application included a preliminary amendment in which the text of original patent claims 1-3 and 7-8 was amended and new claims 10-14 were added. No Office action has been mailed in the '902 reissue application.

6. Concurrently, on November 1, 2010, patent owner filed the instant petition under 37 CFR 1.182 in the '105 proceeding.

7. On November 23, 2010, a notice of the filing of the '902 reissue application was published in the *Official Gazette*.

8. On December 1, 2010, the '902 reissue application was docketed to an examiner and is ready for examination.

9. On December 7, 2010, the Office issued a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) in the '105 proceeding, stating that the reexamination certificate will indicate that claims 1-3 and 7-9 of the '499 patent are cancelled and that claims 4-6, as amended, are patentable over the prior art.

10. On December 12, 2010, the '105 reexamination was released to publications for issuance of the reexamination certificate.

CLAIMS OF RECORD

A review of the prosecution history for the '105 reexamination proceeding reveals that original patent claims 1 and 3 have been cancelled and the text of original patent claims 2 and 4-8 has been amended. The BPAI has affirmed the examiner's rejection of claims 2 and 7-9. Amended claims 4-6 have been confirmed as patentable. Thus, the reexamination certificate is to issue with amended claims 4-6.

A review of the '902 reissue application file reveals that the text of original patent claims 1-3 and 7-8 has been amended and that new claims 10-14 have been added. Thus, claims 1-14 are pending in the '902 reissue application.

The claims of the '105 reexamination proceeding and the claims of the '902 reissue application are <u>not</u> identical.

RELEVANT AUTHORITY

35 U.S.C. § 314(c) provides:

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

37 CFR 1.103(e) states:

> *Notice of suspension on initiative of the Office*. The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

37 CFR 1.991 provides, in part:

> If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

MPEP § 2686.03 provides, in part:

> The general policy of the Office is that the examination of a reissue application and an *inter partes* 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 the reissue and the reexamination to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two files on behalf of the patent owner. If both a reissue application and a reexamination proceeding are pending concurrently on a patent, a decision will normally be made to merge the reissue application examination and the reexamination or to stay one of the two. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

MPEP § 2686.03(II)(C) provides, in part (emphasis added):

> In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination third party requester. If such issues are raised, merger would ordinarily not be ordered, and one of the two proceedings stayed. In addition, consideration will also be given to the status of the reexamination proceeding. For example, if the reexamination proceeding is on appeal to the Board or to the Court of Appeals for the Federal Circuit, or a Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination proceeding, that fact would be considered in making a decision whether to merge the reissue application examination and the reexamination proceeding or stay one of them.

PATENT OWNER'S REQUEST UNDER 37 CFR 1.182 FOR MERGER

In support of its request for merger of the '105 reexamination proceeding and the '902 reissue application, patent owner asserts the following:

> Reissue Application No. 12/916,902 was filed to request examination of claims of different scope than those that issued in U.S. Patent No. 6,387,499 (hereinafter "the '499 patent") and that are currently pending in Reexamination Control No. 95/000,105. These claims were not presented earlier because the '499 patent issued without an Office Action or any substantive prosecution. During prosecution of the reexamination proceeding, the patent owner sought entry and consideration of at least some of the subject matter of the claims in the present reissue application, including at least claim 13. Entry and consideration thereof was denied in the reexamination proceeding.
>
> Accordingly, the patent owner has limited options for further consideration of claims of alternate scope beyond the claims of the '499 patent and as currently pending in the reexamination proceeding.
>
> Further prosecution of the subject matter of the '499 patent is warranted in view of the lack of substantive prosecution in the application for the '499 patent and the treatment of the *inter partes* reexamination proceeding with special dispatch pursuant to 37 C.F.R. § 1.937.[1]

DECISION

The '902 reissue application (proceeding) and the '105 reexamination proceeding are currently pending for the same patent. The order has been mailed pursuant to 37 CFR 1.931 for the '105

[1] Petition under 37 CFR 1.182 at pages 1-2.

reexamination proceeding, the '902 reissue application has been announced in the *Official Gazette*, and the '902 reissue application has been docketed to an examiner and is ready for examination. Accordingly, consideration of patent owner's November 1, 2010 request under 37 CFR 1.182 for merger of the '902 reissue application and the '105 reexamination proceeding is appropriate at this time.[2]

In considering patent owner's instant request for merger, the following options have been evaluated: (1) merging the '902 reissue application and '105 reexamination proceedings, (2) conducting the '902 reissue application and '105 reexamination proceedings separately and at the same time, and (3) suspending one of the '902 reissue application and '105 reexamination proceedings. After consideration of the records of the '902 reissue application and the '105 reexamination proceeding, the Office has decided that merger of the two proceedings is not the appropriate option in this case, and that prosecution in the '902 reissue application will be suspended. This decision is based on the following considerations.

1. The Merger Option

With respect to the option of merging the '902 reissue application and the '105 reexamination proceeding, MPEP § 2686.03(II)(C) clearly points out that when a Notice of Intent to Issue a Reexamination Certificate has issued for the reexamination proceeding, that circumstance would itself weigh against merger of the reexamination proceeding with a copending reissue application for the same patent. In this instance, a merger of the '902 reissue application and the '105 reexamination proceeding would impede treatment of the '105 reexamination proceeding with the statutorily mandated special dispatch (pursuant to 35 U.S.C § 314(c)) in reexamination. A merger would pull the '105 reexamination proceeding back from its advanced stage (the proceeding has been released to publications for issuance of the reexamination certificate), and return the prosecution to a point in which no examination on the merits of the claims of record in the merged proceeding has taken place. Also, the merged proceeding would be conducted under the broader reissue regulations, as required by 37 CFR 1.565(d). It simply does not appear that prosecution on the '902 reissue application will be concluded so quickly as to provide the statutorily mandated special dispatch for the '105 reexamination proceeding if the two proceedings are merged. There is a public interest in the outcome of the '105 reexamination proceeding and the public has a right to have that proceeding conducted with special dispatch, rather than have prosecution in this instance delayed indefinitely in favor of prosecution of a reissue application that has not yet had a first examination on the merits, and which may be subject to prosecution that might subsequently be extended by multiple follow-on filings.[3]

As patent owner asserts, the reissue claims are different from the claims that have been confirmed as patentable in the reexamination proceeding and that "at least some of the subject

---

[2] While a reissue application will generally not be acted on sooner than two months after announcement of the filing of the reissue has appeared in the *Official Gazette* (see MPEP 1441), in this instance, consideration of the instant petition under 37 CFR 1.182 is not deemed to be premature given that there would be no apparent benefit to waiting until the conclusion of the two-month delay period (i.e., until January 23, 2011) before making a decision pursuant to 37 CFR 1.991 on the instant petition under 37 CFR 1.182.

[3] Further delay of the '105 proceeding, after it has already been pending for over five years and progressed to a point where it is in the process of publication and issuance of the reexamination certificate, is not deemed to be in the public interest.

matter" of the claim amendments made in the reissue application were denied entry into the reexamination. Thus, such claims would require complete examination on the merits with respect to all statutory requirements for patentability in the merged proceeding, as explained below.

In this instance, the '902 reissue application was filed more than two years after the issue date of the '499 patent; thus, applicant/patent owner will not have the opportunity to provide broadening claims in the reissue application. However, the reissue application is subject to an entirely new examination not only on new art but also on previously applied art, whereas examination in a reexamination proceeding is limited to art that raises a substantial new question of patentability. Thus, even if the claims are not broadened in the reissue application, the examiner of a merged proceeding, as proposed, would need to (a) consider any grounds of rejection of the patent claims other than those based solely on prior patents and printed publications, (b) consider any grounds of rejection of the patent claims other than those based solely on art that raises a substantial new question of patentability, and (c) evaluate the adequacy and propriety of the reissue declaration. These additional issues would retard the prompt resolution of the reexamination proceeding in contradiction to the statutory mandate of 35 U.S.C. § 314(c) for special dispatch.

In view of the foregoing considerations, it is not deemed beneficial to consolidate the '902 reissue application and '105 reexamination proceedings within the Office. Accordingly, patent owner's instant request under 37 CFR 1.182 for merger of the '902 reissue application and the '105 reexamination proceeding is **dismissed**.

2. The Option to Conduct the Proceedings Separately

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '499 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner, and not providing complex requirements for separate concurrent prosecution of proceedings. In this instance, separate and concurrent prosecution would involve undue complexities in coordinating the proceedings which would run contrary to the special dispatch requirement of 35 U.S.C. § 314(c), and would require re-work in each proceeding based on resulting outcomes of the other proceeding. As pointed out above, the claims of the reissue application and the claims of the reexamination proceeding are not identical.

3. The Suspension Option

Given that the examination of the '902 reissue application and the '105 reexamination proceedings will not be conducted separately and at the same time, and will not be merged for the reasons stated above, the only remaining option is to suspend one of the proceedings. The question remains as to which of the two proceedings should proceed, and which should be suspended.

To answer this question, it is observed that there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceedings (pursuant to 35 U.S.C. § 314(c)). In making a

decision on whether to merge a reissue application and a reexamination proceeding, consideration is given to the status of each proceeding. See MPEP 2686.03(II)(C). In this instance, a significant amount of prosecution has taken place in the '105 reexamination proceeding. A Notice of Intent to Issue a Reexamination Certificate was issued for the reexamination proceeding on December 7, 2010, and the proceeding was released to publications for issuance of the reexamination certificate on December 12, 2010. In contrast, the '902 reissue application has not had an action on the merits.

Thus, a suspension of the reissue application would not result in a delay of a proceeding that has progressed substantially toward its resolution. Because 35 U.S.C. § 314(c) provides the statutory requirement that *inter partes* reexamination proceedings must be conducted with special dispatch, the examination of the reexamination proceeding must take precedence in this instance.

Based on the above, a decision is being issued concurrently herewith, ***sua sponte* suspending action in the '902 reissue application** pursuant to 37 CFR 1.103(e) in favor of the '105 reexamination proceeding.

CONCLUSION

1. Patent owner's November 1, 2010 "PETITION UNDER 37 C.F.R. §1.182" is **dismissed**.

2. On an even date herewith, a decision is being mailed in the '902 reissue application *sua sponte* suspending action in the '902 reissue application.

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

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

January 4, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,120	01/17/2006	6210293	00634.0004.RXUS01	6322

7590 01/18/2011

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P. O. Box 1022
Minneapolis, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122; 95/000,123
Patents 6,210,293; 6,503,156; 6,506,130; 6,595,873

DECISION ON PETITION

This is a decision on Patent Owner's "Petition for Temporary Relief in Light of New Court Decision," filed January 14, 2010 ("Petition").

In the Petition, Patent Owner requests "that an order issue immediately, on an *ex parte* basis, adjourning the oral hearing [presently scheduled for January 19, 2011] for forty (40) days to February 28, 2011." Petition at 2.

Pursuant to the provisions of 35 U.S.C. § 41.20, the fee of $400 has been charged to the attorney's deposit account.

FINDINGS

1. On January 6, 2011, the Acting Chief Administrative Patent Judge entered a Decision on Request to Reschedule Hearing denying Patent

Owner's request to delay for ninety (90) days the oral hearing previously scheduled for January 19, 2011.

2. On January 13, 2011, the U.S. District Court for Delaware held that Requester breached a valid settlement agreement by initiating the present Reexamination Proceedings. Petition, Exhibit A.

ANALYSIS

Patent Owner's position may be distilled to a single point - whether the requester's breach of a settlement agreement by filing a reexamination request renders the resulting institution of a reexamination proceeding by the United States Patent and Trademark Office (USPTO) *ultra vires* (i.e. whether the proceeding was beyond the USPTO's legal authority to conduct).

Notwithstanding the ruling by the District Court on the settlement agreement issue, it is apparent that (1) the USPTO was not a party to the District of Delaware proceedings and (2) there is no definitive ruling by the District Court requiring that the present Reexamination Proceedings be terminated.

Patent Owner's novel theory improperly conflates an action by a requester with the action by the USPTO in initiating these reexamination proceedings. Simply put, the Central Reexamination Unit (CRU) received a reexamination request and fee, and acted upon it in the normal course of business. That the requester may have breached a contractual obligation not to do so does not necessarily make the subsequent actions of the USPTO illegal or the proceeding "unlawfully initiated" by the CRU (Petition at 5).

It is noted that Patent Owner is, and was, well aware of the USPTO's position on whether these reexamination proceedings were *ultra vires*. *See e.g.*, Reexamination Proceeding 95/000,123, Decision on Petition to Vacate Order Granting Reexamination, Jun. 7, 2006 (denying the petition to vacate). This proceeding is in a mature phase and this is not a new issue.

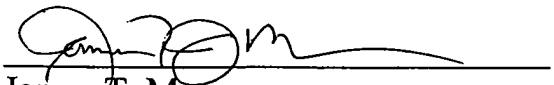
It is also noted that this argument has been scheduled for some time, and the panel has completed its preparation. That preparation was extensive given the complex litigation involved in this case. It would be wasteful of scarce judicial resources to reschedule the argument 40 days later, requiring the panel to prepare anew.

Finally, the decision will take some time to prepare – likely some weeks – and any effect on the Patent owner will be minimal.

We note that a "Response and Opposition" was filed by Acushnet dated January 18, 2011 and a "Petition to Accept Reply" and "Reply" was filed by Calloway also on January 18, 2011. The opening petition did not make out a case for relief to be granted, as a consequence the "Response and Opposition" has not been considered, and the Petition to Accept Reply is dismissed as moot, as there is no need for a Reply to a Response which has not been considered.

DECISION

In view of the forgoing, the Petition is DENIED. The hearing scheduled for January 19, 2011 will proceed as scheduled.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122 and 95/000,123
Patent 6,210,293; 6,503,156; 6,506,130 and 6,595,873

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/09/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122; 95/000,123
Patents 6,210,293; 6,503,156; 6,506,130; 6,595,873

DECISION ON PETITIONS

This is a decision on Patent Owner's:

1. "Petition to Vacate Inter Partes Reexaminations or, in the Alternative, to Postpone Oral Hearing," filed January 12, 2011;
2. "Petition for Temporary Relief In light of New Court Decision," filed January 14, 2011;
3. "Supplemental Petition for Temporary Relief In light of New Court Decision," filed January 14, 2011; and
4. "Petition to Accept Reply Filing and Reply In Further Support of Callaway Golf's Supplemental Petition for Temporary Relief In light of New Court Decision," filed January 18, 2011.

Also considered with the foregoing petitions by Patent Owner was Third Party Requester's:

"Acushnet Company's Comprehensive Response and Opposition to Callaway's Petitions to (1) Vacate *Inter Partes* Reexaminations or, in the alternative, to Postpone Oral Hearing, (2) Supplemental Petition for Temporary Relief in light of New Court Decision; and (3) Petition for Temporary Relief in light of New Court Decision," filed January 18, 2011.

Patent owner's Petitions present two issues:

1. Should the present reexamination proceedings be vacated?

2. Should the oral hearing scheduled for January 19, 2011 be postponed?

FINDINGS

1. An oral hearing was scheduled for January 19, 2011 in the present reexamination proceedings. On January 6 and 18, 2011, the Chief Administrative Patent Judge entered Decisions denying Patent Owner's Petitions to postpone the oral hearing. An oral hearing was held on January 19, 2011, as scheduled. Thus, the issue of whether or not to proceed with the oral hearing is moot.

2. Patent Owner previously sought dismissal of the 120 reexamination proceeding in Petitions filed on April 13, 2006 and June 16, 2006. Those Petitions were denied, respectively, in Decisions entered June 7, 2006 and September 7, 2006. The Decision of September 7, 2006 stated that:

> This decision is a final agency action within the meaning of 5 U.S.C. § 704.

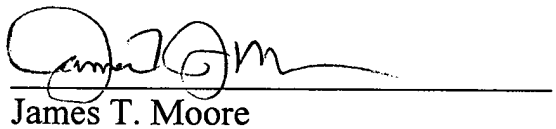
Decision, p. 15 (emphasis in original.)

ANALYSIS

In the final agency action of September 7, 2006, the Office of Patent Legal Administration (OPLA) specifically addressed Patent Owner's argument made then and now that Requester's breach of a settlement agreement by instituting a reexamination proceeding constitutes sufficient cause for vacating the reexamination proceeding. *See,* Decision Denying Petition for Reconsideration and Returning Improper Paper, pp. 6-11 (OPLA Sept. 7, 2006). That argument was rejected. The period for Patent Owner to seek appropriate relief from the OPLA Decision of September 7, 2006 has long since expired.

DECISION

In view of the forgoing, the Patent Owner's Petitions are DENIED. The Board of Patent Appeals and Interferences will decide the appeals in the present proceedings.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122 and 95/000,123
Patent 6,210,293; 6,503,156; 6,506,130 and 6,595,873

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CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

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FINDINGS

1. On January 6, 2011, the Acting Chief Administrative Patent Judge entered a Decision on Request to Reschedule Hearing denying Patent

Copied from 95000123 on 09/15/2011

Owner's request to delay for ninety (90) days the oral hearing previously scheduled for January 19, 2011.

2. On January 13, 2011, the U.S. District Court for Delaware held that Requester breached a valid settlement agreement by initiating the present Reexamination Proceedings. Petition, Exhibit A.

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Patent Owner's position may be distilled to a single point - whether the requester's breach of a settlement agreement by filing a reexamination request renders the resulting institution of a reexamination proceeding by the United States Patent and Trademark Office (USPTO) *ultra vires* (i.e. whether the proceeding was beyond the USPTO's legal authority to conduct).

Notwithstanding the ruling by the District Court on the settlement agreement issue, it is apparent that (1) the USPTO was not a party to the District of Delaware proceedings and (2) there is no definitive ruling by the District Court requiring that the present Reexamination Proceedings be terminated.

Patent Owner's novel theory improperly conflates an action by a requester with the action by the USPTO in initiating these reexamination proceedings. Simply put, the Central Reexamination Unit (CRU) received a reexamination request and fee, and acted upon it in the normal course of business. That the requester may have breached a contractual obligation not to do so does not necessarily make the subsequent actions of the USPTO illegal or the proceeding "unlawfully initiated" by the CRU (Petition at 5).

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It is noted that Patent Owner is, and was, well aware of the USPTO's position on whether these reexamination proceedings were *ultra vires*. *See e.g.*, Reexamination Proceeding 95/000,123, Decision on Petition to Vacate Order Granting Reexamination, Jun. 7, 2006 (denying the petition to vacate). This proceeding is in a mature phase and this is not a new issue.

It is also noted that this argument has been scheduled for some time, and the panel has completed its preparation. That preparation was extensive given the complex litigation involved in this case. It would be wasteful of scarce judicial resources to reschedule the argument 40 days later, requiring the panel to prepare anew.

Finally, the decision will take some time to prepare – likely some weeks – and any effect on the Patent owner will be minimal.

We note that a "Response and Opposition" was filed by Acushnet dated January 18, 2011 and a "Petition to Accept Reply" and "Reply" was filed by Calloway also on January 18, 2011. The opening petition did not make out a case for relief to be granted, as a consequence the "Response and Opposition" has not been considered, and the Petition to Accept Reply is dismissed as moot, as there is no need for a Reply to a Response which has not been considered.

DECISION

In view of the forgoing, the Petition is DENIED. The hearing scheduled for January 19, 2011 will proceed as scheduled.

James T. Moore
Acting Chief Administrative Patent Judge

Copied from 95000123 on 09/15/2011

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Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,121	01/17/2006	6503156	00634.0004 RXUS04	6323

7590 01/18/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122; 95/000,123
Patents 6,210,293; 6,503,156; 6,506,130; 6,595,873

DECISION ON PETITION

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Pursuant to the provisions of 35 U.S.C. § 41.20, the fee of $400 has been charged to the attorney's deposit account.

FINDINGS

1. On January 6, 2011, the Acting Chief Administrative Patent Judge entered a Decision on Request to Reschedule Hearing denying Patent

Owner's request to delay for ninety (90) days the oral hearing previously scheduled for January 19, 2011.

2. On January 13, 2011, the U.S. District Court for Delaware held that Requester breached a valid settlement agreement by initiating the present Reexamination Proceedings. Petition, Exhibit A.

ANALYSIS

Patent Owner's position may be distilled to a single point - whether the requester's breach of a settlement agreement by filing a reexamination request renders the resulting institution of a reexamination proceeding by the United States Patent and Trademark Office (USPTO) *ultra vires* (i.e. whether the proceeding was beyond the USPTO's legal authority to conduct).

Notwithstanding the ruling by the District Court on the settlement agreement issue, it is apparent that (1) the USPTO was not a party to the District of Delaware proceedings and (2) there is no definitive ruling by the District Court requiring that the present Reexamination Proceedings be terminated.

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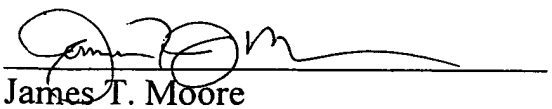

James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122 and 95/000,123
Patent 6,210,293; 6,503,156; 6,506,130 and 6,595,873

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EXAMINER

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ART UNIT	PAPER NUMBER

DATE MAILED: 03/09/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122; 95/000,123
Patents 6,210,293; 6,503,156; 6,506,130; 6,595,873

DECISION ON PETITIONS

This is a decision on Patent Owner's:

1. "Petition to Vacate Inter Partes Reexaminations or, in the Alternative, to Postpone Oral Hearing," filed January 12, 2011;
2. "Petition for Temporary Relief In light of New Court Decision," filed January 14, 2011;
3. "Supplemental Petition for Temporary Relief In light of New Court Decision," filed January 14, 2011; and
4. "Petition to Accept Reply Filing and Reply In Further Support of Callaway Golf's Supplemental Petition for Temporary Relief In light of New Court Decision," filed January 18, 2011.

Also considered with the foregoing petitions by Patent Owner was Third Party Requester's:

"Acushnet Company's Comprehensive Response and Opposition to Callaway's Petitions to (1) Vacate *Inter Partes* Reexaminations or, in the alternative, to Postpone Oral Hearing, (2) Supplemental Petition for Temporary Relief in light of New Court Decision; and (3) Petition for Temporary Relief in light of New Court Decision," filed January 18, 2011.

Patent owner's Petitions present two issues:

1. Should the present reexamination proceedings be vacated?
2. Should the oral hearing scheduled for January 19, 2011 be postponed?

FINDINGS

1. An oral hearing was scheduled for January 19, 2011 in the present reexamination proceedings. On January 6 and 18, 2011, the Chief Administrative Patent Judge entered Decisions denying Patent Owner's Petitions to postpone the oral hearing. An oral hearing was held on January 19, 2011, as scheduled. Thus, the issue of whether or not to proceed with the oral hearing is moot.

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> This decision is a final agency action within the meaning of 5 U.S.C. § 704.

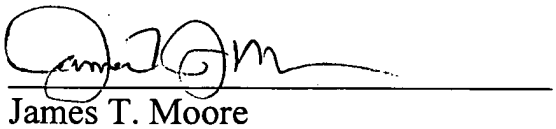
Decision, p. 15 (emphasis in original.)

ANALYSIS

In the final agency action of September 7, 2006, the Office of Patent Legal Administration (OPLA) specifically addressed Patent Owner's argument made then and now that Requester's breach of a settlement agreement by instituting a reexamination proceeding constitutes sufficient cause for vacating the reexamination proceeding. *See,* Decision Denying Petition for Reconsideration and Returning Improper Paper, pp. 6-11 (OPLA Sept. 7, 2006). That argument was rejected. The period for Patent Owner to seek appropriate relief from the OPLA Decision of September 7, 2006 has long since expired.

DECISION

In view of the forgoing, the Patent Owner's Petitions are DENIED. The Board of Patent Appeals and Interferences will decide the appeals in the present proceedings.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122 and 95/000,123
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,122	01/17/2006	6506130	00364.0004RXUS02	6325

7590 01/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
Third Party Requester

Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122; 95/000,123
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Pursuant to the provisions of 35 U.S.C. § 41.20, the fee of $400 has been charged to the attorney's deposit account.

FINDINGS

1. On January 6, 2011, the Acting Chief Administrative Patent Judge entered a Decision on Request to Reschedule Hearing denying Patent

Owner's request to delay for ninety (90) days the oral hearing previously scheduled for January 19, 2011.

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Patent Owner's position may be distilled to a single point - whether the requester's breach of a settlement agreement by filing a reexamination request renders the resulting institution of a reexamination proceeding by the United States Patent and Trademark Office (USPTO) *ultra vires* (i.e. whether the proceeding was beyond the USPTO's legal authority to conduct).

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Inter partes Reexamination Control 95/000,120; 95/000,121; 95/000,122 and 95/000,123
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95/000,122	01/17/2006	6506130	00364.0004RXUS02	6325

7590 03/09/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CALLAWAY GOLF COMPANY
Patent Owner

ACUSHNET COMPANY
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Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122; 95/000,123
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DECISION ON PETITIONS

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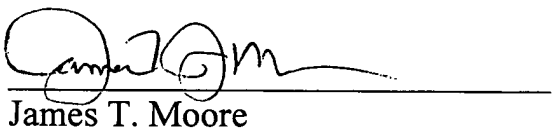

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Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122 and 95/000,123
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95/000,123	01/17/2006	6595873	00634.0004.RXUS03	6324

7590 01/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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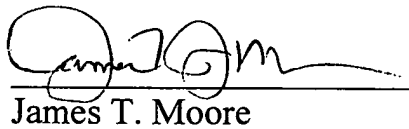
DECISION

In view of the forgoing, the Patent Owner's Petitions are DENIED. The Board of Patent Appeals and Interferences will decide the appeals in the present proceedings.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control Proceedings 95/000,120; 95/000,121; 95/000,122 and 95/000,123
Patent 6,210,293; 6,503,156; 6,506,130 and 6,595,873

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 04/27/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20001-4413

EXAMINER

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DATE MAILED: 04/27/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed January 18, 2011 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed January 26, 2011 ("Opposition"). In the Petition, "[Patent Owner] Rambus requests that the Office expunge [Third Party Requester] Micron's cross-appeal brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,124 . . .) and because the Examiner did not adopt those issues in these proceedings." Petition, p. 1.

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FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting Samsung's *inter partes* reexamination request of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting Micron's *inter partes* reexamination request of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the Office merged the '026 and '1124 proceedings.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on February 19, 2010, the Office issued a first Right of Appeal Notice.

9. On September 3, 2010, the Office issued a second Right of Appeal Notice rejecting claims 1-28 and confirming claims 29-35.

10. On October 1, 2010, Rambus filed a Notice of Appeal.

11. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

12. On December 15, 2010, Rambus filed an Appeal Brief.

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13. Also on December 15, 2010, Micron filed a Cross-Appeal Brief..

14. On January 18, 2011, Rambus filed the present Petition.

15. On January 26, 2011, Micron filed the present Opposition.

ANALYSIS

In several *inter partes* reexamination proceedings involving the same parties, Rambus has sought the expungement of Micron briefs on the ground that Micron's briefs address issues that initially were raised in a Samsung initiated reexamination request and not in a Micron initiated request. The Office has addressed this issue on several occasions within the past few months. With the exception of one early decision that was grounded on an improper interpretation of MPEP § 2674 that subsequently has been reversed, the Office consistently has held that Micron has the right to appeal any decision favorable to patentability that is present in a merged proceeding at the time the RAN is entered irrespective of who initially raised the patentability issue in question. See, e.g., Decision on Petition entered February 16, 2011 in merged proceedings 95/001,026 and 95/001,128, and Decision on Petition entered April 15, 2011 in merged proceedings 95/000,183 and 95/001,112.

At this juncture, further detailed consideration and discussion of the issue will merely be repetitive of the analyses presented in the prior relevant decisions and therefore will be wasteful of the Office's limited resources. Accordingly, counsel should consider whether it is advisable to submit further petitions presenting only this same issue.

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DECISION

For the forgoing reason, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 05/06/2011

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EXAMINER

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RAMBUS, INC.
Patent Owner

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Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed January 18, 2011 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 26 pages and 14,891 words in length." Petition, p. 1.

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

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2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").

10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

13. On December 15, 2010, Rambus filed an Appeal Brief.

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14. On December 15, 2010, Micron filed a Cross-Appeal Brief.

15. On January 18, 2011, Rambus filed the Respondent Brief that is the subject of the present Petition, and the present Petition.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

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ANALYSIS

As an initial matter, Rambus argues that "In its brief, Micron attempts to resurrect two proposed rejections that Micron did not raise in its reexamination request and that Micron has no standing to raise on appeal." Petition, p. 3. In this proceeding, this issue was decided in the Decision Dismissing Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief, April 27, 2011:

> [T]he Office consistently has held that Micron has the right to appeal any decision favorable to patentability that is present in a merged proceeding at the time the RAN is entered irrespective of who initially raised the patentability issue in question. See, e.g., Decision on Petition entered February 16, 2011 in merged proceedings 95/001,026 and 95/001,128, and Decision on Petition entered April 15, 2011 in merged proceedings 95/000,183 and 95/001,112.

Decision, p. 3.

Further, Rambus contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." Petition, p. 2.

Micron's Cross-Appeal Brief is 40 pages in length and includes at least eight patentability issues involving at least five references. Further, the second RAN is 137 pages in length.

In view of the number of different patentability issues presented in this merged reexamination proceeding, an increase of eleven pages in the permitted length of Rambus's Respondent Brief is deemed reasonable. It is unnecessary to reach Rambus's due process argument.

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DECISION

For the forgoing reason, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
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SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c)," filed April 1, 2011 ("Petition"). In the Petition, Requester requests that it be permitted to submit a respondent brief up to 27 pages in length. Petition, p. 1.

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a

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corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").

10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On December 15, 2010, Rambus filed an Appeal Brief.

13. On February 4, 2011, the Office entered a Notification of Defective Brief because Rambus's Appeal Brief exceeded the page limit specified by 37 C.F.R. § 1.943(c).

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14. On March 4, 2011, Rambus filed Patent Owner's Rep[l]acement Appeal Brief.

15. On April 1, 2011, Micron filed the present Petition.

RELEVANT AUTHORITY

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).

In respect to papers filed in *inter partes* reexamination proceedings, 37 C.F.R. § 1.943(c) provides:

(a) The form of responses, written comments, briefs, appendices and other papers must be in accordance with the requirements of § 1.52.

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

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

37 C.F.R. § 1.52(b) specifies:

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination

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proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6) . . . .

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

As indicated, for papers filed in *inter partes* reexamination proceedings, the line spacing must be one and one-half or double spaced, and the text font must be 6 or greater, preferably 12.

An examination of Rambus's Replacement Appeal Brief, filed March 4, 2011, reveals that the line spacing is single spaced and the font size is in the range of 10-12. The number of pages countable under Rule 1.943(c) appears to be 30.

In this circumstance, i.e., Rambus's brief is 30 pages of single spaced text, fairness requires that Micron be given a reasonable accommodation for the length of its respondent brief. Micron has requested that it be granted permission to file a respondent brief up to 27 pages in length having a font size of 12 and double spaced line spacing. This is a reasonable accommodation for responding to Rambus's Replacement Appeal Brief.

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DECISION

For the forgoing reason, the Petition is GRANTED. Micron is authorized to file a respondent brief having up to 27 pages countable under Rule 1.943(c), and having double line spacing and 12 point font size.

James T. Moore
Acting Chief Administrative Patent Judge

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Patent Owner

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Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c), filed July 5, 2011 ("Micron's Petition for Waiver"). Micron requests that it be allowed to submit a Rebuttal Brief of up to 8,447 words or 21 pages.

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FINDINGS

1. Patent 6,452,863 issued on September 17, 2002, with 35 claims. The '863 patent is assigned to Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007, and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was entered, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office mailed a first Right of Appeal Notice ("RAN").

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10. On September 3, 2010, the Office entered a second RAN, rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

13. On December 15, 2010, Rambus filed an Appeal Brief.

14. On December 15, 2010, Micron filed a Cross-Appeal Brief.

15. On January 18, 2011, Rambus filed a Patent Owner's Respondent Brief (Rambus's Respondent Brief") and a Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief ("Rambus's Petition for Waiver"), because the Respondent Brief was 26 pages long and included 14,891 words.

16. On May 6, 2011, the Office granted Rambus's Petition for Waiver, allowing Rambus's Respondent Brief to be 26 pages long.

17. On June 3, 2011, an Examiner's Answer was mailed.

18. On July 5, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71. ("Micron's Rebuttal Brief"). Micron's Rebuttal Brief is 21 pages.

19. On July 5, 2011, Micron filed the instant Petition for Waiver.

RELEVANT AUTHORITY

Page and word limits for briefs in reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party

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> shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

This and other rules of the Office may be suspended pursuant to 37 C.F.R. § 1.183:

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

ANALYSIS

Micron requests that 37 C.F.R. § 1.943(c) be waived so that it may submit a rebuttal brief of 21 pages. (Micron's Petition for Waiver 1.) Micron argues that the Office granted Rambus's Petition for Waiver to file a Respondent Brief of 26 pages and, thus, should permit Micron to file a Rebuttal Brief of 21 pages. (*Id.*) According to Micron, an "extraordinary situation" occurred when Rambus's Petition for Waiver was granted and "justice requires" providing for more than 15 pages to respond to all of the arguments raised by Rambus in its Respondent Brief, as well as issues in the Examiner's Answer of June 3, 2011. Micron asserts that the provision of 37 C.F.R. § 1.943(c) providing for equal number of pages for both respondent and rebuttal briefs would be upheld by granting the current petition. (*Id.* at 2.)

Previously, the number of different patentability issues presented in this merged reexamination proceeding were found to merit waiver of the

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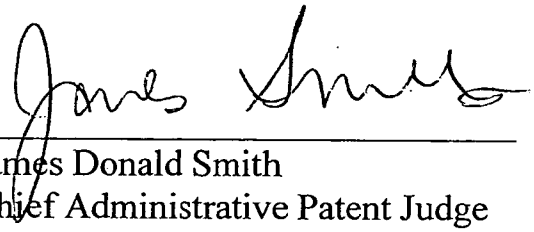
page limits imposed on Rambus's Respondent Brief. (*See* Decision on Petition entered May 6, 2011).

In the interest of the requirement for special dispatch, *see* 35 U.S.C. § 314(c), the Rebuttal Brief Micron filed on July 5, 2011 is **entered**.

DECISION

In view of the foregoing, Micron's Petition for Waiver is GRANTED.



James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,138	03/23/2006	6645742	0259-0432L	4952

7590 01/04/2012

Robert Silver
Caesar Rivise Bernstein Cohen &
Pokotilow, Ltd.
12th Flr, Seven Penn Ctr., 1635 Market St.
Philadelphia, PA 19103-2212

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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PO BOX 747
FALLS CHURCH, VA 22040-0747

Date: MAILED
JAN 04 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000138
PATENT NO. : 6645742
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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Robert Silver
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(For Patent Owner)

MAILED
JAN 04 2012
CENTRAL REEXAMINATION UNIT

Birch Stewart Kolasch & Birch
PO Box 747
Falls Church, VA 22040-0747

(For Third Party Requester)

In re De Ferra et al.	:	
Reexamination Proceeding	:	**DECISION DISMISSING**
Control No. 95/000,138	:	**PETITION TO STAY**
Filed: March 23, 2006	:	**REISSUE PROCEEDING**
For: U.S. Patent No. 6,645,742	:	

This is a decision on the September 16, 2011 third party requester petition entitled "Petition Under 37 CFR 1.182 For Stay of Reissue Proceeding until Issuance of *Inter Partes* Reexamination Certificate" (the petition under 37 CFR 1.182). This decision also addresses patent owner's October 14, 2011 opposition paper entitled "Patent Owner's Response to Third Party Requester's Petition Under 37 C.F.R. § 1.182" (the opposition).

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration for decision.

The petition under 37 CFR 1.182 is **dismissed**.

The petition under 37 CFR 1.182 is an improper paper. Because the present petition papers have been scanned into the electronic Image File Wrapper (IFW), the petition papers are being **expunged** from the record by marking them "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

REVIEW OF THE RELEVANT FACTS

1. On November 11, 2003, U.S. Patent No. 6,645,742 (the '742 patent) issued to De Ferra et al. with 32 claims.

[1] See MPEP 2267.

2. On March 23, 2006, a request for *inter partes* reexamination of claims 1-32 of the '742 patent, assigned control number 95/000,138 (the '138 proceeding), was filed by a third party requester.

3. On May 22, 2006, *inter partes* reexamination was ordered on claims 1-32 of the '742 patent in the '138 proceeding. The '138 proceeding has progressed to the point where a Notice of Intent to Issue a Reexam Certificate (NIRC) was mailed on December 05, 2011.

4. On June 24, 2011, patent owner filed a reissue application for reissue of the '742 patent, which application was assigned application number 13/167,785 (the '785 reissue application).

5. On September 16, 2011, the third party requester filed the instant petition under 37 CFR 1.182 in the '138 proceeding to stay the '785 reissue application.

6. On October 14, 2011, the patent owner filed the instant opposition to the third party requester's September 16, 2011 petition under 37 CFR 1.182.

APPLICABLE REGULATIONS AND PROCEDURES

37 C.F.R. § 1.182 addresses questions not specifically provided for:

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

37 C.F.R. § 1.939(a) addresses unauthorized papers in *inter partes* reexamination:

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

37 C.F.R. § 1.985(b) addresses notification of prior or concurrent proceedings:

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

> reexamination proceeding. Any paper not so limited will be returned to the sender.

MPEP 2686.03 sets forth the procedure for a third party requester to petition for merger or stay in *ex parte* reexamination proceedings:

> The third party requester may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, <u>or stay the reexamination proceeding</u>, after the order to reexamine (37 CFR 1.931), in the event the Office has not acted prior to that date to merge or stay. Any such petition under 37 CFR 1.182 filed prior to the initial Office action on the merits must also be filed under 37 CFR 1.183 to waive the requirement of 37 CFR 1.933(b) that no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination proceeding. Any petition to merge or stay which is filed by a party other than the patent owner or the third party requester of the reexamination will not be considered, but will be returned to that party by the OPLA. (emphasis added).

DECISION

Third party requester has filed the petition under 37 CFR 1.182 requesting that the '785 reissue application be stayed pending completion of the instant '138 *inter partes* reexamination proceeding. Third party requester has not, however, specified any statutory basis permitting such a third party requester paper, requesting that the Office take action with respect to a reissue proceeding in which requester is not a party.

A third party may file a paper notifying the Office of the existence of a concurrent reissue proceeding. However, 37 C.F.R. § 1.985(b) requires that any such paper "must be limited to merely providing notice of the other proceeding without discussion of issues of the current inter partes reexamination proceeding." Any paper that is not so limited will be returned to the sender per § 1.985(b) or expunged if inadvertently entered. The instant third party requester paper goes beyond mere notice as to requesting that the Office take action in a proceeding other than the '138 reexamination proceeding in which the petition was filed. Therefore, the instant third party requester paper is not a proper submission under § 1.985(b).

The petition under 37 CFR 1.182 is improper because the third party requester is requesting action be taken in a proceeding other than the '138 reexamination proceeding in which the petition was filed - a reissue proceeding in which requester is not a party. Neither 35 U.S.C. § 314(b)(2), nor any other provision of the reexamination statute, provides any right for the third party requester to file a paper in an *inter partes* reexamination proceeding that requests action be taken in a separate proceeding.[2] While enactment of the *inter partes* reexamination statute was

[2] *See Animal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991) (stating "we find nothing in the law which gives rise to a right in nonapplicants to object to the way in which patent applications of others are prosecuted").

for the purpose of expanding a third party requester's participation in the merits of a reexamination proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to participate in other Office proceedings. Such a right was not provided in the enactment of the *inter partes* reexamination statute (nor in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

The instant petition under § 1.182, if granted, would circumvent the *ex parte* nature of reissue applications and permit third party participation in the examination of a reissue application, contrary to the existing laws and regulations. Therefore, the petition is not appropriate under § 1.182, which may only provide relief for "situations not specifically provided for in the regulations," but may not waive rules or provisions of the laws.

For the above reasons, the petition under 37 CFR 1.182 is dismissed as not having a right of entry, and the petition paper is being expunged.

CONCLUSION

1. The third party requester petition filed September 16, 2011 is dismissed as not having a right of entry.

2. The petition paper filed by the third party requester on September 16, 2011 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '138 *inter partes* reexamination proceeding and marking the paper "closed" and "not public."

3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.

4. A copy of this decision will be made of record in the reexamination file.

5. Telephone inquiries relating to this decision should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717, or in her absence, to Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726.

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

01-03-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,152	05/10/2006	6673604	1149-00-001Y01	6018

86012 7590 02/17/2012

VLP Law Group LLP
555 Bryant Street
Suite 820
Palo Alto, CA 94301

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-17-12

Bioheart Inc.
13794 NW 4th Street
Suite 212
Sunrise, FL 33325

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000152
PATENT NO. : 6673604
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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FEB 17 2012

CENTRAL REEXAMINATION UNIT

VLP Law Group LLP (For Patent Owner)
555 Bryant Street
Suite 820
Palo Alto, CA 94301

Bioheart Inc. (For Requester)
13794 NW 4th Street
Suite 212
Sunrise, FL 33325

In re Albert Edge :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,152 : **DISMISSING PETITION**
Filed: May 10, 2006 : **UNDER 37 CFR 1.137(b)**
For: U.S. Patent No. 6,673,604 :

This is a decision on the September 13, 2011 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed submission pursuant to 37 CFR 1.951(a) and revive the present terminated reexamination ("the September 13, 2011 patent owner petition to revive").

The September 13, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The September 13, 2011 patent owner petition to revive is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*****

(d) *Terminal disclaimer.*
(1) ***
(2) ***
(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

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

MPEP 2668 provides, in pertinent part:

> II. PETITION BASED ON UNINTENTIONAL DELAY
>
> The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).
>
> *****
>
> IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS
>
> See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

Inter Partes Reexamination Certificate No. C1 6,673,604 issued for the present proceeding on March 24, 2009. The present petition under 37 CFR 1.137(b) to accept an unintentionally delayed submission pursuant to 37 CFR 1.951(a) and revive the present terminated reexamination was filed by patent owner on September 13, 2011.

37 CFR 1.181(f) states, in pertinent part:

> (f) ... Any petition under **this part** not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable. [Emphasis added.]

The time-frame in § 1.181(f) is not only applicable to matters that seek to invoke supervisory authority of the Director under § 1.181(a)(3), but is also inclusive of petitions § 1.137 for revival which are petitions under part 1 of Chapter I, Subchapter A, of Title 37 of the Code of Federal Regulations. Such petitions include § 1.137 petitions for unintentional delay filed after issuance of reexamination certificates.

In view of the Office's mandate under 35 U.S.C. 305 for "special dispatch" in carrying out reexamination proceedings, Office practice is to insist that all petitions for

unintentional revival filed after issuance of a reexamination certificate be submitted within two months of the certificate, which certificate is the action from which relief is being requested – absent a grantable petition under 37 CFR 1.183 which must state the details as to the delay in filing a revival petition that establish an extraordinary situation when justice requires waiver of the two-month period.

Under the time limit established by 37 CFR 1.181(f), any petition requesting relief from the March 24, 2009 certificate was due in the '152 reexamination proceeding on or before May 24, 2009. The present petition was not filed in the '152 reexamination proceeding until September 13, 2011, and was not accompanied by a grantable petition under 37 CFR 1.183 stating the details as to the delay in filing the petition that establish an extraordinary situation for which justice requires waiver of the two-month period. Therefore, the September 13, 2011 petition to revive is untimely.

Accordingly, the September 13, 2011 patent owner petition to accept an unintentionally delayed submission pursuant to 37 CFR 1.951(a) is **dismissed**.

CONCLUSION

1. The September 13, 2011 patent owner petition to revive under 37 CFR 1.137(b) is **dismissed**.

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

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

02/16/2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,153	07/17/2006	6753013	3893-0251L	2949

2292 7590 08/05/2010

BIRCH STEWART KOLASCH & BIRCH
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FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2010

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Martin B. Pavane

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MAILED

AUG 05 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,153*.

PATENT NUMBER *6,753,013*.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

AUG 05 2010

CENTRAL REEXAMINATION UNIT

Martin B. Pavane (For Requester)
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, NY 10176

In re Didriksen et al.	:	
Inter Partes Reexamination Proceeding	:	
Control No. 95/000,153	:	DECISION GRANTING PETITION
Filed: July 17, 2006	:	
For: U.S. Patent No. 6,753,013	:	

This is a decision on the July 20, 2010, patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR PREMATURE ACP, TO REOPEN PROSECUTION, AND TO HAVE NEW OFFICE ACTION."

The petition and the 95/000,153 *inter partes* reexamination proceeding are before the Central Reexamination Unit for consideration of the above petition.

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

REVIEW OF SALIENT FACTS

1. U.S Patent number 6,753,013 ("the '013 patent") issued to E. Didriksen *et al* on June 22, 2004.

2. On July 17, 2006, a request for *inter partes* reexamination of the '013 patent was filed by a third party requester, and assigned control number 95/000,153 ("the '153 reexamination proceeding").

3. On September 13, 2006, an Order Granting *Inter Partes* Reexamination for the '153 reexamination proceeding was mailed. The order was accompanied by a non-final rejection.

4. Subsequent to responses by patent owner and third party requester, an Action Closing Prosecution ("ACP") was mailed September 5, 2007.

5. On September 19, 2007, patent owner petitioned for a two month extension of time to respond to the ACP.

6. On September 28, 2007, the petition for two months extension of time for patent owner to respond to the ACP was granted.

7. On December 5, 2007, patent owner filed a response to the ACP and also petitioned for withdrawal of the ACP.

8. On January 9, 2008, third party requester filed written comments directed to the ACP.

9. On June 20, 2008, the petition for withdrawal of the ACP was dismissed.

10. On July 17, 2008, a Right of Appeal Notice ("RAN") was mailed.

11. On August 11, 2008, patent owner petitioned for: (a) waiver under 37 C.F.R. 1.183 of the provisions of 37 C.F.R. 41.61(a) and (e) that set a nonextendable period of time for filing a notice of appeal as being the time set in the RAN; and (b) supervisory intervention by the Director under 37 C.F.R. 1.181 to reopen prosecution of the '153 reexamination proceeding.

12. On August 20, 2008 the petition for waiver of the rules was dismissed.

13. On December 10, 2008, the petition under 37 CFR .181 was granted.

14. On December 19, 2008, Patent Owner submitted additional evidence after reopening of prosecution. In addition, Patent owner filed a petition under 37 CFR 1.182 for continued re-examination, a situation not otherwise provided for by the rules.

15. On December 31, 2008, the petition under 37 CFR 1.182 was dismissed.

16. On December 12, 2009, a second non-final action was mailed, confirming claim 11 and rejecting claims 1, 2, 4-8, 12, 14, 16-19, 23 and 39-90.

17. On January 15, 2010, patent owner petitioned for a one month extension of time, which petition was granted on February 16, 2010.

18. On January 21, 2010, Patent Owner petitioned for a waiver of the page limit rules to respond to the December 12, 2009 rejection, which petition was granted on March 9, 2010.

19. On March 10, 2010, Patent Owner submitted a replacement response to the non-final rejection of December 12, 2009 which reinstated Claim 21, amended claim 39, 53 and added claims 92-148.

20. On April 8, 2010, Third Party Requester filed remarks on patent owners March 10, 2010 amendment which included proposed rejections of the previously presented and newly added claims. (Response, summarized at 44).

21. On July 7, 2010, an Action Closing Prosecution was mailed which again confirmed the patentability of Claim 11 and rejected claims 1-2, 4-8, 12, 14, 16-19, 21, 23 and 39-91 and did not consider newly presented claims 92-148.

22. On July 19, 2010, Patent Owner petitioned for a 1-month extension of time. A two week

extension of time was granted on July 21, 2010.

23. On July 20, 2010, Patent Owner filed three separate petitions, one each under 37 CFR 1.181, 181 and 183.

RELEVANT AUTHORITY

35 U.S.C. 313 Inter partes reexamination order by Director

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(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.

37 CFR § 1.530 Statement by patent owner in ex parte reexamination; amendment by patent owner in ex parte or inter partes reexamination; inventorship change in ex parte or inter partes reexamination.

(e) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

2666.01 Amendment by Patent Owner (in part)

If an amendment is submitted to add claims to the patent being reexamined (i.e., to provide new claims), then excess claims fees pursuant to 37 CFR 1.20(c)(3) and (c)(4) may be applicable to the presentation of the added claims. See MPEP § 2666.04. Amendments proposed in a reexamination will normally be entered if timely, and will be considered to be entered for purposes of prosecution before the Office (if they are timely and comply with the rules); however, amendments do not become effective in the patent until the certificate under 35 U.S.C. 316 is issued and published.

DECISION

In the office action of July 7, 2010, the primary examiner did not enter newly presented claims 92-148. See paragraph numbered 4 of the Action Closing Prosecution. As indicated in MPEP 2666.01, claims

added by Patent Owner after non-final rejection will normally be entered if they comply with the relevant rules and time periods. Paragraph 4 does not set out a rule-based or statutory argument for non-entry of the claims.[1]

Accordingly, the Action Closing Prosecution of July 7, 2010 is vacated and no response by patent owner is necessary or appropriate. An appropriate action or communication will follow.

This decision does not address (a) the sufficiency of the support for the new claims identified in the response of March 10, 2010; (b) the extent to which the newly presented claims would tend to resolve the identified substantial new questions of patentability in this proceeding; (c) compliance with other rules regarding presentation of claim amendments such as 37 CFR 1.530; or (d) merits of the third party rejections identified in the third party requester response of April 8, 2010.

CONCLUSION

1. Patent owner's petition is granted insofar as the Action Closing Prosecution of July 7, 2010 is vacated.

2. An appropriate action or communication from the examiner will follow.

3. Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-3838, or, in his absence, to Deborah Jones, SPE of art unit 3991, at (571) 272-1535.

Gregory Morse
Director,
Central Reexamination Unit

[1] Paragraph 4 does allude to the requirement of 37 CFR 1.530(e) that newly presented claims be accompanied by support in the specification. However, the reference in paragraph 4 refers to adding limitations to existing claims.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,153	07/17/2006	6753013	3893-0251L	2949

2292 7590 08/16/2010
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2010

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Martin B. Pavane

Cohen Pontani Lieberman and Pavane

551 Fifth Ave Ste 1210

New York, NY 10176

MAILED

AUG 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/000,153*.

PATENT NUMBER *6,753,013*.

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.

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

REEXAMINATION CONTROL NUMBER *95/000,153*.

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PO BOX 747
FALLS CHURCH, VA 22040-0747

(For Patent Owner)

MAILED

AUG 16 2010

CENTRAL REEXAMINATION UNIT

MARTIN B PAVANE
COHEN, PONTANI, LIEBERMAN AND PAVANE
551 FIFTH AVE STE 1210
NEW YORK, NY 10176

(For Requester)

In re Didriksen et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,153
Filed: July 17, 2006
For: U.S. Patent No. 6,753,013 B1

DECISION
DISMISSING PETITIONS
UNDER 1.182 AND 1.183

This is a decision on the July 20, 2010 patent owner petitions entitled "PETITION UNDER 37 C.F.R. § 1.182 TO SEEK RELIEF THAT IS NOT CURRENTLY PROVIDED BY AN EXISTING RULE BY REOPENING PROSECUTION OR REQUEST FOR CONTINUED REEXAMINATION PROCEEDING (AND REQUEST FOR DECISION BEFORE NEXT DUE DATE OF AUGUST 7, 2010," and "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES TO WAIVE DUE DATE FOR FILING PATENT OWNER RESPONSE TO ACTION CLOSING PROSECUTION UNDER 37 C.F.R. § 1.951(a) AND REQUEST FOR DECISION BEFORE NEXT DUE DATE OF AUGUST 7, 2010."

The patent owner petitions arebefore the Office of Patent Legal Administration.

The petition fees of $400.00 under 37 C.F.R. § 1.17(f) has been charged for each petition.

The petitions are **dismissed as moot**.

BACKGROUND

1. On July 7, 2010, an action closing prosecution (ACP) was mailed in the 95/000,313 *inter partes* reexamination.

2. On July 19, 2010, patent owner submitted a request for extension of time under 37 C.F.R. § 1.956.

3. On July 20, 2010, patent owner submitted the instant petitions entitled "PETITION UNDER 37 C.F.R. § 1.182 TO SEEK RELIEF THAT IS NOT CURRENTLY PROVIDED BY AN EXISTING RULE BY REOPENING PROSECUTION OR

REQUEST FOR CONTINUED REEXAMINATION PROCEEDING (AND REQUEST FOR DECISION BEFORE NEXT DUE DATE OF AUGUST 7, 2010)," and "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES TO WAIVE DUE DATE FOR FILING PATENT OWNER RESPONSE TO ACTION CLOSING PROSECUTION UNDER 37 C.F.R. § 1.951(a) (AND REQUEST FOR DECISION BEFORE NEXT DUE DATE OF AUGUST 7, 2010)."

4. Also on July 20, 2010, patent owner submitted the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR PREMATURE ACP, TO REOPEN PROSECUTION AND TO HAVE NEW OFFICE ACTION (AND REQUEST FOR DECISION BEFORE NEXT DUE DATE OF AUGUST 7, 2010)."

5. On July 21, 2010, patent owner's July 19, 2010 request for extension of time under 37 C.F.R. § 1.956 was granted, extending the time for response through August 21, 2010.

6. On August 8, 2010, patent owner's July 20, 2010 petition under 37 C.F.R. § 1.181 was granted, vacating the July 7, 2010 ACP.

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. § 1.182 provides:

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

DECISION

On August 8, 2010, the Office issued a decision granting patent owner's petition under § 1.181 petition, therefore reopening prosecution in the '153 proceeding. The July 7, 2010 ACP was vacated by the Central Reexamination Unit in the August 8, 2010 decision, which stated that "an appropriate action or communication will follow" and "no response by patent owner is necessary or appropriate."

Since prosecution has been reopened, the claims in the proceeding are no longer under an ACP. Therefore, reopening of prosecution is no longer needed, and patent owner's petition for reopening of prosecution under 37 C.F.R. § 1.182 has become moot. The instant petition under 37 C.F.R. § 1.182 is thus dismissed as moot. Under the same rationale and facts, an extension of time is no longer needed, and patent owner's petition for an extension of time under 37 C.F.R. § 1.183 has become moot. The instant petition under 37 C.F.R. § 1.183 is thus dismissed as moot.

With respect to the petition under 37 C.F.R. § 1.183, it is further noted that the filing of such a petition after ACP but before RAN is inappropriate because such an extension is provided for under the alternative avenue of 37 C.F.R. § 1.956. The extraordinary relief of waiving a rule under 37 C.F.R. § 1.183 is not granted if the rules provide an alternative avenue for obtaining the relief sought. *See Cantello v. Rasmussen,* 220 USPQ 664 (Comr. 1982).

CONCLUSION

- The petitions are **dismissed as moot**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/
Michael Cygan
Legal Advisor
Office of Patent Legal Administration

August 16, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,153	07/17/2006	6753013	3893-0251L	2949

2292 7590 03/14/2011

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EXAMINER

ART UNIT	PAPER NUMBER

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COHEN PONTANI LIEBERMAN AND PAVANE
551 FIFTH AVE. STE 1210
NEW YORK, NY 10176

Date:

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MAR 14 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000153
PATENT NO. : 6753013
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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Andrew D. Meikle
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For Patent Owner

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MAR 14 2011

CENTRAL REEXAMINATION UNIT

Martin B. Pavane
Cohen Pontani Lieberman and Pavane
551 Fifth Ave., Ste 1210
New York, NY 10176

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,153
Filed: July 17, 2006
For: US Patent No. 6,753,013

DECISION FOR
PETITION UNDER
37 CFR 1.181

This is a decision on the petition under 37 CFR 1.181, filed January 18, 2011 to invoke supervisory authority of the Director to enter into the record Exhibit (S) Guenther et al document and Exhibit (T) Kaufmann et al document submitted on September 27, 2010 in response to the Action Closing Prosecution.

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

The petition is denied for the reasons set forth below.

Review of Facts

1. U.S. Patent 6,753,013 ('013 patent) issued to E. Didriksen et al on June 22, 2004.

2. On July 17, 2006, a request for *inter partes* reexamination of the '013 patent was filed by a third party requester and assigned control number 95/000,153 ('153 proceeding).

3. On September 13, 2006, on Order Granting *inter partes* reexamination was mailed. The order was accompanied by a non-final rejection.

4. Subsequent to responses by Patent Owner and third party requester, an Action Closing Prosecution (ACP) was mailed on September 5, 2007.

5. On September 19, 2007, Patent Owner petitioned for a two-month extension of time to respond to the ACP.

6. On September 28, 2007 the petition for two-months extension of time was granted.

7. On December 5, 2007 Patent Owner filed a response to the ACP and also petitioned for withdrawal of the ACP.

8. On January 9,2008 third party requester filed written comments directed to the ACP.

9. On June 20, 2008 the petition for withdrawal of the ACP was dismissed.

10. On July 17,2008, a Right of Appeal Notice (RAN) was mailed.

11. On August 11, 2008 Patent Owner petitioned for: (a) waiver under 37 CFR 1.183 of the provision of 37 CFR 41,61(a) and (e) that set a non-extendable period of time for filing a notice of appeal as being the time set in the RAN; and (b) supervisory intervention by the Director under 37 CFR 1.181 to reopen prosecution of the '153 reexamination proceeding.

12. On August 20, 2008 the petition for waiver of the rules was dismissed.

13. On December 10, 2008 the petition under 37 CFR 1.181 was granted.

14. On December 19, 2008 Patent Owner submitted additional evidence after reopening of prosecution. In addition, Patent Owner filed a petition under 37 CFR 1.182 for continued reexamination, a situation not otherwise provided for by the rules.

15. On December 31, 2008, the petition under 37 CFR 1.182 was dismissed.

16. On December 10, 2009, a second non-final action was mailed confirming claim 11 and rejecting claims 1,2,4-8, 12,14,16-19, 23 and 39-90.

17. On January 15, 2010 Patent Owner petitioned for a one-month extension of time, which petition was granted on February 16, 2010.

18. On January 21, 2010 Patent Owner petitioned for a waiver of the page limit rules to respond to the December 12, 2009 rejection which petition was granted on March 9, 2010.

19. On March 10, 2010 Patent Owner submitted a replacement response to the non-final rejection of December 12, 2009 which reinstated claim 21, amended claim 39, 53, and added claims 92-148.

20. On April 8, 2010 third party requester filed remarks on Patent Owners March 10, 2010 amendment which included proposed rejections of the previously presented and newly added claims.

21. On July 7, 2010 an ACP was mailed which again confirmed the patentability of claim 11 and rejected claims 1-2, 4-8, 12, 14, 16-19, 21, 23 and 39-91 and did not consider newly presented claim 92-148.

22. On July 19, 2010, Patent Owner petitioned for a one-month extension of time. A two week extension was granted on July 21, 2010.

23. On July 20, 2010 Patent Owner filed three separate petitions, one each under 37 CFR 1.181, 1.182 and 1.183.

24. On August 5, 2010, the petition under 37 CFR 1.181 to vacate the ACP of July 7, 2010 was granted.

25, On August 16, 2010, the petitions under 37 CFR 1.182 and 1.183 were dismissed as moot.

26. On August 27, 2010, an ACP was mailed confirming claim 11 and rejecting claims 1, 2 ,4-8, 12, 14, 16-19, 21, 23 and 39-148.

27. On September 27, 2010, Patent Owner filed written comments directed to the ACP of August 27, 2010. The comments included additional exhibits and amendments to the claims.

28. On October 25, 2010, third party requester filed comments directed to Patent Owner's response.

29. On December 15, 2010, a Right of Appeal (RAN) was mailed confirming claim 11 and indicating claim 12 patentable and rejecting claims 1, 2, 4-8, 14, 16-19, 21, 23, and 39-148. The RAN further indicated that the amendment and exhibits filed after ACP would not be entered.

30. On January 14, 2011, third party requester filed a Notice of Appeal.

31. On January 18, 2011, Patent Owner filed the present petition under 37 CFR 1.181 to enter the exhibits submitted with the response filed on September 27, 2010.

32. On January 18, 2011, Patent Owner filed a Notice of Appeal.

33. On February 18, 2011, third party requester filed comments on the present petition.

Decision

37 CFR 1.116(e) states:

(e) 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.

Patent Owner has admitted on the record that it was aware of the exhibits but did not fully appreciate the relevance until after filing the response to the non-final Office action on March 10, 2010. The "relevance" notwithstanding, there was ample opportunity to file these documents at some time during the 5+ years this proceeding has been pending before the Office. The documents were published in 2002 and feature products of Leo Pharmaceuticals (Patent Owner). There have been two non-final actions, three ACPs and two RANs issued in this proceeding all of which are based on the same references and present essentially the same position regarding the claims. As pointed out by Patent Owner, these exhibits do not raise issues that differ significantly from those already addressed in the ACP of August 27, 2010 or the RAN of December 15, 2010. Consequently, there is no apparent reason why they are necessary.

The examiner provided a cursory review of these documents when they were first presented on September 27, 2010 in the response to the ACP which issued on August 27, 2010. She provided an advisory opinion that they were insufficient to overcome any of the rejections, did not appear to be commensurate in scope with the broad claims, and did not ameliorate any of the issues or place the claims in

better form for appeal. This advisory opinion was not the sole basis for not entering the documents, but to show support that entry of the documents would not overcome the rejections or remove issues from appeal, in accordance with 37 CFR 1.116. The record shows, and even the Patent Owner admits on page 3 of the petition, that the response of September 27,.2010 did not provide a reason as to why the documents were not submitted earlier (see the first paragraph on page 3 of the petition). Therefore, the record is clear that the examiner appropriately followed Office regulations and policies in her determination that the documents should not be entered in the interest of the statutory mandate of special dispatch. The issues in this proceeding are fully developed and ready for appeal, as indicated in the ACP issued on August 27, 2010. As explained above, Patent Owner has not presented good and sufficient reasons why these documents, published in 2002 and featuring products of Leo Pharmaceuticals (Patent Owner), were not presented earlier.

The third party requester's comments, dated February 18, 2011, have been considered, but will not be further addressed in this decision. The comments advance similar reasons, as stated in this decision, as to why Patent Owner's petition should be dismissed.

In summary, the examiner appropriately applied Office policies and procedures in determining that exhibits (S) and (T) should not be entered because these exhibits fail to overcome the rejections, remove issues, or place the proceeding in better form for appeal and Patent Owner has failed to provide good and sufficient reasons why these documents were not provided earlier. 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 not enter the exhibits.

Conclusion

1. The Patent Owner's petition to enter into the record Exhibit (S) Guenther et al document and Exhibit (T) Kaufmann et al document submitted on September 27, 2010 in response to the Action Closing Prosecution is denied.

2. The Patent Owner's Appeal Brief is due March 18, 2011.

3. Response may be submitted as follows:

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

By Mail to: Mail Stop *Ex Parte* Reexam
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Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
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By Fax to: (571) 273-9900
Central Reexamination Unit

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

Irem Yucel
Director Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,153	07/17/2006	6753013	3893-0251L	2949

2292 7590 03/06/2012
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
HUANG, EVELYN MEI

ART UNIT	PAPER NUMBER
3991	

MAIL DATE	DELIVERY MODE
03/06/2012	PAPER

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes LEO Pharmaceutical Products, Ltd.
v.
Galderma R&D

Reexamination Control No. 95/000,153
Appeal 2012-003165
Patent 6,753,013
Technology Center 3900

DECISION ON PETITION

This is a decision on the third party requester's Petition under 37 C.F.R. 1.183, filed March 1, 2012 (present petition).

FINDINGS

1. On July 7, 2006, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,753,013.

2. Reexamination was ordered on September 13, 2006, and a non-final Office action was mailed on September 13, 2006.

3. Prosecution was conducted and on December 15, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Patent owner filed a notice of appeal on January 18, 2011, of the rejections of claims 1, 2, 4-8, 14, 16-19, 21, 23, and 39-148.

5. Patent owner filed an appellant brief on May 12, 2011.

6. Third party requester filed a respondent brief on June 13, 2011.

7. On June 24, 2011, an examiner's answer was mailed.

8. Patent owner filed a request for oral hearing and a rebuttal brief on July 25, 2011. Third party requester neither timely filed a request for oral hearing nor paid the fee for a request for oral hearing.

9. An appeal docketing notice was mailed on December 29, 2011 assigning appeal number 2012-003165.

10. A notification of oral hearing was mailed on January 31, 2012, and an oral hearing was scheduled for March 7, 2012.

11. On March 1, 2012, third party requester submitted the instant petition requesting that counsel for the third party requester be permitted to present arguments at the scheduled oral hearing.

12. On March 5, 2012, patent owner submitted comments responsive to third party requester's petition requesting that the oral hearing scheduled for March 7, 2012 be permitted to proceed without third party requester participation.

13. Patent Owner's comments did not indicate that they would be prejudiced by the grant of the petition.

DISCUSSION

In the Present Petition, the third party requester requests that the timeframe for submitting a request for oral hearing and fee be waived and that third party requester be permitted to present oral arguments and the hearing scheduled for March 7, 2012.

ANALYSIS

Counsel, with unusual and commendable candor, acknowledges the oversight and explains the error made in failing to request oral argument in this instance. For the reasons stated in the petition of March 1, 2012, plus the fact that there is no prejudice to either party in granting this petition, the third party requester's request to present arguments at the oral hearing on March 7, 2012, is granted. Counsel is cautioned that this relief is not likely to be granted in the future.

The present petition is **granted,** and the oral hearing scheduled for March 7, 2012, will proceed.

DECISION and ORDER

In view of the foregoing, the present petition is GRANTED.

The third party requestor/petitioner's deposit account shall be charged for the oral argument fee and the petition fee.

/s/ James T. Moore, Vice Chief Administrative Patent Judge, for
James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Andrew D. Meikle
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747

Counsel for Third Party Requester:
Marin B. Pavane
COZEN O'CONNOR
277 Patent Avenue
New York, NY 10172

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,160	07/28/2006	6221392	15514/40037	2500

21832 7590 12/22/2010
MCCARTER & ENGLISH, LLP HARTFORD
CITYPLACE I
185 ASYLUM STREET
HARTFORD, CT 06103

EXAMINER
HUANG, EVELYN MEI

ART UNIT	PAPER NUMBER
3991	

MAIL DATE	DELIVERY MODE
12/22/2010	PAPER

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CIMA LABS, INC.
Patent Owner

KV PHARMACEUTICAL CO.
Third Party Requester

Inter partes Reexamination Control 95/000,160
Patent 6,221,392

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37CFR § 1.183 to File Corrected Rebuttal Brief," filed November 1, 2010 ("Petition"). The Petition requests "permission to file an amended rebuttal brief to clarify and correct two statements made in the [originally filed] rebuttal brief."

FINDINGS

1. On April 10, 2010, the Examiner entered an Examiner's Answer.
2. On May 1, 2010, Patent Owner filed a Rebuttal Brief.
3. On May 13, 2010, the Examiner entered a Communication finding the Rebuttal Brief defective and giving Patent Owner one month to file a corrected Brief.
4. Patent Owner filed an Amended Rebuttal Brief on June 11, 2010.

5. By the present Petition, Patent Owner seeks to clarify its statements in the Amended Rebuttal Brief describing the teachings of two references.

RELEVANT AUTHORITY

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).

ANALYSIS

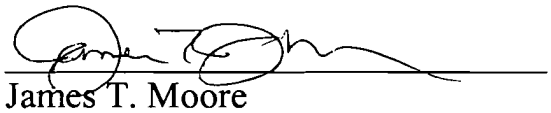
Patent Owner has not established that this is an extraordinary situation for which justice requires that four and a half months after its Amended Rebuttal Brief was due, it should be permitted to amend that Brief. Thus, Patent Owner has not met the requirements under Rule 1.183 for suspension or waiver of the timeliness requirement for filing its Amended Rebuttal Brief.

Inter partes Reexamination Control 95/000,160
Patent 6,221,392

DECISION

In view of the foregoing, the Petition is DENIED.

The petition fee has been charged to the deposit account of Patent Owner's attorney.



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Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,160	07/28/2006	6221392	15514/40037	2500

21832 7590 05/02/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/02/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

CIMA LABS, INC.
Patent Owner

KV PHARMACEUTICAL CO.
Third Party Requester

Inter partes Reexamination Control 95/000,160
Patent 6,221,392

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 35 C.F.R. § 1.550(c)(M.P.E.P. 2265)," filed April 20, 2011 ("Petition"). The Petition "requests a one-month extension of time pursuant to 37 C.F.R. § 1.550(c) to extend the period for filing a reply to the Board of Patent Appeals and Interferences' new rejections, which were raised in the March 24, 2011 BPAI decision in the above-captioned *Inter partes* reexamination." Petition, p. 1.

FINDINGS

1. On March 24, 2011, the Board of Patent Appeals and Interferences ("Board") entered a Decision on Appeal in this reexamination proceeding, including a new ground of rejection. Decision, p. 37.

2. The Decision on Appeal, citing 37 C.F.R. § 41.50(b), stated that Appellant had two months from the date of the Decision to file a response to the new ground of rejection.[1]

3. In the Petition, Appellant contends that:

> [T]he preparation of [new] evidence and a complete response to the Board's new rejections will necessarily require more than the 60 day period set by 37 C.F.R. § 41.50(b).

Petition, p. 3.

RELEVANT AUTHORITY

In respect to the showing required for an extension of time to respond to a new ground of rejection under 37 C.F.R. § 41.50, 37 C.F.R. § 1.550(c) provides:

> The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g).

[1] The correct citation for a new ground of rejection in an *inter partes* reexamination appeal is 37 C.F.R. § 41.77(b). However, having cited an incorrect rule in the Decision on Appeal, the Board will adhere to the cited rule in reaching a decision on the Petition.

ANALYSIS

Patent Owner has established that sufficient cause exists for extending by one month the time for Appellant to reopen prosecution in response to the new ground of rejection.

DECISION

In view of the foregoing, the Petition is GRANTED. A response to the new ground of rejection is due by June 24, 2011.

The petition fee has been charged to the deposit account of Patent Owner's attorney.

James T. Moore
Acting Chief Administrative Patent Judge

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APR 07 2011

CENTRAL REEXAMINATION UNIT

EDWARDS ANGELL PALMER & DODGE LLP
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BOSTON, MA 02205

(For Requester)

In re Pacey	:
Reexamination Proceeding	: **DECISION**
Control No.: 95/000,161	: **GRANTING**
Filing Date: July 28, 2006	: **PETITION**
For: U.S. Patent No.: 6,543,447	:

On July 16, 2010, the third party requester filed a petition, which is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority, to vacate the notice entitled "*Inter Partes* Reexamination Notification re Brief," dated June 16, 2010, that held third party requester's appellant brief, dated April 23, 2010, defective, or alternatively to reopen prosecution. Also, on July 28, 2010, patent owner filed a petition to confirm that the requester's appeal stands dismissed.

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, for decision on the petitions.

The third party requester's petition is granted to the extent that the June 16, 2010 notice is vacated and the requester's April 23, 2010 appellant brief is entered in the record.

The patent owner's petition is dismissed because this decision has entered by April 23, 2010 appellant brief and has vacated the June 16, 2010 notice. Therefore, the requester has satisfied the requirements for timely filing an appeal brief. See 37 CFR 41.67(d).

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,543,447 (hereinafter, the '447 patent) issued on April 8, 2003.

2. A request for inter partes reexamination of the '447 patent was filed by a third party requester on July 28, 2006, which request was assigned control no. 95/000,161 ("the '161 proceeding").

3. Reexamination was ordered in the '161 proceeding on October 25, 2006.

4. The '161 proceeding progressed to appeal to the point where, on March 23, 2010, the Office mailed an "*Inter Partes* Reexamination Notification re Brief," which stated that both the patent owner's and the third party requester's appeal briefs were not compliant with Office regulations.

5. On April 23, 2010, third party requester filed a replacement appeal brief in the '161 proceeding in response to the March 23, 2010 notice. The third party requester also filed a petition requesting clarification of the March 23, 2010 notice.

6. On April 29, 2010, patent owner filed a petition, which was being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's replacement appeal brief, dated April 23, 2010.

7. On May 6, 2010, third party requester filed a respondent brief

8. On May 22, 2010, patent owner filed a respondent brief.

9. On June 16, 2010, the Office mailed decisions addressing the April 23, 2010 petition and the April 29, 2010 petition. On the same day, the Office also mailed an "*Inter Partes* Reexamination Notification re Brief," which stated that the third party requester's replacement appeal brief of April 23, 2010 was not compliant with Office regulations.

10. On July 6, 2010, patent owner filed a petition, which was being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the third party requester's respondent brief, dated May 6, 2010. This petition was dismissed as premature.

11. On July 16, 2010, the third party requester filed the instant petition, which requested vacating the "*Inter Partes* Reexamination Notification re Brief," dated June 16, 2010, that held third party requester's appellant brief, dated April 23, 2010, defective, or alternatively, reopening prosecution.

12. On July 28, 2010, patent owner filed a petition to confirm that the requester's appeal stands dismissed.

DECISION

As pointed out, the requester filed the present petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority, to vacate the notice entitled "*Inter Partes* Reexamination Notification re Brief," dated June 16, 2010, that held third party requester's appellant brief, dated April 23, 2010, defective, or alternatively to reopen prosecution. On July 28, 2010, patent owner filed a petition to confirm that the requester's appeal stands dismissed. This decision addresses both petitions.

The Director's review of the requests on petition is limited to whether the examiner did or did not properly follow reexamination laws, regulations and policies in her decision to hold defective the third party requester's April 23, 2010 appellant brief. Therefore, the review will determine whether the examiner's decision to consider the replacement appellant brief, dated April 23, 2010, as noncompliant was in accordance with the reexamination laws and policies.

Generally, in response to requester's arguments for requesting vacatur of the June 16, 2010 noncompliance notice, the director finds there are good and sufficient reasons to do so. 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an Office action. See MPEP 2666 *et seq.* In this proceeding, the record clearly shows that prosecution has been significantly delayed. See the statement of relevant facts above. One reason is the filing of replacement papers to address issues of noncompliance with reexamination law and procedures. Another reason for the delay is repetitive filing of petitions to enter or to not enter papers by both parties. Specifically, multiple petitions were filed on issues of compliance with appellant and respondent briefs, which required time and Office resources to address. More importantly, the record shows that these petitions have disrupted prosecution and caused delays. Moreover, review of appeal briefs (appellant, respondent, and rebuttal briefs) is now performed by the Board of Patent Appeals and Interferences (BPAI). See the Notice entitled "Streamlined Procedure for Appeal Brief Review in Inter Partes Reexamination Proceeding," 1357 Official Gazette 252 (23 November 2010), 75 Fed. Reg. 50750 (17 August 2010). This Notice states that review of all briefs, filed on or after August 17, 2010, will be the sole responsibility of the Chief Judge of the BPAI in order to reduce the number of noncompliant notices and streamline procedures to provide more consistent treatment during review of appeal briefs. Therefore, any rebuttal briefs filed by the parties in this proceeding will be reviewed by the BPAI for compliance with the appeal laws and procedures. Accordingly, in the interest of the statutory mandate of "special dispatch," maintaining the June 16, 2010 notice is not justified unless a clear violation of the reexamination laws and rules by the April 23, 2010 appellant brief has been demonstrated.

In the requester's petition, the petitioner states that it is not in accordance with reexamination laws and procedures to hold an appellant brief noncompliant because it contains proposed rejection that the examiner has not adopted. See, e.g., page 4 of the petition. The resolution of this issue turns on whether the proposed rejections identified in the June 16, 2010 notice are of record. In other words, the key issue is whether the proposed rejections, which were raised in the

requester's comments of October 15, 2008 and/or May 22, 2009, are of the record in this reexamination proceeding. Looking at the record, page 2 of the Action Closing Prosecution (ACP) clearly states that the requester's comments of October 15, 2008 have been entered and made of record, and page 2 of the Right of Appeal Notice (RAN) clearly states that the requester's comments of May 22, 2009 have been entered and made of record. While both the ACP and RAN state that the proposed rejections are mere allegations of unpatentability (see, e.g., page 33 of the ACP and page 34 of the RAN), these statements do not clearly state that the proposed rejections are not compliant with reexaminations laws and procedures, and therefore, are not considered by the examiner. In addition, the examiner did not mail a notice of noncompliance for the October 15, 2008 comments and give the requester time to correct the comments in accordance with the policies and procedures set forth in MPEP 2666.05. Therefore, the record is such that it supports requester's position that the examiner considered the proposed rejections, and decided to not adopt the proposed rejections. Accordingly, the record is not sufficiently clear to hold that the requester's April 23, 2010 appellant brief is not compliant for the reasons set forth in the June 16, 2010 notice. Based on the facts in this particular proceeding, the Director deems there are sufficient reasons to vacate the June 16, 2010 notice, and to enter the requester's April 23, 2010 appellant brief in the record.

To the extent that requester petitioner's arguments pertain to the merits of the examiner's determinations (e.g., whether the Examiner appropriately did not adopt the proposed rejections), these issues are not appropriate to address via a petition because they are appealable issues. See MPEP 1201 and 1002. In other words, these issues are subject to appeal to the BPAI and will not be addressed in this petition decision.

As stated above, reexamination proceedings must be conducted with special dispatch and review of appeal briefs is now the sole responsibility of the BPAI. Therefore, based on the facts for this proceeding, it is deemed prudent to enter the April 23, 2010 appellant brief so as to advance prosecution in accordance with special dispatch. The BPAI has authority to determine which issues are appropriately raised in the briefs and will review the rebuttal briefs filed by the parties in this appeal. The rebuttal briefs are likely to address issues regarding the proposed rejections raised by the third party requester. The record is clear that the examiner recognized the proposed rejections, did not adopt any of the proposed rejections based upon prior art, and has deemed the claims allowable over the prior art. As discussed above, the record is not clear that the requester's proposed rejections were not entered in the record. Accordingly, for these reasons, the requester's petition is persuasive that the June 16, 2010 notice should be vacated and that the requester's replacement appellant brief, dated April 23, 2010, should be entered into the record. Therefore, the third party requester's petition is granted to the extent that the June 16, 2010 notice is vacated and the April 23, 2010 is entered into the record.

In regard to patent owner's July 28, 2010 petition, this petition is dismissed because the June 16, 2010 notice is hereby vacated. Therefore, the requester's appeal is not dismissed because it cannot be held that the requester failed to comply with the June 16, 2010 notice. In other words, the April 23, 2010 replacement appellant brief is deemed to have been timely filed in accordance with 37 CFR 41.67(d).

CONCLUSION

1. The July 16, 2010 third party requester's petition, which is treated as a petition under 37 CFR § 1.181, is granted to the extent that the June 16, 2010 notice is hereby vacated and the April 23, 2010 is entered into the record.

2. The July 28, 2010 patent owner petition is dismissed.

3. The proceeding will be forwarded to the examiner for action in due course.

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

Irem Yücel, Director
Technology Center 1600

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,161	07/28/2006	6543447	VER2-6-1014	7361

25315 7590 09/15/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Aircraft Medical Ltd.
v.
Verathon, Inc.

Reexamination Control No. 95/000,161
Patent 6,543,447
Technology Center 3900

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition under 37 C.F.R. § 1.182 to Strike Patent Owner's Reply Brief to Examiner's Answer," filed July 6, 2011 (petition). Petitioner requests that the Office strike patent owner's rebuttal brief for non- compliance with 37 C.F.R. § 41.71. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on July 11, 2011.

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

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FINDINGS

1. On July 28, 2006, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,543,447, which was assigned Control No. 95/000,161.
2. On October 25, 2006, reexamination was ordered and on May 4, 2007, a non-final action was mailed.
3. Prosecution was conducted and on June 5, 2009, a Right of Appeal Notice was mailed.
4. Requester filed a Notice of Appeal on July 6, 2009.
5. Patent owner filed a Notice of Cross-Appeal on July 15, 2009.
6. Patent owner filed a corrected appellant brief on April 6, 2010.
7. ~~Requester filed a corrected appellant brief on April 23, 2010.~~
8. Requester filed a respondent brief on May 6, 2010.
9. Patent owner filed a respondent brief on May 22, 2010.
10. On June 6, 2011, an examiner's answer was mailed.
11. Patent owner filed a rebuttal brief on July 1, 2011.
12. Requester filed a rebuttal brief and the instant petition on July 6, 2011.
13. Requester filed a request for oral hearing on August 5, 2011.

DISCUSSION

In the petition of July 6, 2011, requester requests that the Office strike patent owner's rebuttal brief for non- compliance with 37 C.F.R. § 41.71. Requester argues that the examiner never issued an answer directed to the patent owner's cross-appeal brief and thus the patent owner is not allowed to

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simply "reply" at its own initiative and further comment on pending claims that the examiner failed to address.

RELEVANT AUTHORITY

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).

37 C.F.R. § 41.71 provides:

(a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

(b)

(1) The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief.

(2) The rebuttal brief of the owner shall not include any new or non-admitted amendment, or an affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c)

(1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

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(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

ANALYSIS

Requester's petition under 37 C.F.R. § 1.182 has been considered fully. Petitioner requests that the Office strike patent owner's rebuttal brief. It should be noted that a petition to strike another party's submission is only appropriate if a submission is improper. Petitioner asserts that the examiner's answer of June 6, 2011, is directed to requester's appeal, and is not directed to patent owner's cross-appeal. Petitioner contends that the examiner never addressed the issues raised in patent owner's cross-appeal

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i.*e.*, the improper rejection of claims 322, 375, 428 and 429. Petitioner concludes that only the requester had the right to file a rebuttal brief, since only the requester's appeal is addressed in the examiner's answer of June 6, 2011.

However, as pointed out by petitioner, pursuant to37 C.F.R. § 41.71(b)(1) "The rebuttal brief of the owner may be directed to the examiner's answer and/or any respondent brief." It is noted that requester filed a respondent brief on May 6, 2010, and the respondent brief responds to the issues presented in the patent owner's corrected appellant brief of April 6, 2010, as evidenced by requester's arguments concerning the unpatentability of claims 322, 375, 428 and 429. Therefore, the rebuttal brief of the owner is directed to the examiner's answer and/or the respondent brief of the requester, and is therefore in compliance with 37 C.F.R. § 41.71(b)(1).

The present petition is **denied**.

DECISION

In view of the foregoing, the present petition is DENIED.

Jurisdiction of this *inter partes* reexamination is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James Donald Smith
Chief Administrative Patent Judge

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MAY 03 2011
CENTRAL REEXAMINATION UNIT

In re Juhasz et al :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,162 : **GRANTING**
Filed: October 17, 2006 : **PETITION**
For: U.S. Patent No. 7,096,977 :

This is a decision on patent owner's petition entitled "Petition to Exceed Page Limits for Appellant's Appeal Brief under 37 CFR § 41.3", filed on July 23, 2010 (the July 23, 2010 patent owner's petition).

The July 23, 2010 requester petition, and the record as a whole, are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been received.

DECISION

Patent owner's July 23, 2010 petition under 37 CFR 1.183, requesting waiver of the 30-page limit of 37 CFR 1.943(c) for its appellant brief, which was later filed on August 6, 2010, has been fully considered.[1]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 30-page limit of 37 CFR 1.943(c) can be an attempt to draft a brief in compliance with the 30-page limit, and submission

[1] **NOTE** that a petition under 37 CFR 1.183 to waive the page length requirements of a paper "to be filed in the future", are **generally dismissed**, because, without the submission of the paper at issue, the Office cannot evaluate the paper for economizing, extraneous material, and arrangement. In the present case, the Office could make this evaluation because the brief was filed before the Office treated the present petition.

of a resulting brief that is in excess of 30 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c), requesting entry of the submitted brief. Such a brief can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed brief: (1) for justification that more pages are needed to complete the brief, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the brief.

In the instant petition under 37 CFR 1.183, the patent owner requests that the Office waive the page length requirements of 37 CFR 1.943(c). Specifically, the patent owner argues that the patent owner must address 31 adopted grounds of rejection, and respond to a Right of Appeal Notice (RAN) which included 118 pages of substantive content.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

In support of its request for waiver of 37 CFR 1.943(c), the patent owner has submitted, on August 6, 2010, a brief that is in excess of 50 pages.[2] Upon brief review, the August 6, 2010 brief includes 52 pages that are subject to the page limit.

Based on the individual facts and circumstances of this case including, for example, the 118-page RAN and the 31 grounds of rejection adopted by the examiner, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. Thus, even though patent owner's August 6, 2010 brief exceeds the 30-page limit, it is still deemed equitable in this instance to waive the 30-page limit of 37 CFR 1.943(c) to the extent that patent owner's brief <u>not exceed 52 pages</u>. Accordingly, patent owner's petition under 37 CFR 1.183 is <u>granted</u> and the page limit of 37

[2] The Office notes that had the patent owner failed to submit a brief, for which the present petition requests waiver of the page length requirements, the above analysis of the brief would not have been possible, resulting in the likelihood of a dismissal of the present petition. For this reason, a petition under 37 CFR 1.183 should be filed concurrently with the submission to which it pertains.

CFR 1.943(c) is waived to the extent of permitting patent owner's August 6, 2010 brief to exceed the page limit by up to 22 pages. This waiver makes patent owner's August 6, 2010 brief page-length compliant.

The February 5, 2007 Change of Correspondence Address for the Patent Owner is Ineffective

The change of correspondence address, filed by the patent owner on February 5, 2007, is **ineffective**. The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 11/040,453, is shown in the caption of this decision

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. John DeBoer. Absent the filing of a proper change of correspondence address in the patent file, application no. 11/040,453, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The July 23, 2010 patent owner petition is **granted** and the page limit of 37 CFR 1.943(c) is **waived to the extent** of permitting patent owner's August 6, 2010 appellant's brief to exceed the page limit by up to 22 pages. This waiver makes patent owner's August 6, 2010 appellant's brief page-length compliant.

- The change of correspondence address, filed by the patent owner on February 5, 2007, is **ineffective**. A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. John DeBoer. Absent the filing of a proper change of correspondence address in the patent file, application no. 11/040,453, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

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

Cynthia L. Nessler

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

5/02/11

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CENTRAL REEXAMINATION UNIT

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NOVAK, DRUCE & QUIGG, LLP (For the '1122 *inter partes* requester)
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In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,166
Filing Date: August 22, 2007
For: U.S. Patent No.: 6,426,916

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,122
Filed: November 20, 2008
For: U.S. Patent No.: 6, 426,916

DECISION DISMISSING PETITION

This is a decision on the October 15, 2010 patent owner petition entitled "PETITION TO UNMERGE THE MERGED REEXAMINATION PROCEEDINGS."

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

The petition is dismissed.

BACKGROUND

1. On July 30, 2002, the Office issued U.S. Patent No. 6,426,916 (the '916 patent) to Farmwald *et al.*

2. On August 8, 2006, a first request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/000,166 ("the '166 proceeding"). Samsung Electronics, Co. Ltd. is identified as the real party in interest. After receipt of a corrected request the '166 proceeding was granted a filing date of October 12, 2006. Reexamination was ordered on December 26, 2006, which was then vacated on August 14, 2007. On August 22, 2007, a

redacted/corrected request was filed and granted a new filing date. Reexamination of the '916 patent based on the corrected request was ordered on October 19, 2007.

3. On November 20, 2008, a second request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,122 ("the '1122 proceeding"). Micron Technology is identified as the real party in interest. Reexamination was ordered on January 16, 2009.

4. On March 9, 2009, the Office *sua sponte* issued a decision merging the '166 and '1122 proceedings ("the merged proceeding").

5. On August 6, 2010, prosecution in the merged proceeding advanced to the point where the Office issued a Right of Appeal Notice (RAN).

6. On September 7, 2010, third party requester Micron filed a Notice of Appeal.

7. On October 15, 2010, patent owner filed the present petition to unmerge the proceeding.

8. On November 8, 2010, third party requester Micron filed an appeal brief.

9. On December 8, 2010, patent owner filed a respondent's brief.

DECISION

Patent owner requests demerger of the merged proceeding. Patent owner argues that the request for demerger is not untimely as the petition is not in response to the March 9, 2009 Office merger decision, but instead in response to a recent change in circumstance in the merged proceeding. Patent owner asserts that demerger now instead of retention of merger will better facilitate special dispatch. Specifically, patent owner alleges that demerger will result in immediate issuance of a reexamination certificate in the '166 proceeding. Patent owner also alleges that demerger will streamline the '1122 proceeding's appeal, hence also supporting special dispatch.

Patent owner's position is not persuasive. The reexamination proceeding has progressed as a merged proceeding to the point that an Examiner's determination has been appealed and fully briefed. Thus all that remains is an Examiner's Answer, the rebuttal briefing phase and the rendering of a Board decision. Accordingly, dissolution of the merger at this very late stage of the proceeding does not serve the interests of special dispatch in the Office.

CONCLUSION

1. Patent owner's October 15, 2010 petition is **dismissed**.

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

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

January 13, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,166	08/22/2007	6426916	38512.3	7919

22852 7590 03/15/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed December 8, 2010 ("Petition"). In the Petition, Patent Owner "requests that the Director waive the requirement of 37 C.F.R. § 1.943(c) limiting respondent appeal briefs to fifteen pages or 7,000 words in length. Specifically, Rambus requests that the Office accept its respondent appeal brief , which is 25 pages and 14,904 words in length." Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.

6. On March 9, 2009, the '166 and '122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution ("ACP"), confirming claims 1-41.

9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron filed an appellant brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a respondent brief and the present Petition.

RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

ANALYSIS

Using the above guidelines, Micron's appellant brief is 27 pages in length and Rambus's respondent brief is 25 pages in length.

Rambus represents that it "has made every effort to pare down the arguments in its respondent appeal brief, but a respondent appeal brief limited to 15 pages or 7,000 words in length is inadequate to fully address and comprehensively respond to Micron's arguments." Petition, p. 3.

As indicated above, however, there are only two claims at issue here, claims 26 and 28. Further, Micron's appellant brief of 27 pages is well within the limit of 30 pages specified in 37 C.F.R. § 1.943(c) for appellant briefs.

Rambus's due process arguments have been carefully considered, including the Federal Circuit decision in *Patlex Corp. v. Mossinghoff,* 771 F.2d 480 (Fed. Cir. 1985), and are not deemed persuasive. Efficiency of administrative processing is a legitimate basis for restricting submissions from participants in reexamination proceedings. *Id.* at 483-86.

DECISION

In view of the forgoing, the Petition is DENIED. Rambus is given one month or 30 days, whichever is longer, in which to file a respondent brief that conforms to the requirements of 37 C.F.R. § 1.943(c).

James T. Moore
Acting Chief Administrative Patent Judge

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Patent Owner

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Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed December 8, 2010 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed January 7, 2011 ("Opposition"). In the Petition, Patent Owner "requests that the Office expunge Micron's appeal brief from the record because it raises issues the Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding . . . and because the Examiner never adopted those issues in these reexamination proceedings." Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.

6. On March 9, 2009, the '166 and '122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1-41.

9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron filed an appellant brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a respondent brief and the present Petition to expunge Micron's appellant brief.

13. On January 7, 2011, Micron filed the present Opposition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(a)(2) provides:

> (2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to *any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent* by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(emphasis added).

Also relevant is MPEP § 2674(B):

> 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.

(emphasis in original).

ANALYSIS

The relevant statute, rule and MPEP section quoted above are intended to grant a requester the right to appeal any decision by the Examiner favorable to patentability on a proposed rejection irrespective of the origin of such rejection, i.e., whether the rejection was proposed by the Examiner or another requester.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the language:

> 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.*

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

Inter partes Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION

In view of the forgoing, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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95/000,166	08/22/2007	6426916	38512.3	7919

22852 7590 05/31/2011
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EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
05/31/2011	PAPER

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,122	11/20/2008	6,426,916	8963.002.916	1557

22852 7590 05/31/2011
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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Third Party Requester – *Inter partes* Reexamination Control 95/001,122

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief," filed April 15, 2011 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed May 16, 2011 ("Opposition").

In the Petition, Patent Owner "requests that the Director review and overturn the Office's March 15, 2011 Decision on Petition [denying Patent Owner's] petition in which [Patent Owner] requested that the Office expunge Third-Party Requestor [Micron's] appeal brief because it raised

issues that Micron did not propose in its reexamination request and that did not pertain to the Micron-initiated reexamination proceeding." Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.

6. On March 9, 2009, the '166 and '122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1-41.

9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition to Expunge Micron's Appellant Brief.

13. On January 7, 2011, Micron filed an Opposition to Rambus's Petition to Expunge.

14. On March 15, 2011, the Board entered a Decision on Petition, denying Rambus's Petition to Expunge.

15. On April 15, 2011, Rambus filed the present Petition.

16. On May 16, 2011, Micron filed the present Opposition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(a)(2) provides:

> (2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to *any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent* by filing a notice of appeal within the time provided in the Right of Appeal Notice and

> paying the fee set forth in § 41.20(b)(1).

(emphasis added).

Also relevant is MPEP § 2674(B):

> 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.

(emphasis in original).

ANALYSIS

The exact same issue posed by Rambus's present Petition recently has been addressed by the Board in response to several similar Rambus petitions. Clearly, the Board has concluded that the relevant statute and rule, quoted above, are intended to grant a requester the right to appeal any decision by the Examiner favorable to patentability on a proposed rejection irrespective of the origin of such rejection, i.e., whether the rejection was proposed by the Examiner or another requester. See, Merged Proceedings 95/001,026 and 95/001,128, February 16, 2011; 95/000,183 and 95/001,112, April 15, 2011; 95/000,250 and 95/001,124, April 27, 2011.

Further, the facially contradictive language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the language:

> 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*

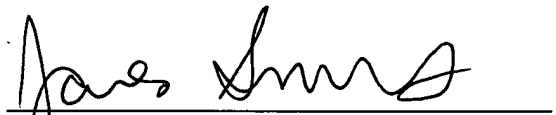
must identify each previously proposed rejection to be contested. (emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

DECISION

In view of the forgoing, the Petition is DENIED.

This Decision constitutes Final Agency Action on this matter.



James D. Smith
Chief Administrative Patent Judge

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Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed April 15, 2011 ("Recon. Petition"). In the Recon. Petition, Patent Owner "requests that the Director overturn the March [15, 2011] Decision and direct the Office to enter Rambus's December 8, 2010 Respondent Brief into the record." Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.

6. On March 9, 2009, the '166 and '122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution ("ACP"), confirming claims 1-41.

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10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37

C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief is 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed the present Recon. Petition. Along with the Recon. Petition, Rambus also filed a Replacement Respondent Brief and an Alternative Replacement Respondent Brief. The Replacement Brief is 15 pages in length and includes citations to expert declarations (Recon. Petition at 8-10), and the Alternative Replacement Brief also is 15 pages in length but does not include citations to expert declarations (Recon. Petition at 10).

RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

With respect to waiver of the Rules, 37 C.F.R. § 1.183 provides:

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

ANALYSIS

In the Recon. Petition, Rambus advances several arguments why application of the page limit specified by Rule 1.943(c) for its respondent brief is unfair and inappropriate, including:

1. In this merged proceeding, in a single respondent brief, Rambus must address issues presented by two third party requesters (Recon. Petition at 2);
2. A respondent brief, having a page limit of 15 pages, is responding to an appellant brief that may be 30 pages in length (Recon. Petition at 2-3); and
3. Limiting a patent owner's ability to address comprehensively issues relating to patentability violates the owner's due process rights (Recon. Petition at 3).

In this merged proceeding, Micron's Appellant Brief is 27 pages in length which is within the 30-page limit prescribed by Rule 1.943(c).

As required by Rule 1.183, waiver of the rules requires presentation of an extraordinary situation for which justice requires a waiver. Here, there is nothing extraordinary about the posture of this appeal. Micron's Appellant Brief is within the 30-page limit prescribed by Rule 1.943(c). Rambus's alleged difficulty in complying with the 15-page limit for its Respondent

Brief is with application of the relevant procedures *per se* and not with any circumstance unique to this appeal. In the absence of facts establishing the existence of a unique situation, i.e., not a situation arising out of routine application of a rule, there can be no extraordinary situation for which justice requires waiver of the rule.

DECISION

In view of the forgoing, the Recon. Petition is DENIED with respect to Rambus's Respondent Brief and Replacement Respondent Brief, and is GRANTED with respect to Rambus's Alternative Replacement Brief. The Office will accept Rambus's Alternative Replacement Brief that is in compliance with Rule 1.943(c).

James D. Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,166	08/22/2007	6426916	38512.3	7919

22852 7590 08/18/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Reconsideration of June 7, 2011 Decision on Petition," filed July 7, 2011 ("Second Reconsideration Petition"). The Second Reconsideration Petition "requests that the Office reconsider its June 7, 2011 Decision on Petition . . . denying Rambus's Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief. . . ." Second Reconsideration Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.

6. On March 9, 2009, the '166 and '122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution ("ACP"), confirming claims 1-41.

9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28. Micron's Appellant Brief is 27 pages long.

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37 C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief is 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed a First Reconsideration Petition along with a Replacement Respondent Brief and an Alternative Replacement Respondent Brief. The Replacement Brief is 15 pages in length and includes citations to expert declarations (First Reconsideration Petition at 8-10), and the Alternative Replacement Brief also is 15 pages in length but does not include citations to expert declarations (First Reconsideration Petition at 10).

15. On June 7, 2011, the Office entered a Decision on Petition denying Rambus's First Reconsideration Petition and agreeing to accept the Alternative Replacement Respondent Brief.

16. On July 7, 2011, Rambus filed the Second Reconsideration Petition under consideration here.

RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

contained in the brief.

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

In respect to affidavits and declarations of expert witnesses, MPEP § 2667 (I)(A)(2) specifies:

> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943.

In respect to waiver of the Rules, 37 C.F.R. § 1.183 provides:

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

ANALYSIS

Here, the relevant background facts are undisputed; namely Micron's Appellant Brief places four issues in dispute – three rejections and a priority dispute. Micron presented its position on these issues in its Appellant Brief in 27 pages, within the 30 page limit proscribed by Rule 1.943(c).

In drafting and adopting Rule 1.943(c), with a 2-to-1 ratio of page and word limits between appellant briefs and respondent briefs, the Office was aware that the issues in an appeal are framed and defined by the opening

brief – the appellant brief. Rule 41.67(c)(1)(vi). In addition, appellant must explain why the position of the Examiner on the relevant issues as set forth in the RAN is incorrect.

Rambus argues that the refusal of the Office to grant Rambus a waiver from the page/word limits of Rule 1.943(c) for its Respondent Brief is "arbitrary and capricious, and violates Rambus's due process rights." Second Reconsideration Petition, p. 3.

The Office will not agree that the application of Rule 1.943(c) to Rambus's Respondent Brief constitutes a per se violation of Rambus's due process rights. Other than mentioning that four issues are presented by Micron's Appellant Brief, Rambus has not described any detail of those issues that would warrant waiving the page/word limits of Rule 1.943(c). Furthermore, 15 pages of text would appear to be more than sufficient to respond to three rejections and a priority issue.

Concerning the citations to statements contained in expert witness affidavits and declarations, Rambus should identify the nature of the statements. If they present expert opinions on patentability issues, they will be treated as countable pages of Rambus's Respondent Brief. If they present factual technical information, they will not be treated as countable pages of the Brief.

As stated in the Decision on the First Reconsideration Petition, a waiver of the rules under Rule 1.183 requires presentation of an extraordinary situation for which justice requires a waiver. Here, there is nothing extraordinary about the posture of this appeal. Micron's Appellant Brief is within the 30-page limit prescribed by Rule 1.943(c). Rambus's alleged difficulty in complying with the 15-page limit for its Respondent

Brief appears to be difficulty in complying with the relevant procedures *per se* and not as a result of any particular circumstance unique to this appeal. In the absence of facts establishing the existence of a unique situation, i.e., not a situation arising out of routine application of a rule, there can be no extraordinary situation for which justice requires waiver of the rule.

DECISION

In view of the forgoing, the Second Reconsideration Petition is DENIED with respect to Rambus's Respondent Brief and Replacement Respondent Brief, and is GRANTED with respect to Rambus's Alternative Replacement Brief. The Office will accept Rambus's Alternative Replacement Brief that is in compliance with Rule 1.943(c). This Decision constitutes final agency action on this matter.

James D. Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,166	08/22/2007	6426916	38512.3	7919

22852 7590 09/27/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/27/2011

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122
Patent 6,426,916

DECISION ON PETITION

This is a decision on Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(C), filed June 27, 2011 ("Micron's Petition for Waiver"). Micron requests that it be allowed to submit a Rebuttal Brief of up to 25 pages.

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FINDINGS

1. Patent 6,426,916 issued on July 30, 2002, with 41 claims. The '916 patent is assigned to Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '1122 proceeding.

6. On March 9, 2009, the '166 and '1122 proceedings were merged.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution ("ACP"), which confirmed claims 1-41, was mailed in the merged proceeding.

9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

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10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron Filed an Appellant Brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37 C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief was 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed a First Reconsideration Petition with a Replacement Respondent Brief and an Alternative Replacement Respondent Brief.

15. On June 7, 2011, the Office entered a Decision on Petition denying Rambus's First Reconsideration Petition and agreeing to accept the Alternative Replacement Respondent Brief.

16. On July 7, 2011, Rambus filed a Second Reconsideration Petition requesting that the Office reconsider the original decision to deny waiver of 37 C.F.R. § 1.943.

17. On August 18, 2011, the Office entered a Decision on Petition denying Rambus's Second Reconsideration Petition and, again, agreeing to accept the Alternative Replacement Respondent Brief.

18. On June 27, 2011, Micron filed a Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 ("Micron's Rebuttal Brief") of more than 15 pages.

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19. On June 27, 2011, Micron filed the Petition for Waiver under consideration here.

RELEVANT AUTHORITY

Page and word limits for briefs in reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

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

ANALYSIS

Micron requests that 37 C.F.R. § 1.943(c) be waived so that it may submit a rebuttal brief of up to 25 pages.[1] (Micron's Petition for Waiver 1.) In the alternative, Micron submits an Alternative Third Party Requester's Rebuttal Brief in Attachment A, which complies with the rule, but is not presented in 12-point font with double-spaced formatting. (*Id.* at 2.)

Twelve-point font with double-spaced formatting is the preferred format for all documents submitted to the Board of Patent Appeals and Interferences. Nevertheless, in the interest of a speedy and efficient proceeding and because Micron's Alternative Rebuttal Brief is apparently in a font size and spacing format similar to those in Rambus's Alternative

[1] Micron requests that it be allowed to submit a "respondent" brief on page 1 of its Petition for Waiver, but it is assumed Micron intended to request waiver for its Rebuttal Brief because Micron filed the Appeal Brief in the proceeding and there are no cross-appeals by Rambus.

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Replacement Respondent Brief and meets the page requirements of the Rule, Micron's Alternative Third Party Requester's Rebuttal Brief in Attachment A is **entered**.

DECISION

In view of the foregoing, Micron's Petition for Waiver is DENIED, but Micron's Alternative Third Party Requester's Rebuttal Brief in Attachment A is entered.

Jurisdiction is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,178	10/06/2006	6,324,120	38512.4	8591

22852 7590 05/12/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Appeal Brief," filed August 23, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 29 pages and 18,777 words in length." Petition, p. 1.

The fee of $400 for a petition under 37 C.F.R. § 1.183 has been received.

FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.

5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.

6. On July 21, 2009, the '178 and '1152 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding. The length of the ACP was 118 pages.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39. The length of the RAN was 110 pages.

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appellant Brief.

13. On July 21, 2010, Micron filed an Appellant Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief along with the present Petition.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of

contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

Rambus argues that Micron raises 13 issues in its Appellant Brief to which Rambus must respond in its Respondent Brief, and that 15 pages is insufficient to present Rambus's responses. Petition, p.4. Rambus also contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." *Id.* at 2.

The eleven issues addressed in Rambus's Appeal Brief, as described in the "Issues to be Reviewed on Appeal" section of the Appeal Brief (Appeal Brief, pp. 1-2), are completely different than the nine issues addressed in Rambus's Respondent Brief, as described in the "Issues to be Reviewed on Appeal" section of the Respondent Brief (Respondent Brief, p. 1), reflecting the different rejections proposed by Micron and Samsung. Clearly, the issues presented by each of the two merged reexamination proceedings are distinct from those presented in the other proceeding.

In view of the number of different patentability issues presented in this merged reexamination proceeding, a reasonable increase in the permitted length of Rambus's Respondent Brief is deemed reasonable. It is unnecessary to reach Rambus's due process argument.

DECISION

For the forgoing reason, the Petition is GRANTED.

James D. Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,178	10/06/2006	6,324,120	38512.4	8591

22852 7590 05/12/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of C.F.R. § 1.943(c)," filed November 22, 2010 ("Petition"). In the Petition, Third Party Requester Micron Technology Inc. requests "that the Office should [] permit Micron to submit a rebuttal brief that is 11,970 words or 30 pages." Petition, p. 1.[1]

The fee of $400 for a petition under 37 C.F.R. § 1.183 has been received.

---

[1] The Petition at page 1, lines 2 and 3, refers to Requester's "respondent brief." As confirmed in a telephone inquiry on May 6, 2011 with a representative of Requester's counsel, this is a typographical error and should be "rebuttal brief."

FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.

5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.

6. On July 21, 2009, the '178 and '1152 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding. The length of the ACP was 118 pages.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39. The length of the RAN was 110 pages.

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appellant Brief.

13. On July 21, 2010, Micron filed an Appellant Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief of 29 pages and 18,777 words along with a Petition seeking waiver of the page and word limits of Rule 1.943(c).

15. On October 21, 2010, the Examiner entered an Answer incorporating the RAN of April 23, 2010.

16 On November 22, 2010, Micron filed a Rebuttal Brief of 30 pages and 11,970 words along with the present Petition.

17. Mailed concurrently herewith is a Decision granting Rambus's Petition for a waiver of the page and word limits specified in Rule 1.943(c) for its Respondent Brief.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

Micron argues that justice requires that in its Rebuttal Brief, it be given an opportunity to respond to Rambus's Respondent Brief on a one-to-one page basis, as inherently specified by Rule 1.943(c). Petition, p. 2. Also, rebuttal briefs may include responses to the Examiner's Answer. Rule 41.71(b)(1) and (c)(1).

In light of Rambus being granted permission to file a Respondent Brief that exceeds the page and word limits of Rule 1.943(c), fairness dictates that Micron be accorded the same treatment for its Rebuttal Brief.

DECISION

For the forgoing reason, the Petition is GRANTED.

James D. Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,178	10/06/2006	6,324,120	38512.4	8591

22852 7590 06/01/2011
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
06/01/2011	PAPER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,152	02/27/2009	6,324,120	8963.002.RXUS00	4649

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Respondent Brief," filed October 15, 2010, ("Petition to Expunge"), and "Third Party Requester's Petition Under 37 C.F.R. §§ 1.182 and 1.183 for Limited Waiver of 37 C.F.R. §§ 1.957(A) and 41.66(B)," filed December 15, 2010, ("Waiver Petition").

In the Petition to Expunge, "Rambus requests that the Office expunge Micron's respondent brief because it was filed after the last day on which Micron was allowed to file such a brief." *Id.* at 1.

In the Waiver Petition, Micron seeks a waiver of the one month period specified for filing a respondent brief, as required by 37 § 41.66(b), and the

refusal to consider an untimely filed brief, as specified by 37 C.F.R. § 1.957(a), because "Micron's late filing was due to an unintentional docketing error." *Id.* at 1.

The fee of $400 for a petition under 37 C.F.R. § 1.183 has been received from Third Party Requester.

FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.

5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.

6. On July 21, 2009, the '178 and '1152 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appellant Brief.

13. On July 21, 2010, Micron filed an Appellant Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief.

15. Also on August 23, 2010, Micron filed a Respondent Brief.

16. On October 15, 2010, Rambus filed the present Petition to Expunge.

17. On December 15, 2010, Micron filed the present Waiver Petition.

RELEVANT AUTHORITY

37 C.F.R. § 1.182 specifies:

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

37 C.F.R. § 1.183 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. § 41.66(b) provides:

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 C..F.R. § 1.957(a) specifies:

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

ANALYSIS

In the Petition to Expunge, Rambus argues that Micron's Respondent Brief was due on August 19, 2010 (Thursday) and that it was not filed until August 23, 2010 (Monday). Petition to Expunge, p. 1. Since August 21 and 22, 2010 fell on Saturday and Sunday, Micron's Respondent Brief was filed late by two working days, namely, August 20 and 23, 2010.

With its Waiver Petition, Micron submitted a copy of its relevant "docketing chart" showing that the due date for its Respondent Brief was docketed incorrectly for August 21, 2010 (Saturday) instead of August 19, 2010 (Thursday).

Micron attributes this docketing error as likely the result of using the filing date of Micron's Appellant Brief (July 21, 2010) instead of the filing date of Rambus's Appellant Brief (July 19, 2010) for determining the due date of Micron's Respondent Brief. Waiver Petition, p. 2.

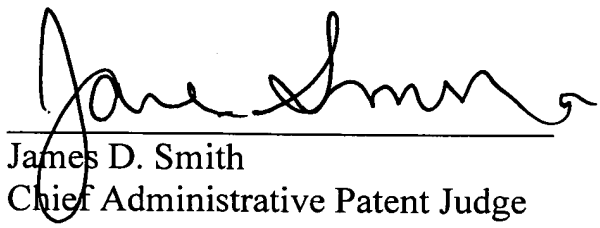
Under 37 C.F.R. §§ 1.957(a) and 41.66(b), if a requester's respondent brief is filed more than one month after the date of filing of

patent owner's appellant brief, the untimely filed respondent brief "will be refused consideration." Since this situation expressly is provided for in the rules, 37 C.F.R. § 1.182 is inapplicable. Thus, waiver of the applicable rules is considered only under 37 C.F.R. § 1.183.

By explaining how the docketing error likely occurred, Micron has not established that this is "an extraordinary situation" in which "justice requires" waiver of the rule, as required by 37 C.F.R. § 1.183. For example, Micron has not explained what procedures were in place at the law firm of Micron's attorney for docketing *inters partes* reexamination matters; why those procedures were insufficient in this instance; and why the docketing error was an extraordinary situation for which justice requires waiver of the rule-specified filing deadline.

DECISION

In view of the foregoing, Micron's Waiver Petition is DENIED without prejudice to the filing a renewed petition within one month from the mailing date hereof. Action on Rambus's Petition to Expunge will be held in abeyance pending the filing of a renewed petition by Micron.



James D. Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

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22852 7590 06/07/2011

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ART UNIT	PAPER NUMBER

DATE MAILED: 06/07/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE
OFFICE OF PATENT LEGAL ADMINISTRATION

and

BOARD OF PATENT APPEALS AND INTERFERENCES[1]

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

DECISION ON PETITIONS

This is a decision on:

1. Patent Owner's " Petition to Expunge Third Party Requester's Cross-Appeal Brief," filed August 23, 2010 (Cross-Appeal Brief Petition); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Cross-

[1] OPLA has authority to review Requesters Cross-Appeal Brief, filed July 21, 2010, and BPAI has authority to review Requester's Rebuttal Brief, filed November 22, 2010. *See,* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010).

Appeal Brief," filed January 7, 2011 (Cross-Appeal Brief Opposition); and

2. Patent Owner's "Petition to Expunge Third Party Requester's Rebuttal Brief," filed December 30, 2010 (Rebuttal Brief Petition); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Rebuttal Brief," filed January 18, 2011 (Rebuttal Brief Opposition).

FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.

5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.

6. On July 21, 2009, the '178 and '1152 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appeal (Appellant) Brief.

13. On July 21, 2010, Micron filed a Cross-Appeal (Appellant) Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief and the Cross-Appeal Brief Petition.

15 Also on August 23, 2010, Micron filed a Respondent Brief.

16. On October 21, 2010, the Examiner entered an Answer incorporating the RAN of April 23, 2010.

17. On November 22, 2010, Rambus filed a Rebuttal Brief.

18. Also on November 22, 2010, Micron filed a Rebuttal Brief.

19. On December 30, 2010, Rambus filed the Rebuttal Brief Petition.

20. On January 10, 2011, Micron filed the Cross-Appeal Brief Opposition.

21. On January 18, 2011, Micron filed the Rebuttal Brief Opposition.

DISCUSSION

Rambus seeks expungement of Micron's Cross-Appeal and Rebuttal Briefs because those briefs present arguments premised on rejections initially proposed by Samsung and not by Micron. As recently discussed in the Decision on Petition entered April 27, 2011 in merged reexamination proceeding 95/000,250 and 95/001,124, involving the same parties that are involved here, the Office has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed rejections that were before the Office at the time of the RAN. In view of the detailed analysis that the Office has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

DECISION

In view of the foregoing:

The Cross-Appeal Brief Petition is DENIED.

Brian E. Hanlon
Director, Office of Patent Legal Administration

The Rebuttal Brief Petition is DENIED.

James D. Smith
Chief Administrative Patent Judge, Board of Patent Appeals and Interferences

Inter partes Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

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EXAMINER

ART UNIT	PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152
Patent 6,324,120

DECISION ON PETITIONS

This is a decision on Third Party Requester's Renewed Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 41.66(B), filed June 30, 2011 ("Renewed Waiver Petition").

FINDINGS

1. Patent 6,324,120 issued on November 27, 2001, with 39 claims. The '120 patent is assigned to Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.

3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.

5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.

6. On July 21, 2009, the '178 and '1152 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appellant Brief.

13. On July 21, 2010, Micron filed an Appellant Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief.

15. Also on August 23, 2010, Micron filed a Respondent Brief.

16. On October 15, 2010, Rambus filed a Petition to Expunge Third-Party Requester's Respondent Brief ("Petition to Expunge").

17. On December 15, 2010, Micron filed a Third Party Requester's Petition Under 37 C.F.R. §§ 1.182 and 1.183 for Limited Waiver of 37 C.F.R. §§ 1.957(A) and 41.66(B) ("Waiver Petition").

18. In a Decision on Petitions, Micron's Waiver Petition was denied without prejudice to the filing of a renewed petition within one month and Rambus's Petition to Expunge was held in abeyance pending the filing of a renewed petition.

19. On June 30, 2011, Micron filed the present Renewed Waiver Petition.

RELEVANT AUTHORITY

37 C.F.R. § 41.66(b) states

> Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief.

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Other rules of the Office may be suspended, as follows:

> 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. § 1.183.

ANALYSIS

Micron's Respondent Brief was due August 19, 2010, but was not filed until August 23, 2010, making it two days late considering that August 21 and 22 fell on Saturday and Sunday in 2010. In its Waiver Petition, Micron sought a waiver of the one month period specified in 37 C.F.R. § 41.66(b) for filing a respondent brief. Micron attributed the late filing to a docketing error in which the filing date of Micron's Appellant Brief (July 21, 2010) was used instead of the filing date of Rambus's Appellant Brief (July 19, 2010) for determining the due date of Micron's Respondent Brief. (*See* Waiver Petition, 2.) Micron also noted that Rambus's Appellant Brief was not received until five business days after it was served. (*See* Waiver Petition, 3.) Micron submitted two exhibits in support of its Petition for Waiver: Exhibit A, which is an excerpt of the docketing chart relied upon by the attorney prior to filing of Micron's Respondent Brief, and Exhibit B, which is a statement by James P. Murphy.

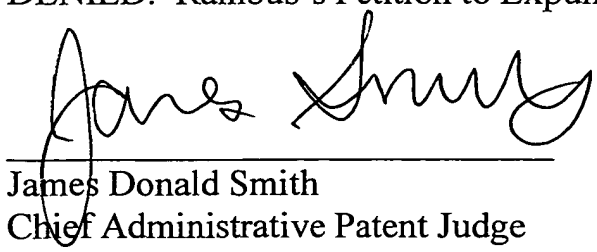
Micron's Petition for Waiver was denied in the previous Decision on Petitions because Micron did not establish that an "extraordinary situation" in which "justice requires" waiver of the rule had occurred.

Micron now asserts that there was an "unusually long delay" in the receipt of Rambus's Appellant Brief and that this delay, coupled with the inadvertent docketing error, created an "extraordinary situation," under 37 C.F.R. § 1.183, warranting acceptance of Rambus's Respondent Brief two days late. (Renewed Petition, 3.) According to Micron, the docketing error was not noticed because of the early filing by Rambus and the subsequent delay in the mail allowed the docketing error to go unnoticed. (*Id.*)

Rule 41.66 provides the time period for filing a brief by a respondent from "the date of service." Micron does not dispute that the date Rambus served its Appeal Brief was evident from its Certificate of Service or that Micron could not have known the date of service. Nor does Micron argue that the delay in the U.S. mail was so long that there was not time to prepare a Respondent's Brief. Thus, the only cause of Micron's late filing was the error in docketing, which does not rise to the level of an extraordinary situation. Micron has provided no showing that this situation is extraordinary nor that justice requires waiver of the rules. Accordingly, the present request for reconsideration is **denied**. Micron's respondent brief is **not entered**.

DECISION

In view of the foregoing, Micron's Renewed Waiver Petition is DENIED. Rambus's Petition to Expunge is GRANTED.



James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,183 95/001,112	08/24/2007	6182184	38512.5	2395

22852 7590 09/07/2010

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901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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DALLAS, TX 75219

Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183; 95/001,112
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112 ; 95/000,183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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(For Patent Owner)

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

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(For 95/001,112 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,183
Filed: August 24, 2007
For: U.S. Patent No. 6,182,184

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,112
Filed: November 17, 2008
For: U.S. Patent No. 6,182,184

DECISION GRANTING PETITIONS

This is a decision on the May 10, 2010 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S APPEAL BRIEF," and on the June 10, 2010 third party requester Micron petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)," requesting waiver of 37 CFR 1.943(c) for its respondent brief.

The petitions are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

The petitions are granted.

REVIEW OF THE RELEVANT FACTS

1. U. S. Patent Number 6,182,184 (the '184 patent) issued to Farmwald et al. on January 30, 2001, with 29 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,183 ('183 proceeding), was initially deposited by third party requester on October 4, 2006. A corrected request was then filed, and received a filing date of August 24, 2007. Samsung Electronics Co., Ltd., ("Samsung") was identified as the real party in interest.

3. On October 19, 2007, the Office issued an order for the '183 reexamination proceeding, granting reexamination of claims 1-29 of the '184 patent.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,112 ('1112 proceeding), was filed November 17, 2008, by third party requester Micron Technology Inc. ("Micron").

5. An order granting reexamination of claims 13 and 14 of the '184 patent was mailed for the '1112 reexamination proceeding on January 16, 2009.

6. On March 6, 2009, the '183 and '1112 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, patent owner filed comments in response to the ACP.

9. On October 21, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

10. On January 29, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 26, 2010, patent owner filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, requester Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 1010, patent owner filed an appellant's brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

15. On June 10, 2010, third party requester Micron filed a respondent brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

16. On July 2, 2010, patent owner filed a petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by third party requester Samsung. This petition is being addressed by a separate decision mailed on even date with the present decision, as will be discussed below.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides (in pertinent part):

For additional information with respect to the length of papers, see Subsection I.A.2 above.

DECISION

I. Patent Owner's Petition of May 10, 2010

In its May 10, 2010 petition, petitioner patent owner requests waiver of 37 CFR 1.943(c), which limits appellant briefs to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit patent owner to file its appellant brief of 26,278 words in length, which has been concurrently submitted with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant brief in compliance with the 30-page limit, and submitting the resulting response, which has a length of 67 pages that count toward the regulatory page limit. Patent owner asserts that it "has made every effort to pare down the arguments in its appeal brief."[1]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted to permit patent owner's May 10, 2010 appellant brief to exceed the page limit by 37 pages. This waiver makes patent owner's May 10, 2010 appellant brief page-length compliant.

II. Third Party Requester Micron's Petition of June 10, 2010

In its June 10, 2010 petition, petitioner third party requester Micron requests waiver of 37 CFR 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit third party requester Micron to file a respondent brief of 37 pages or 17,266 words in length. Third party requester concurrently submitted its respondent brief with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

Waiver is requested only if the Office grants the patent owner's May 10 , 2010 petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c) for patent owner's appellant brief.[2]

In this instance, third party requester Micron has made a showing in support of the request for waiver of the 15-page limit of 37 CFR 1.943(c) by attempting to draft a respondent brief in compliance with the 15-page limit, and submitting the resulting response, which has a length of 32 pages that count toward the regulatory page limit. And, the proffered respondent brief is half the size of the appellant brief, in keeping with the ratio of respondent brief to appellant brief, in 37 CFR 1.943(c).

Based on the particular circumstances of the present merged proceeding, it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) for requester's respondent brief in this instance by an amount proportional to the amount granted for patent owner's appellant brief. Therefore, third party requester's petition under 37 CFR 1.183 is granted to permit third party requester's

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[1] Patent owner's May 10, 2010 petition at page 3.
[2] Third party requester's June 10, 1010 petition at page 2.

respondent brief to exceed the page limit by 17 pages. This waiver makes third party requester Micron's June 10, 2010 respondent brief page-length compliant.

On even date with this decision, the Office is dismissing patent owner's July 2, 2010 petition under 37 CFR 1.182/1.183 to strike portions of third party requester Micron's June 10, 2010 respondent brief. The Office's dismissal of patent owner's July 2, 2010 petition to strike portions of third party requester Micron's respondent brief will therefore not affect the present determination of the page limit waiver of third party requester Micron's respondent brief.

III. Appendix

What is Included or Excluded from the Page Limit Count

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Furthermore, the sections of the appellant brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. If any portion of the relevant section includes material that goes beyond that which is required by those sections, the entire section will be counted toward the page total. Partial pages will be tallied as whole pages for this purpose.

A comparison of 37 CFR 41.67(c) and 37 CFR 41.68(b), which set out the respective requirements for an appellant's brief and a respondent's brief, reveals that the claims appendix is the only item required in the appellant's brief that is not required in the respondent's brief. Section 1.943 does not, however, specify that reference materials are excluded from the page count of respondent's brief. To the extent that the rule can be read as giving unequal treatment to reference materials in determining the page count of appellant and respondent briefs, the rule is hereby waived. Specifically, "reference materials such as prior art references" that are properly part of an appendix to the respondent's brief are not being counted toward the page limit set in § 1.943(c). Furthermore, the sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and 37 CFR 41.68(b)(1)(i)-(iv) respectively are deemed to be included in "reference materials" that do not count toward the page limits.

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count only insofar as they are documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court of the Board as identified in the "Related appeals and interferences" section of the brief. Any documents that are not required to be submitted (such as Office actions, requests for reexamination, etc.) are counted toward the size limit of the brief.

---

[3] i.e., (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments, (ix) Evidence Appendix, (x) Related Proceedings Appendix, and (xi) Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

CONCLUSION

1. Patent owner's and third party requester's petitions under 37 CFR 1.183 are both granted, making the proffered appellant brief and a respondent's brief (respectively) page length compliant.

2. 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

8-31-10
kenAppeal/length

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,183 95/001,112	08/24/2007	6182184	38512.5	2395

22852 7590 09/07/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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

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DALLAS, TX 75219

Date:
MAILED
SEP 07 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183; 95/001,112
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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HOUSTON, TX 77002

Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112, 95/000,183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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SEP 07 2010

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(For 95/001,112 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,183
Filed: August 24, 2007
For: U.S. Patent No. 6,182,184

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,112
Filed: November 17, 2008
For: U.S. Patent No. 6,182,184

DECISION DISMISSING PATENT OWNER'S PETITION TO STRIKE PORTIONS OF REQUESTER'S RESPONDENT BRIEF

This is a decision on the July 2, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THIRD-PARTY REQUESTER'S RESPONDENT BRIEF." Since the petition is actually on challenging the making of record of the respondent brief by the Central Reexamination Unit (CRU), the petition will be taken and decided as a petition under 37 CFR 1.181 challenging an action taken by the CRU – see the below discussion.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. U. S. Patent Number 6,182,184 (the '184 patent) issued to Farmwald et al. on January 30, 2001, with 29 claims.

2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,183 ('183 proceeding), was initially deposited by third party requester on October 4, 2006. A corrected request was then filed, and received a filing date of August 24, 2007. Samsung Electronics Co., Ltd., ("Samsung") was identified as the real party in interest.

3. On October 19, 2007, the Office issued an order for the '183 reexamination proceeding, granting reexamination of claims 1-29 of the '184 patent.

4. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,112 ('1112 proceeding), was filed November 17, 2008, by third party requester Micron Technology Inc. ("Micron").

5. An order granting reexamination of claims 13 and 14 of the '184 patent was mailed for the '1112 reexamination proceeding on January 16, 2009.

6. On March 6, 2009, the '183 and '1112 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, patent owner filed comments in response to the ACP.

9. On October 21, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

10. On January 29, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 26, 2010, patent owner filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, requester Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 1010, patent owner filed an appellant's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

15. On June 10, 2010, third party requester Micron filed a respondent brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

16. On July 2, 2010, patent owner filed the present petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by third party requester Samsung.

RELEVANT AUTHORITY

35 U.S.C. § 312 (Determination of issue by Director) provides (in pertinent part):

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. § 313 (*Inter partes* reexamination order by Director) provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

35 U.S.C. § 314 (Conduct of *inter partes* reexamination proceedings) provides (in pertinent part):

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

35 U.S.C. § 315 (Appeal) provides (in pertinent part):

(b)THIRD-PARTY REQUESTER.— A third-party requester—
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and
(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

35 U.S.C. § 317 (Inter partes reexamination prohibited) provides (in pertinent part):

(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 1.181 provides (in pertinent part):

(a)Petition may be taken to the Director:
(1)From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 41.68 provides (in pertinent part):

(a)(1)Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.
(2)The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).
(3)The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.
(4) A requester's respondent brief may not address any brief of any other requester.

DECISION

I. Patent owner's July 2, 2010 Petition

In its present petition, patent owner requests under 37 CFR 1.182 and if necessary, under 37 CFR 1.183, that those portions of Requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by Requester Samsung and not raised by Micron in its request for reexamination be stricken. In support of its request that portions of Requester Micron's respondent brief addressing issues raised by another third party requester be striken, petitioner patent owner points to the following authority: (1) MPEP 2675.02 and 37 CFR 41.68(a)(3) state

that the "respondent brief must ...be limited to issues raised in the appellant brief to which the respondent brief is directed," and (2) 37 CFR 41.68(a)(4) states "[a] requester's respondent brief may not address any brief of any other requester."[1]

Patent owner further argues that Rambus's appeal brief addresses rejections raised by both Samsung and Micron because the Office merged the Micron initiated reexamination proceeding (the '1112 proceeding) with the Samsung initiated reexamination proceeding (the '183 proceeding), and that merger of the two proceedings should "neither expand Micron's reexamination rights nor allow Micron to address rejections in its respondent brief that it did not previously propose and that it could not have addressed if the Office had not merged the reexamination proceeding."[2] Patent owner specifically requests that "the Office should strike Sections VII.A-VII.E at pages 1-25 and Section VII.G at pages 29-31 of Micron's Respondent Brief"[3] that address the "six Samsung-proposed rejections – anticipation rejections based on *iAPX* and *Budde*, obviousness rejections over *iAPX* or *Budde* in view of *Inagaki*, and obviousness rejections of *iAPX* or *Budde* in view of *Lofgren*."[4]

Patent owner further argues that "[b]y appealing and addressing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second reexamination of the '184 patent."[5]

Finally, patent owner cites to two specific Board decisions, to support its present request. Patent owner argues that "[t]he Board had indicated that that [sic] a requester cannot appeal a rejection that it did not propose,"[6] and cites as exemplary decisions to *Meadwestvaco Packaging Sys., LLC v. Patent of C. Brown Lingamfelter*. Appeal No. 2009-002578, 2010 WL 191281 (B.P.A.I. Jan. 12, 2010) and *Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.* Appeal No. 2009-002973, 2010 WL 1064484 (B.P.A.I. Mar. 23, 2010).[7]

II. Analysis and Findings

As pointed out above, patent owner's petition under 37 CFR 1.182/1.183 is taken as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the requester's respondent brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions of the respondent brief. Patent owner is actually asserting that the requester respondent brief was improperly placed of record in the Image File Wrapper (IFW)) for the proceeding, and requesting that it be expunged, with requester being directed to replace the brief by a redacted or revised respondent brief to exclude the portions of the paper argued to be improper.

Patent owner's petition has been fully considered, and not found persuasive. A review of Requester Micron's respondent brief reveals that it does address the six Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1112

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[1] Petition at page 2.
[2] *Id.* at pages 2 and 5.
[3] *Id.* at page 2.
[4] *Id.* at page 6.
[5] *Id.* at page 4.
[6] *Id.*
[7] *Id.*

proceeding). However, these six proposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted the Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Patent owner argues that 37 CFR 41.68(a)(4) limits requester Micron's respondent brief by stating that a requester's respondent brief may not address any brief of any other requester. Such argument is unpersuasive and not on point. 37 CFR 41.68(a)(4) is directed to filing a respondent brief in response to the brief of the other requester (in this case, Samsung), which was not filed in the instant proceeding. Rather, Micron's respondent brief is a respondent brief in response to the brief of the patent owner.

Patent owner argues that MPEP 2675.02 states that the respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. This does not support patent owner's position that requester Micron cannot address issues raised in patent owner's appellant brief, since the examiner's adopted rejections (originally proposed by Samsung) are addressed by patent owner's appellant brief, and Micron's respondent brief is entitled to then address what patent owner's appellant brief said about those rejections.

Patent owner presents arguments that the Board has indicated, in its decisions, that a requester cannot appeal a rejection that it did not propose. These arguments again are not on point, since requester Micron's respondent brief is addressing patent owner's argument as to the rejection the Office has adopted, as its own, and requester is not appealing a rejection that it did not propose. A third party requester may comment on an issue that has been adopted by the examiner and raised in patent owner's appeal brief, as the proposed rejections that are adopted become the examiner's rejections in the reexamination proceeding. Furthermore, 35 U.S.C. § 315(b)(2) states that a requester may be a party to any appeal taken by the patent owner and the statute does not provide the extent of the party.

Patent owner argues that requester Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '184 patent by addressing issues not raised in its request. This argument is not persuasive. First, the issues addressed by Micron are already part of the present reexamination proceeding, as discussed above. Second, this argument does not relate to the propriety of the issues raised in requester Micron's respondent brief, based on the statute, regulations, and practice.

Since requester Micron's respondent brief is limited to addressing issues raised in the patent owner's appellant brief that have been adopted by the examiner, the issues raised in requester Micron's respondent brief are not improper. Accordingly, patent owner's July 2, 2010 petition is dismissed.

CONCLUSION

1. Patent owner's July 2, 2010 petition to strike portions of Requester Micron's respondent brief is **dismissed**.

3. Any questions concerning this communication should be directed to the undersigned at (571) 272-3838.

Gregory Morse
Director
Central Reexamination Unit

8-31-10
KenAppeal/decisions/entry issues

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed June 2, 2010 ("Petition"), and Third Party Requester Micron Technology, Inc's. "Third Party Requester's Opposition to Patent Owner's Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed July 26, 2010 ("Opposition").

In the Petition, Patent Owner seeks to have stricken "those portions of [Third Party Requester] Micron's appeal brief that raise issues that Micron did not propose in its request for reexamination and that are not part of the Micron-initiated reexamination proceeding (control no. 95/001,112 . . .)." Petition, p. 1.

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

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief along with the present Petition.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On July 26, 2010, Micron filed the present Opposition.

RELEVANT AUTHORITY

Concerning the contents of appeal briefs, 37 C.F.R. §§ 41.67(c)(1)(vi) and (vii) provide:

> (vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. . . .
>
> (vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on.

ANALYSIS

In the Petition, Rambus argues that:

> Samsung is not appealing, yet, relying on the merger as its only alleged basis for doing so, Micron continues to address issues raised only in Samsung's request for reexamination. Rambus, therefore requests that those portions of Micron's appeal brief that are not directed to issues raised in Micron's request for reexamination be stricken.

Petition, p. 4.

In the Opposition, Micron argues that:

> The statutory and regulatory language do not require the requester to have proposed the rejection sought on appeal, but instead merely require the appealed decision to have been favorable to patentability.

Opposition, p. 3.

In this merged proceeding, this issue previously was addressed in the Decision Dismissing Patent Owner's Petition to Strike Portions of Requester's Respondent Brief of September 7, 2010:

> A review of Requester Micron's respondent brief reveals that [it] does address the six Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1112 proceeding). However, these six proposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted the Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Decision, p. 6.

DECISION

For the forgoing reason, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Appeal Brief," filed June 10, 2010 ("Respondent Brief Petition"), and "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Rebuttal Brief," filed October 25, 2010 ("Rebuttal Brief Petition"). In the Respondent Brief Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 22 pages and 11,860 words in length." Respondent Brief Petition, p. 1. In the Rebuttal Brief Petition, Patent Owner requests "that the Office accept its rebuttal brief, which is 21 pages and 11,681 words in length." Rebuttal Brief Petition, p. 1.

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

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29. The ACP is 142 pages in length.

8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29. The RAN is 196 pages in length.

11. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief along with the present Respondent Brief Petition.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On September 24, 2010, the Examiner entered an Examiner's Answer.

19. On October 25, 2010, Rambus filed a Rebuttal Brief along with the present Rubuttal Brief Petition.

20. Also on October 25, 2010, Micron filed a Rebuttal Brief.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

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

On papers filed by the patent owner in an *inter partes* reexamination proceeding, MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

Rambus argues that the requested waivers are needed so that it can comprehensively reply to the rejections arising out of both reexamination proceedings. Respondent Brief Petition, pp. 1-2; Rebuttal Brief Petition, p. 1-2.

Rambus also represents that it has "made every effort to pare down the arguments" in its respective Respondent and Rebuttal Briefs. Respondent Brief Petition, p. 3; Rebuttal Brief Petition, p. 4.

Rambus further contends that by merging both reexamination proceedings into a single merged proceeding, it is constrained by the page limitation of a single brief (respondent and rebuttal) instead of two briefs if the proceedings were conducted separately. Respondent Brief Petition, p. 2; Rebuttal Brief Petition, p. 4-5.

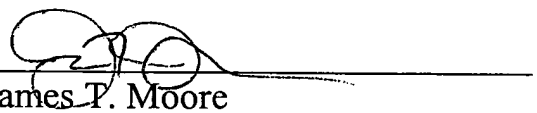
Also, Rambus contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights," Respondent Brief Petition, p. 2, and "unfairly burden the patent owner's ability to defend its property rights," Rebuttal Brief Petition, p. 5.

It is noted that the ACP of August 21, 2009 is 142 pages in length and the RAN of January 29, 2010 is 196 pages in length.

In view of the number of different issues presented in this merged reexamination proceeding, Rambus's requests to file a Respondent Brief having a length of 22 pages and 11,860 words and a Rebuttal Brief having a length of 21 pages and 11,681 words are deemed reasonable. This conclusion is reached without considering Rambus's due process arguments.

DECISION

In view of the forgoing, the Respondent Brief Petition and Rebuttal Brief Petition are both GRANTED.



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Inter partes Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,183	08/24/2007	6182184	38512.5	2395

22852 7590 02/23/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third Party Requester's Rebuttal Brief," filed December 27, 2010 ("Rebuttal Brief Petition"); and Requester Micron's "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Rebuttal Brief," filed January 18, 2011 ("Rebuttal Brief Opposition"). In the Rebuttal Brief Petition, Patent Owner "requests that the Office expunge Micron's rebuttal brief because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,112 . . .)." Rebuttal Brief Petition, p. 1.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 22, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

9. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

10. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

11. On March 10, 2010, Micron filed a Notice of Cross Appeal for claims 13-14.

12. On May 10, 2010, Rambus filed an Appeal Brief.

13. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

14. On June 10, 2010, Rambus filed a Respondent Brief.

15. Also on June 10, 2010, Micron filed a Respondent Brief.

16. On September 24, 2010, the Examiner entered an Examiner's Answer.

17. On October 25, 2010, Rambus filed a Rebuttal Brief.

18. Also on October 25, 2010, Micron filed a Rebuttal Brief.

19. On December 27, 2010, Rambus filed the present Petition.

20. On January 18, 2011, Micron filed the present Opposition.

RELEVANT AUTHORITY

With respect to the contents of a rebuttal brief filed by a requester, 37 C.F.R. § 41.71(c) provides:

> (c) (1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.
> (2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.
> (3) No new ground of rejection can be proposed by a requester.

See also MPEP § 2678.

ANALYSIS

The parties do not contest that the relevant patentability issues were first presented by Requester Samsung in the Samsung-initiated proceeding. Those issues have been discussed in Micron's Appellant Brief, Rambus's Respondent Brief and Micron's Rebuttal Brief.

In a Petition filed June 2, 2010, Rambus sought to have stricken "those portions of Micron's appeal brief that raise issues that Micron did not propose in its request for reexamination." Appeal Brief Petition, p. 1. The Appeal Brief petition was denied in a Decision on Petition issued November 18, 2010.

In seeking expungement of Micron's Rebuttal Brief, Rambus relies on the same arguments as it did in the Appeal Brief Petition. Rambus does not contend that Micron's Rebuttal Brief does not comply with 37 C.F.R § 41.71(c), quoted above.

There are two dispositive factors to be considered here. First, during prosecution, the Examiner, i.e., the Office, has considered and taken a position on the patentability issues proposed by both Samsung and Micron. Those issues may be addressed by all parties in this merged proceeding.

Second, Rambus relies on MPEP § 2674, which states:

> 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.

(emphasis in original).

The focus of this passage is that on appeal, a requester can address only rejections previously proposed during prosecution and cannot address a rejection first proposed on appeal. Here there is no disagreement that the issues addressed in Micron's Rebuttal Brief were first proposed during prosecution, albeit by Samsung.

DECISION

In view of the forgoing, the Rebuttal Brief Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,183	08/24/2007	6182184	38512.5	2395

22852 7590 04/15/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on Patent Owner Rambus Inc.'s "Petition for Reconsideration of Decision Denying Patent Owner's Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed December 20, 2010 ("Recon Petition"), and Third Party Requester Micron Technology, Inc's. "Third Party Requester's Opposition to Patent Owner's Petition for Reconsideration of Decision Denying Patent Owner's Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed January 5, 2011 ("Recon Opposition").

In the Recon Petition, Patent Owner again requests that "the Office expunge from the record those portions of Micron's appeal brief that raise

issues that Micron did not propose in its reexamination request," citing the Decision on Petition on a similar issue in Merged Reexamination Proceeding 95/001,026 and 95/001,128. Recon Petition, p. 1.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

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8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross-Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief along with an initial Petition seeking expungement of portions of Micron's Cross-Appeal Brief.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On July 26, 2010, Micron filed an Opposition to Rambus's initial Petition.

19. On November 19, 2010, the Office entered a Decision on Petition denying Rambus's initial Petition.

20. On December 20, 2010, Rambus filed the present Recon Petition.

21. On January 5, 2011, Micron filed the present Recon Opposition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

Also relevant is MPEP § 2674(B):

> 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.

(emphasis in original).

ANALYSIS

The Board confirms that the relevant statutes, rules and MPEP sections quoted above are intended to include all proposed rejections presented by the Examiner, patent owner or requester(s) during prosecution of a single unmerged reexamination proceeding or plural merged reexamination proceedings.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the following language of that section:

> 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.*

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

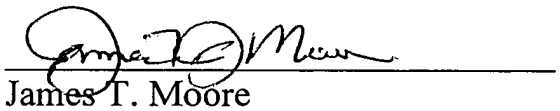
Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

As the parties undoubtedly are aware, in the Merged Reexamination Proceeding 95/001,026 and 95/001,128, the Board reversed its initial

holding on this issue and denied Rambus's petition to expunge Micron's Cross-Appeal Brief. See Decision on Petition, February 16, 2011.

DECISION

For the forgoing reason, the Recon Petition is DENIED. This Decision constitutes final agency action on this matter.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,183	08/24/2007	6182184	38512.5	2395

22852 7590 04/27/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/27/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on:

1. Patent Owner Rambus Inc.'s ("Rambus") "Petition Seeking Review of Decision Dismissing Patent Owner's Petition to Strike Portions of Third Party Requester's Respondent Brief," filed October 15, 2010 ("Respondent Brief Recon Petition"), and Third Party Requester Micron Technology, Inc's. ("Micron") "Third Party Requester's Opposition to Patent Owner's Petition Seeking Review of Decision Dismissing Patent Owner's Petition to Strike Portions of Third Party Requester's Respondent Brief," filed January 5, 2011 ("Respondent Brief Recon Opposition"); and

2. Rambus's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Rebuttal Brief," filed March 23, 2011 (Rebuttal Brief Recon Petition).

In the Respondent Brief Recon Petition and Rebuttal Brief Recon Petition, Rambus requests that the Office expunge Micron's Respondent Brief and Rebuttal Brief, respectively, because the briefs address issues that initially were raised in the reexamination request of Requester Samsung Electronics Co., Ltd. ("Samsung") and not by Micron. Respondent Brief Recon Petition, pp. 1-2, Rebuttal Brief Recon Petition, pp. 1-2.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus.

2. Third Party Requester Samsung filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross-Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief and a Petition seeking expungement of portions of Micron's Cross-Appeal Brief.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On July 2, 2010, Rambus filed a Petition seeking expungement of portions of Micron's Respondent Brief.

19. On July 26, 2010, Micron filed an Opposition to Rambus's Appeal Brief Petition.

20. On September 7, 2010, the Office entered a Decision on Petition denying Rambus's Respondent Brief Petition.

21. On October 15, 2010, Rambus filed a Petition seeking reconsideration of the Office's Decision denying Rambus's Respondent Brief Petition.

22. On October 25, 2010, Rambus filed a Rebuttal brief.

23. Also on October 25, 2010, Micron filed a Rebuttal Brief.

24. On November 19, 2010, the Office entered a Decision denying Rambus's Appeal Brief Petition.

25. On December 20, 2010, Rambus filed a Petition seeking reconsideration of the Office's Decision denying Rambus's Appeal Brief Petition.

26. On December 27, 2010, Rambus filed a Petition seeking expungement of Micron's Rebuttal Brief.

27. On January 5, 2011, Micron filed an Opposition to Rambus's Petition seeking reconsideration of the Office's Decision denying Rambus's Appeal Brief Petition.

28. Also on January 5, 2011, Micron filed an Opposition to Rambus's Petition seeking reconsideration of the Office's Decision denying Rambus's Respondent Brief Petition.

29. On January 18, 2011, Micron filed an Opposition to Rambus's Rebuttal Brief Petition.

30. On February 23, 2011, the Office entered a Decision denying Rambus's Rebuttal Brief Petition.

31. On March 23, 2011, Rambus filed a petition seeking reconsideration of the Office's Decision denying Rambus's Rebuttal Brief Petition.

32. On April 15, 2011, the Office entered a Decision denying Rambus's Petition seeking reconsideration of the Decision denying Rambus's Appeal Brief Petition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent . . . .*

(emphasis added).

Similarly, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

Also relevant is MPEP § 2674(B):

> 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.

(emphasis in original).

In respect to merged reexamination proceedings, MPEP § 2686.01 III provides:

> A decision to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses/comments by the patent owner and the third party requester(s) must consist of a single response/comment paper, addressed to both files, filed in duplicate each bearing a signature, for entry in both files.

ANALYSIS

The Board confirms that the relevant statutes, rules and MPEP sections quoted above are intended to include all proposed rejections presented by the Examiner, patent owner or requester(s) during prosecution of a merged reexamination proceeding.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the following language of that section:

> 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.*

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of

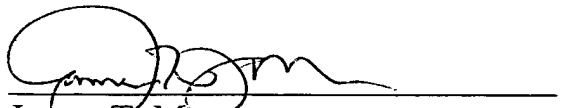
rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

Also noteworthy is the requirement in MPEP § 2686.01 III that in a merged proceeding, the parties are required to address a single set of claims and submit identical responses in all merged reexamination proceeding files. Thus, all rejections adopted or rejected by the Examiner, whether originating from the Examiner or a requester, are before all of the requesters.

As the parties undoubtedly are aware, in the present merged proceeding, on April 15, 2011, the Board reached a similar result on a Rambus Petition for reconsideration seeking expungement of portions of Micron's Appeal Brief. Also, in Merged Reexamination Proceeding 95/001,026 and 95/001,128, on February 16, 2011, the Board reversed its initial position on this issue and denied Rambus's Petition to expunge Micron's Cross-Appeal Brief.

DECISION

In view of the foregoing, Rambus's Respondent Brief Recon Petition and Rebuttal Brief Recon Petition are DENIED. This Decision constitutes Final Agency Action on these matters.



James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,184	11/21/2006	6938709	NOV-15:RE	4556

21897 7590 11/09/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/09/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

GARY L BUSH
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600 TRAVIS, SUITE 4200
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000184
PATENT NO. : 6938709
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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MAILED

NOV 0 9 2010

CENTRAL REEXAMINATION UNIT

Gary L. Bush (For Requester)
Andrews Kurth LLP
600 Travis
Suite 4200
Houston, TX 77002

In re Daniel Juhasz et al. :
Inter Partes Reexamination Proceeding : **DECISION DISMISSING**
Control No. 95/000,184 : **PETITION UNDER**
Filed: November 21, 2006 : **37 CFR 1.137(b)**
For: U.S. Patent No. 6,938,709 :

This is a decision on the May 6, 2010 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late Patent Owner's Amended Replacement Brief in the above-identified reexamination proceeding ("the May 6, 2010 patent owner petition").

The May 6, 2010 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 6, 2010 patent owner petition is **dismissed**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

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

*

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, ***a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c)***, or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and ***abandoned for failure to prosecute***, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

37 CFR 1.953(c) provides:

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

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

*

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

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

*

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

MPEP 711.03(c)(II)(A)(2) provides, in pertinent part:

(b) A reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

*
*
*

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.

*

(c) In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. PETITION REQUIREMENTS

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

MPEP 2675 provides, in pertinent part:

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the May 6, 2010 petition does not require a terminal disclaimer.[1]

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

The May 6, 2010 petition satisfies only two of the three criteria required under 37 CFR 1.137(b).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 6, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), however, the criterion of submitting the requisite response required by the May 5, 2009 Right of Appeal Notice (RAN) has not been satisfied.

Specifically, the prosecution of the instant *inter partes* reexamination proceeding was terminated within the meaning of 37 CFR 1.957(b) due to patent owner's failure to timely submit a proper response under 37 CFR 1.953(c) to the May 5, 2009 RAN. Although patent owner timely filed a Notice of Appeal on June 5, 2009, patent owner's subsequent briefs have been found to be non-compliant, and patent owner failed to timely file a corrected appellant's brief in response to the February 5, 2010 Inter Partes Reexamination Notification re Brief.

In an *inter partes* reexamination proceeding terminated for failure to timely file an appellant brief, the response required for consideration of a petition to revive must be the appellant brief. Patent owner submitted a paper titled "Patent Owner's Amended Replacement Brief" on May 6, 2010. The Board of Patent Appeals and Interferences (BPAI) has confirmed that the May 6, 2010 replacement brief is defective. A notice of non-compliance regarding the May 6, 2010 replacement brief is being issued by the BPAI concurrently with this decision. Therefore, the May 6, 2010 petition is incomplete.

For the foregoing reasons, the May 6, 2010 patent owner petition to revive is **dismissed**.

ADDITIONAL DISCUSSION

The filing of a proper appellant brief is the required "reply" within the meaning of 37 CFR 1.137. In this regard, 35 U.S.C. 133 provides that an application becomes abandoned (terminated) for "failure ... to prosecute the application ...." 37 CFR 1.137 is the regulation that provides a remedy for a failure to prosecute.[2] 35 U.S.C. 314(a) incorporates the provisions of 35 U.S.C. 133 into the *inter partes* reexamination statute, to apply those provisions to *inter partes* reexamination proceedings. The instant *inter partes* reexamination proceeding has become terminated for failure to timely file an appellant brief,[3] and this has resulted in termination of the prosecution for failure to

[2] *See*: MPEP 711.03(c)(II)(A)(2)(b) and (c).
[3] MPEP 2675 establishes that the failure to timely file an appellant brief leads to termination of the prosecution.

prosecute; thus, it is clear from 35 U.S.C. 133 that a petition for revival may be filed, to remedy that failure to prosecute. 37 CFR 1.137 provides the regulatory procedure to revive. 37 CFR 1.137(c) defines the reply (termed a "response" in reexamination) required for a petition to revive as an element of the 37 CFR 1.137 remedy "for a failure to prosecute." A proper appellant brief provides the required response (reply) that addresses the failure to prosecute, since it was the patent owner's failure to timely file a proper appellant brief that was the failure to prosecute.

Accordingly, the Office has authority and jurisdiction to apply 37 CFR 1.137 in instances where the required reply under 37 CFR 1.137(b)(1) is patent owner's appellant brief in an *inter partes* reexamination proceeding.

CONCLUSION

1. The May 6, 2010 patent owner petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Patent Owner's Amended Replacement Brief is **dismissed**.

2. For a grantable petition under 37 CFR 1.137(b), it is required that patent owner provide a compliant appellant brief. Any such submission(s) should include a cover letter titled "Renewed Petition Under 37 CFR 1.137(b)."

3. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested only under 37 CFR 1.956; extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter titled "Renewed Petition under 37 CFR 1.137(b)."

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

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

November 4, 2010
Kenpet-ab/IP reexam

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,184	11/21/2006	6938709	NOV-15:RE	4556

21897 7590 11/02/2011
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SUITE 700
HOUSTON, TX 77057

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/02/2011

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ANDREWS KURTH LLP
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Date:

MAILED

NOV 02 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000184
PATENT NO. : 6938709
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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The Matthews Firm
2000 Bering Drive
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Houston, TX 77057

(For Patent Owner)

MAILED

NOV 02 2011

CENTRAL REEXAMINATION UNIT

Gary L. Bush
Andrews Kurth LLP
600 Travis
Suite 4200
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(For Requester)

In re Daniel Juhasz et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,184
Filed: November 21, 2006
For: U.S. Patent No. 6,938,709

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

This is a decision on the December 9, 2010 patent owner renewed petition under 37 CFR 1.137(b) to accept patent owner's late Patent Owner's Appeal Brief in the above-identified reexamination proceeding ("the December 9, 2010 patent owner renewed petition").

The December 9, 2010 patent owner renewed petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 9, 2010 patent owner renewed petition is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 314(a) provides, in pertinent part:

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

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

*

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, ***a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c)***, or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and ***abandoned for failure to prosecute***, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

37 CFR 1.953(c) provides:

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

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

*

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

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

*

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

37 CFR 41.66(a) provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

MPEP 711.03(c)(II)(A)(2) provides, in pertinent part:

(b) A reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

*
*
*

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.

*

(c) In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).
*
*
IV. PETITION REQUIREMENTS

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

MPEP 2675 provides, in pertinent part:

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

DECISION

The Renewed 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, a terminal disclaimer is not required.[1]

Patent owner's May 6, 2010 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late Patent Owner's Amended Replacement Brief ("the May 6, 2010 patent owner petition") satisfied two of the three criteria required under 37 CFR 1.137(b). Specifically, a petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the May 6, 2010 patent owner petition to revive, which satisfied items (2) and (3), respectively. The May 6, 2010 patent owner petition, however, did not satisfy the criterion of submitting the requisite response required by the May 5, 2009 Right of Appeal Notice (RAN). In the November 9, 2010 decision dismissing the May 6, 2010 patent owner petition, patent owner was advised that, for a grantable petition under 37 CFR 1.137(b), patent owner must provide a compliant appellant brief within one month from the November 9th mail date. Patent owner was further advised that the submission of a compliant brief should include a cover letter titled "Renewed Petition Under 37 CFR 1.137(b)."

Patent owner's December 9, 2010 renewed petition included a Patent Owner's Appeal Brief that has been found to be in compliance with the regulations by the Board of Patent Appeals and Interferences (BPAI). In addition, patent owner's December 9, 2010 renewed petition was filed within one month of the November 9, 2010 decision and included a cover letter titled "Renewed Petition Under 37 CFR 1.137(b)."

Accordingly, the December 9, 2010 patent owner renewed petition to revive is **granted**.

CONCLUSION

1. The December 9, 2010 patent owner renewed petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Patent Owner's Appeal Brief is **granted**.

---

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

2. Patent owner's December 9, 2010 appellant's brief is hereby entered in the record, thus triggering a respondent's brief right for third party requester under 37 CFR 41.68. Accordingly, third party requester may file a respondent's brief as per 37 CFR 41.66(b) within one month of the mailing date of this decision.

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

November 1, 2011

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,196	01/26/2007	6521831	IE-831	3931

30010 7590 03/08/2011

The Jackson Patent Group
1500 Forest Avenue, Suite 212
RICHMOND, VA 23229

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/08/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Michael J. Strauss
Morrison & Foerster LLP
1650 Tysons Blvd, Suite 400
McLean, VA 22102

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

REEXAMINATION CONTROL NUMBER *95/000,196*.

PATENT NUMBER *6,521,831 B1*.

TECHNOLOGY CENTER *3999*.

ART UNIT *3993*.

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

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

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

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

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CENTRAL REEXAMINATION UNIT

The Jackson Patent Group
1500 Forest Avenue, Suite 212
Richmond, VA 23229

(For Patent Owner)

Michael J. Strauss
Morrison & Foerster LLP
1650 Tysons Blvd., Suite 400
McLean, VA 22102

(For Third Party Requester)

In re Gretz	: DECISION
Reexamination Proceeding	: ON
Control No. : 95/000,196	: REQUESTER'S
Filed: January 26, 2007	: PETITION
Patent No. 6,521,831	: UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed September 13, 2010, under 37 CFR 1.181 to vacate the August 16, 2010 Notification Re Brief.

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

SUMMARY

Third Party Requester's petition is DISMISSED as premature for the reasons set forth below, without consideration of the merits.

BRIEF STATEMENT OF RELEVANT FACTS

1. Patent No. 6,521,831 (the '831 patent) issued on February 18, 2003.

2. A request for reexamination, assigned Control No. 95/000,196 (the '196 proceeding), was filed by a third party Requester on January 26, 2007.

3. Reexamination was ordered in the '196 reexamination proceeding on April 13, 2007.

4. An Office action on the merits was mailed on April 14, 2008.

5. An Action Closing Prosecution (ACP) was mailed on January 14, 2009. The ACP confirmed the patentability of claims 3 and 4 and rejected claims 1, 2, 5 and 6.

6. On August 14, 2009, a Right of Appeal Notice (RAN) was mailed. The RAN again confirmed the patentability of claims 3 and 4 and rejected claims 1, 2, 5 and 6.

7. On September 9, 2009, the Patent Owner filed a Notice of Appeal.

8. On September 23, 2009, the Third Party Requester filed a Notice of Cross Appeal.

9. On November 23, 2009, both the Patent Owner and the Third Party Requester filed an Appeal Brief.

10. On June 4, 2010, a Notice of Defective Brief was mailed.

11. On August 16, 2010, a second Notice of Defective Brief was mailed, clarifying a point regarding the rejection under Ground Q.

12. On September 13, 2010, the Third Party Requester filed the instant petition.

13. On September 20, 2010, Patent Owner filed an amended brief as well as an amendment canceling claim 2.

DISCUSSION

The Third Party Requester (petitioner) requests the Office to vacate the Notice of Defective Brief mailed August 16, 2010. The petitioner argues that Notice was issued in error because the Appellant Brief was not defective for the reason provided by the examiner. Petitioner argues that Ground Q is a rejection for claim 2 only, not claims 1 and 2 as stated by the examiner in the August 16, 2010 Notification re Brief. Petitioner then argues that the Patent Owner should not be permitted to file a third brief and the Requester should not be put to the burden of filing a third response.

The request to vacate the Notice of Defective Brief mailed August 16, 2010 is dismissed as premature.

DECISION

The petitioner brings before the Office a petition under 37 CFR § 1.181 to vacate the Notification Re Brief mailed August 16, 2010. The petitioner filed the petition on September 13, 2010. Patent Owner filed a response to the Notification Re Brief on September 20, 2010 that includes a request to cancel claim 2. The Ground Q rejection as issue involves a rejection of claim 2. However, there has been no decision by the examiner to either enter or not enter the proposed cancellation of claim 2. Accordingly, it is premature to invoke supervisory authority regarding vacature of the Notification re Brief mailed August 16, 2010, because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed. It should further be noted that, should the examiner decide to enter the request to cancel claim 2, Third Party Requester's petition would be moot, as the Ground Q rejection would be rendered moot.

CONCLUSION

1. The petition dated August 16, 2010 is dismissed as premature.

2. 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.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,202	01/17/2007	6329636	ITW8637R	9797

23721 7590 09/15/2011

GEORGE R. CORRIGAN
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2168 COLLADAY POINT DRIVE
STOUGHTON, WI 53589

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes The Lincoln Electric Company
v.
Illinois Tool Works, Inc.

Reexamination Control No. 95/000,202
Patent 6,329,636
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Pursuant to § 41.3," filed July 15, 2011(petition). Petitioner requests that the drawing and explanation attached to the petition be entered into the record in this appeal. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's credit card on July 18, 2011.

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FINDINGS

1. On January 17, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,329,636, which was assigned Control No. 95/000,202.
2. On April 10, 2007, reexamination was ordered and a non-final action was mailed.
3. Prosecution was conducted and on July 2, 2009, a Right of Appeal Notice was mailed.
4. Patent owner filed a Notice of Appeal on August 3, 2009.
5. Patent owner filed an appellant brief on October 5, 2009.
6. Third party requester filed a respondent brief on November 5, 2009.
7. ~~On July 14, 2010, an examiner's answer was mailed.~~
8. Patent owner filed a rebuttal brief on August 13, 2010.
9. Patent owner filed a request for oral hearing on September 14, 2010.
10. On March 2, 2011, the appeal was docketed.
11. On March 30, 2011, a notification of appeal hearing was mailed.
11. The oral hearing was conducted on July 6, 2011.
12. Requester filed the present petition on July 15, 2011.

DISCUSSION

Patent owner's petition requests that the drawing and explanation attached to the petition be entered into the record in this appeal.

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RELEVANT AUTHORITY

37 C.F.R. § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

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ANALYSIS

Patent owner's petition has been considered fully. Petitioner explains that the drawing and explanation show the circuit elements that perform the function of "converting the dc second signal into control power," as recited in claim 21, and are submitted in response to questions raised by the Board during the oral hearing. Petitioner states that patent owner's counsel was unable to identify the circuit elements in order to answer the questions at the oral hearing. Petitioner urges that entering the drawing and explanation will allow the Board to fully consider the issue relating to Claims 21-24, serve the interest of justice, provide information sought by the Board, and does not prejudice the third party requester.

The petition is **granted**. The drawing and explanation are entered as arguments for consideration in the appeal before the Board.

DECISION

In view of the foregoing, the petition is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/000,202
Patent No. 6,329,636

Counsel for Patent Owner:
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Counsel for Third Party Requester:
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PERKINS COIE LLP
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Washington, DC 20005-2003

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Ranjana Kadle
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(For Third Party Requester)

In re Reissue Application of
LAKS *et al.*
Application No.: 11/390,537
Filed: March 28, 2006
For: U.S. Patent No. 6,753,035

In re LAKS *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,206
Filed: December 13, 2006
For: U.S. Patent No.: 6,753,035

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

This decision is supplemental to the Office's prior corrected merger decision mailed May 1, 2008, which *sua sponte* merged reissue application No. 11/390,537 and reexamination control No. 95/000,206 into a single proceeding.

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

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then the merged proceeding will be automatically severed, and the reissue application will then be suspended.

Patent owner is put on notice that, in such event, a request for continued examination (RCE) is not available in the 95/000,206 reexamination proceeding, and any response

to the outstanding Office action (e.g., response to an action closing prosecution (ACP) or 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 1.957(b) or "limitation" of the proceeding pursuant to 37 CFR 1.957(c), whichever of the two is appropriate. 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. In the event of limitation, a Right of Appeal Notice (RAN) will be issued providing the third party requestor with the opportunity to appeal with respect to all claims which have been found patentable.

In addition, if an action closing prosecution (ACP) should be issued subsequent to the mail date of this decision in this merged proceeding, then any request for extension for time (to file a submission as to any such subsequent ACP) 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 ACP issued in the present merged proceeding subsequent to the mail date of this decision.

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

CONCLUSION

1. Reissue application No. 11/390,537 and reexamination control No. 95/000,206 remain merged as a single proceeding.

2. If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed, and the reissue application will be automatically suspended pursuant to 37 CFR 1.103(e), until the completion of the '206 proceeding by the issuance of the reexamination certificate. Patent owner is put on notice that, in such event, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to an ACP or 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 1.957(b) or "limitation" of the proceeding pursuant to 37 CFR 1.957(c), whichever of the two is appropriate.

   In such event, at the time that a Reexamination Certificate is issued for the '206 reexamination proceeding, the patent owner would be advised to call the issuance of the Certificate to the attention of the Office, and to request a resumption of examination of the reissue application. The patent owner may include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

3. In addition, if an ACP should be issued in this merged proceeding subsequent to the mail date of this decision, then any request for extension for time (to respond to any such subsequent action) must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any ACP issued subsequent to the mail date of this decision.

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

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

/Kenneth M. Schor/

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

12/02/10
Kenpetmerger/sever
Kenpetmerger/IP-reissue

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

COOPER TECHNOLOGIES COMPANY
Patent Owner

THOMAS & BETTS CORP.
Third Party Requester

Inter partes Reexamination Control 95/000,209
Patent 6,984,791

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition to Suspend Rules for Appeal Brief," filed March 30, 2010 ("Appeal Brief Petition"), and "Petition to Suspend Rules for Amended Rebuttal Brief," also filed March 30, 2010 ("Rebuttal Brief Petition").

By the Appeal Brief Petition, Patent Owner seeks a waiver of 37 C.F.R. §§ 41.67(c)(viii) and 1.530(f) relating to the format of claim 27 in the Claims Appendix of the Appeal Brief.

By the Rebuttal Brief Petition, Patent Owner seeks a waiver of 37 C.F.R. §§ 1.943(c) and 41.71 relating to a newly presented issue.

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

FINDINGS

1. Patent 6,984,791 issued on January 10, 2006 with 30 claims. The '791 patent is assigned to Patent Owner Cooper Technologies Company ("Cooper").

2. Third Party Requester Thomas & Betts Corp. ("Thomas & Betts") filed a request for *inter partes* reexamination on December 21, 2006 and a corrected request on January 25, 2007. Reexamination Control 95/000,209 was assigned to this request.

3. On April 13, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-30 of the '791 patent in the '209 proceeding.

4. The proceeding progressed to the point where, on November 1, 2007, the Office mailed an Action Closing Prosecution ("ACP"), rejecting claims 1-30.

5. On June 25, 2008, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-30.

6. On July 25, 2008, Cooper filed a Notice of Appeal for claims 1-30.

7. On October 1, 2008, Cooper filed an Appeal Brief.

8. On March 27, 2009, the Examiner mailed an Examiner's Answer.

9. On April 27, 2009, Cooper filed a Rebuttal Brief.

10. On March 1, 2010, the Examiner mailed an Inter Partes Reexamination Notification re Brief noting that Cooper's Appeal Brief and Rebuttal Brief were defective. The Appeal Brief defect was noted to be that an improper form was used for indicating cancelled text in claim 27 – strikethroughs instead of brackets, as specified by 37 C.F.R. 1.530(f). The Rebuttal Brief defect was noted to be twofold. First, the Examiner contends that the Brief raises issues not present in the Examiner's Answer. Cooper

argues that the new issue arises from a decision of the Federal Circuit Court of Appeals that was issued after the Examiner's Answer was mailed. Second, the Rebuttal Brief exceeds the page limit of 15 pages as specified in 37 C.F.R. § 1.943(c).

11. On March 30, 2010, Cooper filed the Appeal Brief Petition seeking a waiver under 37 C.F.R. § 1.183 of the form requirements of Rule 1.530(f), or a waiver of all form and length requirements for the Appeal Brief. By a Decision on Petition mailed December 8, 2008, Cooper already has been granted a waiver on the page limitation of the Appeal Brief.

12. With the Rebuttal Brief Petition, Cooper filed an Amended Rebuttal Brief having a length that is within the 15 page limit of Rule 1.943(c).

RELEVANT AUTHORITY

With respect to the propriety of raising new issues in a rebuttal brief, MPEP § 2679 specifies:

> If the examiner determines that the rebuttal brief . . . (B) is not limited to the issues raised in the examiner's answer or the respondent brief; the examiner may *refuse* entry of the rebuttal brief.

(emphasis in original).

ANALYSIS

Appeal Brief Petition

As indicated, the Office already has granted Cooper a waiver on the length of the Appeal Brief.

In respect to the improper format of the canceled subject matter in the text of claim 27 – strikethroughs instead of brackets, there is no confusion or doubt about the intended text of the claim as so amended. No useful purpose

would be served by requiring Cooper to re-file the Brief solely to correct this error.

Rebuttal Brief Petition

As stated above, Cooper's Amended Rebuttal Brief satisfies the page limitation of Rule 1.943(c). Thus, this issue is moot.

As indicated by the quote from MPEP § 2679 above, the question of if, and under what circumstances a new issue may be presented in a rebuttal brief is discretionary. This is an issue that is best resolved by the panel that will decide the appeal in this reexamination proceeding. The panel can consider or ignore the new issue as it deems appropriate. That is particularly true where, as here, the new issue apparently arises from a recent court decision.

DECISION

Appeal Brief Petition

The Petition to waive the requirement of Rule 1.530(f) in respect to the format of the cancelled text in claim 27 in the Claims Appendix of the Appeal Brief is GRANTED.

Rebuttal Brief Petition

The Petition to allow Cooper to present a new issue in the Rebuttal Brief is DEFERRED to the panel that will decide this appeal.

All other issues raised in the Appeal Brief and Rebuttal Brief Petitions have already been decided or are moot.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner Cooper Technologies Company:
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Larson Newman & Abel, LLP
5914 West Courtyard Drive, Suite 200
Austin, TX 78730

Counsel for Third Party Requester Thomas & Betts Corp.:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	RTC-2007-0246	8587

34456 7590 04/19/2011

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AUSTIN, TX 78730

EXAMINER

ART UNIT	PAPER NUMBER

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Kevin W. Jakel
KAYE SCHOLER LLP
901 Fifteenth Street, N.W. SUITE 1100
Washington, DC 20005

Date: MAILED
APR 19 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000209
PATENT NO. : 6984791
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

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MAILED
APR 19 2011
CENTRAL REEXAMINATION UNIT

(For Requester)

Kevin W. Jakel
Kaye Scholer LLP
901 Fifteenth Street, NW, Suite 1100
Washington, DC 20005

In re: Meyer *et alia*	:
Reexamination Proceeding	: **DECISION**
Control No. 95/000, 209	: **ON**
Corrected Request Deposited: January 25, 2007	: **PETITIONS**
For: U.S. Patent No. 6,984,791	:

The *inter partes* reexamination is before the Central Reexamination Unit to address the June 15, 2009 patent owner (PO) paper entitled "PETITION TO REOPEN PROSECUTION" and the August 18, 2009 PO paper entitled "PETITION TO REOPEN PROSECUTION – SUPPLEMENTAL PAPER".

The June 15, 2009 paper requests the following relief under 37 CFR 1.181 or 1.182 or 1.183:

> "(1) determine which documents in the present reexamination qualify as printed publications under 35 U.S.C. § 102(b), (2) allow the Patent Owner to submit publicly available information from the lawsuit and another reexamination and require the Examiner to consider such information, (3) allow the Patent Owner an opportunity to respond to any rejections or issues raised by the Examiner before prosecution is re-closed, and (4) carefully consider any other information or issues that are deemed to be material to the claims involved in the present reexamination."

In the August 18, 2009 paper, "the Patent Owner requests that the Petition to Reopen Prosecution filed on June 15, 2009, be decided under the provisions of 37 CFR. § 1.181, and not under the provisions of 37 C.F.R § 1.182 or 1.183, in order to comply more fully with 37 C.F.R. § 1.4(c)".

As noted by petitioner in the August 18, 2009 paper, the petition of June 15, 2009 is properly dismissed under 37 CFR 1.4(c) and not addressed under plural provisions of 37 CFR. The office will consider the merits of the June 15, 2009 under 37 CFR 1.181 only (consistent with petitioner's request of August 18, 2009), thus rendering the August 18, 2009 petition as moot.

Turning to the substance of the June 15, 2009 petition,

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

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

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

Initially, it is noted that the documents in question were first applied in the non-final rejection mailed April 13, 2007, and were continued to be applied in the Action Closing Prosecution (ACP) of November 1, 2007 and the Right of Appeal Notice (RAN) of June 25, 2008. So, action of the examiner at issue (i.e. that the examiner considered the documents to be available as prior art) was first made on April 13, 2007 and later on November 1, 2007 and June 25, 2008.

Additionally, the question of whether the documents qualify as printed publications under 35 USC 102(b) is squarely subject to appeal to the Board of Patent Appeals and Interferences. It should be noted that this decision does not address the merits of the rejection.

So, petitioning the examiner's rejection based on the examiner's use of the documents as prior art under 35 USC 102(b) is at odds with both 37 CFR 1.181(a)(1) and 37 CFR 1.181(f).

The other requested relief is ancillary to this issue or, in the alternative, can only be considered (under 37 CFR 1.181) as a request to withdraw either the ACP or the RAN as premature. However, petitioner does not point to any error in the examiner's decision to close prosecution on November 1, 2007 or issue a RAN on June 25, 2008.

Thus, the petition of June 15, 2009 is **dismissed**.

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

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

Irem Yucel
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,209	01/25/2007	6984791	RTC-2007-0246	8587

13897 7590 01/10/2012

Abel Law Group, LLP
7300 FM 2222
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Austin, TX 78730

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/10/2012

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Kevin W. Jakel
KAYE SCHOLER LLP
901 Fifteenth Street, N.W. SUITE 1100
Washington, DC 20005

Date: **MAILED**

JAN 1 0 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000209
PATENT NO. : 6984791
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

George R. Meyer ABEL LAW GROUP, LLP 7300 FM 2222 Building 1, Suite 210 Austin, TX. 78730	:	(For Patent Owner)
Kevin W. Jakel KAYE SCHOLER, LLP 901 15th Street, N.W., Suite 1100 Washington, D.C. 20005	:	(For Third Party Requester)
In re: Meyer et al. *Inter Partes* Reexamination Proceeding Control No.: 95/000,209 For: U.S. Patent No.: 6,984,791	:	DECISION ON PETITION

This is a decision on a petition filed by the Patent Owner: a petition filed on June 15, 2009, entitled "PETITION TO EXPUNGE UNDER 37 C.F.R. § 1.59(b)".

The petition is before the Director of the Central Reexamination Unit. The decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,984,791 issued on January 10, 2006.
- A request for *inter partes* reexamination was January 25, 2007 and assigned control no. 95/000,209.
- *Inter partes* reexamination was ordered on April 13, 2007.
- A Non-Final Office Action was mailed on April 13, 2007.
- The Patent Owner filed a Petition under 37 C.F.R. § 1.59(b) "petition" on June 15, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

DECISION

The Patent Owner ("Petitioner") requests that material (Information Disclosure Statement (IDS)) that is subject to a protective order, submitted in a sealed envelope on June 15, 2009, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.02 will be expunged, **if it is found not to be material to patentability** and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary

material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

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

The petition is premature because the prosecution in the present proceeding has not been terminated, and, a final determination has not yet been made as to whether or not the information requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time. Therefore, based on the above determination the decision on the petition will be **held in abeyance** until the issuance of the Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC) is mailed.

CONCLUSION

1. The petition filed June 15, 2009, is **held in abeyance**.

3. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to Mark J. Reinhart at (571) 272-1611.

Sudhanshu C. Pathak
SPRS, CRU

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,216	01/31/2007	6849827	ITW 7188.62R	1214

23721 7590 09/30/2010
CORRIGAN LAW OFFICE
5 BRIARCLIFF CT
APPLETON, WI 54915

EXAMINER

ART UNIT	PAPER NUMBER

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LINCOLN ELECTRIC COMPANY
PERKINS COIE LLP
607 FOURTHEENTH STREET, NW
WASHINGTON, DC 20005-2003

Date:

MAILED

SEP 30 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000216
PATENT NO. : 6849827
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CORRIGAN LAW OFFICE : (For Patent Owner)
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APPLETON, WI 54915 :

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SEP 30 2010

CENTRAL REEXAMINATION UNIT

LINCOLN ELECTRIC COMPANY : (For Third Party
PERKINS COIE LLP : Requester)
607 FOURTEENTH ST. NW :
WASHINGTON, DC 20005 :

In re: Thommes :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,216 : UNDER 37 CFR § 1.181
Deposited: January 31, 2007 :
For: U.S. Patent No.: 6,849,827 :

This is a decision on a petition filed by the third party requester ["petitioner"] on July 9, 2010, entitled: "REQUESTOR'S PETITION FOR ENTRY OF PREVIOUSLY-EXPUNGED REPLY PURSUANT TO 37 C.F.R. § 1.181" ["the petition"].

The petition is first a request to reconsider a prior petition that was previously dismissed because it was filed pursuant to several different rules. The petition is now modified such that it is only filed pursuant to rule 1.181, and therefore is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to enter the third party's comments that were previously expunged from the record as being improper.

The petition is before the Director of the Central Reexamination Unit. The petition is granted to the extent it is considered, but as to the merits it is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,849,827 issued on February 1, 2005.
- A request for *inter partes* reexamination was filed on January 31, 2007 and assigned control no. 95/000,216.
- *Inter partes* reexamination was ordered and prosecution progressed through several stages. Relevant to the instant petition, an Office action was mailed on May 1, 2009.
- The Office received a timely response to the Office action from the patent owner on June 30, 2009.
- The Office received a timely filing of third party comments to the Office action on July 27, 2009 ["Comments"].
- The Office mailed a Notice of Defective Paper on November 9, 2009, stating the Comments were improper ["Notice"] and giving 15 days to rectify and refile.
- The third party submitted amended comments in response to the Notice on November 24, 2009 ["Amended Comments"].
- On March 3, 2010, the Office issued a decision *sua sponte* expunging from the record the Amended Comments as being an improper paper ["Decision"].
- A petition similar to the instant petition was timely filed on April 14, 2010. It was dismissed on June 30, 2010 under rule 1.4(c) because it was filed in the alternative pursuant to 37 CFR §§ 1.181, 1.182, and 1.183.
- The instant petition was filed July 9, 2010, refiling the above petition under only rule 1.181 and requesting reconsideration of the petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 311 Request for inter partes reexamination (in part)

(b) REQUIREMENTS.- The request shall-

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

37 CFR § 1.915 Content of request for inter partes reexamination (in part)

(b) A request for inter partes reexamination must include the following parts:

(3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

. . .

II. Content

. . .

[W]here a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.<

MPEP § 2617 Statement in the Request Applying Prior Art (in part)

> 35 U.S.C. 311(b)(2) states that the request for *inter partes* reexamination must "set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested." 37 CFR 1.915(b)(3) requires that the request include "[a] statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested."
>
> . . .
>
> For proposed obviousness rejections, requester **must provide** at least one basis for combining the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination. Preferably, the requester should quote the pertinent teachings in the reference, referencing each quote by page, column and line number and any relevant figure numbers. The explanation **must not** lump together the proposed rejections or proposed combinations of references.

DECISION

The previous petition filed April 14, 2010 was dismissed because it was filed pursuant to 37 CFR §§ 1.181, 1.182, and 1.183. The instant petition is modified such that it is filed only pursuant to rule 1.181, and petitioner requests reconsideration under only that rule. The petition is granted to the extent that it is considered by the Director.

Petitioner argues that each of the Notice and the Decision were issued in error, that the Comments and the Amended Comments were both proper, and requests entry of the Amended Comments. Petitioner argues that MPEP § 2666.05 has been improperly applied by the examiner in not entering these papers. Petitioner summarizes the arguments in the petition by stating that four reasons justify relief: (1) that the Notice was not based on newly cited art in the Comments, but instead was based on art already of record, in contravention to MPEP § 2666.05; (2) that the Amended Comments were a good faith and reasonable attempt to comply with the Notice; (3) that the Amended Comments clearly set forth the basis for the rejections in a detailed element-by-element analysis; and (4) that the objections to the Comments and Amended Comments are inconsistent with prior actions in this and related proceedings. Petition pp. 3-4. These arguments are fleshed out in the petition and will be addressed in turn.

(1) Argument that the Notice was Directed to Rejections Based on Art of Record

Petitioner argues that both the Notice and the Decision are improper because they are contrary to the section of the MPEP that they cite. Petition pp. 6-8. Specifically, these papers cite to MPEP

§ 2666.05, which petitioner argues is applicable only to proposals where newly cited art is presented, but the examiner relies on this section to show the non-compliance of proposals based on art already of record.

MPEP § 2666.05 is entitled "Third Party Comments After Patent Owner Response." The subsection cited in the Notice and quoted in the Decision (and above) is simply entitled "II. Content." This section of the MPEP, including part II., addresses third party comments where art is newly cited. However, the reasoning underlying that section applies equally in this situation. It is unreasonable to have a particular standard for (ultimately appealable) rejections at the initial stage of a request only to allow more-or-less non-specific rejections to be introduced in a later comment. To the extent that Third Party Requester is arguing that any rejection no matter how ambiguous may be introduced during prosecution so long as one rejection based on the art was adequately presented, this is unpersuasive and does not show that the examiner did not follow established policy.

A new rejection based on newly cited art must be presented in compliance with MPEP § 2617 because such a new rejection stands on the same footing as any presented in the request and is treated the same way in any future Office actions or appeal. The requirements of 35 U.S.C. § 311 are no less important at this stage than when filing the request. This reasoning <u>is exactly the same</u> when applied to newly proposed rejections based on previously cited art. Under 37 CFR § 41.61(a)(2), a requester gains appeal rights in any proposed rejection that is not applied, whether it is from the original request, is based on newly cited art, or based on previously cited art. Once the proposed rejection makes its way into the proceeding, it stands on the very same footing as any other proposed rejection, no matter what type of art it is based upon. The requirements of 35 U.S.C. § 311 are no less important if the art has already been made of record than if it is new. A requester cannot obtain important appeal rights on any combination of references that are of record simply by stating the claims should be rejected without setting forth the pertinency and manner of applying the art to the claims. There is, quite simply, no reason to make a distinction between rejections based on newly cited or previously cited art. Despite the quoted part of MPEP § 2666.05 being explicitly drawn to new rejections based on newly cited art, its reasoning is similarly applicable to new rejections based on previously cited art and such rejections must meet the same requirements.

<u>(2) Argument that the Amended Comments were a Good Faith Response to the Notice</u>

Petitioner next argues that the Amended Comments were a good faith and reasonable attempt to comply with the Notice by eliminating many of the rejections that were in the Comments. Petition pp. 8-13. All responses to Office requirements are expected to be a good faith effort to respond to the requirements.

(3) Argument that the Amended Comments Set Forth Detailed Rejections

Petitioner next argues that each proposed rejection in the Amended Comments clearly sets forth the basis for the rejection in an element-by-element analysis of the claims. Petition pp. 13-14. This argument is not persuasive. The proposed rejections lack clarity based on their lumping together of a number of references and proposals, the very reason that such lumping of rejections is not permitted.

Consider, for example, proposed rejection C. Amended Comments pp. 11-18. Petitioner has clearly lumped together at least four separate proposals in one section (JP '778 in view of Reynolds; JP '778 in view of Carvalho; JP '778 in view of Kanazawa; JP '778 in view of JP '465). MPEP § 2617, as quoted above, clearly states rejections are not to be lumped together. Furthermore, it is not entirely clear if petitioner intended to limit the discussion to just those proposals, or to a combination of all of the secondary references. In at least two places the Amended Comments use "and/or" when discussing the combination of references, rendering it unclear if the examiner is to analyze simply the four combinations above, or all iterations including any combination of the secondary references. *See* Amended Comments p. 12 at Heading (1) (using and/or); p. 17 at second to last line (same). This is one of the reasons requesters are admonished not to lump together rejections in this manner, so that the record is clear as to what exactly is being proposed.

Proposed rejection F at pages 20-24 of the Amended Comments likewise lumps together a large number of proposed rejections. Similarly to proposal C, requester states that "it would have been obvious for one skilled in the art to include power factor correction as taught by any one or all of the PFC References." Amended Comments p. 24. One could argue this to mean that the proposed rejections also include proposals for any combination of one, two, or all of the fifteen PFC References.

Petitioner might argue that these statements are meaningless, that it is clear the proposals are not intended to combine the secondary references. But, a reasonable argument can be made, and thus it could vastly complicate any appeal that might come in this proceeding. By proposing a rejection, a requester gains important appeal rights as to any determination by the examiner not to make a proposed rejection. 37 CFR § 41.61(a)(2). It is therefore important that the requester clearly define what is being proposed, so that there is no confusion as to what exactly requester's rights are on appeal. If petitioner had followed the MPEP and not lumped together at least 30 rejections in a single section, any confusion could have been avoided. For the reasons above, at least the above proposals lack clarity, and it was not improper for the examiner to hold the Amended Comments as non-compliant.

As to the arguments concerning newly cited art versus art already of record and MPEP § 2666.05, this issue is discussed in section (1) *supra*.

CONCLUSION

1. The petition filed July 9, 2010 is considered but it is denied. The Amended Comments will not be entered and will remain expunged from the record.

2. This decision is **not** a final agency decision and is without prejudice to a request for reconsideration or higher-level review. See MPEP 1002.02.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 02/25/2011

LERNER, DAVID, LITTENBERG,
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,227	02/09/2007	6433419	

EXAMINER
TIBBITS, PIA

ART UNIT	PAPER
3992	

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FIFTY-THIRD FLOOR
HOUSTON, TX 77002

DATE MAILED: MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,227	02/09/2007	6433419	

EXAMINER
TIBBITS, PIA

ART UNIT	PAPER
3992	

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DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner)

MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Khandros et al.	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,227	:	**GRANTING IN PART**
Filing Date: February 9, 2007	:	**PETITION TO**
For: U.S. Patent No.: 6,433,419	:	**REOPEN PROSECUTION**

This is a decision addresses the following:

- The petition under 37 CFR 1.182, filed by the patent owner on January 17, 2011, entitled "Petition to Reopen Prosecution" (patent owner's January 17, 2011 petition); and

- Third party requester's opposition to the above petition, filed on February 17, 2011, entitled "Third Party Requestors' Opposition to Petition to Reopen Prosecution" (requester's opposition).

Patent owner's January 17, 2011 petition, requester's opposition to patent owner's January 17, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fee under 37 CFR 1.17(f) for the January 17, 2011 petition has been charged to deposit account 12-1095 as authorized by patent owner's EFS-Web transmittal.

SUMMARY

The January 17, 2011 patent owner petition to reopen prosecution in this *inter partes* reexamination proceeding is **granted in part** to the extent that prosecution of the '0227 *inter partes* reexamination proceeding is hereby **reopened**.

DECISION

Jurisdiction

The requester argues, in its opposition to the present petition, that the present petition is procedurally improper. Specifically, the requester essentially argues that jurisdiction has passed to the Board of Patent Appeals and Interferences (BPAI) because the time for filing all rebuttal briefs has expired. The requester argues that for this reason, the present petition should have been filed under 37 CFR 41.3. Finally, the requester argues that the present petition is untimely under 37 CFR 41.3(e).

Jurisdiction, however, has not passed to the BPAI. 37 CFR 41.64(a) provides (emphasis added):

> Jurisdiction over the proceeding passes to the Board upon **transmittal** of the file, including all briefs and examiner's answers, to the Board.

See also *Streamlined Procedure for Appeal Brief Review in Inter Partes Reexamination Proceedings,* 75 Fed. Reg. 50750 (August 17, 2010), 1360 *Off. Gaz.* 252 (November 23, 2010), which expressly states (emphasis added):

> The jurisdiction of the *inter partes* reexamination proceeding will be transferred to the BPAI **when a docketing notice is entered** after the time period for filing the last rebuttal brief (if appropriate) expires or the examiner acknowledges the receipt and entry of the last rebuttal brief.

In other words, the mere fact that the time period for filing the last rebuttal brief (if appropriate) has expired (or the mere fact that the examiner has acknowledged the receipt and entry of the last rebuttal brief), alone, is insufficient to pass jurisdiction to the BPAI. Jurisdiction passes to the BPAI, after the above-mentioned conditions are satisfied, AND when the file is *transmitted*, i.e., when a docketing notice is entered by the BPAI in the contents of the reexamination proceeding, which can be viewed under the tab "Transaction History" in Public and Private PAIR. To date, a docketing notice by the BPAI has not been entered.

For the reasons given above, jurisdiction has not passed to the BPAI. See 37 CFR 41.3(b), which provides, in pertinent part:

> This section covers petitions on matters pending before the Board . . .; **otherwise, see §§ 1.181 to 1.183 of this title.**

The present matter is not pending before the BPAI because jurisdiction has not passed to the BPAI. Thus, the present petition is properly filed under 37 CFR 1.181.[1]

The requester, in its opposition, further argues that the present petition is "untimely". To the extent that the present petition may be considered untimely under 37 CFR 1.181(f), the provisions of 37 CFR 1.181(f) are hereby waived to the extent that the present petition is taken as

[1] The present petition was filed under 37 CFR 1.182, but is being treated as a petition under 37 CFR 1.181.

timely. The present petition requests that the Office follow its own procedure as set forth in MPEP 2258, subsection I G, with respect to the claim construction applied to the claims of an expired patent, as discussed *infra*. The patent owner informs the Office that the term of U.S. Patent 6,413,419 (the '419 patent), which is under reexamination, expired on September 24, 2010, after the filing of patent owner's rebuttal brief. While no action by the Office has been mailed since that date, the Office will not maintain a broad claim construction, on appeal, that is contrary to published guidelines.

Accordingly, jurisdiction does not rest with the BPAI.

Analysis

In the present petition, the patent owner informs the Office that the term of the '419 patent, which is under reexamination in the present proceeding, has expired. The patent owner correctly argues that for this reason, the examiner cannot maintain her present position, in the July 13, 2010 examiner's answer, that the claims must be given their broadest reasonable interpretation.

Once a patent under reexamination has expired, a narrow claim construction is applied. See MPEP 2666.01.[2] See also MPEP 2258, subsection I G, which provides, in pertinent part:

> In a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment. The statutory presumption of validity, 35 U.S.C. 282, has no application in reexamination (*In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985)).

Accordingly, the prosecution of the present proceeding is being reopened.

The patent owner also requests that the rejections applied in the present proceeding be withdrawn. However, the propriety of a rejection in a reexamination proceeding is an appealable matter, not a petitionable matter. Accordingly, the present proceeding is being referred to the Central Reexamination Unit (CRU) examiner for appropriate action, and the rejections applied in the present proceeding will be reviewed in due course.

The Office notes that the patent owner relies on a decision by the Federal Circuit in an appeal from a determination of the International Trade Commission (ITC) involving the '419 patent, i.e., *Spansion Inc. v. Int'l Trade Comm'n*, No. 2009-1460, 1461, 1462, 1465, 2010 WL 5156992

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[2] MPEP 2666.01 provides, in pertinent part:

> Once the patent expires, a narrow claim construction is applied. See MPEP § 2258, subsection I.G. "Claim Interpretation and Treatment."

(Fed. Cir. Dec. 21, 2010). *Spansion,* however, is not controlling, since it does not arise under section 1338 of title 28, within the meaning of 35 U.S.C. 317(b).

CONCLUSION

- The January 17, 2011 patent owner petition to reopen prosecution in this *inter partes* reexamination proceeding is **granted in part** to the extent that prosecution of the '0227 *inter partes* reexamination proceeding is hereby **reopened**.

- The '0227 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) examiner for appropriate action.

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

Kenneth M. Schor

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

2-24-2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 04/15/2011

LERNER, DAVID, LITTENBERG,
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

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APR 15 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000227
PATENT NO. : 6433419
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APR 15 2011

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NOVAK, DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP) 1000 LOUISIANA STREET FIFTY-THIRD FLOOR HOUSTON, TX 77002	: : : : :	(For Third Party Requester)

In re: Khandros et al. *Inter Partes* Reexamination Proceeding Control No.: 95/000,227 Deposited: February 9, 2007 For: U.S. Patent No.: 6,433,419	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on August 7, 2009, entitled: "REQUEST FOR RECONSIDERATION OF DECISION DISMISSING PETITION" [hereinafter "the petition"].

The petition is a request to the Director to reconsider a previous decision dismissing a previous petition to withdraw a Right of Appeal Notice.

The petition is before the Director of the Central Reexamination Unit. The petition is dismissed as moot.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,433,419 issued on August 13, 2002. A request for *inter partes* reexamination was filed on February 9, 2007 and assigned control no. 95/000,227.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice was mailed for the proceeding on June 19, 2009.
- Patent owner filed a petition to withdraw the Right of Appeal Notice on July 1, 2009. The petition was dismissed in a decision mailed July 30, 2009.
- Patent owner filed the instant petition on August 7, 2009, requesting reconsideration of that decision and again asking for withdrawal of the Right of Appeal Notice.
- In response to a separate petition, prosecution was reopened in a decision mailed February 25, 2011. A new Action Closing Prosecution was mailed March 11, 2011.

DECISION

Patent owner seeks withdrawal of the Right of Appeal Notice. Prosecution was reopened after the filing of the petition, and the Right of Appeal Notice complained of is no longer outstanding. The petition is therefore moot, and accordingly, it is dismissed.

CONCLUSION

1. The petition filed August 7, 2009 is dismissed as moot.

2. The ACP mailed March 11, 2011 remains outstanding.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIIDC	6504

530 7590 09/02/2011

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
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WESTFIELD, NJ 07090

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2011

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Date:
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SEP 02 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000227
PATENT NO. : 6433419
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:95/000,227 MAILED

SEP 02 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED on 08/30/2011.

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. **X** 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 Appeal Brief filed on 08/02/2011, which sets a One (1) month period for filing a response thereto, be extended by Seven (7) days.

   A. **X** Petition fee per 37 CFR §1.17(g)):
      i. X Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. **X** Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. **X** Petition was timely filed.
   D. **X** 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. **X** 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. **X** Other/comment: See Attachment.

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 or Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Sudhanshu C. 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. While the petition complies with all the FORMAL MATTERS (see above), however pursuant to 37 CFR 41.66(b):

Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

Thus, based on the above section, the extension of time is not granted and the Petition dated 08/30/2011 is dismissed.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,228	02/12/2007	6979117	46264.0037	6286

57600 7590 04/20/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Vita-Mix Corporation v. K-TEC, Inc.

Reexamination Control No. 95/000,228
Patent 6,979,117
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 41.3," filed April 1, 2011, ("Petition #1"). In the petition of April 1, 2011, patent owner requests that the oral hearings for reexamination proceedings 95/000,339 and 95/000,228 be consolidated. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to patent owner's deposit account on April 1, 2011.

This is also a decision on requester's "Vita-Mix's Response to K-TEC's Petition to Consolidate Oral Argument," filed April 13, 2011, ("Petition #2). The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to requester's deposit account on April 13, 2011.

FINDINGS

1. On February 12, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,979,117, which was assigned Control No. 95/000,228.

2. On May 7, 2007, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted and on July 15, 2010, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on August 12, 2010, and an appellant brief on February 9, 2011.

5. Patent owner filed a respondent brief on February 28, 2011.

6. On March 31, 2011, an examiner's answer was mailed.

7. Patent owner filed petition #1 on April 1, 2011.

8. Requester filed petition #2 on April 13, 2011.

RELEVANT AUTHORITY

37 CFR § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

37 CFR § 41.73 provides:

(a) An oral hearing should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as an appeal decided after an oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended. The request must include a certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(c) If no request and fee for oral hearing have been timely filed by appellant or respondent as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant or respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 41.20(b)(3).

(e)

(1) At the oral hearing, each appellant and respondent may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an

answer except as permitted by paragraph (e)(2) of this section. The Board will determine the order of the arguments presented at the oral hearing.

(2) Upon a showing of good cause, appellant, respondent and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify the owner and all requesters.

DISCUSSION

A review of the record of *inter partes* reexamination 95/000,228, reveals that it is not docketed at the Board of Patent Appeals and Interferences (BPAI) for a decision on an appeal. Also, no request for oral hearing has yet been received in the '228 proceeding. Accordingly, patent owner's Petition #1 filed April 1, 2011, is **dismissed as premature.**

Requester's Petition #2, is not an authorized submission pursuant to 37 C.F.R. § 41.3(e)(2), which states:

"A party may not file an opposition or a reply to a petition without Board authorization."

The BPAI may consider consolidation of oral arguments once both *inter partes* reexamination proceedings have a request for oral hearing filed and both *inter partes* reexamination proceedings are docketed as appeals at the BPAI. At such time, if feasible, the oral hearings would be scheduled on the same day, *i.e.*, June 1, 2011, in the interest of conserving the resources of the BPAI, and proceeding with special dispatch.

DECISION

In view of the foregoing, Petition #1 is DISMISSED. Petition #2 is an unauthorized submission, and as such is not considered and will be "closed" from the Office's Image File Wrapper (IFW) System.

_____/s/_____
James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
HOLLAND & HART LLP
222 South Main Street, Suite 2200
P.O. Box 11583
Salt Lake City, UT 84110

Counsel for Third Party Requester:
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2100 Bank One Center
600 Superior Avenue, E.
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,238	04/20/2007	6777014	LEE655/52000	2959

60474 7590 03/05/2012
GRAY ROBINSON, P.A.
P.O. Box 2328
FT. LAUDERDALE, FL 33303-9998

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEPHEN M. HASH
VINSON AND ELKINS LLP
2801 VIA FORTUNA, SUITE 100
AUSTIN, TX 78746

Date: MAILED
MAR 05 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000238
PATENT NO. : 6777014
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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GRAY ROBINSON, P.A. P.O. Box 2328 FT. Lauderdale, FL 33303-9998	: : :	(For Patent Owner)

MAILED

MAR 05 2012

CENTRAL REEXAMINATION UNIT

Stephen M. Hash VINSON & ELKINS, LLP 2801 Via Fortuna, Suite 100 Austin, TX 78746	: : : :	(For Third Party Requester)

In re: Singh *Inter Partes* Reexamination Proceeding Control No.: 95/000,238 For: U.S. Patent No.: 6,777,014 B2	: : : :	**DECISION ON PETITION**

This is a decision on a petition filed by the Patent Owner: a petition filed on August 9, 2011, entitled "PATENT OWNER'S/RESPONDENT'S PETITION UNDER 37 C.F.R. § 1.182 FOR DIRCTOR TO ORDER EXAMINER TO EITHER CONDUCT APPEAL CONFERENCE AND FILE EXAMINER'S ANSWER OR REOPEN PROSECUTION".

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

The petition is **dismissed as moot**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,777,014 B2 issued on August 17, 2004.
- A corrected request for *inter partes* reexamination was April 20, 2007 and assigned control no. 95/000,238.
- *Inter partes* reexamination was ordered on June 29, 2007.
- A Non-Final Office Action was mailed on June 29, 2007.
- Patent Owner's Response to the Non-Final Office Action was received by the Office and serviced to the Third Party Requestor on August 29, 2007.
- The Third Party Requestor's Comments responsive to the Patent Owners comments after the Non-Final Office Action were received on September 27, 2007 and serviced to the Patent Owner.
- An Action Closing Prosecution (ACP) was mailed on July 17, 2008.
- Patent Owner's Response and amendment to the Action Closing Prosecution (ACP) was received and serviced to the Third Party Requester on August 18, 2008.
- Patent Owner's corrected response and amendment to the ACP was received and serviced to the Third Party Requester on August 20, 2008.
- The Third Party Comments responsive to the Patent Owners comments were received and serviced to the Patent Owner on September 19, 2008.
- A Notice Re Defective Paper in *Inter Partes* Reexamination was mailed to Patent Owner on July 23, 2009.
- Patent Owner filed a second corrected Amendment on August 5, 2009.
- Patent Owner filed a third corrected amendment placing the amendment to the claims and specification into compliance with 37 CFR 1.530 on September 10, 2009.

- An Action Closing Prosecution (ACP) was mailed on September 17, 2009.
- A Right of Appeal Notice (RAN) was mailed on December 16, 2009.
- Third Party Requester filed a Notice of Appeal on January 19, 2010.
- Third Party Requester filed an Appeal Brief in April 2, 2010.
- Patent Owner Respondent filed a Respondent Brief on April 30, 2010.
- Patent Owner Respondent filed a Status Request Letter on May 17, 2011.
- Patent Owner Respondent filed the above identified petition on August 9, 2011.
- An Appeal Conference was held and Examiner's Answer was mailed on August 30, 2011.
- Third Party Requester Appellant filed a Rebuttal Brief on September 30, 2011.

DECISION

As a procedural matter, the petition is treated as a petition under 37 CFR § 1.181. It is noted that the petition under 37 CFR 1.182 is not proper because this petition address issues that are properly raised under 37 CFR 1.181. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

Patent Owner Petitioner submits that at the time of the filing of the instant petition, it has been over a year since the filing of the Third Party Requester's appeal brief and Patent Owner's respondent brief. Patent Owner Petitioner submits that such delay is unreasonable fails to comply with the "special dispatch" requirement of M.P.E.P. §2609.

Patent Owner Petitioner requests that the Director order the Examiner to promptly confer with the Reexamination Legal Advisor and then either: 1) promptly hold an appeal conference and within two weeks file the Examiner's answer or 2) reopen prosecution and issue a non-final Office Action.

A review of the record shows that the Examiner conducted an appeal conference, and on August 30, 2011, mailed the Examiner's Answer. Accordingly, the ultimate relief requested by Patent Owner petitioner was given by the mailing of the August 30, 2011 Examiner's Answer.

For these reasons, Patent Owner's August 9, 2011 petition is moot, and is hereby dismissed.

CONCLUSION

1. The petition filed by Patent Owner on August 9, 2011, is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed to Stephen Stein, Supervisory Patent Reexamination Specialist, at (571) 272-1544 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,239	05/30/2007	7142347		2282

7590 08/13/2010

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1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NONE

Date:

MAILED

AUG 1 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000239
PATENT NO. : 7142347
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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MAILED
AUG 13 2010
CENTRAL REEXAMINATION UN

(For Patent Owner)

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980

(For Third-Party Requester)

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

In re Islam	
Reexamination Proceeding	DECISION
Control No. 95/000,239	DISMISSING PETITION
Request Deposited: May 30, 2007	
For: U.S. Patent No. 7,142,347	

This is a decision on the July 21, 2010 paper entitled "THIRD-PARTY REQUESTER INFINERA CORPORATION'S PETITION TO REOPEN REEXAMINATION AFTER ACTION CLOSING PROSECUTION". This decision also addresses the August 2, 2010 paper entitled "PETITION OF PATENT OWNER UNDER 37 C.F.R. §1.182 OR ALTERNATIVELY 37 C.F.R. §1.183".

The papers are before the Director of the Central Reexamination Unit for consideration.

The request to reopen is **dismissed** for the reasons set forth below.

BACKGROUND AND DECISION

On December 4, 2009, the office mailed an Action Closing Prosecution (ACP).

On April 8, 2010, the office mailed a Right of Appeal Notice (RAN).

On May 7, 2010, Third-Party Requester (3PR) filed a Notice of Appeal.

On July 21, 2010, 3PR filed their appeal brief and the present petition.

On August 2, 2010, Patent Owner (PO) filed an opposition petition.

37 CFR 1.181(f) states:

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

3PR has filed a petition on July 21, 2010 requesting relief from an action mailed on December 4, 2009. Therefore, the request is **dismissed** as untimely.

PO's paper filed August 2, 2010 is moot.

CONCLUSION

1. 3PR's request to reopen after ACP is **dismissed as untimely**.

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

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

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

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

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

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

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

3. 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, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,239	05/30/2007	7142347		2282

7590 10/14/2010

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
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SOUTHFIELD, MI 48075

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2010

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OCT 14 2010
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

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

(For Third Party Requester)

In re Islam	:	
Reexamination Proceeding	:	DECISION
Control No. 95/000,239	:	DISMISSING PETITION
Correct Request Deposited: May 30, 2007	:	
For: U.S. Patent No. 7,142,347	:	

This is a decision on the August 12, 2010 paper entitled "THIRD-PARTY REQUESTER INFINERA CORPORATION'S PETITION UNDER 37 C.F.R. § 1.182".

The papers are before the Director of the Central Reexamination Unit for consideration.

The request to submit comments is **dismissed** for the reasons set forth below.

BACKGROUND AND DECISION

Third Party Requester ("3PR") has filed a petition to submit comments to the Patent Owner's ("PO") petition of August 2, 2010. PO's petition filed August 2, 2010 was dismissed as untimely in the decision mailed August 13, 2010.

Since PO's petition filed August 2, 2010 is dismissed as untimely, 3PR's request to submit comments to PO's petition is **dismissed as moot**.

CONCLUSION

1. 3PR's petition to submit comments to PO's petition filed August 2, 2010 is **dismissed as moot**.

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

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

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

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

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

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 09/28/2011

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

Date:

MAILED

SEP 28 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

(For Patent Owner)

MAILED

SEP 28 2011

CENTRAL REEXAMINATION UNIT

James W. Miller
527 Marquette Avenue
Suite 1960 Rand Tower
Minneapolis, MN 55402

(For Third Party Requestor)

Inter Partes Reexamination Proceeding
Control No. 95/000,244
Filed: April 26, 2007
For: U.S. Patent No. 6,336,312

: **DECISION DISMISSING**
: **PETITION TO WAIVE**
: **PAGE LIMIT FOR**
: **APPELLANT'S BRIEF**

This is a decision on the patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND REQUIREMENT OF 37 C.F.R § 1.943" (petition under 37 CFR 1.183), filed on July 26, 2010.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for decision.[1]

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

BACKGROUND

1. On January 8, 2002, U.S. Patent No. 6,336,312 (the '312 patent) issued to Bednar *et al.* with claims 1-27.

2. On March 23, 2007, a request for *inter partes* reexamination of claims 1-5, 8-10, 14, 15, 19, 20 and 24-27 of the '312 patent was submitted by a third party requester, which request was assigned control number 95/000,244 (the '0244 proceeding).

[1] It is noted that the procedure set forth in the notice "Streamlined Procedure for Appeal Brief Review in *Inter Partes* Reexamination Proceedings," 75 FR 50750 (August 17, 2010), is applicable to any appeal brief (regardless of whether it is an appellant's brief, a respondent's brief, or a rebuttal brief) that is filed in an *inter partes* reexamination proceeding on or after August 17, 2010. The appeal brief that is subject of the instant petition under 37 CFR 1.183 was filed before August 17, 2010.

3. On April 26, 2007, a corrected request for *inter partes* reexamination was filed in the '0244 proceeding, and the proceeding was assigned a filing date of April 26, 2007.

4. On July 16, 2007, the Office ordered *inter partes* reexamination of claims 1-5, 8-10, 14, 15, 19, 20 and 24-27 of the '312 patent in the '0244 proceeding and concurrently issued a non-final action.

5. The '0244 proceeding progressed to a point where, on April 29, 2010, a Right of Appeal Notice (RAN) was issued.

6. On May 28, 2010, the patent owner filed a Notice of Appeal, appealing the rejection of claims 1-5, 8-10, 14, 15, 19, 20 and 24-36.

7. On July 26, 2010, patent owner filed the instant petition under 37 CFR 1.183, concurrently with an appellant's brief.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

37 CFR 41.67 provides, in-part:

****

> (c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

****

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

****

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

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

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

DECISION

I. Patent Owner Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, the patent owner requests waiver of 37 CFR 1.943(c), which limits an appellant's brief to thirty pages (30) pages or 14,000 words in length. The patent owner states that the brief as filed is 67 pages.[2] Patent owner asserts that "[t]he Right of Appeal Notice (RAN) is 57 pages, contains 20 separate rejections, many of them including lumped together references that result in multiple rejections, and incorporates by reference the Request for Reexamination, which is 67 pages, single spaced, including claim charts, as well as Third Party Requester's comments dated November 15, 2007, which is 50 pages in length."[3] Further, patent owner asserts that "[t]he 57 pages of the RAN deal with a broad diversity of issues. Beyond rejections under 35 U.S.C. §§ 102, 103 and 112, the Office Action addresses issues related to dates and corroboration of alleged prior art documents, substantial amounts of secondary indicia of nonobviousness offered by Patent Owner and counter-arguments offered by Requester, declarations of numerous experts, and new matter, among other issues" and "includes numerous new arguments and the ACP lists new grounds of rejection that have not yet been justified by the Examiner."[4] Hence, patent owner asserts that "[t]he interests of justice are served if Patent Owner is provided the extra 37 pages of argument requested in this Petition to properly respond to the RAN."[5]

II. Analysis and Findings

A. Determining Page Length for Appeal Brief Submission

As noted in MPEP 2667(I)(A)(2), the provisions of 37 CFR 1.943(c) have been waived by the Office to the extent that certain content, including the table of contents pages, table of case law pages, and the pages of the claims, is not counted toward the 30-page limit of the appeal brief. As further noted in MPEP 2667(I)(A)(2), claim charts applying the art to the claims, however, are counted toward the 30-page limit. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[6] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

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[2] Petition at page 5 (stating that there are additional pages "if the Patent Office considers the claim chart showing the correspondence between the independent claims and the specification toward the page limit.").
[3] *Id.*
[4] *Id.* at pages 5-6.
[5] *Id.* at page 6.
[6] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix*, and (xi) *Certificate of Service*. The Claims Appendix is already explicitly addressed in the rule as not being counted.

B. Format Requirement for Appeal Brief Submission with Request for Page Limit Waiver

To obtain a waiver of the 30-page length requirement of 37 CFR 1.943(c), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner appeal brief submission that:

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

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of an appeal brief submission that the Office must review, analyze, and address to the extent needed.

C. Content Requirements for Evidence Appendix

The Evidence Appendix required in 37 CFR 41.67(c)(1)(ix) should only include evidence that has been entered in the record pursuant to 37 CFR 1.130, 1.131, or 1.132, other similar evidence, or evidence relied upon by the examiner in a ground of rejection. The appendix must include a statement where the evidence was entered into the record. The evidence appendix should not include copies of the patent under reexamination, copies of Office actions or prior art references from related cases. To the extent that such items are submitted, any arguments that go to a rejection or patentability of the claims will be counted against the page limits. *Reference to unentered evidence is not permitted in the brief.*

Further, it is noted that prior art references should be identified and made of record through a listing of patents and printed publications as provided for in 37 CFR 1.98. *See* MPEP 2657. It is not necessary or desirable to file duplicate copies of references and Office actions with the appellant brief.

D. Decision on Patent Owner Petition under 37 CFR 1.183

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft a brief in compliance with the 30-page limit, and submitting the resulting brief, which is in excess of 30 pages. However, the Evidence Appendix appears to include information that goes beyond evidence which was entered into the record in accordance with 37 CFR 41.67(c)(1)(ix). For example, the Evidence Appendix includes Exhibit 1, a 33-page "Statement of Facts, Patent Owner's Appeal Brief", which has not been entered into the record of the '0244 proceeding. Further, the Evidence Appendix includes Exhibits 11, 14, 28-32, 44, 48 and 50-54, which appear to be documents from the record of a related reexamination proceeding or from the record of the parent patent, and there is no evidence that such documents were previously made of record in the '0244 proceeding. Because submission of such papers is unnecessary and, with respect to Exhibit 1, inappropriate, waiver of

the 30-page limit of the 37 CFR 1.943(c) to accommodate the submission of such papers is not warranted in this instance. Accordingly, patent owner's July 26, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) is dismissed.

Additionally, the July 26, 2010 patent owner appeal brief is an improper paper because the Evidence Appendix includes information that goes beyond that which is permitted to be submitted in the Evidence Appendix pursuant to 37 CFR 41.67(c)(1)(ix). Accordingly, patent owner's July 26, 2010 appeal brief submission is an improper paper, and as such, is being expunged from the image file wrapper (IFW) of the '0244 proceeding by marking the papers "closed" and "not public."

Pursuant to 37 CFR 41.67(d), patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file either (a) a new appeal brief in compliance with the regulations, or (b) a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) with an appellant brief submission that complies with the Evidence Appendix requirements of 37 CFR 41.67(c)(1)(ix). The time for filing an appellant brief may not be extended. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c), no additional fee need be submitted.

CONCLUSION

1. Patent owner's July 26, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) for patent owner's concurrently-filed appeal brief is **dismissed**.

2. The July 26, 2010 appeal brief submission is an improper paper, and it is being expunged from the IFW of the '0244 proceeding by marking the papers "closed" and "not public."

3. Pursuant to 37 CFR 41.67(d), patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file either (a) a new appeal brief in compliance with the regulations, or (b) a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) with an appeal brief submission that complies with the Evidence Appendix requirements of 37 CFR 41.67(c)(1)(ix). The time for filing an appeal brief may not be extended.

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

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

September 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 11/18/2011

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JAMES W. MILLER
527 MARQUETTE AVE.
SUITE 1960 RAND TOWER
MINNEAPOLIS, MN 55402

Date:
MAILED
NOV 18 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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NOV 18 2011

CENTRAL REEXAMINATION UNIT

Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, MI 48303

(For Patent Owner)

James W. Miller
527 Marquette Avenue
Suite 1960 Rand Tower
Minneapolis, MN 55402

(For Third Party Requestor)

Inter Partes Reexamination Proceeding
Control No. 95/000,244
Filed: April 26, 2007
For: U.S. Patent No. 6,336,312

: **DECISION DISMISSING**
: **PETITION TO WAIVE**
: **PAGE LIMIT FOR**
: **APPELLANT'S BRIEF**

This is a decision on the patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND REQUIREMENT OF 37 C.F.R § 1.943" (renewed petition under 37 CFR 1.183), filed on October 13, 2011. The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In light of the communication from the Board of Patent Appeals and Interferences (Board) mailed on even date herewith, finding patent owner's October 13, 2011 appeal brief non-compliant, the renewed petition under 37 CFR 1.183 is dismissed as moot. If deemed necessary, patent owner may file, concurrently with any corrected appeal brief submitted in response to the Board's communication, another renewed petition under 37 CFR 1.183 for waiver of the page limit requirements of 37 CFR 1.943(c).

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

Pinchus M. Laufer Nov 18, 2011

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,244	04/26/2007	6,336,312	26.0.3.235/C	9125

27572 7590 04/04/2012

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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MINNEAPOLIS, MN 55402

Date:

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APR 04 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000244
PATENT NO. : 6336312
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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(For Patent Owner)

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APR 04 2012

CENTRAL REEXAMINATION UNIT

James W. Miller
527 Marquette Avenue
Suite 1960 Rand Tower
Minneapolis, MN 55402

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,244
Filed: April 26, 2007
For: U.S. Patent No. 6,336,312

: **DECISION GRANTING**
: **RENEWED PETITION**
: **TO WAIVE PAGE LIMIT**
: **FOR APPELLANT'S BRIEF**

This is a decision on the patent owner petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND REQUIREMENT OF 37 C.F.R § 1.943" (renewed petition under 37 CFR 1.183), filed on December 16, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for decision.[1]

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

BACKGROUND

1. On January 8, 2002, U.S. Patent No. 6,336,312 (the '312 patent) issued to Bednar *et al.* with claims 1-27.

2. On March 23, 2007, a request for *inter partes* reexamination of claims 1-5, 8-10, 14, 15, 19, 20 and 24-27 of the '312 patent was deposited by a third party requester, which request was assigned control number 95/000,244 (the '0244 proceeding).

3. On April 26, 2007, a corrected request for *inter partes* reexamination was filed in the '0244 proceeding, and the proceeding was assigned a filing date of April 26, 2007.

[1] It is noted that the procedure set forth in the notice "Streamlined Procedure for Appeal Brief Review in *Inter Partes* Reexamination Proceedings," 75 FR 50750 (August 17, 2010), is applicable to any appeal brief (regardless of whether it is an appellant's brief, a respondent's brief, or a rebuttal brief) that is filed in an *inter partes* reexamination proceeding on or after August 17, 2010. The appeal brief that is subject of the instant petition under 37 CFR 1.183 was filed before August 17, 2010.

4. On July 16, 2007, the Office ordered *inter partes* reexamination of claims 1-5, 8-10, 14, 15, 19, 20 and 24-27 of the '312 patent in the '0244 proceeding and concurrently issued a non-final Office action.

5. The '0244 proceeding progressed to a point where, on April 29, 2010, a Right of Appeal Notice (RAN) was issued.

6. On May 28, 2010, the patent owner filed a Notice of Appeal, appealing the rejection of claims 1-5, 8-10, 14, 15, 19, 20 and 24-36.

7. On July 26, 2010, the patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND REQUIREMENT OF 37 C.F.R § 1.943" (petition under 37 CFR 1.183), concurrently with an appellant's brief.

8. On September 28, 2011, the Office mailed a decision dismissing the petition under 37 CFR 1.183 and finding the July 26, 2010 appellant's brief an improper paper because some of the evidence appendices failed to comply with 37 CFR 41.67(c)(1)(ix) (the September 28, 2011 decision).

9. On October 13, 2011, in accordance with the September 28, 2011 decision, the patent owner filed a renewed petition under 37 CFR 1.183 requesting waiver of the regulatory page limit for its concurrently filed corrected appellant's brief.

10. On November 18, 2011, the Office issued an "Inter Partes Reexamination Notification re Brief," finding the patent owner's October 13, 2011 corrected appellant's brief defective because the independent claims were not individually identified in the "Summary of Claimed Subject Matter" (the notice of defective appeal brief).

10. Also, on November 18, 2011, the Office mailed a decision dismissing the patent owner's October 13, 2011 renewed petition under 1.183 as moot in view of notice of defective appeal brief (the November 18, 2011 decision).

11. On December 16, 2011, in accordance with the November 18, 2011 decision, the patent owner filed the instant renewed petition under 1.183, again requesting waiver of the regulatory page limit for its concurrently-filed corrected appellant's brief, concurrently with a "RESPONSE TO INTER PARTES REEXAMINATION NOTIFICATION RE BRIEF MAILED NOVEMBER 18, 2011," requesting that the concurrently-filed appeal brief be substituted for the October 13, 2011 appeal brief and stating that patent owner did not resubmit the October 13, 2011 Claims Appendix, Related Proceedings Appendix and Evidence Appendix because they did not change.[2]

[2] Accordingly, this decision is based on the December 16, 2011 appeal brief submission and the October 13, 2011 Claims Appendix, Related Proceedings Appendix and Evidence Appendix (collectively referred to herein as "the December 16, 2011 appeal brief submission" or "the December 16, 2011 appellant's brief").

DECISION

I. Patent Owner Renewed Petition Under 37 CFR 1.183

In the instant renewed petition under 37 CFR 1.183, the patent owner requests waiver of 37 CFR 1.943(c), which limits an appellant's brief to thirty pages (30) pages or 14,000 words in length, for its December 16, 2011 appellant's brief. The patent owner states that the December 16, 2011 appellant's brief includes 71 pages that count toward the regulatory page limit.[3]

In support of its request for waiver of 37 CFR 1.943(c), the patent owner asserts that "[t]he Right of Appeal Notice (RAN) is 57 pages, contains 20 separate rejections, many of them including lumped together references that result in multiple rejections, and incorporates by reference the Request for Reexamination, which is 67 pages, single spaced, including claim charts, as well as Third Party Requester's comments dated November 15, 2007, which is 50 pages in length."[4] Further, patent owner asserts that "[t]he 57 pages of the RAN deal with a broad diversity of issues" including, among other issues, rejections under 35 U.S.C. §§ 102, 103 and 112, dates and corroboration of alleged prior art documents, secondary indicia of nonobviousness and counter-arguments, declarations of numerous experts, and new matter.[5] Accordingly, patent owner asserts "that 30 pages is insufficient space to address the numerous prior art rejections (plus an additional non-art rejection), all set out in over 174 pages of Examiner and Third Party Requester argument."[6]

Additionally, patent owner asserts that the December 16, 2011 appellant's brief complies with the formatting requirements for obtaining waiver of the 30-page limit, as set forth on page 5 of the September 28, 2011 decision, and that the content of the Evidence Appendix now complies with the requirements of 37 CFR 41.67(c)(1)(ix).[7]

II. Analysis and Findings

A. Determining Page Length for Appeal Brief Submission

As noted in MPEP 2667(I)(A)(2), the provisions of 37 CFR 1.943(c) have been waived by the Office to the extent that certain content, including the table of contents pages, table of case law pages, and the pages of the claims, is not counted toward the 30-page limit of the appeal brief. As further noted in MPEP 2667(I)(A)(2), claim charts applying the art to the claims, however, are counted toward the 30-page limit. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as

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[3] Petition at page 9.
[4] *Id.* at page 8.
[5] *Id.*
[6] *Id.*
[7] *Id.* at pages 9-10 (stating that Exhibit 1 "Statement of Facts," and Exhibits 11, 14, 28-32, 44, 48, and 50-54 have been removed pursuant to the September 28, 2011 decision finding those exhibits improper, and identifying where the evidence submitted in previously-filed Exhibits 39, 43, 53 and 54 was previously made of record in the '0244 proceeding). See also patent owner's December 16, 2011 "RESPONSE TO INTER PARTES REEXAMINATION NOTIFICATION RE BRIEF MAILED NOVEMBER 18, 2011," stating that patent owner removed "Appendix B" as cumulative.

prior art references." The sections of the appellant's brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[8] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

B. Decision on Patent Owner's Renewed Petition under 37 CFR 1.183

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant's brief in compliance with the 30-page limit, and submitting the resulting appellant's brief, which is in excess of 30 pages.[9] In addition, patent owner demonstrated that the December 16, 2011 appeal brief submission (which incorporates the October 13, 2011 Evidence Appendix) complies with the September 28, 2011 decision by removing exhibits 1, 11, 14, 28-32, 44, 48 and 50-52 from the Evidence Appendix and showing where the evidence submitted in exhibits 34, 35, 36 and 37 (previously identified as exhibits 53, 54, 39 and 43, respectively, in the July 26, 2010 appellant's brief) was previously made of record in the '0244 proceeding.

Based on patent owner's showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant's brief in compliance with the 30-page limit and submitting the resulting brief which is in excess of 30 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance to the extent the patent owner's December 16, 2011 appellant's brief exceeds the 30-page limit by 41 pages.

Accordingly, the patent owner's renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(c) is waived to the extent of permitting patent owner's December 16, 2011 appellant's brief to exceed the regulatory page limit by up to 41 pages.[10] This waiver makes patent owner's December 16, 2011 appellant's brief **page-length compliant**.

CONCLUSION

1. Patent owner's December 16, 2011 renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(c) for patent owner's concurrently-filed appellant's brief is **granted** and the page limit of 37 CFR 1.943(c) is waived to the extent of permitting patent owner's December 16, 2011 appellant's brief to exceed the regulatory page limit by up to 41 pages. This waiver makes patent owner's December 16, 2011 appellant's brief page-length compliant.

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[8] *I.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix*, and (xi) *Certificate of Service*. The Claims Appendix is already explicitly addressed in the rule as not being counted.

[9] The November 18, 2011 appeal brief submission exceeds the regulatory page limit by 41 pages.

[10] Note that the word count certification of 37 CFR 1.943(c) must accompany a brief that exceeds the page limit but satisfies 37 CFR 1.943(c) by virtue of not exceeding the word limit. To the extent 37 CFR 1.943(c) can be interpreted as requiring a certification where a brief exceeds both the page limit and the word limit, this decision *sua sponte* waives that requirement as well.

2. Pursuant to 37 CFR 41.66(b), once patent owner's appellant's brief has been properly filed, a respondent's brief must be filed by respondent within one month from the date of service of the appellant's brief. However, it is the present decision that now makes appellant's brief a compliant paper; thus the mailing of this decision constitutes the service of the appellant's brief on parties. Accordingly, any respondent's brief must be filed within one month from the date of this decision. The time for filing a respondent's brief may not be extended. 37 CFR 41.66(b).

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

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

April 3, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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In re Richard D. Bednar	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,245	: **GRANTING**
Filed: April 26, 2007	: **PETITION UNDER**
For: U.S. Patent No. 6,336,311	: **37 CFR 1.137(b)**

This is a decision on the July 8, 2010 patent owner petition titled "Petition To Revive The *Inter Partes* Reexamination Prosecution Pursuant To 37 CFR § 1.958(b)" ("the July 8, 2010 patent owner petition to revive").

The July 8, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 8, 2010 patent owner petition to revive is **granted**.

The July 2, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file a corrected appellant's brief 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 1.953(c) provides:

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

37 CFR 1.957(b) provides:

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the

reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides:

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

37 CFR 41.63 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

(b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

37 CFR 41.66(a) provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*

*

IV. PETITION REQUIREMENTS

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

MPEP 2674 provides, in pertinent part:

> It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1).

MPEP 2675 provides, in pertinent part:

> Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the prosecution of the instant *inter partes* reexamination proceeding was terminated within the meaning of 37 CFR 1.957(b) due to patent owner's failure to timely submit a proper response under 37 CFR 1.953(c) to the November 5, 2009 Right of Appeal Notice (RAN). Although patent owner timely filed a Notice of Appeal on December 4, 2009, patent owner's February 4, 2010 appellant's brief was non-compliant, and patent owner failed to timely file a corrected appellant's brief in response to the May 27, 2010 Decision Dismissing Petition Under 37 CFR 1.183 For Waiver Of 37 CFR 1.943(c).

Patent owner submitted a corrected appellant's brief on July 8, 2010. The July 8, 2010 corrected appellant's brief has been found to be in compliance with the regulations. Further, patent owner was charged the $540.00 37 CFR 41.20(b)(2) fee for filing a brief in support of an appeal on February 12, 2010. Item (1) has thus been satisfied.

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the July 8, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the July 8, 2010 patent owner petition to revive is **granted**.

The July 2, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file a corrected appellant's brief is **withdrawn**.

CONCLUSION

1. The July 8, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The July 2, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file a corrected appellant's brief is **withdrawn**.

3. Patent owner's July 8, 2010 corrected appellant's brief is hereby entered in the record, thus triggering a respondent's brief right for third party requester under 37 CFR 41.68. Accordingly, third party requester may file a respondent's brief as per 37 CFR 41.66(b) within one month of the mailing date of this decision. However, third party requester's March 4, 2010 paper titled "Notice Of Future Non-Participation" is noted. It states that the third party requester "will not participate further in this *inter partes* proceeding." The Office will consider the March 4, 2010 third party requester paper as a waiver of third party requester's respondent's brief rights under 37 CFR 41.68, and not await requester's respondent's brief under 37 CFR 41.68, unless informed otherwise within 15 days of the mailing date of this decision.

4. Art Unit 3993 of the Central Reexamination Unit will await the expiration of the 15-day time period set above for third party requester to withdraw its waiver of respondent's brief rights under 37 CFR 41.68, after which, if no communication from third party requester is received, the examiner will proceed to issue an examiner's answer under 37 CFR 41.69 or take other appropriate action.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 08/06/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356

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Date:

MAILED

AUG 0 6 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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DALLAS, TX 75219

Date: MAILED
AUG 0 6 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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HOUSTON, TX 77002

In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No.: 95/000,250 :
Filed: June 28, 2007 :
For: U.S. Patent No. 6,452,863 :
:
:
In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No. 95/001,124 :
Filed: November 24, 2008 :
For: U.S. Patent No. 6,452,863 :

DECISION DISMISSING PATENT OWNER'S PETITION TO STRIKE PORTIONS OF REQUESTER'S RESPONDENT BRIEF

This is a decision on the July 16, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THIRD-PARTY REQUESTER'S RESPONDENT BRIEF." Since the petition is actually on challenging the making of record of the respondent brief by the Central Reexamination Unit (CRU), the petition will be taken and decided as a petition under 37 CFR 1.181 challenging an action taken by the CRU – see the below discussion.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On September 17, 2002, U. S. Patent Number 6,452,863 (the '863 patent) issued with thirty-five claims to Farmwald et al.

2. On April 4, 2007, a request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ("the '250 proceeding"), was initially deposited by a third party requester. A corrected request was then filed, and received a filing date of, June 28, 2007. Samsung Electronics, Co. Ltd. ("Samsung") was identified as the real party in interest.

3. On September 5, 2007, an Order was issued by the Office granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 reexamination proceeding.

4. On July 3, 2008, an Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed.

5. On November 24, 2008, a request for *inter partes* reexamination of claims 14-16 of the '863 patent, assigned Reexamination Control No. 95/001,124 ("the '1124 proceeding"), was filed by third party requester Micron Technology, Inc. ("Micron").

6. On January 16, 2009, an Order was issued by the Office granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 reexamination proceeding.

7. On March 6, 2009, the '250 and '1124 proceedings were merged.

8. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-35.

9. On September 28, 2009, patent owner filed comments in response to the ACP.

10. On October 28, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 19, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-28 and confirming claims 29-35.

13. On March 19, 2010, patent owner filed a Notice of Appeal for claims 1-28.

14. On April 2, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 14-16.

15. On June 2, 1010, patent owner filed an appellant's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

16. On July 2, 2010, third party requester Micron filed a respondent brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

17. On July 16, 2010, patent owner filed the present petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by third party requester Samsung.

RELEVANT AUTHORITY

35 U.S.C. § 312 (Determination of issue by Director) provides (in pertinent part):

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. § 313 (*Inter partes* reexamination order by Director) provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

35 U.S.C. § 314 (Conduct of *inter partes* reexamination proceedings) provides (in pertinent part):

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

35 U.S.C. § 315 (Appeal) provides (in pertinent part):

(b)THIRD-PARTY REQUESTER.— A third-party requester—
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and
(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

35 U.S.C. § 317 (Inter partes reexamination prohibited) provides (in pertinent part):

(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 1.181 provides (in pertinent part):

(a)Petition may be taken to the Director:
(1)From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 41.68 provides (in pertinent part):

(a)(1)Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.
(2)The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).
(3)The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.
(4) A requester's respondent brief may not address any brief of any other requester.

DECISION

I. Patent owner's July 16, 2010 Petition

In its present petition, patent owner requests under 37 CFR 1.182 and if necessary, under 37 CFR 1.183, that those portions of Requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by Requester Samsung and not raised by Micron in its request for reexamination be stricken. In support of its request that portions of Requester Micron's respondent brief addressing issues raised by another third party requester be striken, petitioner patent owner points to the following authority: (1) MPEP 2675.02 and 37 CFR 41.68(a)(3) state that the "respondent brief must ...be limited to issues raised in the appellant brief to which the respondent brief is directed," and (2) 37 CFR 41.68(a)(4) states "[a] requester's respondent brief may not address any brief of any other requester."[1]

Patent owner further argues that Rambus's appeal brief addressed rejections raised by both Samsung and Micron because the Office merged the Micron initiated reexamination proceeding (the '1124 proceeding) with the Samsung initiated reexamination proceeding (the '250 proceeding), and that merger of the two proceedings should "neither expand Micron's reexamination rights nor allow Micron to address rejections in its respondent brief that it did not previously propose and that it could not have addressed if the Office had not merged the reexamination proceeding."[2] Patent owner specifically requests that "the Office should strike Sections VII.A-VII.J at pages 1-24 and Section VII.L at pages 30-32 of Micron's Respondent Brief"[3] that address the "eight Samsung-proposed rejections – anticipation rejections based on *iAPX* and *Budde*, obviousness rejections over *iAPX* or *Budde* in view of *Inagaki*, and obviousness rejections of *iAPX* or *Budde* in view of *Lofgren*."[4]

Patent owner further argues that "[b]y appealing and addressing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent."[5]

Finally, patent owner cites to two specific Board decisions, to support its present request. Patent owner argues that "[t]he Board had indicated that that [sic] a requester cannot appeal a rejection that is did not propose,"[6] and cites as exemplary decisions to *Meadwestvaco Packaging Sys., LLC v. Patent of C. Brown Lingamfelter*. Appeal No. 2009-002578, 2010 WL 191281 (B.P.A.I. Jan. 12, 2010) and *Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.* Appeal No. 2009-002973, 2010 WL 1064484 (B.P.A.I. Mar. 23, 2010).[7]

II. Analysis and Findings

As pointed out above, patent owner's petition under 37 CFR 1.182/1.183 is taken as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the

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[1] Petition at page 2.
[2] *Id.* at pages 2 and 5.
[3] *Id.* at page 2.
[4] *Id.* at page 6.
[5] *Id.* at page 4.
[6] *Id.*
[7] *Id.*

requester's respondent brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions of the respondent brief. Patent owner is actually asserting that the requester respondent brief was improperly placed of record in the Image File Wrapper (IFW)) for the proceeding, and requesting that it be expunged, with requester being directed to replace the brief by a redacted or revised respondent brief to exclude the portions of the paper argued to be improper.

Patent owner's petition has been fully considered, and not found persuasive. A review of Requester Micron's respondent brief reveals that does address the eight Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1124 proceeding). However, these eight poposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted the Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Patent owner argues that 37 CFR 41.68(a)(4) limits requester Micron's respondent brief by stating that a requester's respondent brief may not address any brief of any other requester. Such argument is unpersuasive and not on point. 37 CFR 41.68(a)(4) is directed to filing a respondent brief in response to the brief of the other requester (in this case, Samsung), which was not filed in the instant proceeding. Rather, Micron's respondent brief is a respondent brief in response to the brief of the patent owner.

Patent owner argues that MPEP 2675.02 states that the respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. This does not support patent owner's position that requester Micron cannot address issues raised in patent owner's appellant brief, since the examiner's adopted rejections (originally proposed by Samsung) are addressed by patent owner's appellant brief, and Micron's respondent brief is entitled to then address what patent owner's appellant brief said about those rejections.

Patent owner presents arguments that the Board has indicated, in its decisions, that a requester cannot appeal a rejection that it did not propose. These arguments again are not on point, since requester Micron's respondent brief is addressing patent owner's argument as to the rejection the Office has adopted, as its own, and requester is not appealing a rejection that it did not propose. A third party requester may comment on an issue that has been adopted by the examiner and raised in patent owner's appeal brief, as the proposed rejections that are adopted become the examiner's rejections in the reexamination proceeding. Furthermore, 35 U.S.C. § 315(b)(2) states that a requester may be a party to any appeal taken by the patent owner and the statute does not provide the extent of the party.

Patent owner argues that requester Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent by addressing issues not raised in its request. This argument is not persuasive. First, the issues addressed by Micron are already part of the present reexamination proceeding, as discussed above. Second, this argument does not relate to the propriety of the issues raised in requester Micron's respondent brief, based on the statute, regulations, and practice.

Since requester Micron's respondent brief is limited to addressing issues raised in the patent owner's appellant brief that have been adopted by the examiner, the issues raised in requester Micron's respondent brief are not improper. Accordingly, patent owner's July 16, 2010 petition is dismissed.

CONCLUSION

1. Patent owner's July 16, 2010 petition to strike portions of Requester Micron's respondent brief is **dismissed**.

3. Any questions concerning this communication should be directed to the undersigned at (571) 272-3838.

Gregory Morse
Director
Central Reexamination Unit

8-4-10
KenAppeal/decisions/entry issues

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CENTRAL REEXAMINATION UNIT

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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AUG 0 6 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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AUG 0 6 2010

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In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No.: 95/000,250 :
Filed: June 28, 2007 : **DECISION**
For: U.S. Patent No. 6,452,863 : **GRANTING**
: **PETITIONS**
In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No. 95/001,124 :
Filed: November 24, 2008 :
For: U.S. Patent No. 6,452,863 :

This is a decision on the June 2, 2010 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S APPEAL BRIEF," and on the July 2, 2010 third party requester Micron petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)," requesting waiver of 37 CFR 1.943(c) for its respondent brief.

The petitions are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

The petitions are granted.

REVIEW OF THE RELEVANT FACTS

1. On September 17, 2002, U. S. Patent Number 6,452,863 (the '863 patent) issued with thirty-five claims to Farmwald et al.

2. On April 4, 2007, a request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ("the '250 proceeding"), was initially deposited by a third party requester. A corrected request was then filed, and received a filing date of June 28, 2007. Samsung Electronics, Co. Ltd. ("Samsung") was identified as the real party in interest.

3. On September 5, 2007, an Order was issued by the Office granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 reexamination proceeding.

4. On July 3, 2008, an Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed.

5. On November 24, 2008, a request for *inter partes* reexamination of claims 14-16 of the '863 patent, assigned Reexamination Control No. 95/001,124 ("the '1124 proceeding"), was filed by third party requester Micron Technology, Inc. ("Micron").

6. On January 16, 2009, an Order was issued by the Office granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 reexamination proceeding.

7. On March 6, 2009, the '250 and '1124 proceedings were merged.

8. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-35.

9. On September 28, 2009, patent owner filed comments in response to the ACP.

10. On October 28, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 19, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-28 and confirming claims 29-35.

13. On March 19, 2010, patent owner filed a Notice of Appeal for claims 1-28.

14. On April 2, 2010, requester Micron filed a Notice of Cross Appeal for claims 14-16.

15. On June 2, 1010, patent owner filed an appellant's brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

16. On July 2, 2010, third party requester Micron filed a respondent brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

17. On July 16, 2010, patent owner filed a petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by third party requester Samsung. This petition is being addressed by a separate decision mailed on even date with the present decision, as will be discussed below.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides (in pertinent part):

For additional information with respect to the length of papers, see Subsection I.A.2 above.

DECISION

I. Patent Owner's Petition of June 2, 2010

In its June 2, 2010 petition, petitioner patent owner requests waiver of 37 CFR 1.943(c), which limits appellant briefs to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit patent owner to file its appellant brief of 59 pages and 24,235 words in length, which has been concurrently submitted with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant brief in compliance with the 30-page limit, and submitting the resulting response, which has a length of 59 pages that count toward the limit of 30 pages. Patent owner asserts that it "has made every effort to pare down the arguments in its appeal brief."[1]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted to permit patent owner's June 2, 2010 appellant brief to exceed the page limit by 29 pages. This waiver makes patent owner's June 2, 2010 appellant brief page-length compliant.

II. Third Party Requester Micron's Petition of July 2, 2010

In its July 2, 2010 petition, petitioner third party requester Micron requests waiver of 37 CFR 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit third party requester Micron to file a respondent brief of 29 pages or 13,532 words in length. Third party requester concurrently submitted its respondent brief with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

Waiver is requested only if the Office grants the patent owner's June 2, 2010 petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c) for patent owner's 59 page appellant brief.[2]

In this instance, third party requester Micron has made a showing in support of the request for waiver of the 15-page limit of 37 CFR 1.943(c) by attempting to draft a respondent brief in compliance with the 15-page limit, and submitting the resulting response, which has a length of 29 pages that count toward the limit of 15 pages. And, the proffered respondent brief is half the size of the appellant brief, in keeping with the ratio of respondent brief to appellant brief, in 37 CFR 1.943(c).

Based on the particular circumstances of the present merged proceeding, it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) for requester's respondent brief in this instance by an amount proportional to the amount granted for patent owner's appellant brief. Therefore, third party requester's petition under 37 CFR 1.183 is granted to permit third party requester's

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[1] *Id.* at page 4.

[2] Third party requester's July 2, 1010 petition at page 2.

respondent brief to exceed the page limit by 14 pages. This waiver makes third party requester Micron's July 2, 2010 respondent brief page-length compliant.

On even date with this decision, the Office is dismissing patent owner's July 16, 2010 petition under 37 CFR 1.182/1.183 to strike portions of third party requester Micron's July 2, 2010 respondent brief. The Office's dismissal of patent owner's July 16, 2010 petition to strike portions of third party requester Micron's respondent brief will therefore not affect the present determination of the page limit waiver of third party requester Micron's respondent brief.

III. Appendix

What is Included or Excluded from the Page Limit Count

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Furthermore, the sections of the appellant brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. If any portion of the relevant section includes material that goes beyond that which is required by those sections, the entire section will be counted toward the page total. Partial pages will be tallied as whole pages for this purpose.

A comparison of 37 CFR 41.67(c) and 37 CFR 41.68(b), which set out the respective requirements for an appellant's brief and a respondent's brief, reveals that the claims appendix is the only item required in the appellant's brief that is not required in the respondent's brief. Section 1.943 does not, however, specify that reference materials are excluded from the page count of respondent's brief. To the extent that the rule can be read as giving unequal treatment to reference materials in determining the page count of appellant and respondent briefs, the rule is hereby waived. Specifically, "reference materials such as prior art references" that are properly part of an appendix to the respondent's brief are not being counted toward the page limit set in § 1.943(c). Furthermore, the sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and 37 CFR 41.68(b)(1)(i)-(iv) respectively are deemed to be included in "reference materials" that do not count toward the page limits.

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count only insofar as they are documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court of the Board as identified in the "Related appeals and interferences" section of the brief. Any documents that are not required to be submitted (such as Office actions, requests for reexamination, etc.) are counted toward the size limit of the brief.

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[3] i.e:, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments, (ix) Evidence Appendix, (x) Related Proceedings Appendix, and (xi) Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

CONCLUSION

1. Patent owner's and third party requester's petitions under 37 CFR 1.183 are both granted, making the proffered appellant brief and a respondent's brief page length compliant.

2. 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

8-5-10
kenAppeal/length

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed July 2, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 21 pages and 10,773 words in length." Petition, p. 1.

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

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35. The length of the ACP was 134 pages.

8. On September 28, 2009, Rambus filed comments in response to the ACP.

9 On October 28, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

11. On February 19, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-28 and confirming claims 29-35.

12. On March 19, 2010, Rambus filed a Notice of Appeal for claims 1-28.

13. On April 2, 2010, Micron filed a Notice of Cross Appeal for claims 14-16.

14. On June 2, 2010, Rambus filed an Appeal Brief along with a Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Appeal Brief.

15. On July 2, 2010, Rambus filed a Respondent Brief along with the present Petition.

16. Also on July 2, 2010, Micron filed a Respondent Brief.

17. On July 16, 2010, Rambus filed a petition under 37 C.F.R. § 1.182/1.183 requesting to strike those portions of Micron's Respondent Brief of July 2, 2010 addressing rejections proposed by Samsung.

18. On August 6, 2010, the Office mailed a Decision Dismissing Patent Owner's Petition to Strike Portions of Requester's Respondent Brief.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

As an initial matter, Rambus argues that Micron's appeal brief "addresses issues that it did not raise in its request for reexamination but which were instead raised by Samsung." Petition, p. 1. As a matter of propriety, this issue was addressed in the Decision Dismissing Patent Owner's Petition to Strike Portions of Requester's Respondent Brief:

> A review of Requester Micron's respondent brief reveals that [it] does address the eight Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1124 proceeding). However, these eight proposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Decision, p. 6.

Rambus also argues that in addition to the numerous rejections addressed in Micron's Appeal Brief, one of the references relied upon in one

of the rejections is more than 400 pages in length and another reference is not a printed publication. Petition, p. 2.

Further, Rambus contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." *Id.* at 2.

The eleven issues addressed in Rambus's Appeal Brief, as described in the "Issues to be Reviewed on Appeal" section of the Appeal Brief (Appeal Brief, pp. 1-2), are completely different than the nine issues addressed in Rambus's Respondent Brief, as described in the "Issues to be Reviewed on Appeal" section of the Respondent Brief (Respondent Brief, p. 1), reflecting the different rejections proposed by Micron and Samsung. Clearly, the issues presented by each of the two merged reexamination proceedings are distinct from those presented in the other proceeding.

It is further noted that the ACP of August 28, 2009 was 134 pages in length.

In view of the number of different patentability issues presented in this merged reexamination proceeding, a modest increase of six pages in the permitted length of Rambus's Respondent Brief is reasonable. It is unnecessary to reach Rambus's due process argument.

DECISION

For the forgoing reason, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000250 and 95/001,124
Patent 6,452,863

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexaminations of:	)	
	)	
Michael Farmwald et al.	)	Control Nos.: 95/000,250; 95/001,124
	)	
U. S. Patent No. 6,452,863	)	Group Art Unit: 3992
	)	
Issued: September 17, 2002	)	Examiner: Ovidio Escalante
	)	
For: METHOD OF OPERATING A MEMORY DEVICE HAVING A VARIABLE DATA INPUT LENGTH	)	

Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S RESPONDENT BRIEF

Pursuant to 37 C.F.R. § 1.183, Rambus Inc., the owner of U.S. Patent No. 6,452,863 ("the '863 patent"), requests that the Office waive the requirement of 37 C.F.R. § 1.943(c) limiting respondent appeal briefs to fifteen pages or 7,000 words in length. Specifically, Rambus requests that the Office accept its respondent appeal brief, which is 21 pages and 10,773 words in length.[1] Rambus is submitting this petition concurrently with its brief. To the extent that entry and consideration of this petition requires suspension of any rules, suspension is requested pursuant to 37 C.F.R. § 1.183. In addition, a petition fee of $400 is being submitted with this petition. If there is any other fee due in connection with the filing of this petition, please charge the fee to Deposit Account 06-0916.

Rambus seeks entry and consideration of this petition for three reasons. First, Rambus seeks to comprehensively address all of the arguments made by third party requester Micron Technology Inc. ("Micron") in these reexamination proceedings. Specifically, Micron's cross-appeal brief addresses issues that it did not raise in its request for reexamination but which were instead raised by Samsung Electronics Co. Ltd. ("Samsung"). Indeed, Micron devotes nearly

[1] The listed page and word count excludes the pages and words that constitute the "appendices of claims and reference materials" as the Office has interpreted that language of 37 C.F.R. § 1.943(c).

half of its appeal brief to issues raised by Samsung. Micron's brief also addresses the patentability of claims 14-16 of the '863 patent based on U.S. Patent No. 4,734,909 ("*Bennett*"), a reference that is more than 400 pages long, and based on the Scalable Coherent Interface Project ("*Gustavson*"), a reference that is not a printed publication. The Office should permit Rambus to comprehensively address Micron's arguments.

Second, the Office should not use merger of reexamination proceedings to unfairly limit Rambus's ability to fully address all issues in its respondent brief. Micron's appeal involves merged *inter partes* reexamination proceedings. Had the two *inter partes* reexamination proceedings not been merged or had Samsung appealed issues from reexamination control no. 95/000,250, the Office would have allowed Rambus to submit a respondent appeal brief 15 pages or 7,000 words in length in *each* of the two proceedings, totaling 30 pages or 14,000 words. Here, Rambus's respondent brief is 21 pages long and contains 10,773 words. Rambus should not be deprived of 15 pages or 7,000 words merely because the Office merged two reexamination proceedings and Micron seeks to improperly appeal issues from a different proceeding.

Third, Rambus seeks waiver because the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights, especially given the facts here. The Office imposes no page or word count limits on the Examiner during reexamination or appeal, permitting the Examiner to file appeal briefs unlimited in length and issue office actions that often span well over a hundred pages in length and incorporate by reference large portions of the Requests corresponding to proposed rejections. Further, the Office does not impose such limits on appeal briefs in *ex parte* reexamination proceedings. The imposition of such limits on appellant or respondent briefs in *inter partes* reexaminations is arbitrary.

A patent has "the attributes of personal property." 35 U.S.C. § 261 (2000). Placing limits on the patent owner's ability to comprehensively address each of the third party requester's arguments violates the patent owner's due process rights. The Federal Circuit has held that "administrative convenience or even necessity cannot override the constitutional requirements of due process." *See Paltex Corp. v. Mossinghoff*, 771 F.2d 480, 483 (Fed. Cir. 1985). Here, Rambus stands to lose valuable property rights if the Board adopts any of the non-rejections appealed by Micron. The Office should afford Rambus adequate opportunity to present its arguments supporting patentability of the appealed claims.

I. BACKGROUND

On June 28, 2007, a request for *inter partes* reexamination identifying Samsung as the real party in interest was filed seeking reexamination of claims 1-35 of the '863 patent. That proceeding was assigned control no. 95/000,250. On November 24, 2008, a request for *inter partes* reexamination identifying Micron as the real party in interest was filed seeking reexamination of claims 14-16 of the '863 patent. That proceeding was assigned control no. 95/001,124. On March 6, 2009, the Office merged the '250 and '1,124 proceedings.

On February 19, 2010, the Office issued a Right of Appeal Notice ("'863 RAN") in the merged proceedings. In the '863 RAN, the Office rejected claims 1-28 and confirmed claims 29-35 of the '863 patent. Samsung did not appeal any issues from the '250 proceeding. Rambus appealed all of the pending rejections on March 19, 2010. Micron filed a notice of cross-appeal on April 2, 2010. Both Rambus and Micron filed their appeal briefs on June 2, 2010. The appeal brief filed by Micron, however, attempts to resurrect issues raised by Samsung that Samsung is not appealing—issues that Micron did not raise in its reexamination request and that Micron has no standing to raise on appeal.

II. ARGUMENT

Under 37 C.F.R. § 1.943(c), all briefs, other than appellant briefs, cannot exceed fifteen pages or 7,000 words in length. But in light of the issues raised by Micron in its appeal brief, the merger of the Samsung-initiated and Micron-initiated reexamination proceedings, and because Rule 1.943(c) is arbitrary and violates Rambus's due process rights, Rambus requests that the Office accept its respondent appeal brief, which is 21 pages and 10,773 words in length. Rambus has made every effort to pare down the arguments in its respondent appeal brief, but a respondent appeal brief limited to 15 pages or 7,000 words in length is inadequate to fully address and comprehensively respond to Micron's arguments.

A. Rambus Should Be Able to Address Micron's Extensive Arguments

Micron continues to address Samsung-proposed rejections in its appeal. Specifically, in its appeal brief, Micron raises seven issues,[2] including the following three: (1) whether claims 14-

[2] While Micron lists only six numbered issues in is cross-appeal brief, one of the issues is actually two separate issues, namely whether The Scalable Coherent Interface Project ("*Gustavson*") allegedly anticipates <u>and/or</u> renders obvious claims 14-16.

16 are entitled to a filing date prior to January 27, 2000;[3] (2) whether claims 14-16 are anticipated by U.S. Patent No. 5,590,086 ("*Park*"); and (3) whether claims 14-16 are anticipated by Joint Electronic Device Engineering Counsel (JEDEC) Standard No. 21-C, Revision 9, ("*JEDEC Standard*"). Micron, however, did not raise any of these three issues in its reexamination request. Instead, these issues were raised exclusively by Samsung in the '250 proceeding. Micron is not a party to the '250 proceeding, so it is statutorily and otherwise prohibited from appealing those issues from the '250 proceeding.

In addition to the arguments necessary to address Micron's attempt to resurrect Samsung's non-appealed issues, Rambus must also address the issues that Micron appealed from the Micron-initiated proceeding. Two of the four Micron-proposed rejections addressed in Micron's appeal brief are based on U.S. Patent No. 4,734,909 ("*Bennett*"), which constitutes 254 pages of drawings and 282 columns of description and claims.

Rambus previously filed similar petitions requesting a waiver of Rule 1.943(c) concurrently with its respondent briefs in the 95/001,105, 95/001,133, 95/000,166, and 95/001,122 *inter partes* reexamination proceedings. There, Rambus requested a waiver of Rule 1.943(c) because Micron's cross-appeal brief had raised issues similar to those raised in the current reexamination proceedings. Nevertheless, the Office dismissed those petitions, stating that "the third party requester's appellant's brief presents these same issues and yet remains within the page limit requirements set forth in 37 C.F.R. § 1.943(c)." *See* Decision Dismissing Patent Owner's Petition to Waive the Page Limit For Its Appellant's Brief, And Dismissing Petitions to Waive the Page Limits for Respondent's Briefs, dated May 27, 2010, in control nos. 95/001,105 and 95/001,133, at 8 (hereinafter the "Page Limit Decision").

To the extent the Office applies the same reasoning here, it is flawed because it ignores that Micron is permitted 30 pages or 14,000 words for its appeal brief—double the number of pages and words available to Rambus as respondent. Moreover, Micron's appeal brief devotes 13 pages (*see* Micron Br. at 4-17) to rejections that Micron proposed in its request for reexamination and almost 15 pages (*see* Micron Br. at 17-32) to Samsung's issues—issues that

[3] As explained in Rambus's respondent brief, the "priority" issue originally raised by Samsung is not proper in reexamination. Because Micron has attempted to keep this issue alive on appeal, Rambus must also address the propriety of revisiting the "priority" issue.

only Samsung could have appealed in a separate appeal. The Office should permit Rambus equal opportunity to rebut Micron's arguments.

To the extent that the Office cites the limits placed on the patent holder in responding to Office Actions, those do not support limiting the patent owner on appeal to 15 pages or 7,000 words. Indeed, there the patent owner is allowed 50 pages—substantially more than it is being permitted on appeal. Moreover, a respondent brief is not an office action response. An office action response is directed to an Examiner who is familiar with the technical subject matter of the patent under reexamination. In particular, the reexamination of the '863 patent has proceeded for almost three years, and the Examiner conducting these proceeding is also participating in the reexaminations of several other related patents. A respondent appeal brief, on the other hand, is directed to the Board. The Board will likely consider the subject matter of the '863 patent and the cited prior art for the first time during appeal. Therefore, to make cogent arguments about the highly technical subject matter of the '863 patent, it is imperative that Rambus provide sufficient information concerning the patent, the cited references, and the arguments of the third party requester.

The Office has waived the requirements of Rule 1.943(c) under similar circumstances. *See, e.g.*, Decision Granting Petition Under Proceedings 37 CFR 1.183, dated March 6, 2007, in control nos. 95/000,066 and 95/000,069, at 3. In those proceedings, the Office granted leave to file a respondent appeal brief that exceeded the page and word count limitations of Rule 1.943(c), up to a total of 23 pages or 10,500 words. The Office did so in the interest of fairness to allow the responding party to adequately address the opening appeal brief. *Id.* at 3. The same fairness concerns apply here. Indeed, the primary reason Rambus seeks additional pages is due to Micron's attempt to raise issues that it is not allowed to raise.

B. The Office Should Not Use Merger of Reexaminations to Place Unfair Limitations on Rambus

Micron currently raises seven issues from merged reexaminations proceedings. Three of these issues were raised in Samsung's request for *inter partes* reexamination—not Micron's. Indeed, Micron devotes nearly 15 pages of its appeal brief to issues from the '250 proceeding. Moreover, if these proceedings had not been merged, Rambus would have been able to file two separate respondent briefs from any appeals taken, each of which could be 15 pages or 7,000 words in length. But the Office seeks to limit Rambus to a single respondent brief that is 15 pages or 7,000 words in length merely because the proceedings have been merged and Micron

improperly appeals from both proceedings. Rambus's ability to address each claim rejection thoroughly in its respondent brief should not be unfairly limited because of the merger of these proceedings.

The Office did not contemplate limiting a patent owner's rights when it adopted merger practice for co-pending reexaminations of the same patent. It instituted merger practice merely for administrative convenience "to facilitate the orderly handling of the proceedings." M.P.E.P. § 2686.01. The Office adopted the policy of merging concurrent reexamination proceedings "to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner." *See* Rules To Implement Optional Inter Partes Reexamination Proceedings, 65 Fed. Reg. 18154, 18164 (proposed Apr. 6, 2000) (to be codified at 37 C.F.R. pt. 1). Thus, the Office adopted the merger rule to improve the efficiency of reexaminations, not to limit the rights of the patent owner. As a result, the Office should not subject Rambus to unfair limitations that Rambus would not have faced if the '250 and '1,124 proceedings had not been merged. Because Rambus would have been entitled to a total of 30 pages or 14,000 words for its appeal briefs had the proceedings not been merged, and because Rambus must address Micron's arguments on issues Micron should not be able to raise, the Office should permit Rambus to file its 21-page respondent brief that contains 10,773 words in these merged proceedings.[4]

Indeed, if the merger is an impediment to the Office's grant of this petition, the Office should unmerge the two proceedings so that Rambus can limit its brief to the issues in the '1,124 proceeding, obviating the need for additional pages or words.

C. The Limitations Imposed by Rule 1.943(c) Are Arbitrary and Violate Rambus's Due Process Rights

The limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights. The general test for due process in administrative procedures, summarized in *Mathews v. Eldridge*, 424 U.S. 319 (1976), requires evaluation of three factors: (1) the private interest that will be affected by the official action, (2) the risk of erroneous deprivation of such interest through the procedures used, and (3) the Government's interest, including the function involved

[4] Rambus is also concurrently filing a Petition to Strike Portions of the Third Party Requester's Appeal Brief.

and the fiscal and administrative burdens that additional or substitute procedural requirements would entail. *See Paltex*, 771 F.2d at 484.

The private interest that is affected by the Office's decision is Rambus's property interest in the '863 patent. A patent has "the attributes of personal property." 35 U.S.C. § 261 (2000). Moreover, there is serious risk of erroneous deprivation of this property interest because Rambus stands to lose valuable property rights should the Board affirm the Examiner's rejections or enter the non-rejections that Micron purports to appeal. Moreover, the arbitrary limits imposed by the Office unfairly burden the patent owner's ability to defend its property rights. The Office imposes no page or word count limit on the Examiner, allowing the Examiner to issue unlimited office actions or file briefs with no word or page limits. Thus, for example, the Office has permitted an Examiner to file a 60-page Examiner's Answer addressing only 3 claims in an appeal by a third party requester from the unmerged 95/000,154 *inter partes* reexamination proceedings. Imposing a page-limit restriction on the patent owner without a similar restriction on the Examiner is arbitrary.

The administrative burden on the Office by waiving Rule 1.943 for the appellant and respondent briefs is minimal. As discussed above, the Office does not impose any limits on the Examiner. And, notably, the Office does not impose any such limits on briefs in appeals taken from *ex parte* reexamination proceedings. Yet in an *inter partes* proceeding, where a patent owner has to respond to issues raised by a requester as well as the Examiner, the Office imposes stringent limits appeal briefs. Such limits in *inter partes* reexaminations are arbitrary, violate the patent owner's due process rights, and should not be enforced, especially given the facts here. Moreover, as noted by the *Paltex* Court, "administrative convenience or even necessity cannot override the constitutional requirements of due process." *See Paltex*, 771 F.2d at 483. Thus, the page and word count limits imposed by Rule 1.943 violate Rambus's due process rights.

Further, the 15 pages or 7,000 word limit of Rule 1.943(c) for a respondent appeal brief is arbitrary, especially where the appellant brief can be 30 pages or 14,000 words. Even the Federal Circuit permits appellees/respondents to file respondent briefs that are the same length as the opening brief to which they respond. Fed. R. App. Pro. 32(a)(7). The Office should, therefore, afford Rambus adequate opportunity to defend its property rights in this appeal.

III. CONCLUSION

Rambus requests that the Office grant this petition and accept its respondent appeal brief, which contains 21 pages and 10,773 words and exceeds the page and word count limitations imposed by 37 C.F.R. § 1.943(c).

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 2, 2010

By: _____
Naveen Modi
Reg. No. 46,224

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed June 2, 2010 ("Petition"). In the Petition, Patent Owner seeks to have stricken "those portions of [Third Party Requester] Micron's cross-appeal brief that raises issues that Micron did not propose in its request for reexamination and that are not part of the Micron-initiated reexamination proceeding (control no. 95/001,124 . . .)." Petition, p. 1.

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

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.

8. On September 28, 2009, Rambus filed comments in response to the ACP.

9 On October 28, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

11. On February 19, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-28 and confirming claims 29-35.

12. On March 19, 2010, Rambus filed a Notice of Appeal for claims 1-28.

13. On April 2, 2010, Micron filed a Notice of Cross Appeal for claims 14-16.

14. On June 2, 2010, Rambus filed an Appeal Brief.

15. Also on June 2, 2010, Micron filed a Cross-Appeal Brief.

16. On July 2, 2010, Rambus filed a Respondent Brief along with the present Petition

17. Also on July 2, 2010, Micron filed a Respondent Brief.

18. On July 16, 2010, Rambus filed a petition under 37 C.F.R. § 1.182/1.183 requesting to strike those portions of Micron's Respondent Brief of July 2, 2010 addressing rejections proposed by Samsung.

19. On August 6, 2010, the Office mailed a Decision Dismissing Patent Owner's Petition to Strike Portions of Requester's Respondent Brief.

RELEVANT AUTHORITY

Concerning the contents of appeal briefs, 37 C.F.R. §§ 41.67(c)(1)(vi) and (vii) provide:

> (vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. . . .
>
> (vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on.

ANALYSIS

Rambus argues that:

> [P]ortions of Micron's cross-appeal brief [raise] issues that Micron did not propose in its request for reexamination and that are not part of the Micron-initiated reexamination proceeding.... Micron ... seeks to appeal issues from [Samsung-initiated] reexamination control no. 95/000,250.... Because Micron does not have standing to appeal those issues, the Office should strike the portions of Micron's cross-appeal brief addressing those issues.

Petition, pp. 1-2.

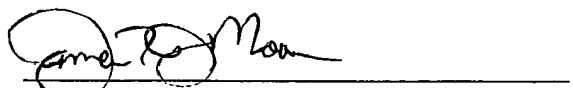
In this merged proceeding, this issue previously was addressed in the Decision Dismissing Patent Owner's Petition to Strike Portions of Requester's Respondent Brief:

> A review of Requester Micron's respondent brief reveals that [it] does address the eight Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1124 proceeding). However, these eight proposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Decision, p. 6.

DECISION

For the forgoing reason, the Petition is DENIED.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000250 and 95/001,124
Patent 6,452,863

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5

PATENT
Customer No. 22,852
Attorney Docket Nos. 10314.0005 and .0019

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexaminations of:	)	
	)	
Michael Farmwald et al.	)	Control Nos.: 95/000,250; 95/001,124
	)	
U. S. Patent No. 6,452,863	)	Group Art Unit: 3992
	)	
Issued: September 17, 2002	)	Examiner: Ovidio Escalante
	)	
For: METHOD OF OPERATING A MEMORY DEVICE HAVING A VARIABLE DATA INPUT LENGTH	)	

Mail Stop *Inter Partes* Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO STRIKE PORTIONS OF THE THIRD PARTY REQUESTER'S APPEAL BRIEF

Pursuant to 37 C.F.R. § 1.182, Rambus Inc., the owner of U.S. Patent No. 6,452,863 ("the '863 patent"), requests that the Office strike portions of Micron Technology Inc.'s ("Micron") cross-appeal brief filed on June 2, 2010. To the extent that entry and consideration of this petition requires suspension of any rules, suspension is requested pursuant to 37 C.F.R. § 1.183. In addition, a petition fee of $400 is being submitted herewith.[1] If there is any other fee due in connection with the filing of this petition, please charge the fee to Deposit Account 06-0916.

Rambus seeks entry and consideration of this petition to strike those portions of Micron's cross-appeal brief that raise issues that Micron did not propose in its request for reexamination and that are not part of the Micron-initiated reexamination proceeding (control no. 95/001,124 or the '1,124 proceeding). The M.P.E.P. says that a "notice of appeal by a third party requester

[1] In accordance with the Decision, *Sua Sponte*, to Merge Reexamination Proceedings, dated March 6, 2009, only one fee is being submitted for this paper, and it is being submitted in the '1,124 proceeding.

must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest." M.P.E.P. § 2674 (emphasis in original). Therefore, Micron should not be permitted to discuss on appeal any issues that it did not previously propose in its request for reexamination. Further, according to 35 U.S.C. § 317(a), once the Office has issued an order for *inter partes* reexamination of a patent, neither the third party requester nor its privies may file a subsequent request for *inter partes* reexamination of the same patent until the Office has issued an *inter partes* reexamination certificate in the pending reexamination proceedings. Micron, however, seeks to appeal issues from reexamination control no. 95/000,250 (the '250 proceeding). Because Micron does not have standing to appeal those issues, the Office should strike the portions of Micron's cross-appeal brief addressing those issues.

Specifically, the Office should strike Sections VII.F-VII.I. at pages 17-32 of Micron's cross-appeal brief, addressing rejections based on the Joint Electronic Device Engineering Counsel (JEDEC) Standard No. 21-C, Revision 9, ("*JEDEC Standard*") and U.S. Patent No. 5,590,086 ("*Park*") and a priority determination that Micron did not propose in its request for reexamination.

I. BACKGROUND

Third-party requester Samsung Electronics Co., Ltd. ("Samsung") initiated an *inter partes* reexamination of claims 1-35 of the '863 patent on June 28, 2007. That proceeding was assigned control no. 95/000,250. In its request, Samsung alleged that the claims of the '863 patent were not entitled to the priority date of Application No. 07/510,898, the application to which the '863 patent claims priority. Samsung also proposed rejections of claims 1-35 based on, *inter alia*, two intervening references—the *JEDEC Standard* and *Park*.

Micron initiated an *inter partes* reexamination of claims 14-16 of the '863 patent on November 24, 2008. That proceeding was assigned control no. 95/001,124. In its request, however, Micron did not raise any priority issues and did not rely on the *JEDEC Standard*, *Park*, or any other intervening reference.

The Office merged the '250 and '1,124 proceedings on March 6, 2009. Prosecution proceeded, and on February 19, 2010, the Office issued a Right of Appeal Notice ("'863 RAN") in the merged proceedings rejecting claims 1-28 and confirming claims 29-35. Rambus appealed all of the pending rejections on March 19, 2010. Micron purported to appeal decisions favorable

to patentability of claims 14-16 on April 2, 2010. Samsung did not appeal any issues in the '250 proceeding, and filed a notice on February 11, 2010, noting that "it no longer intends to participate in the present reexamination." (*See* Samsung's 2/11/2010 Notice of Non-Participation in *Inter Partes* Reexamination.)

Both Rambus and Micron filed their appeal briefs on June 2, 2010. Micron, however, devoted a portion of its cross-appeal brief (Sections VII.F-VII.I at 17-32) to the priority date for claims 14-16 and Samsung's proposed rejections of claims 14-16 over the intervening *JEDEC Standard* and *Park* references—issues not raised in Micron's request for reexamination.

II. ARGUMENT

Rambus seeks to streamline the issues on appeal, conserve the Office's and Rambus's resources, and eliminate the prejudice to Rambus caused by Micron's appeal of issues proposed by a different requester in a different reexamination proceeding. Samsung is not appealing, yet, Micron continues to address issues only raised in Samsung's request for reexamination, relying on the merger as its only alleged basis for doing so. Rambus, therefore, requests that those portions of Micron's cross-appeal brief that are not directed to issues raised in Micron's request for reexamination be stricken.

M.P.E.P. § 2674 provides that 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." M.P.E.P. § 2674 (emphasis in original). And M.P.E.P. § 2674.01 states that "the content of a notice of cross appeal is the same as that for a notice of appeal, except that the notice of cross appeal is titled as such and identifies the original appeal from which the cross appeal is taken." In other words, a third party requester may only appeal those issues that it raised in its request for reexamination. Micron, however, attempts to appeal issues that it did not raise in its request for reexamination. Because Micron has not complied with the requirements of the M.P.E.P. and has exceeded its appeal rights, the Office should strike portions of Micron's cross-appeal brief.

The Board has indicated that a requester cannot appeal a rejection that it did not propose. For example, in *Meadwestvaco Packaging Sys., LLC v. Patent of C. Brown Lingamfelter*, Requester I in a merged proceeding raised a rejection on appeal that had been proposed by Requester II. Appeal No. 2009-002578, 2010 WL 191281, at *40, *46 n.3 (B.P.A.I. Jan. 12, 2010). The Board said that "the record does not indicate that such a rejection was proposed by

Requester I," and concluded that "there is no issue for the Board to decide" under Requester I's appeal of that proposed rejection. *Id.* at *40.

Similarly, in *Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.*, the Board noted that a Requester can only appeal rejections proposed in its request for reexamination. Appeal No. 2009-002973, 2010 WL 1064484, at *6 (B.P.A.I. Mar. 23, 2010). According to the Board, "to the extent that the Respondent desired rejections based on the arguments now set forth . . . the Respondent should have proposed the specific rejection in the Request for Inter Partes Reexamination which started this reexamination proceeding." 2010 WL 1064484 at *6; *see also Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.*, Appeal No. 2009-002973, 2009 WL 2342053, at *4 (B.P.A.I. July 31, 2009). The M.P.E.P., the Rules, and the Board have thus made it clear that a third-party requester can only appeal rejections that it previously proposed.[2]

Micron has argued in other proceedings that it has a statutory right under 35 U.S.C. § 315(b) to appeal issues from the Samsung proceeding because that statute permits a requester to appeal any decision favorable to patentability. Section 315(b), however, does not mention merger, does not authorize merged proceedings, and does not give a requester the right to appeal issues from another proceeding, whether merged or not. Thus, the statute cannot be read as authorizing a practice that it does not contemplate, i.e., appealing issues from separate reexamination proceeding because they have been merged.[3]

---

[2] Similarly, in *In re Laks*, Control No. 95/000,206, Corrected Decision, *Sua Sponte* Merging Reissue and *Inter Partes* Reexamination Proceedings and Waiving Rules (May 1, 2008), the Office merged an *inter partes* reexamination with a co-pending reissue application and permitted the reexamination requester to only comment on matters that it could have commented on prior to the merger. *Id.* at 8. The Office limited the requester so that it did not have more rights than it would have had if the proceedings had not been merged. *Id.* at 9.

[3] Micron also contends that 37 C.F.R. § 1.989(a) states that "a merged reexamination 'normally result[s] in the issuance of a single reexamination certificate,'" so it makes clear that all issues from a merged reexamination are merged into a single proceeding. This interpretation is inconsistent with § 1.989(a) itself, which says that merger *normally* results in a single reexamination certificate, indicating that separate certificates may issue in some instances. M.P.E.P. § 2686.01(III)(A) also contemplates that merged proceedings may not "remain merged," underscoring the separate nature of the proceedings. And the Office maintains separate files and requires that the parties make filings in both proceedings. Thus, merged proceedings are not a "single" proceeding.

Moreover, § 315(b) should not be read in isolation. Rather, it should be read together with the other statutory sections governing *inter partes* reexaminations. Specifically, after the Office has issued an order for *inter partes* reexamination of a patent in response to a request by a third party requester, 35 U.S.C. § 317(a) prohibits the same third party requester or its privies from filing subsequent requests for *inter partes* reexamination of the same patent until the Office has issued an *inter partes* reexamination certificate in the pending reexamination proceedings. By appealing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent. The Office should not permit Micron to evade the limitations of § 317(a).

Micron directs a portion of its cross-appeal brief to a priority issue and to proposed rejections of claims 14-16 based on the intervening *JEDEC standard* and *Park* references. Specifically, Sections VII.F-VII.I, which span pages 17-32, address a priority issue and proposed rejections based on the *JEDEC Standard* and *Park*. Micron did not raise these issues in its request for reexamination. Indeed, Micron has said nothing regarding these issues in its previous submissions. In both its July 22, 2009 Comments and October 28, 2009 Comments Micron merely purported to adopt and incorporate by reference Samsung's Comments. (*See* Micron's 7/22/2009 Comments at 1; Micron's 10/28/2009 Comments at 1.) Micron could not and did not convert those issues into its own issues by allegedly adopting Samsung's Comments. Indeed, in another proceeding, after Rambus objected to Micron and Samsung's incorporation of comments by reference, the Examiner stated that such incorporation "was not considered since it was not deemed to be part of the actual response." (*See* Control Nos. 95/000,166 and 95/001,122, 12/18/09 Right of Notice of Appeal at 4-5.)

The Office adopted merger practice for administrative convenience "to facilitate the orderly handling of the proceedings," not to expand a third-party requester's rights. *See* M.P.E.P. § 2686.01. A third-party requester should only be able to participate in merged *inter partes* reexamination proceedings to the extent that it could have participated prior to merger. Therefore, the Office should strike those portions of Micron's cross-appeal brief that raise issues that Micron did not propose in its request for reexamination and that are not part of the Micron-initiated reexamination proceeding—Sections VII.F-VII.I, which span pages 17-32.

III. CONCLUSION

For at least these reasons, Rambus requests the Office to strike Sections VII.F-VII.I of Micron's cross-appeal brief at pages 17-32.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 2, 2010

By: _____
Naveen Modi
Reg. No. 46,224

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No.: 95/000,250 :
Filed: June 28, 2007 :
For: U.S. Patent No. 6,452,863 :
:
:
In re Farmwald et al. :
Inter partes Reexamination Proceeding :
Control No. 95/001,124 :
Filed: November 24, 2008 :
For: U.S. Patent No. 6,452,863 :

DECISION DISMISSING PATENT OWNER'S PETITION TO STRIKE PORTIONS OF REQUESTER'S RESPONDENT BRIEF

This is a decision on the July 16, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THIRD-PARTY REQUESTER'S RESPONDENT BRIEF." Since the petition is actually on challenging the making of record of the respondent brief by the Central Reexamination Unit (CRU), the petition will be taken and decided as a petition under 37 CFR 1.181 challenging an action taken by the CRU – see the below discussion.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On September 17, 2002, U. S. Patent Number 6,452,863 (the '863 patent) issued with thirty-five claims to Farmwald et al.

2. On April 4, 2007, a request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ("the '250 proceeding"), was initially deposited by a third party requester. A corrected request was then filed, and received a filing date of, June 28, 2007. Samsung Electronics, Co. Ltd. ("Samsung") was identified as the real party in interest.

3. On September 5, 2007, an Order was issued by the Office granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 reexamination proceeding.

4. On July 3, 2008, an Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed.

5. On November 24, 2008, a request for *inter partes* reexamination of claims 14-16 of the '863 patent, assigned Reexamination Control No. 95/001,124 ("the '1124 proceeding"), was filed by third party requester Micron Technology, Inc. ("Micron").

6. On January 16, 2009, an Order was issued by the Office granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 reexamination proceeding.

7. On March 6, 2009, the '250 and '1124 proceedings were merged.

8. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-35.

9. On September 28, 2009, patent owner filed comments in response to the ACP.

10. On October 28, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 19, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-28 and confirming claims 29-35.

13. On March 19, 2010, patent owner filed a Notice of Appeal for claims 1-28.

14. On April 2, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 14-16.

15. On June 2, 1010, patent owner filed an appellant's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

16. On July 2, 2010, third party requester Micron filed a respondent brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

17. On July 16, 2010, patent owner filed the present petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by third party requester Samsung.

RELEVANT AUTHORITY

35 U.S.C. § 312 (Determination of issue by Director) provides (in pertinent part):

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. § 313 (*Inter partes* reexamination order by Director) provides:

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

35 U.S.C. § 314 (Conduct of *inter partes* reexamination proceedings) provides (in pertinent part):

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

35 U.S.C. § 315 (Appeal) provides (in pertinent part):

(b)THIRD-PARTY REQUESTER.— A third-party requester—
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and
(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

35 U.S.C. § 317 (Inter partes reexamination prohibited) provides (in pertinent part):

(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 1.181 provides (in pertinent part):

(a)Petition may be taken to the Director:
(1)From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 41.68 provides (in pertinent part):

(a)(1)Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.
(2)The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).
(3)The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.
(4) A requester's respondent brief may not address any brief of any other requester.

DECISION

I. Patent owner's July 16, 2010 Petition

In its present petition, patent owner requests under 37 CFR 1.182 and if necessary, under 37 CFR 1.183, that those portions of Requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by Requester Samsung and not raised by Micron in its request for reexamination be stricken. In support of its request that portions of Requester Micron's respondent brief addressing issues raised by another third party requester be striken, petitioner patent owner points to the following authority: (1) MPEP 2675.02 and 37 CFR 41.68(a)(3) state that the "respondent brief must ...be limited to issues raised in the appellant brief to which the respondent brief is directed," and (2) 37 CFR 41.68(a)(4) states "[a] requester's respondent brief may not address any brief of any other requester."[1]

Patent owner further argues that Rambus's appeal brief addressed rejections raised by both Samsung and Micron because the Office merged the Micron initiated reexamination proceeding (the '1124 proceeding) with the Samsung initiated reexamination proceeding (the '250 proceeding), and that merger of the two proceedings should "neither expand Micron's reexamination rights nor allow Micron to address rejections in its respondent brief that it did not previously propose and that it could not have addressed if the Office had not merged the reexamination proceeding."[2] Patent owner specifically requests that "the Office should strike Sections VII.A-VII.J at pages 1-24 and Section VII.L at pages 30-32 of Micron's Respondent Brief"[3] that address the "eight Samsung-proposed rejections – anticipation rejections based on *iAPX* and *Budde*, obviousness rejections over *iAPX* or *Budde* in view of *Inagaki*, and obviousness rejections of *iAPX* or *Budde* in view of *Lofgren*."[4]

Patent owner further argues that "[b]y appealing and addressing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent."[5]

Finally, patent owner cites to two specific Board decisions, to support its present request. Patent owner argues that "[t]he Board had indicated that that [sic] a requester cannot appeal a rejection that is did not propose,"[6] and cites as exemplary decisions to *Meadwestvaco Packaging Sys., LLC v. Patent of C. Brown Lingamfelter*. Appeal No. 2009-002578, 2010 WL 191281 (B.P.A.I. Jan. 12, 2010) and *Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.* Appeal No. 2009-002973, 2010 WL 1064484 (B.P.A.I. Mar. 23, 2010).[7]

II. Analysis and Findings

As pointed out above, patent owner's petition under 37 CFR 1.182/1.183 is taken as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the

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[1] Petition at page 2.
[2] *Id.* at pages 2 and 5.
[3] *Id.* at page 2.
[4] *Id.* at page 6.
[5] *Id.* at page 4.
[6] *Id.*
[7] *Id.*

requester's respondent brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions of the respondent brief. Patent owner is actually asserting that the requester respondent brief was improperly placed of record in the Image File Wrapper (IFW)) for the proceeding, and requesting that it be expunged, with requester being directed to replace the brief by a redacted or revised respondent brief to exclude the portions of the paper argued to be improper.

Patent owner's petition has been fully considered, and not found persuasive. A review of Requester Micron's respondent brief reveals that does address the eight Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1124 proceeding). However, these eight poposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted the Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Patent owner argues that 37 CFR 41.68(a)(4) limits requester Micron's respondent brief by stating that a requester's respondent brief may not address any brief of any other requester. Such argument is unpersuasive and not on point. 37 CFR 41.68(a)(4) is directed to filing a respondent brief in response to the brief of the other requester (in this case, Samsung), which was not filed in the instant proceeding. Rather, Micron's respondent brief is a respondent brief in response to the brief of the patent owner.

Patent owner argues that MPEP 2675.02 states that the respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. This does not support patent owner's position that requester Micron cannot address issues raised in patent owner's appellant brief, since the examiner's adopted rejections (originally proposed by Samsung) are addressed by patent owner's appellant brief, and Micron's respondent brief is entitled to then address what patent owner's appellant brief said about those rejections.

Patent owner presents arguments that the Board has indicated, in its decisions, that a requester cannot appeal a rejection that it did not propose. These arguments again are not on point, since requester Micron's respondent brief is addressing patent owner's argument as to the rejection the Office has adopted, as its own, and requester is not appealing a rejection that it did not propose. A third party requester may comment on an issue that has been adopted by the examiner and raised in patent owner's appeal brief, as the proposed rejections that are adopted become the examiner's rejections in the reexamination proceeding. Furthermore, 35 U.S.C. § 315(b)(2) states that a requester may be a party to any appeal taken by the patent owner and the statute does not provide the extent of the party.

Patent owner argues that requester Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent by addressing issues not raised in its request. This argument is not persuasive. First, the issues addressed by Micron are already part of the present reexamination proceeding, as discussed above. Second, this argument does not relate to the propriety of the issues raised in requester Micron's respondent brief, based on the statute, regulations, and practice.

Since requester Micron's respondent brief is limited to addressing issues raised in the patent owner's appellant brief that have been adopted by the examiner, the issues raised in requester Micron's respondent brief are not improper. Accordingly, patent owner's July 16, 2010 petition is dismissed.

CONCLUSION

1. Patent owner's July 16, 2010 petition to strike portions of Requester Micron's respondent brief is **dismissed**.

3. Any questions concerning this communication should be directed to the undersigned at (571) 272-3838.

Gregory Morse
Director
Central Reexamination Unit

8-4-10
KenAppeal/decisions/entry issues

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356

22852 7590 08/06/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 08/06/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

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Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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HOUSTON, TX 77002

Date:

MAILED

AUG 0 6 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001124
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Commissioner for Patents
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID L. MCCOMBS
HAYNES AND BOONE LLP IP SECTION
2323 VICTORY AVENUE SUITE 700
DALLAS, TX 75219

Date: MAILED
AUG 0 6 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000250
PATENT NO. : 6452863
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 04/27/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/27/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed January 18, 2011 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed January 26, 2011 ("Opposition"). In the Petition, "[Patent Owner] Rambus requests that the Office expunge [Third Party Requester] Micron's cross-appeal brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,124 . . .) and because the Examiner did not adopt those issues in these proceedings." Petition, p. 1.

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting Samsung's *inter partes* reexamination request of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting Micron's *inter partes* reexamination request of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the Office merged the '026 and '1124 proceedings.

7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

8. The merged proceeding progressed to the point where, on February 19, 2010, the Office issued a first Right of Appeal Notice.

9. On September 3, 2010, the Office issued a second Right of Appeal Notice rejecting claims 1-28 and confirming claims 29-35.

10. On October 1, 2010, Rambus filed a Notice of Appeal.

11. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

12. On December 15, 2010, Rambus filed an Appeal Brief.

13. Also on December 15, 2010, Micron filed a Cross-Appeal Brief..

14. On January 18, 2011, Rambus filed the present Petition.

15. On January 26, 2011, Micron filed the present Opposition.

ANALYSIS

In several *inter partes* reexamination proceedings involving the same parties, Rambus has sought the expungement of Micron briefs on the ground that Micron's briefs address issues that initially were raised in a Samsung initiated reexamination request and not in a Micron initiated request. The Office has addressed this issue on several occasions within the past few months. With the exception of one early decision that was grounded on an improper interpretation of MPEP § 2674 that subsequently has been reversed, the Office consistently has held that Micron has the right to appeal any decision favorable to patentability that is present in a merged proceeding at the time the RAN is entered irrespective of who initially raised the patentability issue in question. See, e.g., Decision on Petition entered February 16, 2011 in merged proceedings 95/001,026 and 95/001,128, and Decision on Petition entered April 15, 2011 in merged proceedings 95/000,183 and 95/001,112.

At this juncture, further detailed consideration and discussion of the issue will merely be repetitive of the analyses presented in the prior relevant decisions and therefore will be wasteful of the Office's limited resources. Accordingly, counsel should consider whether it is advisable to submit further petitions presenting only this same issue.

Inter partes Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION

For the forgoing reason, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 05/06/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed January 18, 2011 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 26 pages and 14,891 words in length." Petition, p. 1.

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").

10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

13. On December 15, 2010, Rambus filed an Appeal Brief.

14. On December 15, 2010, Micron filed a Cross-Appeal Brief.

15. On January 18, 2011, Rambus filed the Respondent Brief that is the subject of the present Petition, and the present Petition.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

As an initial matter, Rambus argues that "In its brief, Micron attempts to resurrect two proposed rejections that Micron did not raise in its reexamination request and that Micron has no standing to raise on appeal." Petition, p. 3. In this proceeding, this issue was decided in the Decision Dismissing Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief, April 27, 2011:

> [T]he Office consistently has held that Micron has the right to appeal any decision favorable to patentability that is present in a merged proceeding at the time the RAN is entered irrespective of who initially raised the patentability issue in question. See, e.g., Decision on Petition entered February 16, 2011 in merged proceedings 95/001,026 and 95/001,128, and Decision on Petition entered April 15, 2011 in merged proceedings 95/000,183 and 95/001,112.

Decision, p. 3.

Further, Rambus contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." Petition, p. 2.

Micron's Cross-Appeal Brief is 40 pages in length and includes at least eight patentability issues involving at least five references. Further, the second RAN is 137 pages in length.

In view of the number of different patentability issues presented in this merged reexamination proceeding, an increase of eleven pages in the permitted length of Rambus's Respondent Brief is deemed reasonable. It is unnecessary to reach Rambus's due process argument.

DECISION

For the forgoing reason, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

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Houston, TX 77002

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 05/06/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c)," filed April 1, 2011 ("Petition"). In the Petition, Requester requests that it be permitted to submit a respondent brief up to 27 pages in length. Petition, p. 1.

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a

corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").

10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On December 15, 2010, Rambus filed an Appeal Brief.

13. On February 4, 2011, the Office entered a Notification of Defective Brief because Rambus's Appeal Brief exceeded the page limit specified by 37 C.F.R. § 1.943(c).

14. On March 4, 2011, Rambus filed Patent Owner's Rep[l]acement Appeal Brief.

15. On April 1, 2011, Micron filed the present Petition.

RELEVANT AUTHORITY

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).

In respect to papers filed in *inter partes* reexamination proceedings, 37 C.F.R. § 1.943(c) provides:

(a) The form of responses, written comments, briefs, appendices and other papers must be in accordance with the requirements of § 1.52.

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

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

37 C.F.R. § 1.52(b) specifies:

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination

proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6) . . . .

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

As indicated, for papers filed in *inter partes* reexamination proceedings, the line spacing must be one and one-half or double spaced, and the text font must be 6 or greater, preferably 12.

An examination of Rambus's Replacement Appeal Brief, filed March 4, 2011, reveals that the line spacing is single spaced and the font size is in the range of 10-12. The number of pages countable under Rule 1.943(c) appears to be 30.

In this circumstance, i.e., Rambus's brief is 30 pages of single spaced text, fairness requires that Micron be given a reasonable accommodation for the length of its respondent brief. Micron has requested that it be granted permission to file a respondent brief up to 27 pages in length having a font size of 12 and double spaced line spacing. This is a reasonable accommodation for responding to Rambus's Replacement Appeal Brief.

DECISION

For the forgoing reason, the Petition is GRANTED. Micron is authorized to file a respondent brief having up to 27 pages countable under Rule 1.943(c), and having double line spacing and 12 point font size.

James T. Moore
Acting Chief Administrative Patent Judge

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95/000,250	06/28/2007	6452863	38512.8	4189

22852 7590 09/27/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/27/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,250

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,124

Merged *Inter partes* Reexamination Control 95/000,250 and 95/001,124
Patent 6,452,863

DECISION ON PETITION

This is a decision on Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c), filed July 5, 2011 ("Micron's Petition for Waiver"). Micron requests that it be allowed to submit a Rebuttal Brief of up to 8,447 words or 21 pages.

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FINDINGS

1. Patent 6,452,863 issued on September 17, 2002, with 35 claims. The '863 patent is assigned to Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007, and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.

5. On January 16, 2009, the Office issued an order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.

6. On March 6, 2009, the '250 and '1124 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was entered, rejecting claims 1-35.

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.

9. On February 19, 2010, the Office mailed a first Right of Appeal Notice ("RAN").

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10. On September 3, 2010, the Office entered a second RAN, rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.

11. On October 1, 2010, Rambus filed a Notice of Appeal.

12. On October 15, 2010, Micron filed a Notice of Cross-Appeal.

13. On December 15, 2010, Rambus filed an Appeal Brief.

14. On December 15, 2010, Micron filed a Cross-Appeal Brief.

15. On January 18, 2011, Rambus filed a Patent Owner's Respondent Brief (Rambus's Respondent Brief") and a Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief ("Rambus's Petition for Waiver"), because the Respondent Brief was 26 pages long and included 14,891 words.

16. On May 6, 2011, the Office granted Rambus's Petition for Waiver, allowing Rambus's Respondent Brief to be 26 pages long.

17. On June 3, 2011, an Examiner's Answer was mailed.

18. On July 5, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71. ("Micron's Rebuttal Brief"). Micron's Rebuttal Brief is 21 pages.

19. On July 5, 2011, Micron filed the instant Petition for Waiver.

RELEVANT AUTHORITY

Page and word limits for briefs in reexamination appeals are provided for in 37 C.F.R. § 1.943(c), as follows:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party

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> shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

This and other rules of the Office may be suspended pursuant to 37 C.F.R. § 1.183:

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

ANALYSIS

Micron requests that 37 C.F.R. § 1.943(c) be waived so that it may submit a rebuttal brief of 21 pages. (Micron's Petition for Waiver 1.) Micron argues that the Office granted Rambus's Petition for Waiver to file a Respondent Brief of 26 pages and, thus, should permit Micron to file a Rebuttal Brief of 21 pages. (*Id.*) According to Micron, an "extraordinary situation" occurred when Rambus's Petition for Waiver was granted and "justice requires" providing for more than 15 pages to respond to all of the arguments raised by Rambus in its Respondent Brief, as well as issues in the Examiner's Answer of June 3, 2011. Micron asserts that the provision of 37 C.F.R. § 1.943(c) providing for equal number of pages for both respondent and rebuttal briefs would be upheld by granting the current petition. (*Id.* at 2.)

Previously, the number of different patentability issues presented in this merged reexamination proceeding were found to merit waiver of the

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page limits imposed on Rambus's Respondent Brief. (*See* Decision on Petition entered May 6, 2011).

In the interest of the requirement for special dispatch, *see* 35 U.S.C. § 314(c), the Rebuttal Brief Micron filed on July 5, 2011 is **entered**.

DECISION

In view of the foregoing, Micron's Petition for Waiver is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,254	05/30/2007	6765788		9870

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes AU Optronics Corporation v. Getac Technology Corporation

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Reexamination Control Nos. 95/000,254
Patent 6,765,788
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943(c) for Patent Owner's Appeal Brief," filed September 17, 2010. Petitioner requests waiver of the 14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief indicated to be approximately 43 pages or 18,154 words. Petitioner requests the suspension of 37 C.F.R. § 1.183 to permit entry and consideration of this petition. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's credit card account on September 17, 2010, along with the appeal brief fee.

FINDINGS

1. On May 30, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,765,788.

2. Reexamination was ordered on August 8, 2007and a non-final Office action was mailed on July 7, 2008.

3. Patent owner filed a response to the Office action on September 5, 2008, and third party requester filed comments in reply to the Office action and patent owner's response on October 3, 2008, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On August 28 2009, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the ACP on September 28, 2009, and third party requester filed comments in reply to the ACP and patent owner's response on October 27, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On June 21, 2010, a Right of Appeal Notice (RAN) was mailed.

5. Patent Owner filed a Notice of Appeal on July 20, 2010, appealing the rejections of claims 1-19, and third party requester filed a Notice of Appeal on July 21, 2010.

6. On September 16, 2010, Third Party Requester filed an appellant's brief.

7. On September 17, 2010, Patent Owner filed an appellant's brief appealing the rejection of claims 1-19, which was accompanied by the present petition.

DISCUSSION

In the present Petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief is approximately 43 pages and is stated to be 18,154 words.

Waiver is requested for the following reasons:

(1) Petitioner indicates that the RAN mailed on June 21, 2010, is 156 pages, includes 7 separate grounds of rejection under 35 U.S.C. 103(a) of 19 claims, based on 7 different references.

(2) Petitioner states that "Getac has made every effort to pare down arguments in its appeal brief."

(3) Petitioner further states that in its appellant's brief, Getac not only had to address the applied references but also the claim rejections and claim construction issues; the Office devoted nearly 132 pages of the RAN to these issues.

(4) Petitioner observes that "The Office has waived the requirements of 37 C.F.R. § 1.943(c), under similar circumstances. (See Decision Granting Petition dated September 7, 2010, in Control No. 95/001,112) The Office granted the patent owner leave to exceed the page and word count limitation of Rule 1.943 because the patent owner made a showing in support of the request for waiver and that it had made 'every effort to pare down the arguments in its appeal brief.' The same reasoning applies here."

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

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

37 CFR § 1.943(c) provides:

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

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Review of the prosecution history of this proceeding reveals that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. The *inter partes* reexamination rules require that the appellant brief be more limited than pre-appeal responses. In this case, patent owner's appellant brief filed on September 17, 2010, is approximately 43 pages and is stated to be 18,154 words which count toward the limit of 30 pages and 14,000 words, and significantly exceeds the limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the RAN, and the numerous rejections which are appealed. However, the prosecution history reveals that the RAN contains 7 rejections under 35 U.S.C. 103 of 19 claims. Prior to appeal, the examiner included 10 rejections of 19 claims in the non-final Office action, which rejections were addressed within the permitted page limit (*i.e.*, 49 pages) in patent owner's response of September 5, 2008. The Action Closing Prosecution included 11 grounds of rejection of 19 claims, which were addressed in significantly fewer pages (*i.e.*, 10 pages) in patent owner's response of September 28, 2009, than in the present appellant brief (43 pages).

Petitioner asserts that in its appellant's brief, Getac not only had to address the applied references but also the claim rejections and claim construction issues; and the Office devoted nearly 132 pages of the RAN to these issues. While these statements are all accepted as true, the present petition does not explain why these are extraordinary circumstances nor how

the circumstances prevent compliance with the page limit requirements. The page/word limits are intentionally designed to focus the issues and require a concise presentation of arguments. The petition makes the statements that "Getac has made every effort to pare down arguments in its appeal brief" and that a petition was granted in another reexamination because that patent owner made a showing in support of the request for waiver. However, the instant petition provides no persuasive showing of extraordinary circumstances.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to appellant's brief compared to prior responses and comments submitted in reply to actions issued by the Office.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with of 37 CFR 1.943(c), within a non-extendable time period of 30 days/1 month (whichever is longer) from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the appellant's appeal will be dismissed.

In view of the foregoing, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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BEFORE THE
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Inter partes AU Optronics Corporation v. Getac Technology Corporation

---

Reexamination Control Nos. 95/000,254
Patent 6,765,788
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition to Expunge Third Party Requester's Appeal Brief," filed October 15, 2010 ("Petition #1"). Petitioner requests the Director to expunge requester's appellant brief because it identifies a real party in interest, AU Optronics Corp. ("AU Optronics"), different from Cyberlink Corp. ("Cyberlink"), the real party in interest identified in the requester's request for reexamination. Petitioner also requests the Director to refuse entry of any replacement brief filed by the requester on behalf of Cyberlink, because two months have already elapsed since the requester filed its Notice of Appeal. This is also a decision on third party "Requester's Comment on Petition to Expunge Third Party

Requester's Appeal Brief" of October 20, 2010 ("Petition #2"). The petition fees of $400 in accordance with 37 C.F.R. § 41.20(a) have been charged to each petitioner's deposit account on October 15, 2010, and October 20, 2010, respectively.

FINDINGS

1. On May 30, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,765,788.
2. Reexamination was ordered on August 8, 2007, and a non-final Office action was mailed on July 7, 2008.
3. Prosecution was conducted and a Right of Appeal Notice (RAN) was mailed on June 21, 2010.
4. Patent owner filed a Notice of Appeal on July 20, 2010, and third party requester filed a Notice of Appeal on July 21, 2010.
5. On September 16, 2010, third party requester filed an appellant's brief, and on September 17, 2010, patent owner filed an appellant's brief.
6. Patent owner filed a respondent brief on October 15, 2010, accompanied by the instant Petition #1 to expunge third party requester's appellant brief.
7. On October 20, 2010, third party requester filed a "Requester's Comment on Petition to Expunge Third Party Requester's Appeal Brief" of ("Petition #2"), accompanied by a "Notice Regarding Defects in Patent Owner's Appeal Brief," a "Notice Regarding Typographical Error in Requester's Appellant Brief," and a "Third Party Requester Substitute Appeal Brief Pursuant to 37 C.F.R. § 41.67."

RELEVANT AUTHORITY

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 § 41.66 provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

37 CFR § 41.67 provides:

(a) (1) Appellant(s) may once, within time limits for filing set forth in § **41.66**, file a brief and serve the brief on all other parties to the proceeding in accordance with § **1.903** of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § **41.20**(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § **41.66**(a).

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) *Real party in interest.* A statement identifying by name the real party in interest.

. . .

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR § 1.939 provides:

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

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

ANALYSIS

In the present Petition #1, patent owner requests that the third party requester's appellant brief be expunged for stating a real party in interest different from that set forth in the request for *inter partes* reexamination. In the opposition Petition #2, third party requester indicates that the discrepancy is a typographical error resulting from the use of an appellant brief "shell," in which the real party in interest was not updated to set forth the real party in interest for the instant *inter partes* reexamination.

The Board of Patent Appeals and Interferences takes Official Notice that the Real Party in Interest is CyberLink Corp., as set forth in the request for *inter partes* reexamination. Petition #1 is **denied**. Petition #2 is **dismissed as moot**. The three (3) documents filed by third party requester on October 20, 2010, that accompanied Petition #2 are improper pursuant to

37 CFR § 1.939 and will not be considered. The improper documents will be closed in the Office's IFW system.

DECISION

In view of the foregoing, Petition #1 is **DENIED**. Petition #2 is **DISMISSED AS MOOT**. The documents accompanying Petition #2 are improper pursuant to 37 CFR § 1.939, will not be considered, and will be closed in the Office's IFW system.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
Joseph E. Palys
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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,254	05/30/2007	6765788		9870

22852 7590 02/18/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes AU Optronics Corporation v. Getac Technology Corporation

---

Reexamination Control Nos. 95/000,254
Patent 6,765,788
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition to Expunge Third Party Requester's Appeal Brief," filed October 15, 2010 ("Petition #1"). Petitioner requests the Director to expunge requester's appellant brief because it identifies a real party in interest, AU Optronics Corp. ("AU Optronics"), different from Cyberlink Corp. ("Cyberlink"), the real party in interest identified in the requester's request for reexamination. Petitioner also requests the Director to refuse entry of any replacement brief filed by the requester on behalf of Cyberlink, because two months have already elapsed since the requester filed its Notice of Appeal. This is also a decision on third party "Requester's Comment on Petition to Expunge Third Party

Requester's Appeal Brief" of October 20, 2010 ("Petition #2"). The petition fees of $400 in accordance with 37 C.F.R. § 41.20(a) have been charged to each petitioner's deposit account on October 15, 2010, and October 20, 2010, respectively.

FINDINGS

1. On May 30, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,765,788.
2. Reexamination was ordered on August 8, 2007, and a non-final Office action was mailed on July 7, 2008.
3. Prosecution was conducted and a Right of Appeal Notice (RAN) was mailed on June 21, 2010.
4. Patent owner filed a Notice of Appeal on July 20, 2010, and third party requester filed a Notice of Appeal on July 21, 2010.
5. On September 16, 2010, third party requester filed an appellant's brief, and on September 17, 2010, patent owner filed an appellant's brief.
6. Patent owner filed a respondent brief on October 15, 2010, accompanied by the instant Petition #1 to expunge third party requester's appellant brief.
7. On October 20, 2010, third party requester filed a "Requester's Comment on Petition to Expunge Third Party Requester's Appeal Brief" of ("Petition #2"), accompanied by a "Notice Regarding Defects in Patent Owner's Appeal Brief," a "Notice Regarding Typographical Error in Requester's Appellant Brief," and a "Third Party Requester Substitute Appeal Brief Pursuant to 37 C.F.R. § 41.67."

RELEVANT AUTHORITY

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 § 41.66 provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

37 CFR § 41.67 provides:

(a) (1) Appellant(s) may once, within time limits for filing set forth in § **41.66**, file a brief and serve the brief on all other parties to the proceeding in accordance with § **1.903** of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § **41.20**(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § **41.66**(a).

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) *Real party in interest.* A statement identifying by name the real party in interest.

. . .

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR § 1.939 provides:

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

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

ANALYSIS

In the present Petition #1, patent owner requests that the third party requester's appellant brief be expunged for stating a real party in interest different from that set forth in the request for *inter partes* reexamination. In the opposition Petition #2, third party requester indicates that the discrepancy is a typographical error resulting from the use of an appellant brief "shell," in which the real party in interest was not updated to set forth the real party in interest for the instant *inter partes* reexamination.

The Board of Patent Appeals and Interferences takes Official Notice that the Real Party in Interest is CyberLink Corp., as set forth in the request for *inter partes* reexamination. Petition #1 is **denied**. Petition #2 is **dismissed as moot**. The three (3) documents filed by third party requester on October 20, 2010, that accompanied Petition #2 are improper pursuant to

37 CFR § 1.939 and will not be considered. The improper documents will be closed in the Office's IFW system.

DECISION

In view of the foregoing, Petition #1 is **DENIED**. Petition #2 is **DISMISSED AS MOOT**. The documents accompanying Petition #2 are improper pursuant to 37 CFR § 1.939, will not be considered, and will be closed in the Office's IFW system.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
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OCT 15 2010

CENTRAL REEXAMINATION UNIT

Dechert LLP (For Patent Owner)
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Mountain View, CA 94039-0460

Richard Wilder (For Requester)
Sidley Austin LLP
1501 K Street, N.W.
Washington, D.C. 20005

In re Trevor King	: **DECISION**
Inter Partes Reexamination Proceeding	: **GRANTING PETITION**
Control No. 95/000,255	: **UNDER 37 CFR 1.137(b)**
Filed: July 20, 2007	: **AND VACATING**
For: U.S. Patent No. 6,750,386	: **CERTIFICATE**

This is a decision on the August 6, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination proceeding ("the August 6, 2010 patent owner petition to revive").

The August 6, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 6, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,750,386 issued June 3, 2008, for the present proceeding, and the March 6, 2008 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7) provides, in pertinent part:

> REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

35 U.S.C. 133 provides:

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

35 U.S.C. 314(a) provides, in pertinent part:

IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

37 CFR 1.137 provides, in pertinent part:

(b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

*
*

(d) *Terminal disclaimer.*

*
*

(3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

37 CFR 1.945(a) provides, in pertinent part:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

37 CFR 1.957(b) provides, in pertinent part:

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed

to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

37 CFR 1.958(b) provides, in pertinent part:

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

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).
*
*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the October 5, 2007 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The October 5, 2007 Office action set a two-month period for response. A response to the October 5, 2007 Office

action was not filed until August 6, 2010, which was untimely. However, for the purpose of evaluating whether the August 6, 2010 patent owner petition to revive is a grantable petition, the submission of the August 6, 2010 Response To Office Action In Reexamination Proceedings satisfies item (1).[1]

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the August 6, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the August 6, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,750,386 issued for the present proceeding on June 3, 2008. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued on March 6, 2008, 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 6,750,386 to Trevor King of Jamaica, NY (US) for CYCLE OF FIFTHS STEEL PANS, appearing in the *Official Gazette* of June 3, 2008, should be deleted, since the reexamination certificate has been vacated.

LACK OF PROOF OF SERVICE

37 CFR 1.903 provides, in part:

> After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. **Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.** [Emphasis added.]

A review of the instant petition shows that it was accompanied by the following papers: (i) Response To Office Action In Reexamination Proceedings; (ii) First Declaration of Trevor King Under 37 CFR 1.132; (iii) Second Declaration of Trevor King Under 37 CFR 1.132; (iv) Information Disclosure Statement; and (v) Power of Attorney. However, the requisite proof of service (of the instant petition) by the patent owner on the third party requester was not included with the present petition.

---

[1] This decision is not directed to the persuasiveness and propriety of the arguments presented in the August 6, 2010 Response To Office Action In Reexamination Proceedings as to each of the rejections set forth in the October 5, 2007 Office action; such is the examiner's province.

As pointed out in MPEP § 2666.06:

> Any paper filed with the Office, i.e., any submission made, by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding including any other third party requester that is part of the proceeding due to merger of reexamination proceedings.
>
> **As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper.** It is required that the certificate of service set forth the name and address of the party served and the method of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party. [Emphasis added.]

A certificate of service pursuant to MPEP § 2666.06 has not been found attached to the instant petition.

Accordingly, the copy of the petition submitted by the requester is being forwarded to the third party requester together with all attachments thereto. Any future communications filed by the patent owner in the present reexamination proceeding must include proof of service on the patent owner pursuant to 37 CFR 1.903.

CONCLUSION

1. The August 6, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

2. The termination of prosecution noted in the March 6, 2008 NIRC, and the NIRC itself, are **vacated**.

3. The *Inter Partes* Reexamination Certificate issued June 3, 2008, is **vacated**.

4. Patent owner's response to the October 5, 2007 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 within 30 days of the mailing date of this decision.

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

/Kenneth M. Schor/

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

10/14/2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,255	07/20/2007	6750386		1861

37509 7590 10/05/2011

DECHERT LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/05/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

RICHARD WILDER
SIDLEY AUSTIN LLP
1501 K STREET, NW
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NUMBER *95/000,255*.

PATENT NUMBER *6,750,386*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

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

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

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

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

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OCT 05 2011

CENTRAL REEXAMINATION UNIT

Dechert LLP
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Mountain View, CA 94309-0460

(For Patent Owner)

Richard Wilder
Sidley Austin LLP
1501 K Street, NW
Washington, DC 20005

(For Third Party Requester)

In re King
Inter Partes Reexamination Proceeding
Control No. 95/000,255
Filed: July 20, 2007
For: U.S. Patent No. 6,750,386

: **DECISION**
: **GRANTING PETITION**
: **UNDER § 1.183**

This is a decision on the August 8, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.183 Requesting (1) Waiver of the Prohibition of an Extension of Time for Filing an Appeal Brief" and (2) Request for Extension of the Period to File an Appeal Brief."

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 an extension of time is **granted** to the extent specified below.

BACKGROUND

- On July 27, 2007, a corrected request for *inter partes* reexamination of claims 1-3 of U.S. Patent 6,835,887 was filed by a third party requester. This proceeding was accorded control number 95/000,255 ("the '255 proceeding"). Reexamination was ordered on October 5, 2007, and a non-final Office action was issued on the same date rejecting claims 1-3.

- Prosecution progressed until, on July 8, 2011, a Right of Appeal Notice was issued by the Office, in which patent claims 1-3 were rejected.

- On August 8, 2011, patent owner filed a Notice of appeal and the following petitions:

- A petition entitled "PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181 requesting reconsideration of the examiner's decision to close prosecution.
- The instant petition entitled "PETITION UNDER 37 CFR § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until after decisions are issued on the co-filed § 1.181 petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.183 states:

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

37 C.F.R. § 41.61(b) states:

> (1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
> (2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on June 20, 2011, simultaneously with the filing of a Notice of Appeal. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for waiver of the prohibition of an extension of time for filing an appellant's brief until after a decision is issued on the co-filed petition under § 1.181. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed Notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, the patent owner filed a Notice of appeal on August 8, 2011. Third party requester did not file a Notice of cross-appeal. Therefore, the time for patent owner petitioner to file an Appellant's Brief is due to expire two months from the August 22, 2011 expiry of the two-week period for filing a notice of cross-appeal. The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) a petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the due date; i.e., through November 22, 2011.

If the petition under § 1.181 has not yet been decided at the point where the time for requester to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed August 8, 2011 for filing an Appellant's Brief is **granted to the extent stated above.**

2. The time for to file an Appellant's Brief, by either or both of the patent owner or the third party requester, is extended to run **30 days** from the due date; i.e., through November

22, 2011.

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

October 4, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,255	07/20/2007	6750386	381550-386RX (102316)	1861

37509 7590 04/04/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Richard Wilder
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Washington, DC 20005

Date:
MAILED
APR 04 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000255
PATENT NO. : 6750386
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

DECHERT LLP P.O. Box 390460 Mountain View, CA 94039	: : :	(For Patent Owner)

SIDLEY AUSTIN LLP 717 N. Harwood Suite 3400 Dallas, TX 75201	: : : :	(For Third Party Requester)

In re King *Inter Partes* Reexamination Proceeding Control No.: 95/000,255 Filed: 20 July 2007 Patent No. 6,750,386	: : : : :	DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.181

This is a decision addressing Patent Owner's petition, filed 8 August 2011, under 37 CFR 1.181 requesting that the amendment dated 6 June 2011 be entered into the record. This decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in denying entry of the amendment in the Right of Appeal Notice.

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

Patent Owner's petition is DENIED.

STATEMENT OF FACTS RELEVANT TO THE DECISION

- Patent No. 6,750,386 (the '386 patent) issued on 15 June 2004.
- On 20 July 2007, a Third Party Requester filed a complete request for reexamination, which was assigned Control No. 95/000,255 (the '255 proceeding).
- On 5 October 2007, the Office ordered reexamination of claims 1-3 in the '255 proceeding and issued an Office action on the merits. The Office action contained rejections of patent claims 1-3.
- On 6 March 2008, the Office issued a Notice of Intent to Issue a Reexamination Certificate after Patent Owner failed to timely respond to the Office action mailed on 5 October 2007.
- On 6 August 2010, Patent Owner filed a petition to revive for unintentional abandonment along with a response to the Office action mailed on 5 October 2007. The response did not propose to amend or add any claims.
- On 15 October 2010, the Office granted Patent Owner's petition to revive for unintentional abandonment.
- On 28 January 2011, the Office issued an Action Closing Prosecution (ACP), which continued to reject patent claims 1-3.
- On 28 March 2011, Patent Owner filed a response to the ACP. The response proposed to add new claims 4-11 and was supported by three declarations under 37 CFR 1.132. The amendments were not in a format compliant with Office regulations. On 29 March 2011, Patent Owner submitted a corrected set of proposed amendments.
- On 28 April 2011, Third Party Requester filed comments.
- On 6 May 2011, the Office issued a Notice Regarding a Defective Paper in *Inter Partes* Reexamination because the Patent Owner's response on 29 March 2011 failed to comply with 37 CFR 1.943(b).
- On 6 June 2011, Patent Owner submitted a corrected response.
- On 15 June 2011, Third Party Requester submitted comments to the Patent Owner's corrected response.

- On 8 July 2011, the Office issued a Right of Appeal Notice (RAN). The RAN denied entry of Patent Owner's 6 June 2011 corrected response and maintained the rejection of claims 1-3.

- On 8 August 2011, Patent Owner filed the instant petition under 37 CFR 1.181.

- On 8 August 2011, Patent Owner also filed a petition under 37 CFR 1.183. The Office mailed a decision on this petition on 6 October 2011, which granted an additional 30 days to file an appeal brief.

- On 8 August 2011, Patent Owner further filed a Notice of Appeal.

DECISION UNDER 37 CFR 1.181

The Patent Owner seeks relief under 37 C.F.R. § 1.181 to have the 6 June 2011 amendment entered into the proceeding record. Patent Owner specifically requests that the Director find that the RAN improperly denied entry of the 6 June 2011 proposed amendment because Patent Owner has shown good and sufficient reason why the proposed amendment was necessary and not earlier presented. See, e.g., pages 3-4 of the petition.

In response to Patent Owner's arguments for entering the 6 June 2011 proposed amendment in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN) and/or an action closing prosecution (ACP). The petition does not state that the examiner failed to follow Office policies and procedures, and does not allege that the RAN was premature. The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue a RAN, and did not categorically deprive the Patent Owner of its statutory rights to present amendments and evidence in reexamination proceedings.

Second, upon review of the record, it is clear that the 6 June 2011 amendments do more than merely cancel claims, adopt examiner's suggestions, remove issues for appeal, or in some other way require only a cursory review by the examiner. *See*, 37 CFR 1.116(b) and MPEP 2673. For example, the amendments add new claims 4-11 that contain limitations that were not previously

claimed (e.g., "the horizontal distance . . . every pair of notes in the first and second series"). The examiner made a showing of why entry of the amendment would be an undue burden as required by 37 CFR 1.116 and MPEP 2673. See pages 2-4 of the RAN. Specifically, the examiner explained that the amendments would require the examiner to further consider whether the newly added claims are supported by the original specification as well as consider the new grounds of rejection that were proposed by the Third Party Requester. Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered.

Third, the Patent Owner did not make a showing of good and sufficient reasons why the amendment is necessary and not earlier presented, as required by 37 CFR 1.116(b), in the submission of 6 June 2011. While an amendment touching the merits of the patent under reexamination may be admitted after an Action Closing Prosecution, this can only be done upon a showing of good and sufficient reason why the amendment is necessary and was not earlier presented. 37 CFR 1.116(b). A review of the record does not show that Patent Owner made such a showing in the submission of 6 June 2011 for consideration by the examiner.

The examiner needs only to state a reasonable basis for denying entry, and upon review of the record at the time of the RAN, the record supports the examiner's analysis. In other words, the record does not show that the examiner's actions were arbitrary and capricious.

In this petition, Patent Owner attempts to make a showing that the 6 June 2011 amendments should be entered because there is a good and sufficient reason why the amendment is necessary and not earlier presented, as required by 37 CFR 1.116(b). Specifically, Patent Owner asserts that it was only after a meeting on 9 March 2011, which occurred after the mailing of the ACP on 28 January 2011, that the significance of the additional features in the proposed amendment became apparent. Petition, p. 3. However, the ACP merely repeated the rejections that were set forth in the Non-Final Office action, mailed on 5 October 2007. Patent Owner submitted a response, with the assistance of his current counsel, on 6 August 2010. The record fails to explain why the discussion in which additional features were considered, as in the 9 March 2011 meeting, could not have been held prior to the issuance of the ACP. As such, the Director finds the showing in this petition does not set forth a good and sufficient reason why the amendment is necessary and not earlier presented.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." In addition, the current petition does not make a showing of a good and sufficient reason why the 6 June 2011 amendment is necessary and was not earlier presented. 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 amendments. Therefore, the Patent Owner's petition is <u>denied</u>.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed 8 August 2011, is DENIED for the reasons discussed above.

2. Any response should be addressed as follows:

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

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

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

   By EFS: Registered users of EFS-Web may alternatively submit such correspondence via 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.

3. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.

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
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/636,350	12/07/2006	Sundar Raman	80615-242201	8357

7590 12/03/2010

Venable LLP
Attn: Sefan Kirchanski
2049 Century Park East, Suite 2100
Los Angeles, CA 90067

EXAMINER
TRAN, QUOC DUC

ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
12/03/2010	PAPER

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

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

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Date: DEC 0 2 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KIA L. FREEMAN
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000269
PATENT NO. : 6829473
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Stefan J. Kirchanski (For Patent Owner)
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CENTRAL REEXAMINATION UNIT

Kia L. Freeman (For Third Party Requester)
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

In re Reissue Application of UTStarcom, Inc. Application No.: 11/636,350 Filed: December 7, 2006 For: U.S. Patent No. 6,829,473 B2 In re UTStarcom, Inc. *Inter Partes* Reexamination Proceeding Control No.: 95/000,269 Filed: June 21, 2007 For: U.S. Patent No.: 6,829,473	SUPPLEMENT TO PRIOR DECISION TO MERGE REISSUE AND REEXAMINATION PROCEEDINGS

This decision is supplemental to the Office's prior merger decision(s) mailed November 28, 2007 and March 4, 2008, which *sua sponte* merged reissue application No. 11/636,350 and reexamination control No. 95/000,269 into a single proceeding.

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

If a request for continued examination (RCE) is filed under 37 CFR 1.114, as is permitted for the reissue application, then the merged proceeding will be automatically severed, and the reissue application will then be suspended.

Patent owner is put on notice that, in such event, a request for continued examination (RCE) is not available in the 95/000,269 reexamination proceeding, and any response to the outstanding Office action (e.g., response to an action closing prosecution (ACP)

or 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 1.957(b) or "limitation" of the proceeding pursuant to 37 CFR 1.957(c), whichever of the two is appropriate. 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. In the event of limitation, a Right of Appeal Notice (RAN) will be issued providing the third party requestor with the opportunity to appeal with respect to all claims which have been found patentable.

An action closing prosecution (ACP) has been issued on even date with this decision in this merged proceeding. Any request for extension for time (to file a submission as to any such subsequent ACP) 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 ACP issued in the present merged proceeding subsequent to the mail date of this decision.

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

CONCLUSION

1. Reissue application No. 11/636,350 and reexamination control No. 95/000,269 remain merged as a single proceeding.

2. If a request for continued examination (RCE) is filed under 37 CFR 1.114, the merged proceeding will be automatically severed, and the reissue application will be automatically suspended pursuant to 37 CFR 1.103(e), until the completion of the '269 proceeding by the issuance of the reexamination certificate. Patent owner is put on notice that, in such event, a request for continued examination (RCE) is not available in the reexamination proceeding, and any response to the outstanding Office action (e.g., response to an ACP or 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 per 37 CFR 1.957(b) or "limitation" of the proceeding pursuant to 37 CFR 1.957(c), whichever of the two is appropriate.

   In such event, at the time that a Reexamination Certificate is issued for the '269 reexamination proceeding, the patent owner would be advised to call the issuance of the Certificate to the attention of the Office, and to request a resumption of examination of the reissue application. The patent owner may include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

3. An action closing prosecution (ACP) has been issued on even date with this decision in this merged proceeding. Any request for extension for time (to respond to any such subsequent action) must be filed under 37 CFR 1.136(b) where an extension is permitted by rule. No extension of time will be permitted under 37 CFR 1.136(a) after any ACP issued subsequent to the mail date of this decision.

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

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

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

12/02/10
Kenpetmerger/sever
Kenpetmerger/IP-reissue

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3414 Peachtree Rd.
Atlanta, GA 30326

Baker and McKenzie LLP (For Requester)
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711 Louisiana, Suite 3400
Houston, TX 77002-2716

In re Hunter Fan Company	:	
Reissue Application	:	
Application No. 11/703,606	:	
Filed: February 7, 2007	:	
For: U.S. Patent No. 7,131,819 B2	:	DECISION
	:	SEVERING
In re Hunter Fan Company	:	MERGER
Inter Partes Reexamination Proceeding	:	
Control No. 95/000,270	:	
Filed: June 26, 2007	:	
For: U.S. Patent No. 7,131,819 B2	:	

The merged proceeding consisting of reissue application 11/703,606 and *inter partes* reexamination proceeding 95/000,270 is before the Office for issuance of a decision to *sua sponte* sever the merged proceeding, in order to permit separate prosecution and examination of the reissue application and the *ex parte* reexamination proceeding.

REVIEW OF SALIENT FACTS

1. On October 24, 2007, a decision merging reissue application 11/703,606 (the '606 reissue application) and inter partes reexamination control number 95/000,270 (the '270 reexamination proceeding) was mailed.

2. The merged proceeding of the '606 reissue application and the '270 reexamination proceeding progressed to the point where, on September 25, 2009, a final office action was mailed. The time for response expired on October 27, 2009 (a one month shortened statutory period for reply was set and October 25, 2009 was a Sunday) and no response has been received from the patent owner or third party requestor.

DECISION

At page 10 of the merger decision mailed October 24, 2007, it was stated:

> "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. Thereafter, with respect to the '270 inter partes reexamination proceeding, if it is appropriate to terminate the prosecution of the reexamination proceeding (there are no patentable claims), a Notice of Intent to Issue a Reexamination Certificate (NIRC) will be issued, and the Director will proceed to issue a reexamination certificate under 37 CFR 1.997 in accordance with the last Office action. See 37 CFR 1.957(b). Where there is at least one patentable claim, prosecution will continue in the reexamination proceeding as to the patentable claim(s) until requester's appeal rights have been exhausted. See 37 CFR 1.957(c)."

In this instance, the patent owner failed to file a timely and appropriate response to the final Office action of September 25, 2009. Accordingly, the merged proceeding of the '606 reissue application and the '270 reexamination proceeding is hereby dissolved and severed into two separate proceedings.

Since the notice of abandonment for the '606 reissue application was mailed on November 17, 2009, no further action in the '606 reissue application is necessary.

The '270 reexamination proceeding is forwarded to Technology Center 3700, for action as follows:

The reexamination prosecution will be terminated, and a reexamination certificate under 37 CFR 1.997 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 inter partes reexamination and reissue proceedings.

If further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination will be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under inter partes reexamination (e.g., improperly broadened claims) will be applied by the examiner. The existence of any questions/issues remaining which cannot be considered under inter partes reexamination following the dissolution will be noted by the examiner as not being proper under inter partes reexamination pursuant to 37 CFR 1.906(c).

CONCLUSION

1. The merged proceeding consisting of '606 reissue application and the '270 *inter partes* reexamination proceeding is hereby severed into (1) a separate proceeding, for the '606 reissue application, for reissue of the '819 patent, and (2) a separate proceeding, the '270 inter partes reexamination, for reexamination of the '819 patent. The two proceedings will be addressed separately.

2. Jurisdiction over the '606 reissue application proceeding and the '270 reexamination proceeding is returned to the examiner in Technology Center 3700 for immediate action on the '270 reexamination proceeding (the '606 reissue application already abandoned), toward resolution of the proceeding, and not inconsistent with this decision.

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

Linda Sholl

Linda Sholl
Special Program Examiner
Technology Center 3700

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,282	08/02/2007	6,514,531	SYL509 US REX	6236

5487 7590 09/30/2011

ANDREA Q. RYAN
SANOFI-AVENTIS U.S. LLC
1041 ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

SANOFI-AVENTIS
Patent Owner

SYNTHON LABORATORIES, INC.
Third Party Requester

Inter partes Reexamination Control 95/000,282
Patent 6,514,531 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on Third Party Requester's Petition Under 37 C.F.R. § 1.183 to Permit Entry of Supplemental Respondent's Brief, filed August 15, 2011 ("Petition for Submission"). Third Party Requester Synthon Laboratories, Inc. ("Synthon") requests that it's Supplemental Respondent's Brief be entered.

FINDINGS

1. Patent 6,514,531 B1 (hereinafter "'531 patent") issued on February 4, 2003, with 47 claims. The '531 patent is assigned to sanofi-aventis.

2. On August 2, 2007, Synthon filed a request for *inter partes* reexamination and Control No. 95/000,282 was assigned to this request.

3. On November 1, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-47 of the '531 patent in the '282 proceeding.

4. On April 18, 2008, the Office issued an Office Action in *Inter Partes* Reexamination rejecting claims 1-47 of the '531 application under 35 U.S.C. § 103(a) over several prior art references.

5. The '282 proceeding progressed to a point when, on August 19, 2010, the Office issued a Right of Appeal Notice, rejecting claims 1-47.

6. On September 17, 2010, sanofi-aventis filed a Notice of Appeal.

7. On December 1, 2010, sanofi-aventis filed an Appellant's Brief.

8. On January 3, 2011, Synthon filed a Respondent's Brief.

9. On May 13, 2011, the Court of Appeals for the Federal Circuit issued an opinion in *In re Kao*, 639 F.3d 1057 (Fed. Cir. 2011) ("*Kao*").

10. On June 15, 2011, the Office issued an Examiner's Answer.

11. On July 15, 2011, sanofi-aventis filed a Patent Owner's Rebuttal Brief.

12. On August 15, 2011, Synthon filed a Supplemental Respondent's Brief and the present Petition for Submission.

RELEVANT AUTHORITY

Parties to an *inter partes* reexamination may file briefs according to 37 C.F.R. § 41.66, which provides:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.
>
> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.
>
> * * *
>
> (d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.
>
> (e) *No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.*

(Emphasis added.)

The respondent's brief is also provided in 37 C.F.R. § 41.68, which provides, in part:

> (a)(1)Respondent(s) in an appeal may *once*, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(Emphasis added.)

These and other rules of the Office may be suspended pursuant to 37 C.F.R. § 1.183:

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

ANALYSIS

Synthon requests that its Supplemental Respondent's Brief be entered, thus requesting suspension of 37 C.F.R. §§ 41.66(e) and 41.68(a)(1), which limit a respondent to only one brief. (Petition for Submission 1). According to Synthon, sanofi-aventis presented new arguments in its Rebuttal Brief and asserted that the recent opinion in *Kao* is controlling. (Petition for Submission 5). Synthon argues that because sanofi-aventis devotes its entire Rebuttal Brief to *Kao*, and purportedly misstates the effect of the decision, a "unique and extraordinary situation" has occurred requiring further comment by Synthon. (*Id.* at 5-7).

Though sanofi-aventis states that the purpose of its Rebuttal Brief "is to bring to the Board's attention the decision of the Court of Appeals for the Federal Circuit in *In re Kao* . . . , which was decided after Patent Owner's

Appeal Brief was submitted" (Patent Owner's Rebuttal Brief 1), Synthon has not cited what it considers to be new arguments presented by sanofi-aventis. Arguments regarding a recent court opinion are not necessarily new arguments. Purported misapplication of the facts and holdings of a recent court opinion to the current facts, as Synthon asserts (*see* Petition for Submission 7-8), does not rise to the level of an "extraordinary situation." Synthon has not shown that the arguments presented by sanofi-aventis are new arguments, nor has it provided a showing that an "extraordinary situation" requiring waiver of the rules exists.

Accordingly, Synthon's Supplemental Respondent's Brief **is not entered**.

DECISION

In view of the foregoing, Synthon's Petition for Submission is DENIED.

Pursuant to 37 C.F.R. § 1.939(a), the requester's supplemental respondent brief of August 15, 2011, is an unauthorized paper and will be closed from the Office's Image File Wrapper (IFW) system and made non-viewable.

James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control No. 95/000,282
Patent 6,514,531

Counsel for Patent Owner sanofi-aventis U.S., LLC:
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Counsel for Third Party Requester Synthon Laboratories, Inc.:
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INTELLECTUAL PROPERTY
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SUSAN E. SHAW MCBEE
WOMBLE, CARLYLE, SANDRIDGE & RICE, PLLC
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ATLANTA, GA 30357-0037

(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding Control No. 95/000,285 Filed: September 21, 2007 For: U.S. Patent No. 7,097,719 *Inter Partes* Reexamination Proceeding Control No. 95/001,085 Filed: October 2, 2008 For: U.S. Patent No. 7,097,719	**DECISION GRANTING RENEWED PETITION FOR WAIVER OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE**

This is a decision on the July 2, 2010 patent owner's petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION" (hereinafter "the renewed petition under 37 CFR 1.183"). The petition requests waiver of the 37 CFR 1.943(b) requirement that patent owner's response to an office action in an *inter partes* reexamination proceeding not exceed 50 pages in length.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

Patent owner's renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

FEES

No fee is required for patent owner's renewed petition.

BACKGROUND

1. U.S. Patent No. 7,097,719 (the '719 patent) issued to Bray *et al.* on August 29, 2006.

2. A first request for *inter partes* reexamination of the '719 patent was filed on September 21, 2007, by a first third party requester, which request was assigned control number 95/000,285 (the '0285 proceeding).

3. On December 19, 2007, *inter partes* reexamination was ordered for the '0285 proceeding.

4. A second request for *inter partes* reexamination of the '719 patent was filed on October 2, 2008, by a second third party requester, which request was assigned control number 95/001,085 (the '1085 proceeding).

5. On December 12, 2008, *inter partes* reexamination was ordered for the '1085 proceeding.

6. On March 24, 2009 the Office mailed a decision ("the merger decision"), *sua sponte*, merging into a single proceeding the '0285 and the '1085 proceedings ("the merged proceeding").

7. The merged proceeding progressed to the point where, on April 1, 2010, the Office issued a non-final Office action in the merged proceeding.

8. On April 26, 2010 patent owner filed a petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION" ("the petition under 37 CFR 1.183") to waive the page limit requirements of 37 CFR 1.943(b), concurrently with a request for extension of time pursuant to 37 CFR 1.956.

9. On May 10, 2010, the Office mailed a decision dismissing the patent owner's April 26, 2010 request for extension of time.

10. On May 24, 2010, patent owner filed a second request for extension of time pursuant to 37 CFR 1.956.

11. On May 28, 2010, the Office mailed a decision granting patent owner's second request for extension of time, extending the time period for patent owner's response to the April 1, 2010 Office action to July 1, 2010.

12. On June 30, 2010, the Office issued a decision dismissing the patent owner's April 26, 2010 petition under 37 CFR 1.183 to waive the page limit for its response to the April 1, 2010 Office action.

13. On July 2, 2010, patent owner filed the instant renewed petition under 37 CFR 1.183, to waive the page limit for its response to the April 1, 2010 Office action, concurrently with an "Amendment and Response" to the April 1, 2010 Office action.

14. On August 2, 2010, first third party requester filed comments after patent owner's July 2, 2010 response. Concurrently, on August 2, 2010, second third party requester filed comments after patent owner's July 2, 2010 response.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent Owner's Renewed Petition under 37 CFR 1.183

On June 30, 2010, the Office mailed a decision dismissing patent owner's April 26, 2010 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.943(b). On July 2, 2010, patent owner submitted a response to the April 1, 2010 Office action, concurrently with the renewed petition under 37 CFR 1.183.[1] In the July 2, 2010 renewed petition under 37 CFR 1.183, patent owner states that it believes the July 2, 2010 response is in compliance with the 50-page limit but that "out of an abundance of caution, and in case that the Patent Office concludes that any additional pages of the four declaration[s] should be applied to the page count limit, Patent Owner requests that 37 C.F.R. § 1.943(b) be suspended to allow the submission of a response that exceeds the fifty (50) page limit of that rule."[2]

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[1] The July 2, 2010 response is accompanied by four declarations subsequently referred to herein as the "Sawtell declaration", the "Goodman declaration", the "Grandt declaration" and the "Bray declaration."
[2] The renewed petition under 37 CFR 1.183 at page 4.

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner asserts that it "diligently worked to comply with the 50 page limit, and believe[s] it is in compliance as shown on pages 32-33 of the accompanying Amendment and Response."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the April 1, 2010 Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

It has been determined that a total of 69 pages of patent owner's July 2, 2010 response, including the four accompanying declarations, count toward the page limit of 37 CFR 1.943(b). In particular, the remarks portion of the July 2, 2010 response includes 34 pages of arguments,[5] and the four accompanying declarations include approximately 35 pages of arguments that count toward the page limit pursuant to MPEP 2667(I)(A)(2).[6] Thus, the portions of patent owner's July 2, 2010 response, including the portions of the four accompanying declarations, which count toward the page limit, exceed 50 pages by 19 pages.

Based on the specific facts set forth in the renewed petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages), and the individual facts and circumstances of this case (such as the length of the April 1, 2010 Office action),[7] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, the renewed petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's July 2, 2010 response to exceed the page limit by 19 pages. This waiver makes patent owner's July 2, 2010 response page-length compliant.

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[3] *See* the July 2, 2010 response at pages 32-33, and the renewed petition under 37 CFR 1.183 at page 4 (stating that the remarks portion of the response spans 24 pages (pp. 8-31) and that patent owner believes no pages of the accompanying Bray, Goodman and Grandt declarations count toward the page limit, but that 7 pages of the Sawtell declaration count toward the page limit.)

[4] *See* the renewed petition under 37 CFR 1.183 at pages 2 and 3 (asserting that "[t]he Office Action sets forth eighteen different grounds of rejection"; that the first seventeen grounds of rejection essentially incorporate by reference the '1085 request, the '285 request, the November 19, 2009 comments, and the May 19, 2009 comments; that the eighteen different grounds of rejection are based on several legal theories, including under 35 USC 102, 103, 112 and 314(a); and that the eighteen grounds of rejection cite thirteen references spanning over 350 pages.)

[5] *See, e.g.*, pages 8-31 of the remarks portion of the July 2, 2010 response. Additionally, on page 12 of the July 2, 2010 response, patent owner relies on arguments made on pages 24-30 of its prior response and on pages 15-17 of the previously-submitted "2009 Bray declaration." Although these arguments are not repeated in the body of the July 2, 2010 response itself, the 10 pages on which those arguments appear count toward the page limit because patent owner relies upon them in response to the April 1, 2010 Office action.

[6] *See, e.g.*, pages 6-8 and 12-35 of the Bray declaration, pages 10-11 of the Grandt declaration, and pages 4-6 and 10-12 of the Sawtell declaration. It does not appear that any pages of the Goodman declaration count toward the page limit. *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinon(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] On its face, the April 1, 2010 Office action spans approximately 22 pages and incorporates by reference approximately 49 pages from the '1085 request, the '285 request, the November 19, 2009 comments, and the May 19, 2009 comments, for a total of 71 pages.

CONCLUSION

1. Patent owner's July 2, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 2, 2010 response to the April 1, 2010 Office action to exceed the page limit by 19 pages. This waiver makes patent owner's July 2, 2010 response page-length compliant.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, Office of Patent Legal Administration, at (571) 272-8150 or Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Cynthia L. Nessler

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Senior Legal Advisor
Office of Patent Legal Administration

09-22-2010

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Thomas et al
Inter Partes Reexamination Proceeding
Control No. 95/000292
Filed: September 4, 2007
For: U.S. Patent No. 6,910,601

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

This decision is in response to the July 13, 2010 requester petition entitled "Petition to the Office of Petitions under 37 C.F.R. §§ 1.182 and 1.183 to Withdraw Dismissal of Appeal" (the July 13, 2010 requester petition) and to the July 16, 2010 patent owner petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 Opposing Petition Filed 7/13/2010 and Requesting Relief Not Specifically Provided For" (the July 16, 2010 patent owner petition).

This decision also addresses the third party requester change of correspondence address filed on July 13, 2010 (the July 13, 2010 requester change of correspondence address).

The July 13, 2010 requester petition, the July 16, 2010 patent owner petition, the July 13, 2010 requester change of correspondence address, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.182 has been received.

In view of the specific facts and circumstances of the present case, the $400 petition fee set forth in 37 CFR 1.17(f) for the present patent owner petition under 37 CFR 1.182 is hereby waived.

SUMMARY

The July 13, 2010 requester petition is **dismissed.**

The July 16, 2010 patent owner petition is **granted to the extent** that the petition, which includes patent owner's arguments, has been entered and considered in conjunction with requester's July 13, 2010 petition.

The July 13, 2010 requester change of correspondence address has been entered and is **effective** as of July 13, 2010.

BACKGROUND

- On June 28, 2005, U.S. Patent 6,910,601 (the '601 patent) issued to Thomas et al.

- On August 17, 2007, the requester deposited a request for *inter partes* reexamination, including a transmittal letter identifying the correspondence address of the third party requester as Mark Levy & Associates, PLLC, Press Building, Ste. 902, 19 Chenango Street, Binghamton, NY 13901 (the Chenango street address). The signature block of the representative of the third party requester, appearing on page 77 of the request, also identifies the Chenango street address. The reexamination proceeding was assigned control no. 95/000,292 (the '0292 proceeding).

- On September 4, 2007, the requester deposited a supplemental request paper, i.e., a request for *inter partes* reexamination transmittal form PTO/SB/58, identifying, on page 2, the correspondence address of the third party requester as that of customer number 41245. Office records reveal that the address identified with customer number 41245 is Mark Levy, Hinman, Howard, & Kattell, LLP, 80 Exchange Street, P.O. Box 5250, Binghamton, NY 13901 (the Exchange street address).

- On September 6, 2007, the Office mailed a notice of assignment of *inter partes* reexamination request, and a notice of *inter partes* reexamination request filing date to the third party requester at the Chenango street address, and to the patent owner. The '0292 proceeding was given a filing date of September 4, 2007.

- On November 14, 2007, the Office mailed an order granting reexamination in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

- Also on November 14, 2007 the Office mailed a first Office action in the '0292 proceeding to the third party requester at the Chenango street address, and to the patent owner.

- On January 10, 2008, the patent owner filed a response to the November 14, 2007 Office action, and a certificate of service stating that a copy of the January 10, 2008 response was served on the third party requester at the Chenango street address.

- On February 11, 2008, the third party requester filed comments after the January 10, 2008 patent owner response. The February 11, 2008 comments are accompanied by a certificate of mailing dated February 8, 2008, and contain a signature block of the representative for the third party requester identifying the Chenango street address.

- On April 23, 2008, the Office mailed a notice of defective paper to the third party requester at the Chenango street address, and to the patent owner.

- On May 13, 2008, the patent owner filed a response to the April 23, 2008 notice of defective paper, accompanied by a certificate of service stating that a copy of the May 13, 2008 response was served on the third party requester at the Chenango street address.

- On February 23, 2009, the Office mailed an action closing prosecution (ACP) to third party requester at the Chenango street address, and to the patent owner.

- On March 18, 2009, the patent owner filed a response to the February 23, 2009 action closing prosecution, accompanied by a certificate of service stating that a copy of the March 18, 2009 response was served on the third party requester at the Chenango street address (the March 18, 2009 patent owner response).

- On April 17, 2009, the third party requester filed comments after the March 18, 2009 patent owner response. The April 17, 2009 comments contain, on page 14, a signature block of the representative of the third party requester identifying the Exchange street address (the April 17, 2009 requester comments).

- On April 18, 2009, the patent owner filed a petition under 37 CFR 1.183, which was taken as a petition to waive the requirement of 37 CFR 1.951(a) that, after an action closing prosecution has been mailed by the Office, the patent owner may only once file comments limited to the issues raised in the Office action closing prosecution (the April 18, 2009 patent owner petition).

- On August 12, 2009, a decision granting the April 18, 2009 patent owner petition was mailed by the Office to the requester at the Chenango street address and to the patent owner. A courtesy copy of the decision was also mailed to the requester at the Exchange street address. The decision notified the requester that all future correspondence will be mailed to the official correspondence address of record, at the Chenango street address, unless a clearly identified change of correspondence address was properly filed.

- On August 14, 2009, a right of appeal notice was mailed by the Office to requester at the Chenango street address, and to the patent owner. As a courtesy, a copy of the right of appeal notice was also mailed to the requester at the Exchange street address.

- On September 16, 2009, the requester filed a notice of appeal (certificate of mailing, September 14, 2009).

- On September 21, 2009, the requester filed a certificate of service certifying that the September 16, 2009 notice of appeal was mailed via first class mail to the patent owner on September 17, 2009.

- On November 25, 2009, the requester deposited an appellant brief (certificate of mailing, November 16, 2009).

- On December 2, 2009, the patent owner filed a respondent brief.

- On April 6, 2010, an *inter partes* reexamination notification *re*: brief, stating that the November 25, 2009 requester appellant brief was defective, was mailed to the requester at the Chenango street address, and to the patent owner.

- On May 12, 2010, an *inter partes* reexamination notification re: brief, stating that the appeal of the third party requester was dismissed, was mailed by the Office to the requester at the Chenango street address, and to the patent owner. As a courtesy, a copy of the *inter partes* reexamination notification re: brief was also mailed to the requester at the Exchange street address.

- On June 9, 2010, the requester deposited a change of correspondence address. The June 9, 2010 correspondence address change attempted to change the requester's official address from the Chenango street address to the Exchange street address. The June 9, 2010 change of correspondence address, however, was not accompanied by a certificate of service pursuant to 37 CFR 1.903.

- On June 11, 2010, the requester filed a petition, taken as a petition under 37 CFR 1.181, entitled "Petition to Withdraw Dismissal of Appeal" (the June 11, 2010 requester petition).

- On July 2, 2010, a decision denying the June 11, 2010 requester petition was mailed by the Office to the Chenango street address, and to the patent owner. As a courtesy, a copy of the July 2, 2010 decision was also mailed to the requester at the Exchange street address.

- On July 13, 2010, the present petition, entitled "Petition to the Office of Petitions under 37 C.F.R. §§ 1.182 and 1.183 to Withdraw Dismissal of Appeal" was mailed (the July 13, 2010 requester petition).

- Also on July 13, 2010, the requester filed a requester change of correspondence address, accompanied by a certificate of service. The July 13, 2010 change of correspondence address changed the official correspondence address of the requester in this proceeding from the Chenango street address to the Exchange street address.

- On July 16, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 Opposing Petition Filed 7/13/2010 and Requesting Relief Not Specifically Provided For" (the July 16, 2010 patent owner petition).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314(b)(1) provides:

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

37 CFR 1.33 provides, in pertinent part:

Correspondence address and daytime telephone number . When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing . . .The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address.

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(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more. 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.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.903 provides:

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect

service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

MPEP 403 provides, in pertinent part:

37 CFR 1.33(a) provides that in a patent application the applicant must specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. The correspondence address must appear either in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with an application filing. Where more than one correspondence address is specified, the Office will select one of the correspondence addresses for use< as the correspondence address. This is intended to cover, for example, the situation where an application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying 37 CFR 1.63 oath or declaration, or other similar situations. The Office will select which of the multiple correspondence addresses to use according to the following order: (A) application data sheet (ADS); (B) application transmittal; (C) oath or declaration (unless power of attorney is more current); and (D) power of attorney.< If more than one correspondence address is specified in a single document, the Office will select the address associated with a Customer Number over a typed correspondence address.

I. Customer Number Practice

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As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application will generally be resolved in favor of the address of the Customer Number.

MPEP 601.03 provides, in pertinent part (emphasis added):

Unless the correspondence address is designated as the address associated with a Customer Number, **a separate notification must be filed in each application for which a person is intended to receive communications from the Office**. See MPEP § 403 for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02 . . . The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record . . .

The obligation (see 37 CFR 11.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

MPEP 2609 provides, in pertinent part:

Patent owners and third party requesters are cautioned that the reexamination statute, regulations, and published examining procedures do not countenance so-called "litigation tactics" in reexamination proceedings. The parties are expected to conduct themselves accordingly.

MPEP 2613 provides, in pertinent part:

> All correspondence for a third party requester is addressed to the representative of the requester, unless a specific indication is made to forward correspondence to another address.

DECISION

The present petition is an exact duplicate of the June 11, 2010 requester petition under 37 CFR 1.181, with the exception of the title "Petition to the Office of Petitions Under 37 C.F.R. §§ 1.182 and 1.183 to Withdraw Dismissal of Appeal" and of the phrase "and pursuant to the Decision on Petition Under 37 C.F.R. § 1.181 mailed on July 2, 2010", both of which appear on page 1 of the present petition, and with the exception of the date "July 13, 2010", which appears on page 7, the last page of the present petition. The June 11, 2010 requester petition was denied by the eight-page decision mailed on July 2, 2010, which explained the reasons for the denial in detail. Solely by virtue of the title of the petition, the requester requests relief under 37 CFR 1.182 and 37 CFR 1.183.

The facts of the present case, however, do not represent a "situation not specifically provided for" as specified by 37 CFR 1.182. Specifically, the requester may seek, by September 2, 2010 (see 37 CFR 1.181(f)):

a) reconsideration of the July 2, 2010 decision, denying requester's June 11, 2010 petition under 37 CFR 1.181; and/or

b) supervisory review by a higher official, pursuant to 37 CFR 1.181(a)(3), of the July 2, 2010 decision.

For this reason, the present petition under 37 CFR 1.182 is **dismissed**.

The requester may also file a petition under 37 CFR 1.183 requesting waiver of provisions of 37 CFR 41.67(d). 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an *extraordinary situation* in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

Addressing the instant petition under 37 CFR 1.183, the extraordinary relief of waiving a rule is not granted if the rules provide an alternative avenue for obtaining the relief sought, such as items a) and/or b) above. *See Cantello v. Rasmussen*, 220 USPQ 664 (Comr. 1982). Furthermore, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. The requester claims that the Office was notified of a change of address on or about March 1, 2008, and points to Exhibits A-1 and A-2 as evidence of this notification. Exhibits A-1 and A-2, however, only provide evidence that on March 10, 2008, the Office received a change of address for the registered patent attorneys and agents roster. As clearly explained in the July 2, 2010 decision denying requester's petition under 37

CFR 1.181 to withdraw dismissal of the appeal, the requester did not properly notify the Office of a change of correspondence address in accordance with the rules or with Office procedure. MPEP 601.03 provides, in pertinent part:

> The obligation (see 37 CFR 11.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications.

The requester admits that "the undersigned failed to notify the Office in this file of his change of address on March 1, 2008" (emphasis in original). The requester argues that "the mailing address error is harmless". The requester, however, has formerly argued that it had not been properly served with a copy of patent owner's March 18, 2009 response, due to the fact that the patent owner served the requester at the Chenango street address, and, for this reason, the patent owner's response should have been refused consideration by the Office. See page 1 of the April 17, 2009 requester comments. The requester, therefore, cannot now argue that its failure to correct its mailing address is "harmless". In the decision mailed on August 12, 2009, the Office conducted a thorough analysis of the record and determined that the official correspondence address of the requester in this reexamination proceeding was the Chenango street address, and that the patent owner's service of the March 18, 2009 response was proper. See page 11 of the August 12, 2009 decision.

In addition, as plainly stated in the July 2, 2010 decision denying requester's petition under 37 CFR 1.181 to withdraw dismissal of the appeal, the official correspondence address used for all Office communications, until the filing, on July 13, 2010, of a proper change of correspondence address, was the Chenango street address, and the official address for service used by the patent owner was the Chenango street address. The fact that both the Office and the patent owner mailed courtesy copies, at times, to the Exchange street address did not effect a correspondence address change in the reexamination proceeding, *and* the statement in the courtesy copy of the August 12, 2009 decision that - all future correspondence would be mailed to the official correspondence address of record, at the Chenango street address, unless a clearly identified change of correspondence address was properly filed - clearly put requester on notice that the courtesy copy did not effect or reflect a change of address. The requester argues that "the current address" has been associated with ". . . the undersigned's law firm's Customer Number 41245"; however, the requester did not file an effective change of correspondence address to start using this customer number until July 13, 2010, the date of filing the present petition.

Most importantly, as pointed out, the August 12, 2009 decision clearly informed the requester that all future correspondence would be mailed to the Chenango street address, unless a clearly identified change of correspondence address was filed. Yet, the requester has not explained, in particular, the eleven-month delay in filing a proper change of correspondence address in response to this express notification in the August 12, 2009 decision.

The dismissal of the requester's appeal was in clear accordance with Office policies set forth in MPEP 2675.02, as discussed on page 7 of the July 2, 2010 decision. For the reasons given above, the requester has not shown how the facts give rise to *an extraordinary situation, such*

that justice requires waiver of the rule. Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

The July 16, 2010 patent owner petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 Opposing Petition Filed 7/13/2010 and Requesting Relief Not Specifically Provided For" (the July 16, 2010 patent owner petition) requests that "(1) this paper [the July 16, 2010 patent owner petition] and the facts and arguments contained herein be considered in conjunction with the 7/13/2010 petition filed in this reexamination proceeding, and the 7/13/2010 petition be denied; and (2) a Reexamination Certificate be issued as set forth in the Withdrawal of the Appeal mailed 5/12/2010 without any further delay – regardless of whatever additional petitions that the third party requester may file in the future." The patent owner points out that the Office is required to conduct reexamination proceedings "with special dispatch". The Office, however, is also required to conduct reexamination proceedings in accordance with the rules and with standard Office procedure. Accordingly, the July 16, 2010 patent owner petition is **granted to the extent** that the petition, which includes patent owner's arguments, has been entered and considered in conjunction with requester's July 13, 2010 petition.

The July 13, 2010 requester change of correspondence address is accompanied by a proper certificate of service, and is **effective** as of July 13, 2010.

CONCLUSION

- The July 13, 2010 requester petition is **dismissed.**
- The July 16, 2010 patent owner petition is **granted to the extent** that the petition, which includes patent owner's arguments, has been entered and considered in conjunction with requester's July 13, 2010 petition.
- The July 13, 2010 requester change of correspondence address is **effective** as of July 13, 2010.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for appropriate action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Beverly Flanagan, of CRU Art Unit 3993, at (571) 272-4766.
- Any further correspondence with respect to this matter should be addressed as follows:

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

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

By Fax: (571) 273-9900

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

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

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

9-20-10
Kept-ab/.../

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Charles D. Gunter, Jr. Whitaker Chalk Swindle & Swayer LLP 301 Commerce St., 3500 City Ctr Tower II Fort Worth, TX 76102	(For Patent Owner)
Paul M. Thompson Cochran Freund & Young LLC 2026 Caribou Drive, Suite 201 Fort Collins, CO 80525	(For Third Party Requester)

MAILED

SEP 21 2010

CENTRAL REEXAMINATION UNIT

In re Anderson Reexamination Proceeding Control No. : 95/000,294 Filed: August 30, 2007 Patent No. 7,152,413	DECISION ON REQUESTER'S PETITION UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed August 10, 2010, under 37 CFR 1.181 requesting supervisory review of the examiner's action in issuing the Action Closing Prosecution (ACP) and the Right of Appeal Notice (RAN). It is noted that Requester filed a separate petition under 37 CFR 1.183, which will be addressed in another decision in due course.

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

SUMMARY

Third Party Requester's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 7,152,413 (the '413 patent) issued on December 26, 2006.

2. A request for reexamination, assigned Control No. 95/000,294 (the '294 proceeding), was filed by a Third Party Requester on August 30, 2007.

3. Reexamination was ordered in the '294 reexamination proceeding on October 4, 2007.

4. An Office action on the merits was mailed on the same day, October 4, 2007.

5. Prosecution continued in the reexamination proceeding, and on April 1, 2009 an Action Closing Prosecution (ACP) was mailed. The ACP confirmed patent claims 1-7, 9, and 10 and rejected patent claim 8.

6. On September 29, 2009, a Right of Appeal Notice (RAN) was mailed. No response was filed to the ACP. The RAN again confirmed patent claims 1-7, 9, and 10 and rejected patent claim 8.

7. On October 27, 2009, the Third Party Requester filed a Notice of Appeal.

8. On December 17, 2009, the Third Party Requester filed an Appeal Brief.

9. On January 15, 2010, the Patent Owner filed a Respondent Brief.

10. On March 10, 2010, the Office mailed a Notice that informed the Third Party Requester that the December 17, 2009 Appeal Brief was defective because it contained new evidence not of record.

11. On April 9, 2010, the Third Party Requester filed a replacement Appeal Brief.

12. On May 7, 2010, the Patent Owner filed a replacement Respondent Brief.

13. On June 10, 2010, the Office mailed a Notice of Intent to Issue a Reexamination Certificate, which confirmed patent claims 1-7, 9, and 10 and canceled rejected patent claim 8 due to Patent Owner's failure to timely appeal the rejection. The Notice also stated that the appeal by the Third Party Requester is dismissed because the April 9, 2010 Appeal Brief was still not compliant with Office rules and procedures.

14. On August 10, 2010, Third Party Requester filed the petition under 37 CFR 1.181. The Third Party Requester also filed a petition under 37 CFR 1.183 requesting waiver of the rules. The petition 37 CFR 1.183 will be addressed in separate decision.

Discussion

The Third Party Requester (petitioner) requests supervisory review of the examiner's actions in issuing the Action Closing Prosecution, dated April 1, 2009, and the Right of Appeal Notice, dated September 29, 2009. The petitioner considers the ACP and RAN improper because of the withdrawal of the prior art rejections and indication of claims 1-7, 9, and 10 as patentable.

The request to review the ACP and RAN is dismissed as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

...

Decision

The petitioner brings before the Office a petition under 37 CFR § 1.181 to review the Action Closing Prosecution, dated April 1, 2009, and the Right of Appeal Notice, dated September 29, 2009. The petitioner filed the petition on August 10, 2010. The action from which relief is requested is the Action Closing Prosecution, which was mailed on April 1, 2009, and the Right of Appeal Notice, which was mailed on September 29, 2009. Therefore, the petition was filed over **two** months from the mailing date of the action (April 1, 2009 and September 29, 2009) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

In other words, this petition is untimely to request relief from the examiner's actions in the ACP and RAN. It is noted that even if this petition was deemed timely filed, the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of claim interpretation and application of the prior art to the claims are appealable issues, and therefore, cannot be addressed by petitions.

CONCLUSION

1. Third Party Requester's petition under 37 CFR 1.181, filed August 10, 2010, is **dismissed** as untimely for the reasons discussed above.

2. The August 10, 2010 petition under 37 CFR 1.183 will be addressed by the Office of Patent Legal Administration in a separate decision.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,294	08/30/2007	7152413	ICEE.22USYA	6977

7590 09/21/2010

Charles D. Gunter, Jr.
Whitaker Chalk Swindle and Sawyer LLP
301 Commerce Street
3500 City Ctr. Tower II
Fort Worth, TX 76102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/21/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Paul M. Thompson
Cochran Freund & Young LLC
2026 Caribou Drive, Suite 201
Fort Collins, CO 80525

Date:

MAILED

SEP 2 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000294
PATENT NO. : 7152413
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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Whitaker, Chalk, Swindle & Sawyer, LLP (For Patent Owner)
3500 City Center Tower II
301 Commerce Street
Fort Worth, TX 76102-4186

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SEP 21 2010

CENTRAL REEXAMINATION UNIT

Cochran, Freund & Young LLP (For Requester)
2026 Caribou Drive
Suite 201
Fort Collins, CO 80525

In re Anderson :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,294 : **DISMISSING**
Filed: August 30, 2007 : **PETITION**
For: U.S. Patent No. 7,152,413 :

This decision is in response to the August 10, 2010 requester petition entitled "Petition Pursuant to 37 C.F.R. § 1.183 For Suspension of Rules 37 C.F.R. §1.116(f), 37 C.F.R. §1.939(a), 37 C.F.R. §41.37(d) and 37 C.F.R. §41.63(c)" (the August 10, 2010 requester petition).

The August 10, 2010 requester petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of $400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.183 has been received.

SUMMARY

The August 10, 2010 requester petition is **dismissed**. A reexamination certificate issued on September 7, 2010. This reexamination certificate will remain as issued, in view of this decision.

DECISION

The requester requests waiver of 37 CFR 1.116(f) (prohibiting submission of affidavits or other evidence after the issuance of the right of appeal notice (RAN)); 37 CFR 1.939(a) (generally prohibiting submission of unauthorized papers); 37 CFR 41.37(d) (appeal stands dismissed if appellant filed an amended brief in response to a notification of defective brief, and the amended brief does not overcome all the reasons for non-compliance stated in the notification); and 41.63(c) (prohibiting submission of affidavits or other evidence after the filing of an appeal).

The requester argues that the present petition is proper, since the rules, as triggered in the present reexamination, create an extraordinary situation which procedurally prohibits the requester from presenting rebuttal evidence to rebut a finding of fact by the examiner. The requester points out that because the patent owner did not file a response to the action closing prosecution (ACP), the requester was procedurally precluded from filing any paper at that time. After the mailing of the

RAN, the requester was procedurally precluded from filing an affidavit or other evidence pursuant to 37 CFR 1.116(f). When requester filed a notice of appeal, the requester was further precluded from filing any affidavit or other evidence pursuant to 37 CFR 41.63(c). The requester argues that the guidelines articulated in MPEP 2673.01, subsection I (stating that the requester has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds), violates the rights of the parties in agency actions as provided for under 5 U.S.C. § 556(d) of the Administrative Procedures Act ("APA"), which states that: "[A] party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts". Finally, the requester argues that the issuance of a notice of intent to issue a reexamination certificate (NIRC) by the examiner after the requester filed a second defective brief, in response to an earlier notification of defective brief, is "both unwarranted and unjust", and is an *ultra vires* action.

The present petition under 37 CFR 1.183, however, is untimely, and was filed well after the time for filing it. This resulted in the proceeding being present in the phase of the reexamination certificate "printing cycle" at which the issuance of a certificate could no longer be prevented. Any disturbance of the certificate would fly in the face of special dispatch unless requester could show an *extraordinary* situation that resulted in the significantly delayed submission of the petition. The requester has provided such a showing.

To be timely, any petition under 37 CFR 1.181, 1.182, or 1.183 must be filed within two months of the action or notice from which relief is requested. See 37 CFR 1.181(f). In the present case, any petition under 37 CFR 1.183 would have needed to have been filed, at the latest, within two months from the mail date of the March 10, 2010 notification of defective brief, i.e., on or before May 10, 2010. Accordingly, the present petition is treated as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.181(f).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an *extraordinary* situation, *when justice requires*, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an *extraordinary* situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

Although its petition under 37 CFR 1.183 would have needed to have been filed on or before May 10, 2010, requester did not file its petition until August 10, 2010. The requester fails to provide any explanation for the delay in filing the present petition. As pointed out by requester, it was procedurally precluded from filing any paper until the appeal stage because the patent owner did not file a response to the action closing prosecution (ACP); thus, a prudent requester would have filed the present petition with its December 17, 2009 appellant brief, in order to obtain entry of the evidence, for which entry is <u>now</u> being sought. Further, requester could have later filed the present petition with its April 9, 2010 corrected appellant brief, after requester was explicitly notified by the Office of the defect in the brief; this defect is one which a 37 CFR 1.183 can rectify (when granted). At the very latest, the requester must have filed the present petition on or

before May 10, 2010, i.e., within two months of the March 10, 2010 notification of defective brief, which expressly informed the requester that its appellant brief was improper due to the inclusion of new evidence, contrary to 37 CFR 41.67(b)(2). Furthermore, the requester could have avoided termination of the appeal by filing, in addition to the brief which included the newly submitted evidence, a second brief that complied with the rules, i.e., a brief that excluded the newly submitted evidence. At no time, however, does the requester explain the reason for any of these delays, or the reason why a compliant brief was not also filed.

In addition, the requester waited until two months after the mail date of the NIRC to file the present petition, long after the proceeding had been sent to the contractor for publication. As can be viewed in Public PAIR, in the transaction history of the present proceeding, the present proceeding was sent to the contractor for publication on June 21, 2010. Once the proceeding is sent to the contractor for publication, the Office cannot prevent the publication of the reexamination certificate. If Office procedure were changed to include a six-to-eight week delay after the mailing of the NIRC before the publication process could commence, such a procedure would be contrary to the statutory mandate for special dispatch. See 35 U.S.C. 314(c). The requester has not explained why the requester delayed the filing of the present petition until such time that the Office could not prevent the publication of the certificate.

The requester points to a June 2, 2010 decision by the Office in reexamination proceeding control no. 95/000,330 (the '330 proceeding), which granted a petition under 37 CFR 1.183 to suspend the rules and permit the entry of a declaration under 37 CFR 1.132, which was newly submitted with requester's appellant brief. The facts of the '330 proceeding, however, differ substantially from those of the present proceeding. In the '330 proceeding, the petition under 37 CFR 1.183 was *timely filed*, i.e., it was filed *simultaneously with* the appellant brief which included the declaration. In the present proceeding, the present petition under 37 CFR 1.183 was not filed until nearly eight months after the requester filed its initial appellant brief, five months after the Office mailed the notification of defective brief to the requester, four months after the requester filed the second (defective) brief, and two months after the Office mailed the NIRC.

In the present proceeding, the patent owner filed arguments in favor of patentability in response to the first Office action, in which the examiner rejected all of the claims under reexamination. The requester in the present proceeding had the opportunity at that time to submit comments and any other evidence to rebut patent owner's response. Upon reviewing both the patent owner's response and the requester's comments, the examiner in this proceeding made the determination to confirm all of the claims under reexamination, with the exception of claim 8, in the ACP. The requester essentially argues that it cannot be expected to know that the patent owner would not file a response to the ACP; therefore, the requester argues, it is unreasonable to expect the requester to file all of its arguments and comments in response to patent owner's response to the first Office action. The Office, however, is required to conduct reexamination proceedings with special dispatch. The Office cannot permit the requester to delay the reexamination proceeding by choosing to file further evidence, at a later date, that could have been filed earlier in the proceeding. All evidence must be submitted in a timely manner, so that the proceeding can proceed with special dispatch. The requester is presumed to be aware of the rules and Office procedure, and is presumed to know that the examiner may be persuaded by patent owner's arguments, and confirm at least some, if not all, of the claims under reexamination. The

requester is also presumed to know that patent owner need not file a response to an ACP, which would preclude the filing of any comments by the requester until the appeal stage. The Office cannot permit the requester to delay the proceeding by filing, at a later date in the proceeding, evidence directed to issues raised earlier, given its statutory mandate to conduct reexamination with special dispatch. Thus, it is not unreasonable to require the requester to present rebuttal evidence at its earliest opportunity.

The requester points to a declaration under 37 CFR 1.132 by Mr. Justin N. Woo, filed concurrently with the present petition. Mr. Woo calls attention to reexamination proceeding control nos. 95/000,460 and 95/001,154. In 95/000,460, unlike the present case, a petition under 37 CFR 1.181 by the requester to reopen prosecution *was filed concurrently with an appellant brief by the requester of that proceeding*. In any event, the petition under 37 CFR 1.181 in 95/000,460 has not yet been decided. In 95/001,154, a petition under 37 CFR 1.182 to strike requester's appellant brief has not been properly filed, as set forth in the July 27, 2010 decision. The issue in 95/001,154 has not been resolved, and in any event, the facts of 95/001,154, with which another *inter partes* proceeding has been merged, substantially differ from those of the present proceeding. At a minimum, the requester in 95/001,154 has not, as in the present case, filed a second defective brief in response to a notification of defective brief, without an accompanying petition under 37 CFR 1.183 to waive the rules and enter the newly submitted evidence. Even if a petition under 37 CFR 1.182 had been properly filed in 95/001,154, the Office does not, in one proceeding, pre-decide petitions filed in other proceedings.

The requester argues that the guidelines articulated in MPEP 2673.01, subsection I, violate the APA, which states that a party is permitted to submit rebuttal evidence. The APA, however, does not authorize the *untimely* submission of rebuttal evidence, which would result in the delay of a reexamination proceeding, contrary to a statutory mandate to resolve it with special dispatch. Had the requester filed the present petition with its initial appellant brief or with its corrected brief, the petition might have been granted. The present petition, however, was not filed until long after the filing of its second (defective) brief, and long after the mailing of the NIRC. The requester further argues that the guidelines set forth in MPEP 2673.01 fail to account for the fact that requester is prohibited by the rules from submitting affidavits or other evidence after ACP, when the patent owner does not respond. MPEP 2673.01, subsection I, however, expressly states that the requester "has no right to comment on and address a finding of patentability made during the reexamination proceeding *until the appeal stage*, unless the patent owner responds" (emphasis in original). As explained in detail above, the requester has the opportunity to address a finding of patentability *at the appeal stage*. Concurrently with the filing of its appellant brief, the requester could have, and should have, filed a petition under 37 CFR 1.183 to waive the rules and permit entry of the newly submitted evidence. The requester failed to do so.

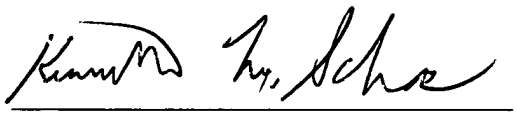
The requester also argues that the issuance of a notice of intent to issue a reexamination certificate (NIRC) by the examiner after the requester filed a second defective brief, in response to an earlier notification of defective brief, is "both unwarranted and unjust", and is an *ultra vires* action. The requester apparently argues that a "technical violation of the form rules for Appeal Briefs" permits the requester to again attempt, *for a third time*, to comply with the rules. However, the Office is required to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). The requester is presumed to be aware of the rules. The requester

was notified of the defect in its initial appellant brief. The requester failed to respond to the notification of defective brief by (1) *timely* filing a brief including the newly submitted evidence, accompanied by (or timely followed by) a petition under 37 CFR 1.183 to waive the rules and permit entry and consideration of the newly submitted evidence, and/or (2) timely filing a companion compliant brief. Finally, the requester has failed to provide *any* explanation for the long delay in filing the present petition.

For the reasons given above, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. Accordingly, the present petition under 37 CFR 1.183 is **dismissed**. Since the present petition is dismissed, the September 7, 2010 reexamination certificate will remain as issued.

CONCLUSION

- The August 10, 2010 requester petition is **dismissed.**
- The September 7, 2010 reexamination certificate will remain as issued.
- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



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

9-21-10
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,313	10/31/2007	6925469	108.0007-00000	7392

22882 7590 03/31/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes GOOGLE, INC.
v.
INTERTAINER, INC.

Reexamination Control No. 95/000,313
Patent 6,925,469
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 for Waiver of the Page Limit of 37 C.F.R. § 1.943(c)," filed February 10, 2011 ("Petition #1"). Petitioner is requesting waiver of the 30 page limit of 37 C.F.R. §1.943(c), to permit 17 additional pages in the appellant brief. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on February 10, 2011, along with the appeal brief fee.

This is also a decision on requester's "Petition under 37 C.F.R. § 1.183 to Waive the 15-Page Limit for the Respondent Brief as set forth in 37 C.F.R. § 1.943," filed March 9, 2011 ("Petition #2"). Petitioner is requesting waiver of the 15 page limit of 37 C.F.R. §1.943(c), to permit a 21 page respondent brief. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on March 9, 2011, along with the appeal brief fee.

FINDINGS

1. On October 31, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,925,469.

2. On January 29, 2008, reexamination was ordered and a non-final Office action was mailed on February 13, 2008.

3. Patent owner filed a response to the Office action on April 14, 2008, and third party requester filed comments in reply to the Office action and patent owner's response on May 14, 2008, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On March 19, 2009, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the ACP on May 19, 2009, and third party requester filed comments in reply to the ACP and patent owner's response on June 16, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On November 4, 2009, a Right of Appeal Notice (RAN) was mailed, which refused entry of the May 19, 2009, amendment.

7. Patent Owner filed a Notice of Appeal on December 4, 2009, and also filed a petition under 37 C.F.R. § 1.182 requesting continued reexamination, to permit entry of the May 19, 2009, amendment.

8. On January 15, 2010, the § 1.182 petition was granted.

9. Requester filed comments on February 12, 2010, in reply to the patent owner response of May 19, 2009.

10. On May 21, 2010, a second Action Closing Prosecution (ACP) was mailed.

11. On November 12, 2010, a second Right of Appeal Notice (RAN) was mailed.

12. Patent Owner filed a Notice of Appeal on December 4, 2009, appealing the rejections of claims 1-10, 12-21, 23-38, 47-63 and 67.

13. On February 10, 2011, Patent Owner filed an appellant's brief appealing the rejections of claims 1-10, 12-21, 23-38, 47-63 and 67, and accompanied by Petition #1.

14. Requester filed a respondent brief on March 9, 2011, accompanied by Petition #2.

DISCUSSION

In Petition #1, patent owner is requesting waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief is stated to be 17 pages over the limit.

Waiver is requested for the following reasons stated by petitioner:

(1) Patent owner discussed the totality of the rejections in the November 2010 RAN, in order to respond to every ground of rejection per MPEP 2675. The RAN is 71 pages, and incorporates portions of the October 2007 request, the May 2008 comments, and the February 2010 comments.

(2) Patent owner was required to address 12 rejections under 35 U.S.C. 112, first and second paragraphs, and 19 rejections under § 102 and § 103 based on at least 15 references.

(3) The RAN does not accurately describe the scope of the art rejections. The true scope was only apparent after a thorough review of the request and both sets of comments incorporated by reference into the RAN, and then various discrepancies involving the art rejections became apparent.

(4) Patent Owner submits that the examiner did not properly frame the scope of the rejections within the "four corners" of the November 2010 RAN, therefore patent owner required approximately 8 pages to discuss the true scope of the art rejections and attempt to resolve the discrepancies.

In Petition #2, requester is requesting waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to 15 pages or 7,000 words in length. The requester's respondent brief is stated to be 21 pages, and indicated to be due to the length of patent owner's appellant brief of 47 pages in a small font.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. However, the appellant brief and respondent brief filed subsequent to appeal are significantly longer than permitted, whereas the rules require that the briefs be more limited than pre-appeal responses. Patent owner's appellant brief filed on February 10, 2011, is stated to be 17 pages over the limit of 30 pages and 14,000 words. The brief is 47 pages, but in a small font. A certificate of the word count does not appear to have been included with the appellant brief. Given the small font utilized, it is readily apparent that the number of words far exceeds the 14,000 word limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the RAN, the numerous rejections which are appealed, and the alleged unclear scope of the rejections and purported discrepancies. However, the prosecution history reveals that the patent owner chose to amend a significant number of patent claims, as well as to present an additional 23 claims in the April 2008 amendment, without canceling any of the original 47 patent claims. In the May 2009 amendment, patent owner further amended claims, and canceled 16 claims. This amendment was originally not entered by the examiner because it did not comply with 37 C.F.R. 1.116. Patent owner forced the entry of the amendment by filing a petition requesting continued reexamination and entry of the May 2009 amendment. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims

being examined has increased, and the numerous claim amendments necessitated many new rejections, as well as revision of earlier rejections. The Patent Owner caused this challenge itself.

Petitioner has stated that the RAN contains 12 rejections under 35 U.S.C. 112, first and second paragraphs, and 19 rejections under § 102 and § 103, based on at least 15 references. While these statements are all accepted as true, the present petition does not explain why these are extraordinary circumstances nor how the circumstances prevent compliance with the page and word limit requirements. It is noted that the ACP was the same and/or similar in size and number of issues as compared to the RAN, and the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. The appellant brief and respondent brief filed subsequent to appeal are significantly longer than the permitted limits, whereas the rules require that the briefs be more limited than pre-appeal responses. The page and word limits are intentionally designed to focus the issues and require a concise presentation of arguments.

A persuasive showing has not been made that this situation is extraordinary, nor that justice requires that significantly more pages/words be allotted to appellant's brief. Petition #1 is **denied**. The appellant brief of February 10, 2011, is **not entered**.

The respondent brief of March 9, 2011, is premature since an appellant brief has not been properly filed (37 C.F.R. § 41.66(b)). The respondent brief is **not entered**. Petition #2 is **dismissed as moot**.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with of 37 CFR § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the patent owner's appeal will be dismissed.

If a corrected appellant brief is timely filed, then requester is given one month from the date of service to file a respondent brief in compliance with 37 CFR § 1.943(c).

In view of the foregoing, Petition #1 is DENIED. Petition #2 is DISMISSED AS MOOT.

James T. Moore
Acting Chief Administrative Patent Judge

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Hartville, OH 44632

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,313	10/31/2007	6925469	108.0007-00000	7392

22882 7590 03/31/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes GOOGLE, INC.
v.
INTERTAINER, INC.

Reexamination Control No. 95/000,313
Patent 6,925,469
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 for Waiver of the Page Limit of 37 C.F.R. § 1.943(c)," filed February 10, 2011 ("Petition #1"). Petitioner is requesting waiver of the 30 page limit of 37 C.F.R. §1.943(c), to permit 17 additional pages in the appellant brief. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on February 10, 2011, along with the appeal brief fee.

This is also a decision on requester's "Petition under 37 C.F.R. § 1.183 to Waive the 15-Page Limit for the Respondent Brief as set forth in 37 C.F.R. § 1.943," filed March 9, 2011 ("Petition #2"). Petitioner is requesting waiver of the 15 page limit of 37 C.F.R. §1.943(c), to permit a 21 page respondent brief. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on March 9, 2011, along with the appeal brief fee.

FINDINGS

1. On October 31, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,925,469.

2. On January 29, 2008, reexamination was ordered and a non-final Office action was mailed on February 13, 2008.

3. Patent owner filed a response to the Office action on April 14, 2008, and third party requester filed comments in reply to the Office action and patent owner's response on May 14, 2008, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On March 19, 2009, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the ACP on May 19, 2009, and third party requester filed comments in reply to the ACP and patent owner's response on June 16, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On November 4, 2009, a Right of Appeal Notice (RAN) was mailed, which refused entry of the May 19, 2009, amendment.

7. Patent Owner filed a Notice of Appeal on December 4, 2009, and also filed a petition under 37 C.F.R. § 1.182 requesting continued reexamination, to permit entry of the May 19, 2009, amendment.

8. On January 15, 2010, the § 1.182 petition was granted.

9. Requester filed comments on February 12, 2010, in reply to the patent owner response of May 19, 2009.

10. On May 21, 2010, a second Action Closing Prosecution (ACP) was mailed.

11. On November 12, 2010, a second Right of Appeal Notice (RAN) was mailed.

12. Patent Owner filed a Notice of Appeal on December 4, 2009, appealing the rejections of claims 1-10, 12-21, 23-38, 47-63 and 67.

13. On February 10, 2011, Patent Owner filed an appellant's brief appealing the rejections of claims 1-10, 12-21, 23-38, 47-63 and 67, and accompanied by Petition #1.

14. Requester filed a respondent brief on March 9, 2011, accompanied by Petition #2.

DISCUSSION

In Petition #1, patent owner is requesting waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief is stated to be 17 pages over the limit.

Waiver is requested for the following reasons stated by petitioner:

(1) Patent owner discussed the totality of the rejections in the November 2010 RAN, in order to respond to every ground of rejection per MPEP 2675. The RAN is 71 pages, and incorporates portions of the October 2007 request, the May 2008 comments, and the February 2010 comments.

(2) Patent owner was required to address 12 rejections under 35 U.S.C. 112, first and second paragraphs, and 19 rejections under § 102 and § 103 based on at least 15 references.

(3) The RAN does not accurately describe the scope of the art rejections. The true scope was only apparent after a thorough review of the request and both sets of comments incorporated by reference into the RAN, and then various discrepancies involving the art rejections became apparent.

(4) Patent Owner submits that the examiner did not properly frame the scope of the rejections within the "four corners" of the November 2010 RAN, therefore patent owner required approximately 8 pages to discuss the true scope of the art rejections and attempt to resolve the discrepancies.

In Petition #2, requester is requesting waiver of 37 C.F.R. § 1.943(c), which limits the respondent brief to 15 pages or 7,000 words in length. The requester's respondent brief is stated to be 21 pages, and indicated to be due to the length of patent owner's appellant brief of 47 pages in a small font.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. However, the appellant brief and respondent brief filed subsequent to appeal are significantly longer than permitted, whereas the rules require that the briefs be more limited than pre-appeal responses. Patent owner's appellant brief filed on February 10, 2011, is stated to be 17 pages over the limit of 30 pages and 14,000 words. The brief is 47 pages, but in a small font. A certificate of the word count does not appear to have been included with the appellant brief. Given the small font utilized, it is readily apparent that the number of words far exceeds the 14,000 word limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the RAN, the numerous rejections which are appealed, and the alleged unclear scope of the rejections and purported discrepancies. However, the prosecution history reveals that the patent owner chose to amend a significant number of patent claims, as well as to present an additional 23 claims in the April 2008 amendment, without canceling any of the original 47 patent claims. In the May 2009 amendment, patent owner further amended claims, and canceled 16 claims. This amendment was originally not entered by the examiner because it did not comply with 37 C.F.R. 1.116. Patent owner forced the entry of the amendment by filing a petition requesting continued reexamination and entry of the May 2009 amendment. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims

being examined has increased, and the numerous claim amendments necessitated many new rejections, as well as revision of earlier rejections. The Patent Owner caused this challenge itself.

Petitioner has stated that the RAN contains 12 rejections under 35 U.S.C. 112, first and second paragraphs, and 19 rejections under § 102 and § 103, based on at least 15 references. While these statements are all accepted as true, the present petition does not explain why these are extraordinary circumstances nor how the circumstances prevent compliance with the page and word limit requirements. It is noted that the ACP was the same and/or similar in size and number of issues as compared to the RAN, and the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. The appellant brief and respondent brief filed subsequent to appeal are significantly longer than the permitted limits, whereas the rules require that the briefs be more limited than pre-appeal responses. The page and word limits are intentionally designed to focus the issues and require a concise presentation of arguments.

A persuasive showing has not been made that this situation is extraordinary, nor that justice requires that significantly more pages/words be allotted to appellant's brief. Petition #1 is **denied**. The appellant brief of February 10, 2011, is **not entered**.

The respondent brief of March 9, 2011, is premature since an appellant brief has not been properly filed (37 C.F.R. § 41.66(b)). The respondent brief is **not entered**. Petition #2 is **dismissed as moot**.

DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with of 37 CFR § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the patent owner's appeal will be dismissed.

If a corrected appellant brief is timely filed, then requester is given one month from the date of service to file a respondent brief in compliance with 37 CFR § 1.943(c).

In view of the foregoing, Petition #1 is DENIED. Petition #2 is DISMISSED AS MOOT.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,313	10/31/2007	6925469	108.0007-00000	7392

22882 7590 05/31/2011
MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER
FERRIS III, FRED O

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
05/31/2011	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes GOOGLE, INC.
v.
INTERTAINER, INC.

Reexamination Control No. 95/000,313
Patent 6,925,469
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. §§ 1.182/1.183 for Entry of Explanation of Discrepancies as to Claim Rejections," filed May 2, 2011("present petition"). Petitioner requests that the Claim Rejection Explanation be entered into the record under 37 C.F.R. § 1.182. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on May 2, 2011.

FINDINGS

1. On October 31, 2007, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,925,469.

2. On January 29, 2008, reexamination was ordered and a non-final Office action was mailed on February 13, 2008.

3. Prosecution was conducted and on November 12, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Patent owner filed a Notice of Appeal on December 10, 2010.

5. Patent owner filed an appellant brief on February 10, 2011, accompanied by a petition to waive the page/word limit.

6. Requester filed a respondent brief on March 9, 2011, accompanied by a petition to waive the page/word limit.

7. On March 31, 2011, a petition decision was mailed denying entry of the appellant brief and the premature respondent brief. Appellant was given **one** opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c) within one month of the petition decision (emphasis added).

8. Patent owner filed a corrected appellant brief on May 2, 2011, including a certificate stating the word count to be 13,958 words, and accompanied by the present petition.

RELEVANT AUTHORITY

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).

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. § 1.943(c) provides:

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

37 C.F.R. § 41.63(c) provides:

(c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

DISCUSSION

In the present petition, patent owner requests that the Claim Rejection Explanation be entered into the record under 37 C.F.R. § 1.182. Petitioner also offers three alternatives:

1. If the Claim Rejection Explanation is considered to be non-entered evidence, then petitioner requests waiver of 37 C.F.R. § 41.63(c) under 37 C.F.R. § 1.183.
2. If the Claim Rejection Explanation is counted as part of the patent owner's appellant brief and therefore causes the brief to exceed the page/word limits, then petitioner requests waiver of 37 C.F.R. § 1.943(c) under 37 C.F.R. § 1.183.

3. If the present petition jeopardizes the entry of the appellant brief, then patent owner requests that the present petition be deemed withdrawn.

Petitioner indicates that they have compiled this document to explain the discrepancies in the claim rejections as a courtesy to the Board of Patent Appeals and Interferences (Board). This document is not necessary and is not in compliance with the *inter partes* reexamination rules for briefing. It is an additional submission, and not authorized by the *inter partes* reexamination rules. Pursuant to § 1.939(a), "If an unauthorized paper is filed by any party at any time during the inter partes reexamination proceeding it will not be considered and may be returned."

To the extent that this is a petition to accept an unauthorized submission, no showing has been provided of an extraordinary situation when justice requires waiver of the *inter partes* reexamination rules. The Claim Rejection Explanation is an unauthorized paper. It is not entered and will not be considered. Since this document was submitted via the electronic filing system (*e*FS), it will be closed from the record and made non-viewable.

The present petition does not jeopardize the entry of the appellant brief. As noted in Finding #8, patent owner has filed a corrected appellant brief, which has been accepted by the Office. The time period for filing a respondent brief continues to run from the date of certificate of service of the appellant brief.

The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

James Donald Smith
Chief Administrative Patent Judge

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Counsel for Third Party Requester:
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,324	02/08/2008	6,857,001	112056-0501RX	8186

24267 7590 08/29/2011

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/29/2011

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
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
RONALD L. YIN
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

Date:

MAILED

AUG 29 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000324
PATENT NO. : 6857001
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

AUG 29 2011

CENTRAL REEXAMINATION UNIT

Cesari and McKenna LLP
88 Black Falcon Avenue
Boston, MA 02210

(For Patent Owner)

DLA Piper US LLP
2000 University Avenue
East Palo Alto, CA 94303-2248

(For Third Party Requestor)

Inter Partes Reexamination Proceeding
Control No. 95/000,324
Filed: February 8, 2008
For: U.S. Patent No. 6,857,001

: **DECISION GRANTING**
: **PETITIONS TO WAIVE**
: **PAGE LIMIT FOR BRIEFS**
:

This is a decision on the following petitions requesting waiver of 37 CFR 1.943(c):

(1) Petition filed July 14, 2010 by patent owner entitled "PETITION PURSUANT 37 C.F.R. §1.182, OR ALTERNATIVELY 37 C.F.R. §1.183 TO WAIVE OR SUSPEND THE PAGE AND WORD COUNT LIMITATIONS OF 37 C.F.R. §1.943".

(2) Petition filed July 20, 2010 by third party requestor entitled "PETITION, PURSUANT TO 37 CFR § 1.182 OF THIRD PARTY REQUESTER IN INTER-PARTES RE-EXAMINATION OF U.S. PATENT NO. 6,857,001 TO WAIVE OR SUSPEND THE PAGE AND WORD COUNT LIMIT OF 37 CFR § 1.943".[1]

The petitions are before the Office of Patent Legal Administration for decision.

REVIEW OF THE RELEVANT FACTS

1. On February 15, 2005, U.S. Patent No. 6,857,001 ('the '001 patent) issued to Hitz *et al.*

[1] Third party requestor's petition incorrectly asks for waiver or suspension via 37 CFR 1.182, but the correct venue is 37 CFR 1.183. Hence, the petition is treated as a petition under 37 CFR 1.183.

2. On November 30, 2007, a request for *inter partes* reexamination of claims 1-63 of the '001 patent was submitted by a third party requester, which request was assigned control number 95/000,324 ("the '0324 proceeding").

3. On February 8, 2008, a corrected request was filed on the '0324 proceeding.

4. On April 4, 2008, the Office ordered reexamination of the '001 patent in the '0324 proceeding and concurrently issued a non-final action.

5. The '0324 proceeding then progressed to a point where, on March 11, 2010, a Right of Appeal Notice (RAN) was mailed.

6. On April 9, 2010, the patent owner filed a Notice of Appeal for claims 1-72.

7. On April 22, 2010, the third party requestor filed a Notice of Appeal for claims 1-63.

8. On June 22, 2010, both the patent owner and the third party requestor filed their appellant briefs.

9. On July 14, 2010 the patent owner filed petition paper entitled "PETITION PURSUANT 37 C.F.R. §1.182, OR ALTERNATIVELY 37 C.F.R. §1.183 TO WAIVE OR SUSPEND THE PAGE AND WORD COUNT LIMITATIONS OF 37 C.F.R. §1.943" (Patent Owner Petition).

10. On July 20, 2010, the third party requester filed a respondent's brief, along with a petition paper entitled "PETITION, PURSUANT TO 37 CFR § 1.182 OF THIRD PARTY REQUESTER IN INTER- PARTES RE-EXAMINATION OF U.S. PATENT NO. 6,857,001 TO WAIVE OR SUSPEND THE PAGE AND WORD COUNT LIMIT OF 37 CFR § 1.943" (Third Party Requestor Petition).

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 CFR 41.67. Appellant's brief (selected sections) provides:

...(c)(1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

...

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

37 CFR 41.68. Respondent's brief (selected sections) provides:

...(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to § § 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in

the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent 's brief. See § 41.63 for treatment of evidence submitted after appeal.
(ix) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.
...
(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

DECISION

I. Patent Owner Petition

The patent owner requests waiver of 37 CFR 1.943(c), which limits their appellant brief to thirty pages (30) pages or 14,000 words in length. The patent owner states that the brief as filed is 44 pages.[2] It is noted that the filed brief includes 37 pages that count toward the page limit.[3]

Patent owner asserts that "there are 72 claims currently pending in the re-examination of which 70 are being appealed" and "[t]he RAN includes 27 pages of remarks and relies on 10 prior art references in support of 10 grounds of rejection. However, within those remarks there are a total of 280 pages which are incorporated by reference in support of the actual rejections".[4] The "application of the page limits of 37 C.F.R. § 1.943 is that Patent Owner has less than 10% of the number of pages for its Appeal Brief as compared to the page count of the allegations and rejections being appealed", so the "Patent Owner will not be able to fully address the numerous allegations and rejections in the space permitted".[5]

II. Third Party Requester Petition

The third party requester requests waiver of 37 CFR 1.943(c), which limits third party requestor's respondent brief to fifteen (15) pages or 7,000 words in length. The third party requester states that the brief as filed is 23 pages. It is noted that the filed brief includes 23 pages that count toward the page limit.[6]

Third party requester asserts that "[g]iven that the Appellant's Brief, has addressed ten prior art references, with each prior art reference discussed with a plurality of different groups of claims,

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[2] Patent Owner Petition at page 5.
[3] *See infra* Section III.A (discussing how pages are counted toward the page limit).
[4] Patent Owner Petition at pages 4-5.
[5] *Id.* at page 5.
[6] *See infra* Section III.A (discussing how pages are counted toward the page limit).

the total number of issues raised by Appellant's Brief exceeds forty three. Respondent respectfully requests a waiver of 37 CFR § 1.943 so that the issues raised by the Appellant m[a]y be fully briefed."[7]

III. Analysis and findings

A. Determining Page Length

As noted in MPEP 2667(I)(A)(2), the provisions of 37 CFR 1.943(c) have been waived by the Office to the extent that certain content, including the table of contents pages, table of case law pages, and the pages of the claims, are not counted toward the 30 page limit of the appellant brief or 15 page limit of the respondent brief. Additionally, by its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." The sections of the appellant's briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[8] are deemed to be included in "reference materials" that do not count toward the page limits. However, if any portion of the relevant section includes material that goes beyond that which is required by those sections, then the entire section will be counted toward the page total. Partial pages are tallied as whole pages for this purpose.

B. Decision on Patent Owner Petition

Patent Owner's reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised in the RAN. Based on the specific facts set forth in the petition under 1.183 and the particular circumstances of the '0324 proceeding, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. In particular, patent owner's petition under 37 CFR 1.183 is **granted** to waive the page length requirement of 37 CFR 1.943(c) for the appellant brief filed on June 22, 2010.

C. Decision on Third Party Requestor Petition

Third party requestor's reasons provided in support of waiving the page/word limits, detailed above, essentially relate to the number of claims and rejections/issues raised the patent owner's appellant brief. Based on the specific facts set forth in the petition under 1.183 and the particular circumstances of the '0324 proceeding, it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) in this instance. In particular, third party requestor's petition under 37 CFR 1.183 is **granted** to waive the page length requirement of 37 CFR 1.943(c) for the respondent brief filed on July 20, 2010.

---

[7] Third Party Requestor Petition at page 2.

[8] *i.e.*, (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix, and* (xi) *Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

CONCLUSION

1. Patent owner's petition, filed on July 14, 2010, under 37 CFR 1.183 is **granted** to the extent that patent owner's appellant brief filed on June 22, 2010 is deemed page length compliant.

2. Third party requestor's petition, filed on July 20, 2010, under 37 CFR 1.183 is **granted** to the extent that third party requestor's respondent brief filed on July 20, 2010 is deemed page length compliant.

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

Brian E. Hanlon

Brian Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,325	04/18/2008	7165175	308898-201	8261

100302 7590 11/23/2011

Google Inc/ Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 11-23-11

Kevin J. Zimmer
COOLEY, GODWARD, KRONISH, LLP, ATTN: PATENT GROUP
777 6TH STREET, NW SUITE 1100
WASHINGTON, DC 20001

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000325
PATENT NO. : 7165175
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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FROMMER LAWRENCE & HAUG
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NEW YORK, NY 10151

(For Patent Owner)

COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP
777 6TH STREET, NW SUITE 1100
WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Kollmyer *et al.*
Control No. 95/000,325
Filed: April 18, 2008
For: U.S. Patent No. 7,165,175

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

This decision is in response to Patent Owner's petition, filed on November 9, 2009, under 37 CFR 1.181 requesting that the Director expunge any Requester's Comments in response to the Notice of October 23, 2009. The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The Patent Owner's Petition to Expunge filed on November 9, 2009 is dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 7,165,175 (the '175 patent) issued on January 16, 2007.

2. A completed request for reexamination of the '831 patent was filed on April 18, 2008. The request was assigned control No. 95/000,325 (the '325 proceeding).

3. On June 23, 2008, the Office ordered that the patent be reexamined.

4. On March 23, 2009, the Office mailed a first Office action in the '325 proceeding.

5. On May 26, 2009, the Patent Owner filed a response to the Office action.

6. On May 28, 2009, the Patent Owner filed a replacement response.

7. On June 25, 2009, the Third Party Requester filed comments.

8. On September 18, 2009, the Office mailed a Notice of Defective Papers which stated that the Requester's Comments of June 25, 2009 were noncompliant with the requirements of 37 CFR 1.943. The Notice gave Requester 15 days to file replacement comments.

9. On October 5, 2009, the Requester filed replacement comments to the Patent Owner's response.

10. On October 23, 2009, the Office mailed a Notice of Defective Papers which stated that the Requester's comments, dated October 5, 2009, did not comply with the requirements of with 37 CFR 1.947. The Notice gave Requester 15 days to file replacement comments.

11. On November 8, 2009, the Requester filed replacement comments to the Patent Owner's response.

12. On November 9, 2009, the Patent Owner filed the instant petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of October 23, 2009 and expunge any replacement comments filed by the Requester in response to the October 23, 2009 Notice.

13. On November 11, 2009, the Requester filed a petition under 37 CFR § 1.183 requesting that the Director waive the rules and allow Requester to enter a response to Patent Owner's petition within a period no less than 10 days from a favorable decision on this petition. This petition will be addressed in a separate petition in due course.

14. On October 1, 2011, the Office mailed an action which determined that the November 8, 2009 comments are not compliant with Office regulations, and for this reason, are not considered. The action also clarified that the June 25, 2009 comments and the October 5, 2009 comments are not considered. Furthermore, the action stated that the Requester is

not permitted any further opportunities to submit comments in response to the March 23, 2009 Office action and the May 28, 2009 Patent Owner response.

DECISION

As pointed out, the Patent Owner filed a November 9, 2009 petition under 37 CFR 1.181 requesting withdrawal of the October 23, 2009 Notice and expungement of any Requester's comments filed in response to the Notice from the proceeding record. Patent Owner alleges that the October 23, 2009 Notice was not permitted because guidelines set forth in MPEP 2666.05 only permit one additional opportunity to provide replacement comments when notified of defective comments. See, e.g., pages 4-6 of the petition. For this reason, Patent Owner asserts that any Requester's comments filed in response to the Notice should be expunged from the proceeding record.

On October 1, 2011, as discussed above, the Office mailed an action that determined that the November 8, 2009 replacement comments are noncompliant with Office regulations and policy. Therefore, the November 8, 2009 replacement comments were not considered and are expunged from the record. In addition, the action made the record clear that the June 25, 2009 comments and the October 5, 2009 comments are not considered. These comments are also expunged from the record. As the June 25, 2009 comments, October 5, 2009 comments, and November 8, 2009 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments are expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

In regard to Patent Owner's assertion that the October 23, 2009 Notice is an unauthorized action, policies and procedures set forth in the MPEP contain instructions to the examiners, and do not have the force of law. See the Foreword of the MPEP. The instructions in MPEP 2666.05 require the examiner to notify the Requester at least once of the reasons for noncompliance and to give the Requester an additional opportunity to file replacement comments. The instructions in MPEP 2666.05 do not preclude the examiner from using his/her discretion to give an additional opportunity to supply corrected comments, especially in the situation where the first Notice failed to explain all the reasons why the originally-filed comments were not compliant. Specifically, in this proceeding, the September 18, 2009 Notice failed to state that the originally-filed comments were not compliant with the requirements of 37 CFR 1.947. Therefore, the examiner used his/her authorized discretion to send a second Notice in order to give the Requester a fair and full opportunity to make comments as provided by in 35 USC 314(b)(2). Accordingly, the October 23, 2009 Notice is deemed an authorized paper and will not be withdrawn or vacated by the Office.

As a result of the October 1, 2011 Office action, however, the remedy of expungement of any replacement comments submitted in response to the October 23, 2009 Notice is already given. In other words, the ultimate relief requested by the November 8, 2009 petition was given by the recent Office action.

For these reasons, the Patent Owner's November 9, 2009 petition is moot, and hereby, dismissed.

CONCLUSION

1. The November 9, 2009 Patent Owner's petition is dismissed as moot.

2. Telephone inquiries related to this decision should be directed Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,325	04/18/2008	7165175	308898-201	8261

100302 7590 01/11/2012

Google Inc/ Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/11/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Kevin J. Zimmer
COOLEY, GODWARD, KRONISH, LLP, ATTN: PATENT GROUP
777 6TH STREET, NW SUITE 1100
WASHINGTON, DC 20001

Date: MAILED
JAN 1 1 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000325
PATENT NO. : 7165175
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JAN 11 2012

Cooley LLP (For Third Party Requester)
Attn: Patent Group
Suite 1100
777 - 6th Street, NW
Washington, DC 20001

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,325 : **DISMISSING**
Filed: April 18, 2008 : **PETITION**
For: U.S. Patent No. 7,165,175 : **AS MOOT**

This is a decision on third party requester's November 11, 2009 petition entitled "REQUEST TO SUBMIT RESPONSE TO PETITION UNDER 37 C.F.R. §1.181 TO EXPUNGE COMMENTS OF THIRD PARTY REQUESTOR FROM THE RECORD," requesting waiver of 37 CFR 1.939 under 37 CFR 1.183 to submit a response to patent owner's November 9, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.181." The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In light of the decision issued by the Central Reexamination Unit (CRU) on November 23, 2011, dismissing patent owner's November 9, 2009 petition under 37 CFR 1.181 as moot, the instant petition under 37 CFR 1.183 is dismissed as moot.

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

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

01-05-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,328	01/14/2008	6892211	112056-0499C5RX	4693

24267 7590 10/27/2010

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

ART UNIT	PAPER NUMBER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,328	01/14/08	6892211	

EXAMINER
CHOI, WOO

Ronald L. Yin
DLA PIPER US LLP
2000 EAST UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

ART UNIT	PAPER
3992	

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OCT 27 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,328	01/14/08	6892211	

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

Decision on Petition for Extension of Time in Reexamination	Control No.:95/000,328 MAILED

OCT 27 2010
CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 18 October 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on _____, which sets a _____ period for filing a response thereto, be extended by _____.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☐ Granted-in-part for _ _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☒ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☒ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☒ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See other).
      v. ☐ The petition is moot.
      vi. ☒ Other/comment: Activity in other proceedings are not germane to actions in this proceeding, further, the rejection of over 75 newly added claims could have been reasonably expected by the patent owner._____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE Art Unit 3992
[*Signature*]	(Title)

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CESARI AND MCKENNA, LLP :(for Patent Owner)
88 BLACK FALCON AVENUE :
BOSTON, MA 02210 :

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AUG 16 2011

CENTRAL REEXAMINATION UNIT

RONALD YIN :
DLA PIPER LLP (US) :(for Requester)
2000 UNIVERSITY AVENUE :
EAST PALO ALTO, CA 94303-2248 :

In re Application of: Hitz et alia :
Control No.: 95/000,328 : Response to Petition
Deposited: January 14, 2008 : Under 37 CFR 1.59
For: US Patent No. 6,892,211 :

This is a response to the renewed petition under 37 CFR 1.59(b), filed on March 4, 2010, by which petitioners request to expunge information from the above identified proceeding.

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

Petitioner requests that two (2) documents submitted under seal along with the accompanying Information Disclosure Statement, filed December 8, 2009, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

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

CONCLUSION

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

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

Andy Kashnikow
SPE AU 3993
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,328	01/14/2008	6892211	112056-0499C5RX	4693

24267 7590 08/30/2011
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

RONALD L YIN
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303

Date:

MAILED

AUG 3 0 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000328
PATENT NO. : 6892211
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

(For Patent Owner)

MAILED

AUG 30 2011

CENTRAL REEXAMINATION UNIT

RONALD YIN
DLA PIPER LLP
2000 UNIVERSITY AVENUE
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(For Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,328
Filed: January 14, 2008
For: U.S. Patent No. 6,892,211

DECISION ON PETITION

This is a decision on the patent owner petition entitled "PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF," filed on August 19, 2011, which is taken as a petition under 37 CFR 1.183 for waiver of 37 CFR 41.66(a).

The petition is before the Office of Patent Legal Administration.

The patent owner petition is DISMISSED.

FACTS

1. On May 10, 2005, U.S. Patent No. 6,892,211 (the '211 patent) issued to Hitz et al.

2. On January 14, 2008, a request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,328 ("the '328 proceeding"), was filed by a third party requester on behalf of real party in interest Sun Microsystems, Inc. ("the '328 requester").

3. On April 2, 2008, *inter partes* reexamination of the '211 patent was ordered in the '328 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course, and such action was issued.

4. The proceeding advanced to the point where, on March 21, 2011, the Office issued a Right of Appeal Notice (RAN) in the '328 proceeding.

5. On April 21, 2011, the patent owner filed a notice of appeal.

6. On April 22, 2011, third party requester filed a notice of cross appeal.

7. On May 18, 2011, the Office reopened prosecution and issued an Action Closing Prosecution (ACP) in the '328 proceeding.

8. On June 16, 2011, patent owner filed comments after ACP.

9. On July 15, 2011, third party requester filed comments after ACP.

10. On August 1, 2011, the Office issued a new RAN in the '328 proceeding.

11. On August 19, 2011 patent owner concurrently filed two petitions, one petition under 37 CFR 1.183 and one petition under 37 CFR 1.181. This decision addresses the petition filed under 37 CFR 1.183 entitled, "PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF." The petition filed under 37 CFR 1.181 will be addressed in a separate decision.

12. To date neither party has filed a notice of appeal in response to the August 1, 2011 RAN.

DECISION

Patent owner has filed the present petition under § 1.183 requesting waiver of 37 CFR 41.66(a). Currently the '328 proceeding is not under appeal. The Office reopened prosecution, and issued an ACP on May 18, 2011, removing the '328 proceeding from its prior appeal stage (which had been based upon the March 2011 RAN and April 2011 notice of appeal filings). Neither party, as of the mailing of this decision, has filed a notice of appeal in response to the August 1, 2011 RAN issued by the Office. Therefore, currently no appeal briefs are due. Accordingly, patent owner's petition for waiver of 37 CFR 41.66(a) is DISMISSED.

CONCLUSION

1. The patent owner petition is DISMISSED.

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

Kenneth M. Schor

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

8-30-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,328	01/14/2008	6892211	112056-0499C5RX	4693

24267 7590 10/20/2011
CESARI AND MCKENNA, LLP
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BOSTON, MA 02210

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2011

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2000 UNIVERSITY AVENUE
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Date:

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OCT 2 0 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000328
PATENT NO. : 6892211
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

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OCT 20 2011

CENTRAL REEXAMINATION UNIT

RONALD YIN
DLA PIPER LLP
2000 UNIVERSITY AVENUE
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(For Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,328
Filed: January 14, 2008
For: U.S. Patent No. 6,892,211

DECISION ON PETITION

This is a decision on (a) the patent owner petition entitled, "RENEWED PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF," filed on September 1, 2011, which is taken as a petition under 37 CFR 1.183 for waiver of 37 CFR 41.66(a); and (b) the third party requester petition entitled, "PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF" filed on September 6, 2011.

The petitions are before the Office of Patent Legal Administration.

Both petitions are GRANTED.

FACTS

1. On May 10, 2005, U.S. Patent No. 6,892,211 (the '211 patent) issued to Hitz et al.

2. On January 14, 2008, a request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,328 ("the '328 proceeding"), was filed by a third party requester on behalf of real party in interest Sun Microsystems, Inc. ("the '328 requester").

3. On April 2, 2008, *inter partes* reexamination of the '211 patent was ordered in the '328 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course, and such action was issued.

4. The proceeding advanced to the point where, on March 21, 2011, the Office issued a Right of Appeal Notice (RAN) in the '328 proceeding.

5. On April 21, 2011, the patent owner filed a notice of appeal.

6. On April 22, 2011, third party requester filed a notice of cross appeal.

7. On May 18, 2011, the Office reopened prosecution and issued an Action Closing Prosecution (ACP) in the '328 proceeding.

8. On June 16, 2011, patent owner filed comments after ACP.

9. On July 15, 2011, third party requester filed comments after patent owner's comments.

10. On August 1, 2011, the Office issued a new RAN in the '328 proceeding.

11. On August 19, 2011 patent owner concurrently filed two petitions, one petition under 37 CFR 1.183 and one petition under 37 CFR 1.181. The petition filed under 37 CFR 1.183 is entitled, "PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF." The petition filed under 37 CFR 1.181 is entitled, "PETITION FOR ENTRY AND CONSIDERATION OF AMENDMENTS."

12. On August 30, 2011, the Office issued a decision dismissing the August 19, 2011 petition under 37 CFR 1.183.

13. On September 1, 2011, patent owner filed a notice of appeal and filed the present petition entitled, "RENEWED PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF."

14. On September 6, 2011, third party requester filed a notice of cross appeal and filed the present petition entitled, "PETITION FOR WAIVER OF RULE PROHIBITING EXTENSION OF TIME TO FILE APPEAL BRIEF AND AN EXTENSION OF TIME TO FILE APPEAL BRIEF."

15. As of even date with this decision, the Office has not issued a decision on the August 19, 2011 petition under 37 CFR 1.181.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.61(b) states:

> (1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
>
> (2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

Patent owner has filed a petition under 37 CFR § 1.183 for an extension of time on September 1, 2011, concurrent with patent owner's filing of a notice of appeal. Third party requester has filed a petition under 37 CFR § 1.183 for an extension of time on September 6, 2011, concurrent with third party requester's filing of a notice of cross appeal. Patent owner had filed a petition under 37 CFR 1.181 for entry and consideration of amendments on August 19, 2011, and to date, the Office has not issued a decision regarding the August 19, 2011 patent owner petition.

The time for filing an appellant's brief is two months from the latest filing date of the last-filed notice of appeal or cross-appeal, pursuant to 37 C.F.R. § 41.66(a). In the present proceeding, a notice of cross-appeal was filed on September 6, 2011. Prior to this decision, the time for the parties to file their respective an appeal briefs was due to expire on November 6, 2011. Under 37 C.F.R. § 41.66(a), the time for filing the appellant's brief may not be extended.

In this instance, however, the parties have both filed petitions for extension of time under § 1.183 to waive the § 41.66(a) prohibition as to obtaining an extension the time (for filing their appellant's briefs) to obtain the results of a decision of the August 19, 2011 petition filed under § 1.181, as a brief may not need to be filed in the event the § 1.181 petition is granted. A decision on the § 1.181 petition has yet to be rendered. In the event the parties were to file their appellant's briefs to keep the proceeding pending, in this case, such filings could cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider the appellant's briefs, the need for which may become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that both petitioners' time periods to submit their appellant's briefs is extended to run an additional 30 days from the due date; i.e., extended to December 6, 2011.

If the petition under § 1.181 has not yet been decided at the point where the time for the filing of appellant's briefs becomes ***less*** *than two weeks prior to the deadline as extended*, then the parties may file petitions under § 1.183 for an additional extension of time. In that event, the parties are strongly advised to contact Joseph Weiss at the phone number given below in the contact information, to inform the Office that petitions for an additional extension of time are being filed, in order to expedite review.

CONCLUSION

1. The patent owner and third party petitions are GRANTED.

2. The patent owner and requester petitions under 37 C.F.R. § 1.183 for waiver of the regulatory prohibition for an extension of time to file an appellant's brief and for an extension of time to file an appellant's brief is granted and, and the time is extended to run 30 days from the November 6, 2011 due date; i.e., through December 6, 2011.

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

/Kenneth M. Schor/

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

10-19-11

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(FOR PATENT OWNER)

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CENTRAL REEXAMINATION UNIT

RONALD L.YIN
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2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

(FOR THIRD PARTY REQUESTER)

In re Hitz *et al.*
Reexamination Proceeding
Control No.: 95/000,328
Filed: January 14, 2008
Patent No. 6,892,211

: **DECISION**
: **ON**
: **PATENT OWNER'S**
: **PETITIONS**
: **UNDER 37 CFR 1.181**

This is a decision addressing patent owner's petition, filed August 19, 2011, under 37 CFR 1.181 requesting that the amendment dated June 16, 2011 be entered into the record. This decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in denying entry of the amendment, dated June 16, 2011, in the Right of Appeal Notice (RAN), dated August 1, 2011. This decision also addresses patent owner's petition under 37 CFR 1.181, filed April 27, 2011.

The petitions are before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent owner's petition, filed April 27, 2011 is DISMISSED as moot, for the reasons stated below.

Patent owner's petition, filed August 19, 2011 is DENIED, for the reasons stated below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,892,211 (the '211 patent) issued on May 10, 2005.

2. A corrected request for reexamination, assigned Control No. 95/000,328 (the '328 proceeding), was filed by a third party requester on January 14, 2008.

3. Reexamination was ordered in the '328 reexamination proceeding on April 2, 2008. The order determined that a substantial new question of patentability was raised for claims 1-24 of the '211 patent.

4. An Office action on the merits was mailed on August 28, 2008. The Office action contained rejections of patent claims 1-24 by adopting many of the proposed rejections set forth in the request for reexamination.

5. On October 9, 2008, patent owner filed a response to the Office action by the examiner. The response did not amend claims but proposed new claims 25-28. No evidentiary declarations were filed with the response.

6. On November 5, 2008, the requester filed comments on the patent owner's response, which included arguments supporting the rejections set forth in the first Office action and proposed new rejections for new claims 25-28.

7. On March 27, 2009, the Office mailed a notice indicating that the patent owner's response, dated October 9, 2008, was defective and set a 30 day time period to file a corrected response.

8. On April 27, 2009, patent owner filed a corrected response.

9. On May 12, 2009, the requester filed comments on the April 27, 2009 patent owner response.

10. On July 21, 2009, the Office mailed a notice indicating that requester's May 12, 2009 comments were not compliant with the requirements of 37 CFR 1.943(b) and set a 15 day time period to file corrected comments.

11. On July 29, 2009, the requester filed corrected comments.

12. On September 8, 2009, the Office mailed a second non-final Office action. This action included rejections for claims 1-28. The Office action contained new rejections on unamended claims based on newly discovered art filed by the requester.

13. On December 8, 2009, patent owner timely[1] filed a response to the Office action by the examiner. The response did not amend patent claims 1-24 and proposed new claims 25-103.

[1] Patent owner's petition for a one month extension of time was granted on November 4, 2009.

14. On January 7, 2010, the requester filed comments on the patent owner's response, which included arguments supporting the rejections set forth in the Office action and arguments against the patentability of the new claims.

15. On April 19, 2010, the Office mailed a notice indicating that the patent owner's response, dated December 8, 2009, was defective and set a 30 day time period to file a corrected response.

16. On May 19, 2010, patent owner filed a corrected response, including declarations filed under 37 CFR 1.132.

17. On June 17, 2010, the requester filed comments on the May 19, 2010 patent owner response.

18. On October 5, 2010, the Office mailed an Action Closing Prosecution (ACP). The ACP continued to reject patent claims 1-24 and proposed new claims 25-28 and added new rejections for newly proposed claims 29-103. The ACP addressed the declarations filed under 37 CFR 1.132 (see, e.g., pages 13-14).

19. On November 5, 2010, patent owner filed a response to the ACP. The response did not include any claim amendments, and was supported by two declarations under 37 CFR 1.132 ("the Hitz declaration" and "the Lewis declaration").

20. On December 6, 2010, the requester filed comments.

21. On March 21 2011, the Office mailed a first Right of Appeal Notice (RAN). The RAN maintained the rejections of claims 1-103.

22. On April 21, 2011, patent owner filed a Notice of Appeal.

23. On April 22, 2001, requester filed a Notice of Cross Appeal.

24. On April 27, 2011, the patent owner filed the petition under 37 CFR 1.181, requesting supervisory review of the RAN, dated March 21, 2011.

25. On May 18, 2011, the Office issued a second ACP, and thereby, withdrew the RAN dated March 21, 2011.

26. On June 16, 2011, patent owner filed a response to the second ACP. The response included claim amendments to patent independent claims 1, 9, and 17, and cancelled proposed new claims 30, 31, 49-71, and 100.

27. On July 17, 2011, the requester filed comments.

28. On August 1, 2011, the Office mailed a second Right of Appeal Notice (RAN). The second RAN maintained rejections of claims 1-103 and addressed the Hitz and Lewis declarations (see, e.g., pages 33 and 36 of the RAN).

29. On August 19, 2011, the patent owner filed the instant petition under 37 CFR 1.181, requesting supervisory review of the RAN, dated August 1, 2011. On the same day, patent owner filed a separate petition under 37 CFR 1.183, requesting "waiver of rule prohibiting extension of time to file appeal brief and an extension of time to file appeal brief".

30. On August 30, 2011, a decision on the August 19, 2011 petition under 37 CFR 1.183 was mailed, dismissing the petition.

31. On September 1, 2011, patent owner filed a Notice of Appeal and a renewed petition requesting "waiver of rule prohibiting extension of time to file appeal brief and an extension of time to file appeal brief".

32. On September 6, 2011, third party requester filed a Notice of Cross Appeal and a petition requesting "waiver of rule prohibiting extension of time to file appeal brief and an extension of time to file appeal brief".

33. On October 20, 2011, a decision was mailed granting the September 1, 2011 patent owner petition and the September 6, 2011 third party requester petition requesting "waiver of rule prohibiting extension of time to file appeal brief and an extension of time to file appeal brief". The decision extended the period for the filing of appellants briefs until December 6, 2011.

DECISION UNDER 37 CFR 1.181

April 27, 2011 Petition

As pointed out, the patent owner filed an April 27, 2011 petition under 37 CFR 1.181 to invoke supervisory authority to review the first RAN, mailed on March 21, 2011. On May 18, 2011, the Office mailed a new ACP, which effectively withdrew the first RAN. Accordingly, the action for which the April 27, 2011 petition requested supervisory review was withdrawn by the examiner. Thus, the patent owner's April 27, 2011 petition is moot, and thereby dismissed.

August 19, 2011 Petition

The patent owner (petitioner) states that they are seeking relief under 37 CFR 1.181 to have the June 16, 2011 amendment entered into the proceeding record. Petitioner specifically requests that the director find that the second RAN improperly denied entry of the June 16, 2011 proposed amendment and failed to address the declarations by Hitz and Lewis and other arguments/evidence. See, e.g., pages 7-9 and 12-14 of the petition.

First, upon review of the record, it is noted prosecution has been extended and patent owner has had numerous opportunities to respond to Office actions. See the stated facts in the background section of this decision. In addition, the June 16, 2011 response was the first time patent owner proposed amendments to the original patent claims.

Second, as stated above, this decision is limited to consideration of whether the examiner followed the laws and procedures in denying entry of the amendment, dated June 16, 2011, in the Right of Appeal Notice (RAN), dated August 1, 2011. Any allegations of improper action prior to the RAN, dated August 1, 2011, will not be addressed as such allegations are not timely raised. Specifically, a petition under 37 CFR 1.181 must have been filed within two months of the allegedly improper action to be timely filed. See 37 CFR 1.181(f), which states, in part:

> "Any petition under this part not filed within **two months** of the mailing **date of the action or notice from which relief is requested** may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable." (Emphasis added.)

In other words, this petition is untimely to request relief from the examiner's actions in the second ACP or any prior Office action.

In regard to issues raised with respect to the second RAN (dated August 1, 2011), patent owner asserts that the second RAN is improper because of (1) error in not entering the June 16, 2011 amendments; (2) failure to address the Hitz and Lewis declarations, filed under 37 CFR 1.132; and (3) failure to address arguments and evidence regarding paragraph 95 in the second ACP as applied to unamended claims.

In regard to the first allegation, the record does not support patent owner's assertion that the examiner erred in the decision to not enter the June 16, 2011 amendments. In other words, the grounds, raised by the patent owner, to not show that the determination to not enter the June 16, 2011 proposed amendment was in error. The record is clear that the examiner had the discretion to enter or not enter the June 16, 2011 proposed amendment. The examiner needs only to state a reasonable basis for denying entry, and upon review of the record, the record supports the examiner's analysis. Specifically, the examiner did make a showing of why entry of the proposed amendment would raise new issues, would not reduce issues for appeal, did not have the required showing why it was not presented earlier, and/or be an undue burden as required by 37 CFR 1.116 and MPEP 2673. See pages 50-52 of the RAN. Accordingly, the record shows that the examiner properly determined that the June 16, 2011 proposed amendment should not be entered in accordance with the statutory mandate of special dispatch.

In regard to the second and third allegations, the second RAN did address the Hitz and Lewis declarations (see pages 33 and 36 of the second RAN) and the arguments and evidence regarding the issues raised in paragraph 95 of the second ACP (see pages 31-32, 46, and 51-52 of the second RAN). It is also noted that paragraph 95 of the second ACP is a response to arguments regarding a rejection under 35 U.S.C. 112 for claims 25-103 (Ground 26), and is not part of the actual rejection. Therefore, the record does not support patent owner's allegation that the second RAN failed to address the declarations under 37 CFR 1.132, and evidence/arguments regarding the "second consistent state" limitation at issue in Ground 26 of rejection. The arguments presented in the petition generally address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of whether the examiner incorrectly addressed, or weighed, the evidence and arguments are

appealable issues, and therefore, cannot be addressed by petition. Therefore, the merits of the examiner's decisions will not be addressed in this decision.

In response to petitioner's general arguments for reopening prosecution in this reexamination proceeding, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN). As stated above, the record shows that prosecution has been extended and that patent owner has had multiple opportunities to respond to Office actions. In addition, the record does not support that the second RAN was improper for the reasons asserted in the petition. Accordingly, the issuance of the second RAN did not categorically deprive the petitioner of its statutory rights to present comments and proposed rejections in reexamination proceedings.

In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the second RAN, and to deny entry of the June 16, 2011 proposed amendment in the interest of "special dispatch." Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding and entry of the June 16, 2011 amendment, is denied.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.181, filed August 19, 2011, is DENIED for the reasons discussed above.

2. Patent owner's petition under 37 CFR 1.181, filed April 27, 2011, is DISMISSED as moot because the action requested to be reviewed (the first RAN) has been withdrawn by the examiner.

3. Per the decision on petition mailed October 20, 2011, the appellant's briefs are due to be filed on or before December 6, 2011.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611.

Irem Yücel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,328	01/14/2008	6892211	112056-0499C5RX	4693

24267 7590 01/06/2012
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes

Ronald L. Yin

v.

Network Appliance Inc.

Inter Partes Reexamination Control No. 95/000,328

Patent 6,892,211

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Pursuant to 37 C.F.R. § 1.183 to Waive or Suspend the Page and Word Count Limitations of 37 C.F.R. §1.943" filed December 6, 2011 (present petition). In the petition, patent owner requests waiver of 37 C.F.R. §1.943(c), to permit patent owner to file an appellant brief of up to 45 pages or 19,671 words. The petition fee

of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on December 19, 2011.

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

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,892,211, on January 14, 2008, which was assigned control no. 95/000,328.
2. On April 2, 2008, reexamination was ordered in the '328 proceeding, and on August 28, 2008, a non-final Office action was mailed, rejecting claims 1-24.
3. Patent owner filed a response to the non-final Office action on April 27, 2009, including an amendment adding claims 25-28; and requester filed comments on July 29, 2009, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On September 8, 2009, a non-final action was mailed, rejecting claims 1-28.
5. Patent owner filed a response to the non-final Office action on May 19, 2010, including an amendment adding claims 25-103; and requester filed comments on June 17, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On May 18, 2011, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1-103.
7. Patent owner filed a response to the ACP on June 16, 2011, and requester filed comments on July 15, 2011, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

8. On August 1, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1-103.
9. Patent owner filed a Notice of Appeal on September 1, 2011, appealing the rejections of claims 1-103.
10. Requester filed a Notice of Cross Appeal on September 6, 2011, appealing the examiner's refusal to adopt numerous proposed grounds of rejection concerning claims 1-26.
11. Requester filed a cross-appeal brief on December 5, 2011.
12. Patent owner filed an appellant brief accompanied by the present petition on December 6, 2011.
13. Requester filed a respondent brief on January 4, 2012.

DISCUSSION

In the present petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner is seeking permission to file an appellant brief no longer than 45 pages or 19,671 words.

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

1. There are 103 claims being appealed.
2. The brief includes 23 pages required for formalities, which leaves only 7 pages for analysis and argument of the issues.
3. The second RAN includes more than 50 pages of remarks, relies on 10 prior art references in support of 13 grounds of rejection based on 35 U.S.C. §§ 102 and 103, and incorporates an additional 50 pages of

material from the Replacement Attachment To Request for Inter Partes Reexamination of January 14, 2008.

4. The patent owner will not be able to address fully the numerous and voluminous allegations and rejections in the second RAN in a 30 page brief.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

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

37 CFR § 1.943(c) provides:

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

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

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Patent owner's petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. However, the appellant is seeking to file an appellant brief that is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner

is requesting permission to file an appellant brief that is stated to be not more than 45 pages or 19,671words, which exceeds the limit of 30 pages or 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the 103 claims being appealed, the length of the RAN and the numerous issues on appeal. However, the record reveals that in response to the non-final Office action, patent owner chose to present an additional 79 claims in his amendment without canceling any of the original 24 patent claims. It is not surprising that patent owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 24 to 103, and is now more than four times the number of original patent claims. Hence, the challenge presented is of the patent owner's making.

Prior to appeal, the examiner included new rejections in the ACP, necessitated by patent owner's amendment adding claims 25-103. Patent owner responded to the rejections in the ACP within the 50 page limit. Petitioner explains appellant's challenge in complying with the page/word limits, but is silent as to what, if anything, appellant has done to reduce the size of the appellant brief. The page and word limits are designed intentionally to focus the issues and require a concise presentation of arguments.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that more pages/words be allotted to appellant's brief than to pre-appeal responses.

The present petition is **denied.**

DECISION

In view of the foregoing, the present petition is DENIED.

Patent owner is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of one (1) month from the mailing date of this decision. If a compliant appellant brief is not timely received, the patent owner's appeal will be dismissed. If a compliant appellant brief is timely filed, then requester will have one month from the date of service to file a respondent brief.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,333	01/18/2008	7096212	20010-016RX1	1001

76808 7590 07/21/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
INTELLIGENT HOSPITAL SYSTEMS LTD.
v.
FORHEALTH TECHNOLOGIES, INC.

Reexamination Control No. 95/000,333
Patent 7,096,212
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition to Strike Improper Papers," filed June 20, 2011 (present petition). In the present petition under 37 C.F.R. § 1.182, patent owner requests that the Office strike the improper papers that accompanied requester's rebuttal brief, and at least portions of the rebuttal brief that rely on those improper papers. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on June 21, 2011.

FINDINGS

1. On January 11, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,096,212.

2. On March 7, 2008, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted and on December 2, 2009, a Right of Appeal Notice (RAN) was mailed.

4. Requester filed a Notice of Appeal on January 4, 2010, and an appellant brief on March 4, 2010.

5. Patent owner filed a respondent brief on April 5, 2010.

6. On March 14, 2011, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on April 14, 2011.

8. On April 25, 2011, a Notice of Defective Brief was mailed indicating that the rebuttal brief is not compliant with 37 C.F.R. § 1.943(c).

9. Requester filed a corrected rebuttal brief on May 25, 2011.

10. Patent owner filed the present petition on June 20, 2011, with an incorrect service address for requester.

11. Patent owner served the requester with the present petition at the correct address on July 8, 2011.

RELEVANT AUTHORITY

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).

37 C.F.R. § 41.71 provides in part:

> (a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.
>
> . . .
>
> (c)
>
> > (1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.
> >
> > (2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.
> >
> > (3) No new ground of rejection can be proposed by a requester.
> >
> > (4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.
>
> (d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.
>
> (e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

ANALYSIS

In the present petition, patent owner requests that the Office strike the improper papers that accompanied requester's rebuttal brief, and at least portions of the rebuttal brief that rely on those improper papers. Petitioner states that on March 4, 2010, requester submitted its appellant brief, and that brief did not include an Appendix nor did it mention the reference document that patent owner seeks to strike from the record, namely:

> IEEE 1284.1 Standard for Information Technology-Transport Independent Printer/System Interface (TIP/SI) 1284.1-1997, approved July 29, 1997 by the IEEE Standards Board ("IEEE Publication").

Petitioner indicates that both the introduction of the IEEE Publication and the arguments were introduced after patent owner submitted its respondent brief, and after the examiner's answer was mailed. Petitioner explains that on April 14, 2011, the requester filed a rebuttal brief which, for the first time in this proceeding, sought to enter the IEEE Publication into the record. Petitioner points out that the requester discusses the IEEE Publication for the first time in the argument section of the rebuttal brief. Petitioner notes that requester's rebuttal brief was indicated to be non-compliant in a notice mailed on April 25, 2011, for failure to comply with the rules regarding page limits. Petitioner states that on May 25, 2011, the requester filed an amended rebuttal brief, which cites the newly submitted IEEE Publication.

Petitioner's arguments have been considered fully. A review of the record reveals that the "Evidence Appendix" of the rebuttal brief does not indicate where in the record the cited IEEE publication was entered and considered by the examiner. The IEEE publication does not appear to have been entered and considered prior to the filing of the rebuttal brief.

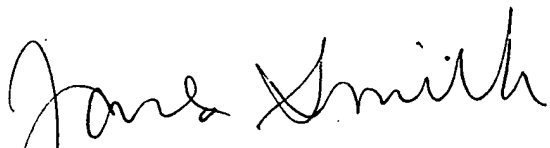
Therefore, it is agreed that the rebuttal brief of May 25, 2011, contains new evidence and is not in compliance with 37 C.F.R. § 41.71 (c)(4). The rebuttal brief is not entered.

Accordingly, the present petition is **granted**.

DECISION

In view of the foregoing, the present petition is GRANTED.

Appellant is given a single, non-extendable period of one month from the mailing date of this decision to file a corrected rebuttal brief. If a corrected rebuttal brief is not timely received, or does not overcome all the reasons for non-compliance, the appeal will proceed without consideration of a rebuttal brief.



James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,333	01/18/2008	7096212	20010-016RX1	1001

76808 7590 09/15/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
INTELLIGENT HOSPITAL SYSTEMS LTD.
v.
FORHEALTH TECHNOLOGIES, INC.

Reexamination Control No. 95/000,333
Patent 7,096,212
Technology Center 3900

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition under 37 C.F.R. § 1.182," filed July 26, 2011 (petition). In the petition, requester seeks reconsideration of the decision to strike the IEEE standard document submitted with requester's rebuttal brief, and requests that the IEEE standard document be admitted into the record as substantive evidence. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on July 27, 2011.

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This is also a decision on "Patent Owner's Petition under 37 C.F.R. § 1.182," filed August 2, 2011 (opposition). In the opposition, patent owner requests that the Office maintain the decision to strike the IEEE standard document submitted with requester's rebuttal brief, and deny entry of the IEEE standard document into the record as substantive evidence. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on August 3, 2011.

FINDINGS

1. On January 18, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,096,212, which was assigned control no. 95/000,333.

2. On March 7, 2008, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted and on December 2, 2009, a Right of Appeal Notice (RAN) was mailed.

4. Requester filed a Notice of Appeal on January 4, 2010, and an appellant brief on March 4, 2010.

5. Patent owner filed a respondent brief on April 5, 2010.

6. On March 14, 2011, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on April 14, 2011.

8. On April 25, 2011, a Notice of Defective Brief was mailed that indicated the rebuttal brief to be non-compliant with 37 C.F.R. § 1.943(c).

9. Requester filed a corrected rebuttal brief on May 25, 2011.

10. Patent owner filed a petition on June 20, 2011, and served the requester with the petition at the correct address on July 8, 2011.

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11. On July 21, 2011, a decision granting the patent owner's petition was mailed.

12. Requester filed the present petition on July 26, 2011.

13. Patent owner filed the present opposition on August 2, 2011.

14. Requester filed a corrected rebuttal brief on August 22, 2011.

DISCUSSION

In the present petition, requester requests that the Office accept the rebuttal brief filed on May 25, 2011, and enter the IEEE standard document as substantive evidence. In an opposition of August 2, 2011, patent owner requests that the Office maintain the decision to strike the IEEE standard document submitted with requester's rebuttal brief, and deny entry of the IEEE standard document into the record as substantive evidence. On August 22, 2011, requester filed a corrected rebuttal brief indicated to be 15 pages in length and 5,052 words, should the Office not grant the petition of July 26, 2011.

RELEVANT AUTHORITY

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 § 41.71 provides in part:

> (a) Within one month of the examiner's answer, any appellant may once file a rebuttal brief.

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. . .

(c)

(1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.

(2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.

(3) No new ground of rejection can be proposed by a requester.

(4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

(d) The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(e) If a rebuttal brief is timely filed under paragraph (a) of this section but does not comply with all the requirements of paragraphs (a) through (d) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended rebuttal brief. If the appellant does not file an amended rebuttal brief during the one-month period, or files an amended rebuttal brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's rebuttal brief and any amended rebuttal brief by that appellant will not be considered.

37 CFR § 41.63 (c) states:

Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

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ANALYSIS

A review of the record reveals that on May 25, 2011, the requester filed a corrected rebuttal brief, which included the evidence:

THE INSTITUTE OF ELECTRICAL AND ELECTRONICS ENGINEERS, *IEEE Standard for Information Technology-Transport Independent Printer/System Interface (TIP/SI)*, IEEE Std 1284.1-1997 (1997) ("IEEE standard document").

Patent owner filed a petition on June 20, 2011, requesting that the rebuttal brief of May 25, 2011, be expunged. The petition was granted in a decision mailed on July 21, 2011. The rebuttal brief of May 25, 2011, was not entered because it was found to contain new evidence and therefore not in compliance with 37 C.F.R. § 41.71 (c)(4). The petition decision set a one month time period for requester to file a corrected rebuttal brief without the new evidence.

In the present petition, requester requests that the Office accept the rebuttal brief filed on May 25, 2011, and enter the IEEE standard document as substantive evidence. In the opposition of August 2, 2011, patent owner requests that the Office maintain the decision to strike the IEEE standard document submitted with requester's rebuttal brief, and deny entry of the IEEE standard document into the record as substantive evidence. On August 22, 2011, requester filed a corrected rebuttal brief indicated to be 15 pages in length and 5,052 words, should the Office not grant the petition of July 26, 2011.

The Office appreciates the filing of a corrected rebuttal brief in compliance with 37 C.F.R. § 1.943(c), that omits reference to the IEEE standard document. The corrected rebuttal brief of August 22, 2011, is **entered**. The rebuttal brief of May 25, 2011, is **not entered**.

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In view of the filing of a compliant rebuttal brief, the present petition and opposition are **dismissed as moot.**

DECISION

In view of the forgoing, the Petition is DISMISSED.

Jurisdiction of this *inter partes* reexamination is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James Donald Smith
Chief Administrative Patent Judge

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For Patent Owner

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OCT 01 2010

CENTRAL REEXAMINATION UNIT

Greg H. Gardella
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P.O. Box 1022
Minneapolis, MN 55440-1022

For 3rd Party Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,334
Filed: January 11, 2008
For: U.S. Patent No. 6,915,823

DECISION ON
PETITIONS

The paper filed November 10, 2009, by the patent owner titled "PETITION UNDER 37 CFR 1.182 TO STRIKE IMPROPER PORTION OF APPELLANT'S POST-WITHDRAWAL COMMENTS FROM RECORD", and the paper filed February 4, 2010, by the third party requester titled "PETITION UNDER 37 CFR 1.182 TO LEAVE OFFICIAL REEXAMINATION RECORD INTACT" are before the undersigned for consideration. Theses papers are being treated under the auspices of 37 CFR 1.181.

Patent owner's petition of November 10, 2009 is **dismissed in part** and **granted in part**.

Third party requester's petition of February 4, 2010 is **granted in part**.

Review of Salient Facts

1. U.S. Patent No. 6,915,823 (the '823 patent) was granted to Osborne et al on July 12, 2005.
2. On January 11, 2005, a request for *inter partes* reexamination of the '823 patent was filed by a third party requester. The request was assigned control No. 95/000,334 (the '334 *inter partes* reexamination proceeding).
3. Reexamination was ordered for all of the claims in the '823 patent on February 27, 2008. On the same date an Action Closing Prosecution (ACP) was mailed confirming all of the claims in the '823 patent.
4. No patent owner response to the ACP was filed.
5. On September 5, 2008 a Right to Appeal (RAN) was mailed maintaining the confirmation of claims 1-30, all of the claims in the patent.

6. On October 2, 2008, third party requester filed a Notice of Appeal, appealing the examiner's decision to confirm the patentability of all of the claims.
7. On December 2, 2008, third party requester filed "THIRD PARTY REQUESTER'S BRIEF ON APPEAL" appealing the confirmation of claims 1-30.
8. On January 2, 2009, patent owner filed "PATENT OWNER'S RESPONDENT BRIEF ON APPEAL" in response to requester's brief of December 2, 2008.
9. On September 29, 2009, the examiner issued an "*INTER PARTES* REEXAMINATION NOTIFICATION RE BRIEF" (hereinafter, "the Notice of Defective Briefs") holding requester's brief and patent owner's respondent brief defective.
10. On October 29, 2009, third party requester filed a paper titled "EXPRESS WITHDRAWAL OF APPEAL BY THIRD PARTY REQUESTER" in response to the Notice of Defective Briefs mailed September 29, 2009. In this paper, third party requester "expressly withdraws the appeal". In addition, third party requester also includes comments directed to the merits of the proceeding. This paper is the subject of a decision being concurrently mailed, which decision deems this paper to be an improper paper and therefore, expunges the paper from the record.
11. On November 10, 2009, patent owner filed a paper titled "PETITION UNDER 37 CFR 1.182 TO STRIKE IMPROPER PORTION OF APPELLANT'S POST-WITHDRAWAL COMMENTS FROM RECORD". This paper is the subject of this decision.
13. On February 4, 2010, third party requester filed a paper titled "PETITION UNDER 37 CFR 1.182 TO LEAVE OFFICIAL REEXAMINATION RECORD INTACT". This paper is also the subject of this decision.

Decision

The paper filed by patent owner on November 10, 2009, titled "Petition Under 37 CFR 1.182 to Strike Improper Portion of Appellant's Post-Withdrawal Comments From Record" requests that the Office (1) strike from the record everything stated in appellant's October 29, 2009 submission after the first sentence that expressly withdraws the appeal, and (2) to clarify whether the Appellant's Brief and Respondent's Brief are part of the official record or not based on the Defective Brief Notice mailed on September 29, 2009.

The paper filed by third party requester on February 4, 2010, titled "Petition Under 37 CFR 1.182 to Leave Official Reexamination Record Intact" requests that the Office leave intact the complete official record of the instant reexamination proceeding, including the parties' appeal briefs and the express withdrawal of appeal filed by the third party requester.

In a separate decision mailed on this date, the entire paper filed by third party requester on October 29, 2009, titled "Express Withdrawal of Appeal by Third Party Requester", has been found to be an improper paper lacking a right of entry and, therefore, the paper has been expunged from the record. Accordingly, patent owner's request to strike portions of the October 29, 2009 paper is dismissed as being moot.

As to the request by patent owner to clarify whether the appellant's brief and respondent's brief are part of the official record or not, and the request by third party requester to leave the complete official record of the instant proceeding, including the aforementioned briefs and third party requester's express withdrawal of appeal paper in the record, it is initially noted that, as mentioned hereinbefore, in a separate decision mailed on this date, the October 29, 2009, the third party requester paper titled "Express Withdrawal of Appeal by Third Party Requester" has been found to be an improper paper lacking right of entry and as such, has been expunged in its entirety from the record. Further, appellant's brief filed by third party requester on December 2, 2008 and patent owner's respondent brief filed January 2, 2009, will remain as part of the official record of this reexamination proceedings as they were timely filed pursuant to 37 CFR 41.66; 41.67; and 41.68. However, in view of the forthcoming dismissal of the appeal due to third party requester's failure to file a corrected brief in response to the Notice of Defective Briefs mailed September 29, 2009, both briefs will remain in place in the file but will not be considered on their merits.

Summary

1. Patent owner's request to strike an improper portion of appellant's paper filed October 29, 2009 is dismissed as being moot in view of the decision mailed on this date expunging from the record the entire October 29, 2009, third party requester submission as such submission was deemed to be an improper submission.

2. Patent owner's request to clarify the record as to whether appellant's brief of December 2, 2008 and the respondent's brief of January 2, 2009 are or are not of record is granted. Both of the aforementioned submissions will remain of record in the file, but will not be considered on their merits.

3. Third party requesters request to leave the entire official reexamination of record intact, including the October 29, 2009 submission titled "Express Withdrawal of Appeal by Third Party Requester" is granted in part. As noted above, appellant's brief and respondent's brief will remain in the file but will not be considered on the merits. However, as per a separate decision mailed on this date, the paper of October 29, 2009 has been deemed to be an improper paper, not enterable on the record, and as such, has been expunged from the record.

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.

Gregory Morse, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,339	01/18/2008	7281842	24122-00084	7858

57600 7590 02/17/2011

HOLLAND & HART
222 South Main Street, Suite 2200
P.O. Box 11583
Salt Lake City, UT 84110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David Smith
McDonald Hopkins LLC
600 Superior Avenue East, Suite 2100
Cleveland, OH 44114-2653

Date:

MAILED

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000339
PATENT NO. : 7281842
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.

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.:95/000,339

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed January 26, 2010 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☐ Destroyed.
      ii. ☒ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535, . In his/her absence, calls may be directed to Stephen Stein at 571-272-1544, in the Central Reexamination Unit.

[Signature] 2/16/2010

Deborah D. Jones
Supervisory Patent Examiner
(Title) CRU - Art Unit 3991

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,339	01/18/2008	7281842	24122-00084	7858

57600 7590 04/20/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2011

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 Vita-Mix Corporation v. K-TEC, Inc.

Reexamination Control No. 95/000,339
Patent 6,829,672
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. §41.3," filed April 1, 2011, ("Petition #1"). In the petition of April 1, 2011, patent owner requests that the oral hearings for reexamination proceedings 95/000,339 and 95/000,228 be consolidated. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to patent owner's deposit account on April 1, 2011.

This is also a decision on requester's "Vita-Mix's Response to K-TEC's Petition to Consolidate Oral Argument," filed April 13, 2011, ("Petition #2"). The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to requester's deposit account on April 13, 2011.

FINDINGS

1. On January 18, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672, which was assigned Control No. 95/000,339.

2. On March 28, 2008, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted and on September 3, 2009, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on September 21, 2009, and an appellant brief on December 30, 2009.

5. Patent owner filed a respondent brief on January 29, 2010.

6. On September 13, 2010, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on October 13, 2010, and a request for oral hearing on November 10, 2010.

8. On February 25, 2011, an Appeal Docketing Notice was mailed.

9. On March 21, 2011, a Notification of Appeal Hearing was mailed indicating that the oral hearing is scheduled for June 1, 2011.

10. Requester filed a confirmation of attendance at the June 1, 2011, hearing on March 30, 2011.

11. Patent owner filed petition #1 on April 1, 2011.

12. Patent owner filed a request for oral hearing on April 11, 2011, accompanied by a confirmation of attendance at the June 1, 2011, hearing.

13. Requester filed petition #2 on April 13, 2011.

RELEVANT AUTHORITY

37 CFR § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a) (3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

37 CFR § 41.73 provides:

(a) An oral hearing should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as an appeal decided after an oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months after the date of the examiner's answer. The time for requesting an oral hearing may not be extended. The request must include a

certification that a copy of the request has been served in its entirety on all other parties to the proceeding. The names and addresses of the parties served must be indicated.

(c) If no request and fee for oral hearing have been timely filed by appellant or respondent as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant or respondent has complied with all the requirements of paragraph (b) of this section, a hearing date will be set, and notice given to the owner and all requesters. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant or respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 41.20(b)(3).

(e)

(1) At the oral hearing, each appellant and respondent may only rely on evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the briefs except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section. The Board will determine the order of the arguments presented at the oral hearing.

(2) Upon a showing of good cause, appellant, respondent and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify the owner and all requesters.

DISCUSSION

A review of the record of *inter partes* reexamination 95/000,228, reveals that it is not docketed at the Board of Patent Appeals and Interferences (BPAI) for a decision on an appeal. Also, no request for oral hearing has yet been received in the '228 proceeding. Accordingly, patent owner's Petition #1 filed April 1, 2011, is **dismissed as premature.**

Requester's Petition #2, is not an authorized submission pursuant to 37 C.F.R. § 41.3(e)(2), which states:

"A party may not file an opposition or a reply to a petition without Board authorization."

The BPAI may consider consolidation of oral arguments once both *inter partes* reexamination proceedings have a request for oral hearing filed and both *inter partes* reexamination proceedings are docketed as appeals at the BPAI. At such time, if feasible, the oral hearings would be scheduled on the same day, *i.e.*, June 1, 2011, in the interest of conserving the resources of the BPAI, and proceeding with special dispatch.

DECISION

In view of the foregoing, Petition #1 is DISMISSED. Petition #2 is an unauthorized submission, and as such is not considered and will be "closed" from the Office's Image File Wrapper (IFW) System.

_____/s/_____
James T. Moore
Acting Chief Administrative Patent Judge

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Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,339	01/18/2008	7281842	24122-00084	7858

57600 7590 06/16/2011

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Salt Lake City, UT 84110

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/16/2011

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 Vita-Mix Corporation
Requester
v.
K-TEC, Inc.
Patent Owner

Reexamination Control No. 95/000,339
Patent 6,829,672
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. §1.182 to Accept Overlength Appeal Brief," filed June 7, 2011, ("Present Petition"). In the petition, patent owner requests that the Board of Patent Appeals and Interferences (BPAI) accept the "overlength appeal brief" filed on January 29, 2010, for reexamination proceeding 95/000,339. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to patent owner's deposit account on June 7, 2011, as authorized on page 3 of the petition.

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

FINDINGS

1. On January 18, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672, which was assigned Control No. 95/000,339.

2. On March 28, 2008, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted and on September 3, 2009, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on September 21, 2009, and an appellant brief on December 30, 2009.

5. Patent owner filed a respondent brief on January 29, 2010.

6. On September 13, 2010, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on October 13, 2010, and a request for oral hearing on November 10, 2010.

8. On February 25, 2011, an Appeal Docketing Notice was mailed.

9. On March 21, 2011, a Notification of Appeal Hearing was mailed.

10. The oral hearing was conducted on June 1, 2011.

11. The present petition was filed on June 7, 2011.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.182 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 1.943(c) provides:

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

37 C.F.R. § 41.68 provides in pertinent part:

(a)(1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

. . .

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

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

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

appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

DISCUSSION

In the present petition, patent owner is requesting acceptance of a respondent brief that exceeds the page limit. This would require waiver of 37 C.F.R. § 1.943(c), which limits patent owner's respondent brief to 15 pages or 7,000 words in length. The patent owner's respondent brief is numbered pages 1-40, which far exceeds the permitted limit. The patent owner indicates that the filing of a respondent brief that exceeds the page limit is inadvertent.

A review of the record reveals that the instant *inter partes* reexamination proceeding is docketed at the BPAI for a decision on the appeal, and an oral hearing has been conducted. At the hearing, the panel inquired as to whether patent owner had filed a word count certification in the '339 proceeding, since the respondent brief exceeds the 15 page limit pursuant to 37 C.F.R. 1.943(c). Patent owner indicated at the hearing that they had submitted such a word count certificate.

In the present petition, patent owner admits that in February 2011, they became aware that the respondent brief was not in compliance with the rules because it exceeded the page limit pursuant to 37 C.F.R. 1.943(c). Patent owner indicates that they contacted the Central Reexamination Unit (CRU) to ask whether they should file a corrected brief, and that the CRU advised them to wait for a notice of defective brief. However, no notice was

sent and patent owner did not do anything to correct this matter, such as file a word count certification, or a corrected respondent brief. Patent owner also admits that they told the BPAI at the oral hearing that they filed a word count certification in the instant *inter partes* reexamination proceeding, when in fact, they did not.

Pursuant to 37 C.F.R. § 41.68(c), "If a respondent brief is filed which does not comply with all the requirements . . ., respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent . . . files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered." Because the instant situation is provided for expressly in the regulations, relief is unavailable under § 1.182. Relief is available by petition under § 1.183 to waive the relevant rule, provided that there is a showing of an extraordinary situation when justice requires waiver of the rule. The filing of a respondent brief that "inadvertently exceeded the page and word count limits set forth in 37 C.F.R. 1.943(c)" is not an extraordinary situation when justice requires waiver of the rule.

The present petition is **denied.**

DECISION

In view of the foregoing, the present petition is DENIED.

Patent owner is given one opportunity to file a corrected respondent brief in compliance with of 37 CFR § 1.943(c), within a non-extendable time period of 15 days from the mailing date of this decision. If patent owner does not file an amended respondent brief within the set time period, or files an amended respondent brief which is not compliant, the respondent brief and any amended respondent brief by the patent owner will not be considered.

James Donald Smith
Chief Administrative Patent Judge

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,339	01/18/2008	7281842	24122-00084	7858

57600 7590 06/24/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Vita-Mix Corporation
Third Party Requester
v.
K-TEC, Inc.
Patent Owner

Reexamination Control No. 95/000,339
Patent 6,829,672
Technology Center 3900

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition under 37 C.F.R. § 41.3 to Expedite Production of Oral Hearing Transcript," ("present petition") of June 15, 2011. In the petition, requester requests that the oral hearing transcript for reexamination proceeding 95/000,339 be processed and delivered to the parties. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to patent owner's deposit account on June 15, 2011.

FINDINGS

1. On January 18, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672, which was assigned Control No. 95/000,339.
2. On March 28, 2008, reexamination was ordered and a non-final Office action was mailed.
3. Prosecution was conducted and on September 3, 2009, a Right of Appeal Notice was mailed.
4. Requester filed a Notice of Appeal on September 21, 2009, and an appellant brief on December 30, 2009.
5. Patent owner filed a respondent brief on January 29, 2010.
6. On September 13, 2010, an examiner's answer was mailed.
7. Requester filed a rebuttal brief on October 13, 2010, and a request for oral hearing on November 10, 2010.
8. On February 25, 2011, an Appeal Docketing Notice was mailed.
9. On March 21, 2011, a Notification of Appeal Hearing was mailed.
10. The oral hearing was conducted on June 1, 2011.
11. Requester filed the present petition on June 15, 2011.

RELEVANT AUTHORITY

37 CFR § 41.3 provides:

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and
(2) In pending contested cases, procedural issues. See § 41.121(a) (3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

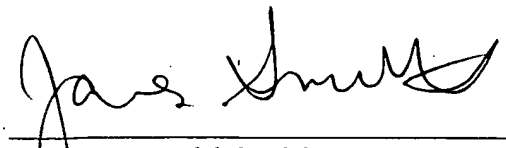
(e) Time for action.
(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:
(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and
(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.
(2) A party may not file an opposition or a reply to a petition without Board authorization.

DISCUSSION

A review of the record of *inter partes* reexamination 95/000,339, reveals that the oral hearing was conducted on June 1, 2011. On June 17, 2011, the transcript of the oral hearing was mailed to the parties and entered into the file. The present petition is **dismissed as moot**.

DECISION

In view of the foregoing, the present petition is DISMISSED.



James Donald Smith
Chief Administrative Patent Judge

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Salt Lake City, UT 84110

Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

93344 7590 01/28/2011

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

JAN 28 2011

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
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Flachsbart & Greenspoon, LLP
333 N. Michigan Ave.
27th Floor
Chicago, IL 60601

(For Patent Owner)

MAILED
JAN 28 2011
CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq.
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

(For Third Party Requester)

In re Chris Knotts	:	
Inter partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No: 95/000,353	:	**PETITION TO**
Filing Date: February 29, 2008	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 6,985,748	:	**REEXAMINATION PROCEEDING**

This is a decision on the following:

- The patent owner request for reconsideration, filed on August 16, 2010, entitled "Request for Reconsideration of the Petition to Terminate *Inter Partes* Reexamination Proceeding Based on Statutory Estoppel (35 U.S.C. § 317(b); 37 C.F.R. § 1.907(b); 37 C.F.R. § 1.182) (the August 16, 2010 patent owner request for reconsideration); and

- The patent owner petition, filed on September 21, 2010, entitled "Petition Under 37 C.F.R. § 1.182 and 35 U.S.C. § 317(b) to Supplement Petition for Reconsideration and Incorporate Additional Facts Showing the Requester "Could Have Raised" All Prior Art Issues Now Part of This Reexamination" (the September 21, 2010 supplemental patent owner petition).

The August 16, 2010 patent owner request for reconsideration, the September 21, 2010 supplemental patent owner petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fee under 37 CFR 1.17(f) for the September 21, 2010 supplemental patent owner petition has been paid.

SUMMARY

The August 16, 2010 patent owner request for reconsideration, and the September 21, 2010 supplemental patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination are **granted**. The prosecution of the '353 *inter partes* reexamination proceeding is hereby **terminated**.

DECISION

The patent owner argues that termination of the '353 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

The patent owner states that, pursuant to the statute, a final decision has been entered against a defendant in a civil action, that it has not sustained its burden of proving invalidity of any claim in suit, i.e., claims 1, 3-6, 9-14, and 17-19 of the '748 patent, which is the patent under reexamination. The patent owner has provided evidence that the defendant, Mobile 365, is apparently a privy of Sybase, Inc., the real party in interest in the '353 *inter partes* reexamination proceeding, because Mobile 365 is a wholly owned subsidiary of Sybase, Inc.[1] This evidence has not been contested by the requester.

On May 22, 2009, a statutory disclaimer under 37 CFR 1.321(a) of claims 2, 7, 8, 15, and 16 of the '748 patent was filed in the '748 patent file, which is application no. 10/720,343. Accordingly, the pending claims of the '353 reexamination proceeding, i.e., claims 1, 3-6, 9-14, and 17-19 of the '748 patent, are therefore identical to the patent claims in suit.

On March 31, 2009, a judgment was entered against Mobile 365 in the United States District Court for the Eastern District of Virginia (district court), holding that claims 1, 3-6, 9-14, and 17-19 of the '748 patent were not invalid.[2] On April 28, 2009, this judgment was appealed to the United States Court of Appeals for the Federal Circuit (Federal Circuit).[3] On December 23, 2009, the parties to the litigation filed a joint motion in the Federal Circuit to remand jurisdiction to the district court, which was ordered by the Federal Circuit "so that the parties may request the District Court to enter additional orders in aid of their settlement." [4] On July 21, 2009, the Federal Circuit dismissed the appeal, noting that "[t]he parties having so agreed."[5] On January 8,

---

[1] See Exhibit A, a November 8, 2006 press release entitled "Sybase Completes Acquisition of Mobile 365". Exhibit A is attached to the present petition.

[2] See Exhibit C, *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, U.S. District Court for the Eastern District of Virginia, Civil Action No. 3:06CV485, final judgment, March 31, 2009. Exhibit C is attached to the present petition.

[3] See Exhibit D, attached to the present petition.

[4] See Exhibit J, attached to the present petition. Each party was ordered to bear its own costs.

[5] See *Telecommunications Systems, Inc. v. Mobile 365, Inc.*, 2009 U.S. App. LEXIS 21015 (Fed. Cir. 2009).

2010, the district court entered a stipulated order of dismissal dismissing, with prejudice, "the parties' respective claims and counterclaims", and ordering each party to bear its own attorney fees and costs.[6] The Federal Circuit and the district court did not state, or otherwise indicate, that the March 31, 2009 holding of the district court was vacated. In view of the specific facts and circumstances of the present case, the March 31, 2009 district court judgment is deemed to be a final decision within the meaning of the statute.[7] Thus, a final decision has been entered against a defendant (Mobile 365) in a civil action, who is apparently in privy with the requester (Sybase, Inc.) of the present reexamination proceeding. The final decision held that the defendant/requester has not sustained its burden of proving the invalidity of claims 1, 3-6, 9-14, and 17-19 of the '748 patent.

Furthermore, in the September 21, 2010 supplemental patent owner petition, the patent owner now provides an adequate showing that the defendant/requester "could have raised", in the earlier litigation, the prior art which was later raised by the requester in the request for *inter partes* reexamination, because the litigation was still ongoing at the time the request for *inter partes* reexamination was filed.[8]

For the reasons given above, the August 16, 2010 patent owner request for reconsideration, and the September 21, 2010 supplemental patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination are **granted**.

In the August 16, 2010 patent owner request for reconsideration, the patent owner again argues that the application of the estoppel provisions of the statute is not precluded by the last sentence of 35 U.S.C. 317(b), which permits "the assertion of invalidity based on newly discovered prior art unavailable to the third party requester . . . at the time of the inter partes proceedings". However, it is not necessary to address the last sentence of 35 U.S.C. 317(b). In granting the present request for reconsideration and supplemental petition, the Office is relying upon the provision, in the first sentence of 35 U.S.C. 317(b), that "an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office". In its September 21, 2010 supplemental petition, the patent owner newly provides an adequate showing that the defendant/requester "could have raised", in the earlier litigation, the prior art which was later raised by the requester in the request for *inter partes* reexamination, as discussed *supra*.

Accordingly, based upon 35 U.S.C. 317(b), the prosecution of the '353 *inter partes* reexamination proceeding is hereby **terminated**.

The '353 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and

---

[6] See Exhibit L, attached to the present petition.

[7] The Federal Circuit, in its remand to the district court and in its dismissal of the appeal, was silent regarding the March 31, 2009 holding of the district court that claims 1, 3-6, 9-14, and 17-19 of the '748 patent were not invalid. The district court, in its stipulated order of dismissal, stated only that the parties' respective claims and counterclaims were dismissed with prejudice.

[8] See, particularly, page 4 of the September 21, 2010 patent owner petition.

process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

1. The August 16, 2010 patent owner request for reconsideration, and the September 21, 2010 supplemental patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination, are **granted.**

2. The prosecution of the '353 *inter partes* reexamination proceeding is hereby **terminated**, and will be concluded.

3. The '353 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing to conclude the '353 proceeding, as set forth above.

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

/Kenneth M. Schor/

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

1-26-2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,353	02/29/2008	6985748	2187.011REX0	5061

93344 7590 01/06/2012

FLACHSBART & GREENSPOON, LLC
333 N. MICHIGAN AVE.
27TH FLOOR
CHICAGO, IL 60601

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2012

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Date: 1-6-12

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000353
PATENT NO. : 6985748
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JAN 06 2012

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq. Sterne, Kessler, Goldstein & Fox, PLLC 1100 New York Ave, N.W. Washington, D.C. 20005-3934	:	(For Third Party Requester)
Flachsbart & Greenspoon, LLC 333 N. Michigan Ave. 27th Floor Chicago, IL 60601	:	(For Patent Owner)
In re Chris Knotts *Inter Partes* Reexamination Proceeding Control No.: 95/000,353 For: U.S. Patent No. 6,985,748	:	DECISION ON PETITION TO EXPEDITE PROSECUTION OF REEXAMINATION PROCEEDING

This is a decision on the 5 June 2009 petition filed by the third party requester under 37 CFR 1.181 entitled, "Petition Under 37 C.F.R. § 1.81 [sic] Requesting Exercise of Supervisory Authority to Expedite Prosecution of Reexamination Control No. 95/000,353" [hereinafter "the petition to expedite"] and the 25 August 2009 supplemental petition filed by the third party requester under 37 CFR 1.181 entitled, "Supplemental Petition Under 37 C.F.R. § 1.181 Requesting Exercise of Supervisory Authority to Expedite Prosecution of Reexamination Control No. 95/000,353" [hereinafter "the supplemental petition to expedite"]. The petition to expedite and the supplemental petition to expedite request that the Office expedite prosecution of reexamination control number 95/000,353 and set a one-month or thirty day period, whichever is longer, shortened statutory period for responses for all Office actions issuing in this reexamination.

These petitions are before the Director of the Central Reexamination Unit.

The petition to expedite is dismissed for the reasons set forth below.

The supplemental petition to expedite is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,985,748 issued to Knotts on 10 January 2006.
- On 29 February 2008, third party requester filed a request for *inter partes* reexamination. The resulting reexamination proceeding was assigned control number 95/000,353 [hereinafter "the '353 proceeding"].
- On 20 May 2008, the Office issued an order granting *inter partes* reexamination in the '353 proceeding.
- On 28 May 2008, patent owner requested that Office terminate the reexamination proceeding.
- On 20 June 2008, third party requested filed an opposition to the patent owner's petition to terminate.
- On 24 June 2008, patent owner filed a petition in support of its petition to terminate.
- On 18 August 2008, patent owner's petition to terminate the reexamination was dismissed.
- On 5 June 2009, third party requester filed the petition to expedite.
- On 4 August 2009, the Office issued an Office action on the merits.
- On 25 August 2009, third party requester filed a supplemental petition to expedite.
- On 31 August 2009, the Office issued a supplemental Office action on the merits.
- On 25 November 2009, patent owner requested an extension of time.
- On 1 December 2009, the Office issued a one month extension of time to patent owner.
- On 31 December 2009, patent owner filed a response to the Office action.
- On 16 August 2010, patent owner filed petition to request reconsideration of the petition to terminate.

- On 27 August 2010, the Office issued an Action Closing Prosecution.
- On 21 September 2010, patent owner filed a supplemental petition for reconsideration.
- On 27 September 2010, patent owner filed comments after the Action Closing Prosecution.
- On 28 January 2011, the Office granted the petition to terminate.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.4(c) provides as to correspondence with the Office:

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

37 CFR 1.181(a) provides that petitions to the Director may be made:

> (a) Petition may be taken to the Director:
>
> (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
>
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
>
> (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.939 provides for treatment for unauthorized papers:

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

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

DECISION ON PETITION

The petition to expedite filed on 5 June 2009 and the supplemental petition to expedite filed on 25 August 2009 in this reexamination proceeding ***will not*** be decided on the merits.

First, these petitions are moot. The reexamination proceeding in question has been terminated by the Office decision mailed 28 January 2011. Since the relief requested in these petitions cannot be granted due to this termination of the reexamination proceeding, the petitions are moot.

Second, these petitions will be returned as improper papers that do not have a right of entry. See MPEP 2667.

The petition to expedite filed on 5 June 2009 and the supplemental petition to expedite filed on 25 August 2009 do not have a right of entry because they are not proper under 37 CFR 1.181. 37 CFR 1.181(a)(1) provides for a petition to be taken from any action or requirement of the examiner. This provision limits petitions to issues that have been raised and does not provide for petitions, such as the instant petition, to challenge future decisions that fall within the Office's discretionary procedural process. 37 CFR 1.181(a)(3) provides for a petition when the Office did not follow its established procedure and policies. The petition to expedite and the supplemental petition to expedite do not assert that the Office did not follow its established procedure and policies. Furthermore, these petitions are similar to a petition requesting that an extension of time be denied. MPEP 2667 clearly states that such petitions "... will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the re-examination proceeding...." For these reasons, the petition to expedite and the supplemental petition to expedite do not raise issues permitted in a petition under 37 CFR 1.181. These petitions are deemed improper papers and will be returned in accordance with 37 CFR 1.939 and MPEP 2667. As the papers have been entered into the electronic Image File Wrapper (IFW) record, the papers will be "returned" by closing the papers in the IFW, and marking the papers nonpublic to expunge it from the record. The present decision will, however, be made of record in the reexamination proceeding. See also MPEP 2667.

In view of the foregoing, these petitions will not be made of record in the '353 reexamination proceeding, and they are being returned to the third party requester ***without consideration of the substance of the petition***.

These petitions are **dismissed** as being moot and are being returned as improper papers.

CONCLUSION

1. The requester's petition under 37 CFR 1.181 and requester's supplemental petition under 37 CFR 1.181 to expedite the reexamination proceeding are hereby **dismissed.**

2. The requester's petition under 37 CFR § 1.181 and the requester's supplemental petition under 37 CFR 1.181 **will be expunged** from the record by closing the papers in the IFW record, and marking the papers nonpublic. This decision, however, will be of record in the proceeding.

3. The reexamination proceeding remains terminated in view of the Office decision of 28 January 2011.

4. 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.

5. Telephone inquiries with regard to this decision should be directed to Daniel Ryman, SPE AU 3992, at (571) 272-3152, in the event that Daniel Ryman is unavailable, to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,361	04/07/2008	7,004,852	OEKM-135565	5444

50086 7590 07/21/2011

LAW OFFICE OF DAVID H. JUDSON
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SUITE 225
DALLAS, TX 75248

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes TAYLOR MADE GOLF COMPANY, INC.
v.
DOGLEG RIGHT CORPORATION

Reexamination Control No. 95/000,361
Patent No. 7,004,852
Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Petition under 37 C.F.R. § 1.183 to Waive Page Limit Requirement of Appeal Brief under 37 C.F.R. § 1.943(c)," of June 9, 2011 ("present petition"). Petitioner requests waiver of 37 C.F.R. § 1.943(c) to permit entry and consideration of the requester's respondent brief filed on June 9, 2011, which is stated to contain 7,835 words. The petition fee of $400 pursuant to 37 C.F.R. §1.17(f) has been charged to petitioner's deposit account on June 9, 2011.

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

FINDINGS

1. U.S. Patent No. 7,004,852 issued on February 28, 2006.

2. A request for *inter partes* reexamination of the '852 patent was filed by a third party requester on April 7, 2008, and was assigned Control No. 95/000,361.

3. On June 19, 2008, reexamination was ordered and a non-final Office action was mailed.

4. Prosecution was conducted and on February 7, 2011, a Right of Appeal Notice (RAN) was mailed.

5. Patent owner filed a Notice of Appeal on March 7, 2011, and an appellant brief on May 9, 2011.

6. Requester filed a respondent brief on June 9, 2011, accompanied by the present petition.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 1.943(c) states:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the

> page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) states:

> For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 C.F.R. § 41.66(b) states:

> Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

ANALYSIS

A review of the record reveals that patent owner filed an appellant brief on May 9, 2011, and included a certificate of word count of 10,251 words. Requester filed a respondent brief on June 9, 2011, and included a certificate of word count of 7,835 words. Patent owner's appellant brief is stated to be 10,251 words, which would be within the limit of 30 pages and 14,000 words. However, patent owner's appellant brief also contains several declarations which count toward the page limit per MPEP § 2667 I.A.2. This causes appellant's brief to far exceed the 30 page limit pursuant to 37 C.F.R. § 1.943(c). Similarly, requester's respondent brief contains two declarations which count toward the page limit. Therefore, respondent's brief not only exceeds the word limit by 835 words, but the numerous pages of declarations cause respondent's brief to far exceed the 15 page limit pursuant to 37 C.F.R. § 1.943(c).

Petitioner's arguments have been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Petitioner's stated

reasons for requesting waiver of the page/word limits for requester's respondent brief are that the additional words are needed "in order to address all of the issues raised in the appeal." However, a review of the appellant's brief reveals that there are only 5 issues, based on 4 references, and 7 claims on appeal. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of 37 C.F.R. § 1.943(c).

The patent owner's appellant brief of May 9, 2011, is not entered for exceeding the page limit pursuant to 37 C.F.R. § 1.943(c), for the reasons explained *supra*. Because the appellant brief is not entered, the respondent brief of June 9, 2011, does not have an entry right pursuant to 37 C.F.R. § 41.66(b). However, even if it did have an entry right, the respondent brief would not be entered for exceeding the page and word limits pursuant to 37 C.F.R. § 1.943(c), for the reasons explained *supra*.

Accordingly, the present petition is **dismissed as moot** in view of the non-compliant appellant brief.

CONCLUSION

The present petition is DISMISSED.

If a compliant appellant brief is timely filed, then requester will have one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of one month from the certificate of service date of the corrected appellant brief pursuant to 37 C.F.R. § 41.66(b). If a compliant respondent brief is not timely received, the appeal will proceed without consideration of a respondent brief.

With respect to whether there comes to be a compliant appellant brief, patent owner, who also is being mailed a copy of this decision, hereby is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the patent owner's appeal will be dismissed.

James Donald Smith
Chief Administrative Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,362	04/07/2008	7,189,169	OEKM-135432	5443

50086 7590 07/21/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes TAYLOR MADE GOLF COMPANY, INC.
v.
DOGLEG RIGHT CORPORATION

Reexamination Control No. 95/000,362
Patent No. 7,189,169
Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Petition under 37 C.F.R. § 1.183 to Waive Page Limit Requirement of Appeal Brief under 37 C.F.R. § 1.943(c)," of June 9, 2011 ("present petition"). Petitioner requests waiver of 37 C.F.R. § 1.943(c) to permit entry and consideration of the requester's respondent brief filed on June 9, 2011, which is stated to contain 7,191 words. The petition fee of $400 pursuant to 37 C.F.R. §1.17(f) was charged to petitioner's deposit account on June 9, 2011.

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

FINDINGS

1. U.S. Patent No. 7,189,169 issued on March 13, 2007.

2. A request for *inter partes* reexamination of the '169 patent was filed by a third party requester on April 7, 2008, and was assigned Control No. 95/000,362.

3. On June 19, 2008, reexamination was ordered and a non-final Office action was mailed.

4. Prosecution was conducted and on February 7, 2011, a Right of Appeal Notice (RAN) was mailed.

5. Patent owner filed a Notice of Appeal on March 7, 2011, and an appellant brief on May 9, 2011.

6. Requester filed a respondent brief on June 9, 2011, accompanied by the present petition.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 1.943(c) states:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the

> page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) states:

> For additional information with respect to the length of papers, see Subsection I.A.2 above.

37 C.F.R. § 41.66(b) states:

> Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

ANALYSIS

A review of the record reveals that patent owner filed an appellant brief on May 9, 2011, and included a certificate of word count of 12,363 words. Requester filed a respondent brief on June 9, 2011, and included a certificate of word count of 7,191 words. Patent owner's appellant brief is stated to be 12,363 words, which would be within the limit of 30 pages and 14,000 words. However, patent owner's appellant brief also contains several declarations which count toward the page limit per MPEP § 2667 I.A.2. This causes appellant's brief to far exceed the 30 page limit pursuant to 37 C.F.R. § 1.943(c). Similarly, requester's respondent brief contains two declarations which count toward the page limit. Therefore, respondent's brief not only exceeds the word limit by 191 words, but the numerous pages of declarations cause respondent's brief to far exceed the 15 page limit pursuant to 37 C.F.R. § 1.943(c).

Petitioner's arguments have been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Petitioner's stated

reasons for requesting waiver of the page/word limits for requester's respondent brief are that the additional words are needed "in order to address all of the issues raised in the appeal." However, a review of the appellant's brief reveals that there are only 7 issues, based on 3 references, and 20 claims on appeal. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of 37 C.F.R. § 1.943(c).

The patent owner's appellant brief of May 9, 2011, is not entered for exceeding the page limit pursuant to 37 C.F.R. § 1.943(c), for the reasons explained *supra*. Since the appellant brief is not entered, the respondent brief of June 9, 2011, does not have an entry right pursuant to 37 C.F.R. § 41.66(b). However, even if it did have an entry right, the respondent brief would not be entered for exceeding the page and word limits pursuant to 37 C.F.R. § 1.943(c), for the reasons explained *supra*.

Accordingly, the present petition is **dismissed as moot** in view of the non-compliant appellant brief.

CONCLUSION

The present petition is DISMISSED.

If a compliant appellant brief is timely filed, then requester will have one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of one month from the certificate of service date of the corrected appellant brief pursuant to 37 C.F.R. § 41.66(b). If a compliant respondent brief is not timely received, the appeal will proceed without consideration of a respondent brief.

With respect to whether there comes to be a compliant appellant brief, patent owner, who also is being mailed a copy of this decision, hereby is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the patent owner's appeal will be dismissed.

James Donald Smith
Chief Administrative Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,373	06/06/2008	7313720	112056-0180RX	5529

24267 7590 06/03/2011

CESARI AND MCKENNA, LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DLA PIPER US LLP
2000 UNIVERSITY AVENUE
E. PALO ALTO, CA 94303-2248

Date:

MAILED

JUN 03 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000373
PATENT NO. : 7313720
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JUN 03 2011

CENTRAL REEXAMINATION UNIT

CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210	: : :	(For Patent Owner)
DLA PIPER US LLP 2000 UNIVERSITY AVENUE E. PALO ALTO, CA 94303	: : :	(For Third Party Requester)
In re: Eng *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/000,373 Deposited: June 6, 2008 For: U.S. Patent No.: 7,313,720	: : : : :	DECISION ON PETITION

This is a decision on a petition filed by the patent owner on December 28, 2010, entitled: "PETITION TO STRIKE THIRD PARTY REQUESTER'S COMMENTS (37 C.F.R.. §§ 1.182 AND 1.947)" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion to review the allegedly improper entry of a paper into the record. The petition is being treated as a petition under 37 CFR § 1.181.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is an Opposition filed by the third party requester on December 30, 2010. The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,313,720 issued on December 25, 2007.
- A request for *inter partes* reexamination was filed on June 6, 2008 and assigned control no. 95/000,373.
- *Inter partes* reexamination was ordered and prosecution progressed until an Action Closing Prosecution was mailed September 28, 2010.
- On October 27, 2010, patent owner responded to the ACP.
- On November 24, 2010, the third party requester filed comments to the patent owner's response.
- On December 28, 2010, patent owner filed the instant petition.
- On December 30, 2010, the third party requester filed the instant opposition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

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

37 CFR § 1.951 Options After Office Action Closing Prosecution in *Inter Partes* Reexamination

(a) After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing

prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

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

MPEP § 2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive Comments

IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2) . . . . If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments. No additional opportunity will be given for the third party requester to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.

DECISION

Patent owner ["petitioner"] argues that the third party requester's comments filed November 24, 2010 are improper because they are directed to issues other than those raised by the Office action or the patent owner's response. In particular, the comments at pages 7-9 argue that the examiner should reject claims 151-158 over prior art, and patent owner states that the issue of whether claims 151-158 should be rejected was not an issue raised in the ACP or patent owner's response. The third party in the comments additionally argues at pages 5-6 that claims 101, 105,

109, 113 and 184 do not find support in the specification and should be rejected under 35 U.S.C. § 112.

As a procedural matter, the petition was filed under 37 CFR § 1.182, which is reserved for questions that are not provided for in the regulations. The Office considers petitions to strike a paper as being properly filed under 37 CFR § 1.181, as this is considered the invocation of supervisory authority of the Director to review the allegedly improper entry of a paper into the record. Such a petition is therefore provided for elsewhere in the regulations and is not proper under 37 CFR § 1.182. The petition is treated as a petition under 37 CFR § 1.181.

35 U.S.C. § 314(b)(2) only permits third party comments "addressing the action of the Office or the patent owner's response thereto." *See also* 37 CFR § 1.947 ("These comments shall be limited to issues raised by the Office action or the patent owner's response."). Accordingly, MPEP 2672(IV) directs that a comments submission filed after an ACP that goes beyond the scope of the patent owner's response or the ACP will be returned and/or expunged from the record. That section also states that no additional opportunity will be given to correct the defect in a post-ACP comments submission.

Turning back to the merits, the third party newly proposes that claims 151-158 be rejected as anticipated or obvious over Thompson or McKusick. These claims were first submitted after a Non-final Office action in the Amendment filed February 22, 2010, where patent owner argued on page 45 that the claims were patentable "for at least the same reasons discussed below with regard to" the independent claims. The third party submitted comments on March 24, 2010, and at that time could have proposed a rejection of these claims. But the third party did not provide any discussion in regards to the particular limitations of these claims; all that was said as to these claims was the blanket statement that "Because claims 1, 11, 18 and 19 are unpatentable over the references cited herein, the new claims 35-184 are unpatentable for at least the same reasons." Comments of March 24, 2010 at p. 31. In the subsequent ACP, the examiner stated that the claims were patentable because the cited art lacked the volinfo block includes a counter, and that the third party said nothing as to these claims therefore there was nothing to rebut. ACP pp. 4, 38.

In the Opposition, the third party argues that in the March Comments it responded to and addressed the limitations of claims 151-158 to the same degree of specificity as the patent owner in arguing for patentability, and that the specific point of the counter was raised for the first time in the ACP. Thus, the third party says its newly proposed rejections are addressing issues raised in the Office action, namely whether the art includes a counter. The Director does not agree.

The point that the third party seems to be missing is the proper burden of proof during patent examination. "Graham [v. John Deere Co., 383 U.S. 1 (1966)] is interpreted as continuing to place the burden of proof on the Patent Office which requires it to produce the factual basis for

its rejection of an application under sections 102 and 103." *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984) (quotation omitted). That is, "the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." *In re Rouffet*, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Thus, when a claim is presented for examination, it is patentable unless the examiner can prove that it is not by presenting a *prima facie* case of unpatentability.

Patent owner was therefore not required, as the third party seems to indicate, to argue any more than it did as to why claims 151-158 were patentable when it presented them. It was more than sufficient under 37 CFR § 1.116(b) to say that they were patentable for the same reasons as the original claims (which patent owner thoroughly argued), as the Office had not yet presented any other reasons to show that these new claims were unpatentable. The third party's response at that time, however, that the claims were unpatentable for the same reasons as the independent claims was clearly insufficient, because it made no attempt whatsoever to show how the additional limitations of these claims were met by the references. The burden of proof does not shift simply because the third party says so, evidence is required; the record, prior to the ACP, was totally devoid of any evidence or even any argument that claims 151-158 were unpatentable.

What this means to us is that the issue of the patentability of claims 151-158 was raised when these claims were presented, in the February 22, 2010 response prior to the ACP. At that point, with nothing more, the claims would be patentable. The burden was then on the examiner, either on his own or via the third party's proposals, to present a case that the claims were unpatentable. The third party made no proposal, only the blanket statement that all claims should be rejected, and the examiner declined to make a case for rejecting the claims on his own. The ACP therefore did not "raise the issue" of whether claims 151-158 were patentable, as that issue was already on the table; the ACP merely did not raise a new issue of unpatentability.

As the patentability of claims 151-158 was first raised upon the presentment of those claims, the proper time to propose new rejections would have been immediately in response to the addition of the claims. The third party had this opportunity in its March 24, 2010 comments, and failed to propose a valid rejection at that time. The ACP and patent owner's response thereto did not raise the issue of the patentability of claims 151-158, as this issue was already raised previously. The new discussion of the patentability of claims 151-158, in the third party's November 24, 2010 Comments after the ACP, therefore went beyond the scope of issued raised by the ACP and response. The comments submission of November 24, 2010 was improper and is expunged from the record.

As a further issue, the third party newly proposes that "dependent [sic, they are independent after the post-ACP amendment] claims 101, 105, 109, and 113, and independent claim 184 should be

rejected under [35 U.S.C.] § 112." November 24, 2010 Comments p. 6. These claims, however, were already present prior to the ACP. Claims 101, 105, 109 and 113 are identical to how they were presented previously, except that they are now placed in independent form. Claim 184 is identical to how it was presented previously, except apparently "a" has been changed to "the" before the last instance of "volinfo", a change that does not affect the third party's argument. Thus, no issue as to 112 written description support was raised in the ACP or the patent owner's response thereto. The third party's raising of the issue now therefore goes beyond the issues raised in the Office action or the patent owner's response thereto, and is improper. This point was not raised in the petition, but the Director finds this as an additional independent basis for striking the comments.

Accordingly, the petition is granted.

CONCLUSION

1. The petition filed December 28, 2010 is granted. The third party comments filed November 24, 2010 are expunged from the record and the third party has no opportunity to correct the defective submission.

2. Jurisdiction returns to the examiner for consideration of patent owner's response to the ACP. An Office action will issue in due course.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the Eric Keasel at (571) 272-4929 or Jessica Harrison at (571) 272-4449.

Mark Reinhart
SPE, Central Reexamination Meeting

United States Patent and Trademark Office

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OCT 22 2010

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In re Eldridge et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,375
Filed: June 6, 2008
For: U.S. Patent No. 6,624,648 B2

: **DECISION DISMISSING PATENT OWNER PETITION UNDER 1.183 AND EXPUNGING PETITION UNDER 1.181 BY THIRD PARTY REQUESTER**

This is a decision on the July 28, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND RULES," requesting entry of a supplemental response to the May 26, 2010 Action Closing Prosecution. This is also a decision as to the propriety of August 30, 2010 requester opposition petition entitled "REQUESTOR'S PETITION UNDER 37 CFR § 1.181 TO REFUSE PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND RULES."

The patent owner and third party requester petitions are before the Office of Patent Legal Administration.

The petition fee of $400.00 under 37 C.F.R. § 1.17(f) for patent owner's petition has been charged as authorized at page 4 of the petition.

The patent owner petition is **dismissed as moot**.

The third party requester petition is **expunged** from the record and will not be considered on the merits, for the reasons set forth below.

BACKGROUND

1. On June 6, 2008, a request for *inter partes* reexamination of claims 1-15, 18-28, and 31-36 of U.S. Patent Number 6,624,648 B2 was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,375 ("the '375 proceeding").

2. On September 3, 2008, an order granting reexamination of claims 1-15, 18-28, and 31-36 of the '648 patent was mailed in the '375 proceeding, and a non-final Office action was mailed in the '375 proceeding.

3. Prosecution advanced, until, on September 14, 2009, the Office issued an Action Closing Prosecution (ACP) rejecting all of the claims subject to reexamination. On September 23, 2009, the Office issued a revised ACP which superseded the earlier ACP, rejecting all of the claims subject to reexamination, claims 1-15, 18-28, and 31-68.

4. On October 23, 2009, patent owner filed comments in response to the September 23, 2009 ACP.

5. On November 20, 2009, third party requester filed a comments paper after patent owner's October 23, 2009 comments paper.

6. On May 26, 2010, the Office issued a (third) ACP, rejecting all of the claims subject to reexamination, i.e., claims 1-15, 18-28, and 31-68.

7. On June 28, 2010, patent owner filed comments in response to the May 26, 2010 ACP, including an amendment cancelling claims 1-15, 18-28, 31-36, 43, 55, 60, 61, and 63; amending claims 37, 53, 54, 56-59, 62, and 65-68; and adding new claims 69-76. As noted by patent owner in the accompanying remarks, entry of this amendment would cancel all of the original patent claims subject to reexamination. A declaration under 37 C.F.R § 1.132 was submitted with the comments.

8. Also on June 28, 2010, patent owner filed a petition under § 1.181 asserting that the May 26, 2010 ACP was premature.

9. On July 28, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND RULES," requesting entry of an accompanying supplemental response to the May 10, 2010 Action Closing Prosecution. The supplemental response included claim amendments restoring, as newly added claims, the original claims proposed to be cancelled in the June 28, 2010 patent owner comments paper.

10. Also on July 28, 2010, patent owner filed a supplemental petition under § 1.181 asserting that the May 26, 2010 ACP was premature.

11. Also on July 28, 2010, third party requester filed a comments paper after patent owner's June 28, 2010 comments paper.

12. On August 30, 2010, third party requester filed a petition under § 1.181 "TO REFUSE PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND RULES." Third party requester also filed, on that date, "COMMENTS RESPONSIVE TO PATENT OWNER'S SUPPLEMENTAL PETITION UNDER 37 C.F.R. § 1.181 THAT THE ACTION CLOSING PROSECUTION IS PREMATURE."

13. On the same date the present decision is being issued, the Central Reexamination Unit (CRU) is issuing a decision granting the June 28, 2010 and July 28, 2010 patent owner petitions under § 1.181.

PERTINENT REGULATION

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). (emphasis added)

DECISION ON PATENT OWNER PETITION

Patent owner seeks waiver of the 37 C.F.R. § 1.951(a) restriction of patent owner to a single response after an ACP. Patent owner seeks permission to file a July 28, 2010 supplemental amendment on the grounds that the cancellation of claims in the June 28, 2010 patent owner comments paper was "inadvertent." See July 28, 2010 patent owner petition at 3.

Patent owner files the instant petition for waiver under 37 C.F.R. § 1.183. To meet the requirements of § 1.183, the petition must establish the existence of an "extraordinary situation" for which "justice requires" waiver of a rule.

The June 28, 2010 and July 28, 2010 papers are being entered for consideration via a CRU decision, mailed on even date herewith, granting the June 28, 2010 and July 28, 2010 patent owner petitions under 37 C.F.R. § 1.181. For that reason, the facts do not show that the extraordinary relief requested by patent owner is the sole means for the desired relief, and thus fail to provide a basis for waiver of the rules. Moreover, the relief requested is no longer needed (it is moot) in view of the finding that the ACP was premature. Rather, patent owner's petition for waiver of the rules is moot, in view of the July 28, 2010 and July 28, 2010 papers being

entered via a CRU decision.

Additional Discussion:

It is further noted that patent owner does not present, in the instant petition, any discussion of how the facts represent an "extraordinary circumstance" as required by § 1.183. Patent owner merely states that the cancellation of claims was "inadvertent" and that granting the petition will "maintain the status quo".

Patent owner's June 28, 2010 comments in response to the May 26, 2010 ACP, included an amendment cancelling claims 1-15, 18-28, 31-36, 43, 55, 60, 61, and 63; amending claims 37, 53, 54, 56-59, 62, and 65-68; and adding new claims 69-76. As noted by patent owner is the accompanying remarks, entry of that amendment would cancel all of the *original* patent claims subject to reexamination. The cancellation of claims appeared in both the claim listing and in the patent owner remarks accompanying the submission.

Since the cancellation of the claims was clearly stated to be intended in both the claim listing and the patent owner remarks, the cancellation is not considered "inadvertent" in the sense that the patent owner submission omitted an item, contained a typographical error, or some other objectively determinable error.[1] The June 28, 2010 paper clearly intended to cancel the listed claims, in favor of the new claims submitted. Patent owner's "inadvertence" is therefore understood as a representing a change in patent owner's position subsequent to the submission of the June 28, 2010 paper. Neither this type of inadvertence, nor the fact that entry would merely "maintain the status quo," adequately supports a finding of "extraordinary circumstances" such that "justice requires" waiver of § 1.951(a). Further, the inclusion of the claims cancelled plus retaining new claims 69-76 does not appear to simplify issues on appeal, nor meet any of the other criteria of 37 CFR 1.111(a)(2) for a supplemental amendment.

Based on the facts and circumstances present in the proceeding as discussed above, the petition does not persuasively show that there exists "extraordinary circumstances" sufficient to meet the requirements for waiver of § 1.951(a) under § 1.183. However, the matter is moot as pointed out above.

DECISION ON THIRD PARTY PETITION AND COMMENTS

With respect to the August 30, 2010 third party requester petition and comments paper opposing patent owner's petition under 37 CFR 1.181, such a request, in the form of a petition under 35 C.F.R. § 1.181, is **not** correct, since it was not filed to address any action taken or not taken by the Office. A petition under 37 CFR 1.182 would be required, since it is not provided for by rule.

[1] Note, for example, the MPEP discussion of "inadvertent" relating to 37 C.F.R. § 1.957(d), at MPEP 2666.30.

More important, even a petition under 37 CFR 1.182 would not be proper, since neither 35 U.S.C. § 314(b)(2), or any other statute, provides any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to request entry of a supplemental amendment. Such a request, in the form of a petition under 35 C.F.R. §§ 1.181/1.182, is **not** a response to an "Office action on the merits." Rather, it goes to an issue that goes to formal requirements and to a matter within the discretion of the Office in balancing the delay in the proceeding against the "extraordinary circumstances" of a specific situation. Stated differently, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to provide waiver of a rule in extraordinary circumstances where justice requires. The latter is clearly a matter within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition that requests entry of a supplemental amendment. No mechanism has been provided for the third party requester to file a paper, such as the present paper. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

A third party requester's opposition to a patent owner's petition requesting entry of a supplemental amendment, by either a comments paper or a petition, is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The petition and comments paper are also not permitted as a submission of written comments on the merits to a patent owner's response to an Office action. Third party requester's opposition paper and opposition petition to patent owner's petition for continued reexamination are therefore not enterable into the record.

In view of the above, the opposition paper and petition is being refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's opposition filed on August 30, 2010 does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the third party requester. Rather, the requester's paper and petition opposing patent owner's request for entry is being expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceeding. Different patent owner addresses are of record for the reexamination proceeding and the patent. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 CFR 1.33(c), and it is that of Formfactor Inc., Legal Department, 7005 Southfront Road, Livermore, CA 94551. Accordingly, all future correspondence will be directed only to that address, unless patent owner changes the correspondence address of record in the patent, using form PTO/SB/123, or an appropriate substitute.

CONCLUSION

1. The July 28, 2010 patent owner petition under § 1.183 is **dismissed**.

2. The August 30, 2010 requester comments paper and petition under § 1.181 are refused entry, as it is an improper paper. The opposition petition and comments paper are not enterable into the record of the present reexamination proceeding, because such submissions are not authorized by the reexamination statute or the regulations promulgated under the statute.

3. Because the opposition petition and comments paper were previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the opposition petition and comments paper are being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." They will not constitute part of the record of the present reexamination proceeding.

4. In order to avoid the next Office correspondence being mailed to the correspondence address of the patent, patent owner must promptly file papers to address the correspondence address and attorney of record considerations in both proceedings, as set forth in the last section of this decision,.

5. Any inquiry concerning 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

October 15, 2010
KenFinal+ACP - after it/ Amdt-Decl enter
Kenpetopposition&reply

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N. KENNETH BURRASTON (For Patent Owner)
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OCT 22 2010

CENTRAL REEXAMINATION UNIT

Richard L. Stroup (For Requester)
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 NEW YORK AVE., N.W.
WASHINGTON, DC 20001

In re Eldridge et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,375	:	FOR REOPENING
Filed: June 6, 2008	:	PROSECUTION
For: U.S. Patent No.: 6,624,648	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on June 28, 2010 and the supplemental 37 CFR 1.181 petition on July 28, 2010. The June 28, 2010 petition is entitled "PETITION UNDER 37 C.F.R. § 1.181 THAT ACTION CLOSING PROSECUTION WAS PREMATURE," and is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and order a corrected Office action in place of the Action Closing Prosecution (ACP) issued on May 26, 2010. The supplemental petition under 37 CFR 1.181 is a request for the Office to accept and enter a supplement post-ACP response dated July 28, 2010.

The petitions are before the Director having oversight over the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated June 28, 2010 is granted with respect to withdrawing the ACP dated May 26, 2010. The supplemental petition under 37 CFR 1.181 to accept and enter a supplement post-ACP response is dismissed as moot.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,624,648 (hereinafter, the '648 patent) issued on September 23, 2003.

2. A request for *inter partes* reexamination, assigned control No. 95/000,375, was filed by a third party requester on June 6, 2008.

3. *Inter partes* reexamination was ordered for the '375 reexamination proceeding on February 10, 2009. On the same day, a non-final Office action was mailed in the '375 reexamination proceeding.

4. Prosecution advance and on September 23, 2009 the Office issued a first Action Closing Prosecution (ACP). The first ACP included a rejection of proposed new claims 37-68 under 35 U.S.C. 112, first paragraph. No other rejection was made to proposed new claims 37-68.

5. On October 23, 2009, the patent owner filed a response to the first ACP. The response included arguments but no proposed amendments or new claims.

6. On November 20, 2009, the third party requester filed comments.

7. On May 26, 2010, the Office issued a second ACP, which addressed the patent owner's response and the third party comments. The second ACP included additional rejections for proposed new claims 37-68.

8. On June 28, 2010, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that a corrected Office action be mailed. The patent owner also filed comments in response to the ACP.

9. On July 28, 2010, the patent owner filed a supplemental petition under 37 CFR 1.181, a petition under 37 CFR 1.183 to suspend the rules, and a supplement post-ACP response.

10. On July 28, 2010, the third party requester filed comments.

11. On August 30, 2010, the third party requester filed petitions in opposition to patent owner's petitions of June 28, and July 28, 2010, as well as comment's on patent owner's supplemental response of July 28, 2010.

DECISION

The patent owner (petitioner) states that the second ACP dated May 26, 2010 was not in accordance with Office policies set forth in MPEP 2673 et seq., because the second ACP added new grounds of rejection not made in the previous Office action. Therefore, patent owner states that Office policy states that the patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. The patent owner states that public policy and Office procedures support the patent owner's position that the ACP was improperly issued and cites to MPEP 2673.01 for support. Because of these grounds, petitioner requests that the ACP dated May 26, 2010 should be deemed premature and that prosecution should be reopened.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds there are good and sufficient reasons to do so for the reasons set forth below, and for the reasons set forth by the patent owner in the petition.

Turning to the facts in this proceeding, patent owner is correct that Office policy supports the reopening of prosecution when the examiner decides to modify his or her position that is adverse to the patent owner's position. Therefore, the ACP of May 26, 2010 cannot fairly be said to have given patent owner an adequate opportunity to address the new position prior to the appeal stage.

Specifically, 37 CFR 1.949 states:

> "Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment."

Therefore, the examiner improperly closed prosecution because the ACP dated May 26, 2010 fails to give patent owner an adequate opportunity to address the new position prior to the appeal stage, in accordance with 37 CFR 1.949 and MPEP 2673.01. Accordingly, good and sufficient reasons to withdraw the ACP dated May 26, 2010 in the reexamination proceeding have been provided and the patent owner's petition, as it relates to withdrawing the ACP dated May 26, 2010, is granted.

Due to the vacatur of the May 26, 2010 Office action, patent owner's responses of June 28, 2010 and July 28, 2010 will be closed and returned and the third party requester's comments of July 28, 2010 , and August 30, 2010, will be closed and returned. Accordingly, the request in the July 28, 2010 supplemental petition under 37 CFR 1.181 to enter the supplemental response of July 28, 2010 is rendered moot.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated May 26, 2010 is **granted**.

2. The Office action, dated May 26, 2010, is hereby **vacated** and the examiner will issue a **corrected** Office action, in due course, to replace the May 26, 2010 Office action.

3. The patent owner's comments, dated June 28, 2010 and July 28, 2010, and third party requester's papers dated July 28, 2010 will be closed and returned. As the papers have been entered into the electronic Image File Wrapper (IFW) record, the papers will be "returned" by closing the paper in the IFW, and marking the papers nonpublic to expunge it from the record.

4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or in his absence to the undersigned at (571) 272-3838.

Irem Yücel, Ph. D., JD,
Director, TC 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,377	09/15/2008	7223361	3289-011	8140

27752 7590 08/25/2010

THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/25/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,377	09/15/08	7223361	3289-011

EXAMINER
DIAMOND, ALAN D.

ART UNIT	PAPER
3991	

TRASKBRITT PC
P O BOX 2550
SALT LAKE CITY, UT 84110

DATE MAILED:

MAILED
Aug 25 2010
CENTRAL REEXAMINATION UNIT

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95/000,377	09/15/08	7223361	3289-011

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EXAMINER
DIAMOND, ALAN D.

ART UNIT	PAPER
3991	

DATE MAILED:

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Global Legal Department – IP
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Cincinnati, OH 45202

For Patent Owner

MAILED

AUG 25 2010

CENTRAL REEXAMINATION UNIT

TRASKBRITT PC
P. O. Box 2550
Salt Lake City, UT 84110

For Requester

Ex Parte Reexamination Proceeding
Control No. 95/000,377
Filed: September 15, 2008
For: US Patent No. 7,223,361

DECISION ON
PETITION UNDER
37 CFR 1.181

This is a decision on the petition filed July 16, 2010 to request entry of amendments after Action Closing Prosecution.

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

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

Statement of Facts

The statement of facts provided by Patent Owner in the present petition is correct. It is important to note that, in the Action Closing Prosecution (ACP), mailed March 22, 2010, Claims 1, 2 and 4-62 were rejected and claim 3 was confirmed. Patent Owner was advised to incorporate the limitations of claim 3 into claims 1 and 22, cancel claims 2 and 3, amend claim 7 as proposed in the amendment of January 11, 2010 and take care of the non-compliance issues in claims 1 and 22. This would render claims 1 and 4-22

patentable over the art discussed in this proceeding. Patent Owner was informed that an amendment after ACP limited to the examiners suggestions and otherwise complying with 37 CFR 116, specifically not presenting additional claims without canceling a corresponding number of claims, would be entered.

On April 22, 2010, Patent Owner presented an amendment that included the suggested amendment of claims 1, 7 and 22 and presented additional new claims 63-102. This amendment was not entered for the reasons set forth on pages 2-3 of the RAN mailed June 17, 2010.

Analysis

37 CFR 1.116 states in pertinent part:

> (a) An amendment after final action must comply with § 1.114 or this section.
>
> (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
>
> > (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
> > (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
> > (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.
>
> (c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).
>
> (e) 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.

MPEP 2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive Comments [R-7].

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

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

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

MPEP 2673 III.

...

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." Where the examiner does enter the amendment, see MPEP § 2673.01 as to whether a Right of Appeal Notice (RAN) can be issued or whether there is a need to reopen prosecution.

Where multiple amendments are submitted after the ACP, all amendments except for the first one will be returned without consideration, since they are improper submissions. Thus, if prosecution is reopened, only the first amendment will be present for entry.

An amendment filed at any time after the ACP and prior to the RAN may be entered (where appropriate for entry). An amendment filed after the RAN will not be entered at all, in the absence of a grantable petition under

> 37 CFR 1.183 because 37 CFR 1.953(c) prohibits an amendment after the RAN in inter partes reexamination. If the examiner wishes to have the patent owner provide an amendment after the RAN, the examiner can reopen prosecution, enter the amendment, and issue a new ACP.

Patent owner has argued that patentee cannot predict future rejections and therefore cannot amend the claims or modify the claim amendments based on the unknown. The patent owner states that new clams were added in response to the 1st and 2nd ACP and could not have been presented earlier. Patent owner also argues that proposed new claims 63-102 would ~~be~~ require a rejection under 35 U.S.C. 112, first paragraph. See pages 5-7 of the petition.

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 <u>cannot</u> 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 <u>cannot</u> 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."

Turning to the facts in this proceeding, the proposed amendment of April 22, 2010, was given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. The additional claims clearly present issues that would require further substantial consideration. As pointed out by the examiner, the amendment presents additional claims without canceling a corresponding number of claims finally rejected in the ACP of March 22, 2010 and the newly added claims are deemed to raise new matter issues. The examiner did not make a rejection under 35 U.S.C. 112, first paragraph, but only stated that the proposed new claims 62-102 raises issues of new matter in support for non-entry of the April 22, 2010 amendment. See pages 3-6 in the RAN dated June 17, 2010.

For these reasons, it is apparent the examiner carefully considered entry of the amendment filed April 22, 2010 and determined that entry would not result in meeting the "special dispatch" requirement for four reasons set forth on pages 2-3 of the RAN. Since the amendment presents additional claims without canceling any finally rejected claims, it is not considered to place the proceeding in better form for appeal. *Ex parte Wirt,* 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905). Entry of amendments after ACP is limited to directly addressing the rejections of record or presenting the claims in better form for appeal.

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the amendment of April 22, 2010 should not be entered, and issued a RAN in the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the amendment of April 22, 2010 and issuing a RAN.

Conclusion

1. The Patent Owner's petition for entry of the April 22, 2010 amendment is **denied**.

2. Any future 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/authenticatuserlocale:html

By Mail to: Mail Stop *Inter Partes* Reexam

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

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

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

Gregory Morse,
Director,
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,377	09/15/2008	7223361	3289-011	8140

27752 7590 09/09/2010

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EXAMINER

ART UNIT	PAPER NUMBER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,377	09/15/08	7223361	3289-011

EXAMINER
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,377	09/15/08	7223361	3289-011

EXAMINER
DIAMOND, ALAN D.

ART UNIT	PAPER
3991	

TRASKBRITT PC
P O BOX 2550
SALT LAKE CITY, UT 84110

DATE MAILED:

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THE PROCTER & GAMBLE COMPANY
GLOBAL LEGAL DEPARTMENT – IP
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299 EAST SIXTH STREET
CINCINNATI OH 45202

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Kvietok et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,377
Filed: September 15, 2008
For: U.S. Patent No. 7,223,361

DECISION
DISMISSING PETITIONS
UNDER 1.182 AND 1.183

This is a decision on the July 16, 2010 patent owner petitions entitled "PETITION UNDER 37 C.F.R. § 1.182 – REQUEST FOR CONTINUED REEXAMINATION" and "PETITION UNDER 37 C.F.R. § 1.183 – REQUEST FOR WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF AND A REQUEST FOR AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF."

The patent owner petitions are before the Office of Patent Legal Administration.

The petition fees under 37 C.F.R. § 1.17(f) of $400 have been submitted with each petition.

The petitions are **dismissed**.

BACKGROUND

- On June 18, 2008, a request for *inter partes* reexamination of U.S. Patent Number 7,223,361 ("the '361 patent") was deposited by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,377 ("the '377 proceeding"). The proceeding was accorded a filing date of September 15, 2008, the date that the filing requirements of 37 C.F.R. § 1.915 were received.

- On November 20, 2008, reexamination was ordered for claims 1-22, all of the claims, of the '377 patent.

- The proceeding progressed to the point where, on January 27, 2010, the Office issued an Action Closing Prosecution (ACP) rejecting pending claims 1, 2, and 4-62 and confirming claim 3.

- On January 11, 2010, patent owner filed a response to the ACP and proposed claim amendments and new claims 63-102. Third party requester filed comments on February 10, 2010.

- On March 22, 2010, the Office issued a second ACP, rejecting pending claims 1, 2, and 4-62 and confirming claim 3, and refusing entry of the patent owner proposed amendment of January 11, 2010.

- On April 22, 2010, the patent owner filed a response to the ACP and proposed claim amendments and new claims 63-102. Third party requester filed comments on May 24, 2010.

- On June 17, 2010, the Office issued a Right of Appeal Notice (RAN), rejecting pending claims 1, 2, and 4-62 and confirming claim 3, and refusing entry of the patent owner proposed amendment of April 22, 2010.

- On July 16, 2010, patent owner filed the instant petitions requesting reopening of prosecution under § 1.182 and extension of time under § 1.183.

- Also on July 16, 2010, patent owner filed a petition under § 1.181 requesting entry of amendments after ACP.

- Also on July 16, 2010, patent owner filed a Notice of appeal.

- On August 25, 2010, the Office issued a decision dismissing the July 16, 2010, patent owner petition under § 1.181 requesting entry of amendments after ACP.

APPLICABLE 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)

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. § 41.61(b) provides:

Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 C.F.R. § 41.66(a) provides:

An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

I. PETITION UNDER 37 C.F.R. § 1.182

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

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. 305 (for *ex parte* reexamination) and 35 U.S.C. 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the requirement of special dispatch favors continued prosecution only where the need for the patent owner's proposed response could not have been anticipated earlier; thus, a petition for continuation of the reexamination prosecution is to explain why the patent owner did not become aware of the need for the new amendment or evidence earlier in the prosecution.

In this instance, patent owner seeks reopening of prosecution after the ACP to enter the April 22, 2010 claim amendments denied entry by the Office on June 17, 2010. Patent owner seeks relief under the provisions of 35 U.S.C. § 314 and under principles of due process.

---

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

1. § 314 Does Not Convey An Unlimited Right To Enter Amendments Or New Claims

Patent owner's plea for relief under 35 U.S.C. § 314 is grounded in the position that § 314(a) permits the entry of claim amendments in *inter partes* reexamination proceedings where the scope of the claim is not broadened, and further, that § 314 incorporates the provisions of § 132(b) permitting continued examination. However, while § 314 permits the patent owner to "propose any amendment to the patent and a new claim or claims," § 314 limits this ability by stating that "reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." Under the procedures established for initial examination, amendments after final action may be proposed, but are limited in their right of entry as set forth in 37 C.F.R. § 1.116.

With respect to continued prosecution after the close of prosecution, 37 C.F.R. § 1.114, which implements § 132(b), contains a provision excepting reexaminations from continued examination; i.e., § 1.114(e). For this reason, continued prosecution in reexamination proceedings as a matter of right is not specifically authorized under § 314.

Where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the Office's 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 facilitate the conducting of the proceeding with special dispatch.

In the present instance, patent owner has not provided reasons as to why reopening the prosecution to enter the April 22, 2010 claim amendments would act to advance rather than retard the proceeding. In looking to the prosecution history of this proceeding, it is seen that the April 22 amendments might reduce issues as the amendment is in accordance with suggestions made by the examiner in the June 17, 2010. However, the amendment also seeks entry of numerous claims which raise new issues, such as whether or not the new claims include new matter and/or are enabled. Although a submission that merely reduces issues for appeal may, if timely filed, reduce issues such that reopening of prosecution by the Office would be in accord with special dispatch, the April 22, 2010 submission is not limited to reduction of issues. Also, the petition has not identified any issue newly raised in the ACP to which these new claims are directed and how they are so directed.

Therefore, in the absence of any patent owner rationale in the petition to the contrary, entry of the amendment would not be in accordance with 35 U.S.C. § 314, and therefore the petition must be dismissed.

2. Petitioner's Due Process Argument Is Not Persuasive

With respect to patent owner's asserted basis for relief under the principles of due process, patent owner predicates this request on the ground that there should be a procedure for patent owner's to obtain further examination, and that more than a single opportunity to amend the claims is required.

With respect to this asserted basis for relief, patent owner has not identified in what manner due process principles would support an unlimited right of entry of responses in the '377 proceeding, particularly in view of the statutory requirement that the Office handle reexamination proceedings with special dispatch, as set forth in 35 U.S.C. § 314. Also, the Office issued the March, 2005 Notice providing for the filing of a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding; however, such a request must be filed without addressing issues that were not newly raised by the examiner in the previous Office action. As the Office has provided an avenue for seeking continued prosecution, patent owner's arguments on that ground are not persuasive. In addition, amendments may be entered after ACP where they satisfy 37 C.F.R. § 1.116. In the present proceeding, multiple ACPs were issued, and patent owner has had multiple opportunities to propose amendments for entry. Thus, entry of amendments is provided for where the amendment does not serve to inequitably delay the proceeding.

In view of the above and the facts and circumstances presented by the present record, the petition under 37 C.F.R. § 1.182 is dismissed.

II. PETITION UNDER 37 C.F.R. § 1.183

Patent owner requests rule waiver under § 1.183 to permit an extension of time to file the appeal brief "until after a decision on the petitions filed concurrently under 37 C.F.R. §§ 1.181 and 1.182. Under 37 C.F.R. 41.66(a), patent owner may file an appeal brief no later than two months from the expiration of the time for filing (by the last party entitled to do so) a notice of appeal or cross appeal as set forth in 37 C.F.R. § 41.61. § 41.61 provides a 14 day time period in which to file a notice of cross appeal after the patent owner has filed a notice of appeal. In the instant proceeding, patent owner filed a notice of appeal on July 16, 2010. The period in which a notice of cross-appeal may be filed ended on July 30, 2010. Pursuant to § 41.66, patent owner may file an appeal brief no later than September 30, 2010.

A decision on the petition under 37 C.F.R. § 1.181 was issued by the Office on August 25, 2010. A decision on the petition under 37 C.F.R. § 1.182 appears above. Therefore, both petitions have been decided adequately prior to the date the appeal brief is due under 37 C.F.R. § 41.66(a) (quoted above). Therefore, patent owner's desired condition has been realized without the need for a waiver under § 1.183. Accordingly, the instant petition under § 1.183 is dismissed.

CONCLUSION

- The petitions are **dismissed**.
- A copy of this decision will be made of record in the reexamination file.

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

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

September 9, 2010

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CENTRAL REEXAMINATION UNIT

LAW OFFICE OF DAVID H. JUDSON
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DALLAS, TX 75248

(For Patent Owner)

SHEPPARD, MULLIN, RICHTER
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LOS ANGELES, CA 90071-1448

(For *Inter Partes* Requester)

In re Billings
Inter partes Reexamination Proceeding
Control No. 95/000,378
Filed: October 9, 2008
For: U.S. Patent No. 7,344,450

: **DECISION**
: **ON PETITIONS**
: **UNDER 37 CFR 1.181**
:

This decision is in response to third party requester's petitions, filed on October 26, 2010, which are petitions to the director to order the examiner to issue a notice of noncompliance regarding patent owner's response of July 2, 2009. The petitions state that the examiner erred in not issuing a notice of noncompliance because the July 2, 2009 response exceeds the page limits set in 37 CFR 1.943 when counting the pages of the declarations filed with the response.

The petitions are before the Director of TC 1600, who oversees the Central Reexamination Unit, for decision.

The third party requester's petitions are **DENIED** for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,344,450 (the '450 patent) issued on March 18, 2008.

2. A request for reexamination of the '450 patent was filed on October 9, 2008. The request was assigned control No. 95/000,378 (the '378 reexamination proceeding).

3. On December 19, 2008, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-18 of '450 patent.

4. On March 25, 2009, the Office mailed an Office action.

5. On April 20, 2009, the patent owner filed a request for a one-month extension of time.

6. On May 4, 2009, a decision granting the one-month extension of time was mailed.

7. On June 16, 2009, the patent owner filed a request for a one-week extension of time.

8. On June 25, 2009, a decision granting the one-week extension of time was mailed.

9. On July 2, 2009, the patent owner's response was timely filed. The response included declarations by Richard Parente and Peter Piotrowski.

10. On August 11, 2009, the third party requester filed the "Petition Under 37 CFR § 1.10(e)" and papers in response to the Patent Owner's July 2, 2009 response and the March 25, 2009 Office action. The petition requests that the director consider the comments, declaration, information disclosure statement, and certificate of service, dated August 11, 2009, as timely filed on August 3, 2009.

11. On August 25, 2009, a decision dismissing the petition under 37 CFR 1.10(e) was mailed.

12. On September 1, 2009, the third party requester filed a request for reconsideration of the petition under 37 CFR 1.10(e) and alternative petitions under 37 CFR 1.182 and 1.183 as a single paper.

13. On October 7, 2009, a decision denying the September 1, 2009 reconsideration petition under 37 CFR 1.10(e) was mailed.

14. On October 13, 2009, the third party requester filed a petition under 37 CFR 1.182 and a petition under 37 CFR 1.183 requesting entry of the August 11, 2009 comments.

15. On November 25, 2009, a decision dismissing the petitions under 37 CFR 1.182 and 37 CFR 1.183 was mailed.

16. On September 15, 2010, the Office mailed an Action Closing Prosecution (ACP), which addressed the patent owner's response of July 2, 2009.

17. On October 26, 2010, the third party requester filed a petition under 37 CFR 1.181 and a petition under 37 CFR 1.182. Both are petitions to the director to order the examiner to issue a notice of noncompliance regarding patent owner's response of July 2, 2009.

18. The patent owner did not file a response to the ACP.

RELEVANT LAW AND REGULATIONS

37 CFR 1.181 provides:

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

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

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

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

ANALYSIS AND FINDINGS

Treatment of the Petition under 1.182

The third party requester filed a petition under 37 CFR 1.181 and a petition under 37 CFR 1.182, both requesting the same relief. The petition under 37 CFR 1.182 is improper because 37 CFR 1.181 provides for the requested relief. Therefore, the petition under 37 CFR 1.182 is treated as a duplicate petition of the petition under 37 CFR 1.181. In other words, both petitions are being decided together solely under 37 CFR 1.181.

DECISION ON PETITION UNDER 37 CFR 1.181

The third party requester (Petitioner) states that they are seeking the director to order the examiner to issue a notice of noncompliance regarding patent owner's response of July 2, 2009. The petitions state that the examiner erred in not issuing a notice of noncompliance because the July 2, 2009 response exceeds the page limits set in 37 CFR 1.943 when counting the pages of the declarations filed with the response.

In response to Petitioner arguments for requiring the examiner to mail a noncompliance notice regarding the patent owner's July 2, 2009 response, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an Office action. See MPEP 2666 *et seq.* In this proceeding, the record clearly shows that prosecution has been significantly delayed. See the statement of relevant facts above. One reason for the delay is requester's repetitive filing of petitions to enter their untimely filed comments of August 11, 2009. Specifically, four petitions were filed on this issue, which required time and Office resources to address. Moreover, the prosecution has advanced to the point where a Right of Appeal Notice (RAN) may be issued. To grant these petitions would require vacatur of the ACP and further delay in sending out a notice, waiting for patent owner's corrected response, waiting for requester's comments (if applicable[1]), and sending out another Office action. Such actions are clearly against the statutory mandate of "special dispatch" and are not justified unless a clear violation of the reexamination laws and rules has been demonstrated.

The petition fails to set forth any facts that clearly show a violation of the reexamination laws and regulations by entry of the July 2, 2009 patent owner response. The petition simply concludes that the declarations by Richard Parente and Peter Piotrowski must be counted as part of the response but fails to show why the declarations must be counted as arguments. The reference to decisions in other reexamination proceedings is not persuasive as decisions in each proceeding are made independently based on the facts of record. In other words, the record of this proceeding does not support Petitioner's position that the ACP was issued in violation of the reexamination laws and regulations. More importantly, the decision as to whether a declaration contains arguments, and if so, what pages count towards the page limit in 37 CFR 1.943 is based upon the discretion of the examiner. Every examiner's action in the Central Reexamination Unit is discussed and agreed upon by another examiner and manager. Therefore, the examiner's decision to hold the July 2, 2009 response as compliant has already been reviewed and agreed upon by two other Office employees. In summary, nothing in the record shows the decision was in clear violation of Office regulations and procedures.

---

1 It is noted that sending out the requested notice of noncompliance may give requester another opportunity to comment on a response in which their original comments were held untimely by multiple petition decisions.

As discussed above, the director has reviewed the facts of this particular proceeding and has found that there is no justification to thwart the statutory mandate of special dispatch by holding the patent owner's response of July 2, 2009 noncompliant with 37 CFR 1.943 and backing up prosecution to the same point it was almost two years ago. In other words, Petitioner has not set forth sufficient facts to show the Office has failed to follow the reexamination laws and procedures in order to support their request that the examiner must mail a notice of noncompliance and not enter the July 2, 2009 response. Therefore, it is in the interest of special dispatch to advance the prosecution and not further delay the proceeding by denying Petitioner's request to hold patent owner's response of July 2, 2009 noncompliant with 37 CFR 1.943.

Accordingly, the third party requester's petition under 37 CFR 1.181 is **DENIED**.

CONCLUSION

1. The third party requester's petitions, filed October 26, 2010, are DENIED for the reasons discussed above.

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

Irem Yucel, Director
Technology Center 1600

Last Page

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,383	10/23/2008	6719434	160702-0015	6595

22206 7590 03/16/2011

FELLERS SNIDER BLANKENSHIP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

Date:
MAILED
MAR 16 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000383
PATENT NO. : 6719434
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAR 16 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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Fellers, Snider, Blankenship, Bailey & Tippens
The Kennedy Building
321 South Boston, Suite 800
Tulsa, OK 74103

(Courtesy Copy)

In re Finn *et al.*	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No.: 95/000,383	:	**GRANTING**
Filed: October 23, 2008	:	**PETITIONS**
For: U.S. Patent No. 6,719,434 B1	:	

This is a decision on:

i. the June 18, 2010 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT OF APPEAL BRIEF UNDER 37 C.F.R. § 1.943(c),"
ii. the July 19, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT OF RESPONDENT/PATENTEE'S RESPONSE TO THIRD PARTY REQUESTOR'S APPEAL BRIEF UNDER 37 C.F.R. § 1.943(c)," and on
iii. the July 27, 2010 third party requester paper entitled "APPELLANT/REQUESTOR'S OPPOSITION TO RESPONDENT'S PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT OF RESPONDENT/PATENTEE'S RESPONSE TO THE THIRD PARTY REQUESTOR'S APPEAL BRIEF."

On March 16, 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 above-identified papers, which are now before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of petitions i – ii under 37 CFR 1.183 has been received.

Waiver of the page limit requirement of § 1.943(c) has been granted under § 1.183 such that the June 18, 2010 appellant's brief and July 19, 2010 respondent's brief are not refused entry under § 1.943(c).

The July 27, 2010 third party requester opposition paper is refused entry into the record, without consideration on the merits, for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

- U. S. Patent Number 6,719,434 (the '434 patent) issued to Finn et al. on April 13, 2004.
- A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,383 ('383 proceeding), was initially deposited by third party requester on July 15, 2008. A corrected request was then filed, and received a filing date of October 23, 2008.
- On January 12, 2009, the Office issued an order for the '383 reexamination proceeding, granting reexamination of claims 1-26, 28-48, and 50-84 of the '434 patent.
- The proceeding progressed to the point where, on March 26, 2010, a Right of Appeal Notice (RAN) was mailed in the proceeding.
- On April 21, 2010, third party requester filed a Notice of Appeal.
- On June 18, 2010, third party requester filed an appellant's brief, with a certificate of a word count of 21,739 words. The brief was accompanied by the instant petition under 37 C.F.R. § 1.183 for waiver of the page limit requirement of 14,000 words as set forth in 37 C.F.R. 1.943(c).
- On July 19, 2010, patent owner filed a respondent's brief, along with a certificate of a word count of 21,257 words. The brief was accompanied by the instant petition under 37 C.F.R. § 1.183, for waiver of the page limit requirement of 7,000 words as set forth in 37 C.F.R. § 1.943(c).
- On July 27, 2010, third party requester filed the instant opposition, opposing patent owner's July 19, 2010 petition requesting waiver of the page limit requirements of 37 C.F.R. § 1.943(c) for its respondent brief.
- On August 31, 2010, the Office mailed a notice of defective paper stating that respondent brief was found defective, because of the use of strike-through in the claims appendix. A thirty day period for corrective response was set.
- On September 19, 2010, patent owner filed a corrected claims appendix.
- On December 27, 2010, the Office issued an examiner's answer.

- On March 10, 2011, the appeal was docketed at the Board of Appeals and Interferences as appeal no. 2011-006144.

DECISION

A. Page Limit Waiver

1. Third Party Requester Petition of June 18, 2010

In its June 18, 2010 petition, petitioner third party requester requests waiver of 37 C.F.R. § 1.943(c), which limits appellant briefs to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit third party requester to file its appellant brief of 21,739 words in length, which has been concurrently submitted with its petition under 37 C.F.R. § 1.183 to waive the requirement of 37 C.F.R. § 1.943(c).

In this instance, third party requester has made a showing in support of the request for waiver of the 30-page limit of 37 C.F.R. § 1.943(c) by attempting to draft an appellant brief in compliance with the 30-page limit, and submitting the resulting response, which has a length of 21,739 words in length that count toward the regulatory page limit. Patent owner asserts that it "has addressed the bases for invalidity of each of the eighty-one dependent claims," which comprises nearly half of the length of the appellant's brief.[1] Additionally, patent owner has prepared and submitted its brief in the understanding that this petition has been granted and the June 18, 2010 third party requester petition has been entered.[2]

Based on the specific facts set forth in patent owner's petition under 37 C.F.R. § 1.183, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 C.F.R. § 1.943(c) in this instance. Accordingly, patent owner's petition under 37 C.F.R. § 1.183 is <u>granted</u> to permit patent owner's June 18, 2010 appellant brief to exceed the page limit to a length equal to the length of requester's June 18, 2010 appellant brief. <u>This waiver makes patent owner's June 18, 2010 appellant brief page-length compliant</u>.

2. Patent Owner Petition of July 19, 2010

In its July 19, 2010 petition, petitioner patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit patent owner to file a respondent brief having a length equal to the length of patent owner's July 19, 2010 respondent brief. Patent owner concurrently submitted its respondent brief with its petition under 37 C.F.R. § 1.183 to waive the requirement of 37 C.F.R. § 1.943(c).

In this instance, patent owner has made a showing in support of the request for waiver of the 7,000 words limit of 37 C.F.R. § 1.943(c) by attempting to draft a respondent brief in compliance with the 7,000 words limit, and submitting the resulting response, which has a length of 21,257 words that count toward the regulatory page limit.

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[1] Patent owner's June 18, 2010 petition at page 2.
[2] *Id.*

Based on the particular circumstances of the present proceeding, it is deemed equitable to waive the 15-page limit of 37 C.F.R. § 1.943(c) for patent owner's respondent brief in this instance to permit entry of patent owner's July 19, 2010 respondent brief. Therefore, patent owner's petition under 37 C.F.R. § 1.183 is granted to permit patent owner's July 19, 2010 respondent brief to exceed the page limit to the total length of the submitted respondent's brief. This waiver makes third party requester's July 19, 2010 respondent brief page-length compliant.

B. Third Party Requester Comments are Not Permitted for Procedural Matters in *Inter Partes* Reexamination

Pursuant to 35 U.S.C. § 314(b)(2), the third party requester, in an ordered *inter partes* reexamination proceeding, has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. This right is implemented by 37 C.F.R. § 1.947, which provides that a third party requester may once file written comments within 30 days from the date of service of a patent owner's response to an Office action on the merits pursuant to 37 C.F.R. § 1.945. Patent owner's petition under 37 C.F.R. § 1.183, requesting suspension of 37 C.F.R. § 1.943(c) for increase of page limit, however, is not a "response" to an Office action on the merits. 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file an opposition to patent owner's petition under 37 C.F.R. § 1.183 for suspension of the rule. A determination of whether the Office will waive a regulation regarding a page limit of a paper is purely discretionary on the part of the Office, and is strictly procedural in nature; waiver of a page limit does not go the merits of the reexamination proceeding. [3]

A third party requester's paper commenting on a patent owner's petition to waive the page limit set out in 37 C.F.R. § 1.943(c) is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Third party requester's July 27, 2010 paper commenting on the patent owner's petition under 37 C.F.R. § 1.183, therefore, is not enterable into the record. [4]

Pursuant to 37 C.F.R. § 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the inter partes reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the third party requester's July 27, 2010 paper commenting on the patent owner's July 19, 2010 petition under 37 C.F.R. § 1.183 does not have a right of entry into the record of the '383 proceeding and, as such, is not an authorized paper. Because the third party requester's July 27, 2010 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 '383 proceeding. See MPEP 2267.

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[3] See, e.g., MPEP 2667 (I)(B)(4), stating [f]urther, any petition requesting that an extension of time be denied will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the reexamination proceeding; whether or not the time is extended clearly does not go to the merits of the reexamination proceeding. The same would apply to oppositions as to petitions for revival of a terminated prosecution, petitions challenging the finality of an Office action, and the like." (emphasis added).

[4] When a petition under 37 C.F.R. § 1.183 includes a paper that, upon granting of the petition, would trigger a right for comment or response by a third party requester, then an opportunity to provide such comment or response is given at the point where the paper is entered (if the petition is granted).

C. Patent Owner's Address

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,719,434 patent file is that of Irell & Manella, LLP, 1800 Avenue of the Stars, Suite 900, Los Angeles, CA 90067. However, the correspondence address of record in the reexamination file is that of Fellers, Snider, Blankenship, Bailey & Tippens, The Kennedy Building, 321 South Boston, Suite 800, Tulsa, OK 74103. As a courtesy, this decision is being mailed to both addresses.

The address of Irell & Manella, LLP, 1800 Avenue of the Stars, Suite 900, Los Angeles, CA 90067, will be the sole address used in future correspondence, until a change in correspondence address in the 6,719,434 patent file is made in accordance with 37 C.F.R. § 1.33(c).

CONCLUSION

1. Requester's June 18, 2010 and patent owner's July 19, 2010 petitions under 37 C.F.R. § 1.183 are both granted, and therefore the proffered appellant brief and respondent's brief are not refused entry under § 1.943(c).

2. The third party requester's July 27, 2010 opposition filed in response to the patent owner's July 19, 2010 petition under § 1.183, requesting suspension of 37 CFR 1.943(c), is refused entry as it is an improper paper.

3. Because the July 27, 2010 paper was previously incorporated into the IFW, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '383 proceeding. No copy of the July 27, 2010 paper will be maintained of record in the Office.

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

Cynthia L. Nessler

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

March 14, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,383	10/23/2008	6719434	160702-0015	6595

22206 7590 04/28/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/28/2011

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 Mole Richardson Co. v. Bruce L. Finn

Reexamination Control No. 95/000,383
Patent 6,719,434
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition under 37 C.F.R. § 1.182" filed April 1, 2011 ("present petition"). Petitioner requests that pages 16-22 of the patent owner's respondent brief of July 19, 2010, be stricken as improper and in violation of 37 C.F.R. § 41.68(a)(3), and that respondent be precluded in this appeal from raising any of the subject matter requested to be stricken. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's deposit account on April 1, 2011.

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

FINDINGS

1. On October 23, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,719,434, which was assigned control no. 95/000,383.
2. On January 12, 2009, reexamination was ordered, and a non-final Office action was mailed on March 13, 2009.
3. Prosecution was conducted, and on March 26, 2010, a Right of Appeal Notice (RAN) was mailed.
4. Requester filed a Notice of Appeal on April 21, 2010.
5. Requester filed an appellant brief on June 18, 2010.
6. Patent owner filed a respondent brief on July 19, 2010.
7. On December 27, 2010, an examiner's answer was mailed.
8. On March 10, 2011, an Appeal Docketing Notice was mailed by the Board of Patent Appeals and Interferences (BPAI).
9. Requester filed the present petition on April 1, 2011.
10. On April 12, 2011, a Notification of Appeal Hearing was mailed.

RELEVANT AUTHORITY

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

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

(b) RESPONSE.-

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

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

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

37 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).

37 C.F.R. § 41.68(a)(3) provides:

The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

ANALYSIS

Petitioner requests that pages 16-22 of the respondent brief be stricken as improper and in violation of 37 C.F.R. § 41.68(a)(3), and that respondent be precluded in this appeal from raising any of the subject matter requested to be stricken. Petitioner's arguments focus on two issues in respondent's brief, including whether the '125 patent is prior art to the claims of the '434 patent; and whether the combination of the '125 patent with any of the Molepar Flyer, the Box Theory Article, or the Hankins patent present a

substantial new question of patentability. Petitioner submits that the patent owner is not permitted to raise these issues in the respondent brief because they were not raised in the appellant brief. Petitioner asserts that it would be grossly unfair and a denial of due process to permit those issues to be raised for the first time in respondent's brief, particularly when appellant has no right to file a reply brief to address these arguments.

35 U.S.C. 314 requires *inter partes* reexamination proceedings to be conducted with special dispatch. A review of the record reveals that the patent owner filed the respondent brief on July 19, 2010, and an examiner's answer was mailed on December 27, 2010. The appeal was docketed at the BPAI on March 10, 2011. Petitioner has provided no explanation as to why requester waited until April 1, 2011, to file the present petition concerning the contents of a brief filed on July 19, 2010. This petition is not consistent with the notion of special dispatch. The panel has discretion to address properly raised issues.

The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

84310 7590 02/04/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/04/2011

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 SanDisk Corporation v. Netac Technology Co., Ltd.

Reexamination Control No. 95/000,384
Patent 6,829,672
Technology Center 3900

DECISION ON PETITIONS

This is a decision on patent owner's "Expedited Petition to Extend Page Limit for Appeal Brief under 37 C.F.R. § 1.183," filed December 23, 2010, ("Petition #1"). This is also a decision on patent owner's "Supplemental Expedited Petition to Extend Page Limit for Appeal Brief under 37 C.F.R. § 1.183," filed January 21, 2011, ("Petition #2"). In the petition of December 23, 2010, patent owner requests extension of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit up to 90 pages or 42,000 words. In the petition of January 21, 2011, patent owner requests extension of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the patent owner's appellant brief now indicated to be less than 60 pages or 28,000

words. The petition fees of $400 in accordance with 37 C.F.R. § 41.20(a) were charged to petitioner's deposit account on December 23, 2010, and January 21, 2011, respectively.

This is additionally a decision on third party requester's "Expedited Petition under 37 C.F.R. § 1.183" filed on January 4, 2011, ("Petition #3"), requesting an extension of the page and word limit for requester's respondent brief. In Petition #3, third party requester requests that the 15 page and 7,000 word limit of 37 C.F.R. §1.943(c), be extended the same number of pages/words as patent owner's appellant brief may be extended if patent owner's petition is granted. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on January 4, 2011.

FINDINGS

1. On July 9, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672.
2. Reexamination was ordered on September 30, 2008, and a non-final Office action was mailed on November 3, 2008.
3. Patent owner filed a petition on January 23, 2009, to extend the page limit and permit 120 pages for response to the non-final Office action, and the petition was granted-in-part in a decision mailed April 6, 2009, extending the limit to permit up to 75 pages, and *sua sponte* extending the limit on requester's comments to also permit up to 75 pages.
4. Patent owner filed a response to the non-final Office action on April 21, 2009, and third party requester filed comments in reply to the Office

action and patent owner's response on December 15, 2009, both within the 75 page limit extended by the petition decision.

5. On September 7, 2010, a Right of Appeal Notice (RAN) was mailed.

6. Patent owner filed a corrected Notice of Appeal on December 3, 2010, appealing the rejections of claims 1-22.

7. Patent Owner filed an Appellant Brief on December 7, 2010, (approximately 120 pages), and on same date, patent owner filed a petition to expunge information under 37 C.F.R. §1.59.

8. A Notification re: Brief was mailed on December 21, 2010, holding that the appellant's brief of December 7, 2010, is defective for exceeding the page and word limit pursuant to 37 C.F.R. §1.943(c).

9. Third party requester filed an "Expedited Petition under 37 C.F.R. §§ 1.181 or 1.182" on December 22, 2010, requesting issuance of a substitute or supplemental Right of Appeal Notice.

10. On December 23, 2010, patent owner filed an "Expedited Petition to Extend Page Limit for Appeal Brief under 37 C.F.R. § 1.183" ("Petition #1").

11. On December 30, 2010, "Patent Owner's Response to Third Party Requester's Expedited Petition under 37 C.F.R. §§ 1.181 or 1.182" was filed.

12. Third party requester filed an "Expedited Petition Under 37 C.F.R. § 1.183" on January 4, 2011, requesting an extension of the page and word limit for requester's respondent brief in light of patent owner's petition to extend page limit for appellant brief ("Petition #3").

13. On January 21, 2011, patent owner filed an appellant brief that is stated to be less than 60 pages or 28,000 words, and a "Supplemental

Expedited Petition to Extend Page Limit for Appeal Brief Under 37 C.F.R. § 1.183 ("Petition #2").

DISCUSSION

Patent owner's Petition #1 filed December 23, 2010, is **dismissed as moot** in view of the appellant brief and patent owner's Petition #2, filed January 21, 2011 ("Petition #2").

In "Petition #2," patent owner requests extending the limits of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief of January 21, 2011, is stated to be 59 pages and 27,223 words.

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

(1) The examiner issued 52 rejections, over 12 references (separately, and in combination, including issues related to the corroboration of the inventors' assertions of conception and diligence in reducing the invention to practice as well as separate issues of obviousness over the various references.
(2) The examiner's rejections largely adopt the arguments and suggestions provided by the third party requester without narrowing or refining the issues at hand. As a result, the ACP and RAN were 17 and 18 pages, respectively. In addition, the examiner incorporated by reference and relied upon the various claim charts (and associated arguments) of the third party requester, which were cited numerous times in both the ACP and RAN. Collectively, these claim charts (provided as appendices C, D, E and F to the

third party requester's Request for *Inter Partes* Reexamination) consist of 120 pages, while the Request for *Inter Partes* Reexamination itself was 99 pages long. As a result, the patent owner is obligated to address each and every argument and suggestion so adopted to avoid waiver.

(3) The examiner failed to discuss the majority of the evidence in the reexamination record, which included 59 separately numbered exhibits submitted by and on behalf of the inventors. This necessitates a lengthy discussion by the patent owner to identify this unconsidered evidence and explain how it supports the inventors' assertions of conception and diligence in reducing the invention to practice.

In Petition #3, third party requester requests an extension of the page and word limit for requester's respondent brief in light of patent owner's petition to extend page limit for appellant brief. Requester asks that in the event that patent owner is granted additional pages and/or words for its appellant brief, that the requester be granted an equal number of extra pages and words for the respondent brief as the patent owner is granted for the appellant brief.

Extension of the limits is requested for the following reasons:

(1) The requester has the burden of addressing all issues raised in the patent owner's appellant brief as described in 37 C.F.R. § 41.68, therefore any expansion of the appellant brief merits an equal expansion of the page limits for the respondent brief.

(2) The requester's need to respond to extra issues raised in the portions of the patent owner's appellant brief that are in excess of the regulatory limit

specified in 37 C.F.R. § 1.943(c) satisfies the standard of 37 C.F.R. § 1.183 for the suspension of the page and word limits for the respondent brief.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

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

37 CFR § 1.943(c) provides:

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

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

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

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

ANALYSIS

Patent owner's appellant brief filed on January 21, 2010, is stated to be 59 pages and 27,223 words which count toward the limit of 30 pages and 14,000 words. It exceeds the page and word limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous rejections which are appealed, issues concerning conception and diligence in reduction to practice, as well as separate issues of obviousness. The prosecution history reveals that the RAN contains 52 rejections under 35 U.S.C. 103(a) of 22 claims. The RAN refers to portions of the request for reexamination, claim charts in Appendices, and discussion in the non-final Office action.

Petitioner asserts that collectively, these claim charts (provided as appendices C, D, E and F to the third party requester's Request for *Inter Partes* Reexamination) consist of 120 pages, while the Request for *Inter Partes* Reexamination itself was 99 pages long. Petitioner concludes that as a result, the patent owner is obligated to address each and every argument and suggestion so adopted to avoid waiver.

Petitioner contends that the examiner failed to discuss the majority of the evidence in the reexamination record, which included 59 separately numbered exhibits submitted by and on behalf of the inventors. This necessitates a lengthy discussion by the patent owner to identify this

unconsidered evidence and explain how it supports the inventors' assertions of conception and diligence in reducing the invention to practice.

In this specific case, a persuasive showing has been made that this situation is extraordinary and that justice requires that more pages/words be allotted to appellant's brief. Petition #2 is **granted,** and the appellant brief of January 21, 2011, is entered.

Since patent owner's petition is granted to extend the page/word limits of the appellant brief to be twice the length permitted by 37 C.F.R. § 1.943(c), the third party requester's Petition #3, requesting an extension of the page and word limit for requester's respondent brief is **granted-in-part**. Instead of the requested relief of extending the limits for the respondent brief the same number of pages and words as extended for patent owner's appellant brief, the relief granted is to extend the page/word limit to be twice the length permitted by 37 C.F.R. § 1.943(c), *i.e.,* 30 pages or 14,000 words.

DECISION

In view of the foregoing, Petition #1 is DISMISSED AS MOOT; Petition #2 is GRANTED; and Petition #3 is GRANTED-In-PART. The appellant brief of January 21, 2011, is entered. Third party requester's respondent brief is due pursuant to 37 C.F.R. § 41.66.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

84310 7590 02/25/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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 SanDisk Corporation v. Netac Technology Co., Ltd.

Reexamination Control No. 95/000,384
Patent 6,829,672
Technology Center 3900

DECISION ON PETITION

This is a decision on requester's "Expedited Petition under 37 C.F.R. § 41.3, and in the alternative, under 37 C.F.R. § 1.182," filed February 9, 2011. In the petition, clarification is requested with regard to a petition decision of the Board of Patent Appeals and Interferences mailed on February 4, 2011, concerning the deadline to file requester's respondent brief. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on February 9, 2011.

FINDINGS

1. On July 9, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672.

2. Reexamination was ordered on September 30, 2008, and a non-final Office action was mailed on November 3, 2008.

3. Prosecution was conducted and on September 7, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Patent owner filed a corrected Notice of Appeal on December 3, 2010, appealing the rejections of claims 1-22.

5. Patent Owner filed an Appellant Brief on December 7, 2010.

6. A Notification re: Brief was mailed on December 21, 2010, holding the appellant's brief of December 7, 2010, defective.

7. Third party requester filed an "Expedited Petition under 37 C.F.R. § 1.183" on January 4, 2011, requesting an extension of the page and word limit for the respondent brief.

8. On January 21, 2011, patent owner filed an appellant brief, and a "Supplemental Expedited Petition to Extend Page Limit for Appeal Brief under 37 C.F.R. § 1.183."

9. In a petition decision mailed on February 4, 2011, the patent owner's petition was granted and the appellant brief of January 21, 2011, was entered; the requester's petition was granted-in-part, extending the page/word limit of the respondent brief to 30 pages or 14,000 words.

10. Requester filed a petition on February 9, 2011, under 37 C.F.R. § 41.3, and in the alternative, under 37 C.F.R. § 1.182, requesting clarification of the deadline to file the respondent brief ("present petition").

11. Requester filed a respondent brief on February 21, 2011, accompanied by a request for oral hearing.

RELEVANT AUTHORITY

37 CFR § 41.3 provides:

(a) *Deciding official.* Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope.* This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) *Petition fee.* The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) *Effect on proceeding.* The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) *Time for action.* (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

37 CFR § 1.182 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 § 41.66 provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

DISCUSSION

In the present petition, petitioner requests clarification of the deadline to file requester's respondent brief. The petition decision of February 4, 2011, stated that third party requester's respondent brief is due pursuant to 37 C.F.R. § 41.66. Since a respondent brief was received from requester on February 21, 2011, *i.e.*, within one month of the date of service of patent owner's appellant brief, the present petition is **dismissed as moot.**

DECISION

In view of the forgoing, the petition is DISMISSED.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	075783.0113	4170

84310 7590 03/22/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/22/2011

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

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Date:

MAILED

MAR 2 2 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000384
PATENT NO. : 6829672
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAR 22 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,384
Filed: July 9, 2008
For: U.S. Patent No. 6,829,672

: **DECISION**
: **DISMISSING**
: **PETITIONS**

This is a decision on patent owner's March 15, 2010 petition paper entitled "PETITION TO EXPUNGE INFORMATION" and on patent owner's December 7, 2010 petition paper entitled "PETITION TO EXPUNGE INFORMATION UNDER 37 C.F.R. § 1.59 AND MPEP 724.05" (the petitions to expunge).

Patent owner's petitions to expunge are before the Office of Patent Legal Administration.

Patent owner's March 15, 2010 and December 7, 2010 petitions to expunge are dismissed for the reasons set forth herein.

RELEVANT AUTHORITY

MPEP 724.03 provides in-part (emphasis added):

> The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments,

> arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

DECISION

In the March 15, 2010 petition to expunge, patent owner requests that "information found to be not material to patentability in the enclosed exhibits 1-3 to the Second Supplemental Declaration of Mr. Deng be expunged." The exhibits were submitted on March 15, 2010 with patent owner's submission under 37 CFR 1.951(a) to the January 13, 2010 action closing prosecution.[1] Patent owner asserts that "[t]hese exhibits contain material that is proprietary to the patent owner, including its software."[2]

In the December 7, 2010 petition to expunge, patent owner requests that "proprietary information found to be not material to patentability of U.S. Patent No. 6,892,672 ("the '672 Patent") in the enclosed Exhibits 29 and 30 to the *Patent Owner's Appeal Brief in Accordance with 37 C.F.R. § 41.67* ("Patent Owner's Appeal Brief") be expunged." The exhibits were submitted on December 7, 2010 with patent owner's appeal brief. Patent owner asserts that Exhibits 29 and 30 were originally filed as Exhibits 2 and 3, respectively, to the Second Supplemental Declaration of Guoshun Deng Under 37 C.F.R. § 1.131 ("the declaration under 37 CFR 1.131") on March 15, 2010 with the submission under 37 CFR 1.951(a).[3] Patent owner further asserts:

> Exhibits 29 and 30 contain source code claim charts provided by the Patent Owner during the reexamination of the '672 Patent that compare the source code for the driver ("Source Code Claim Chart 1") (Exhibit 29) and for the firmware ("Source Code Claim Chart 2") (Exhibit 30) to the elements of many of the claims of the '672 Patent. The information to be expunged includes the Patent Owner's comments in the second and third columns of Source Code Claim Chart 1 (Exhibit 29) and the second and third columns of Source Code of Claim Chart 2 (Exhibit 30) (the first column of each chart contains the claims themselves and is not deemed proprietary).[4]

Pursuant to MPEP 724.03, information for submission under MPEP 724.02 includes materials which are required to be submitted under 37 CFR 1.555, but does not include information favorable to patentability. The exhibits submitted with patent owner's submission under 37 CFR 1.951(a) on March 15, 2010, and again with patent owner's appeal brief on December 7, 2010, were submitted as exhibits to the declaration under 37 CFR 1.131 in support of patent owner's arguments in favor of patentability. There are no statutes or rules that require the disclosure of information favorable to patentability. Therefore, as the Office does not require such material to be submitted, the Office does not give voluntary submissions of such information any special status. Proprietary materials that are submitted in favor of patentability will be made of record in the file and should not be submitted under the procedures of MPEP 724.02. It is noted that, in

[1] The "SECOND SUPPLEMENTAL DECLARATION UNDER 37 C.F.R. §1.131 BY MR. GUOSHUN DENG" is labeled Exhibit F to the March 15, 2010 submission under 37 CFR 1.951(a).
[2] March 15, 2010 petition to expunge at page 1.
[3] December 7, 2010 petition to expunge at page 1.
[4] Id. at page 2.

such circumstances, it might be more appropriate for patent owner to submit a redacted version of information being submitted in favor of patentability to protect any proprietary information from appearing in the public record for the proceeding.

Accordingly, patent owner's March 15, 2010 petition to expunge exhibits 1-3 to the declaration under 37 CFR 1.131 filed with the submission under 37 CFR 1.951(a) on March 15, 2010 and patent owner's December 7, 2010 petition to expunge exhibits 29 and 30 to the appeal brief filed on December 7, 2010 are dismissed. As set forth in MPEP 724.03, the exhibits will be made of record in the file of the 95/000,384 reexamination proceeding and will not be given any special status.

CONCLUSION

1. Patent owner's March 15, 2010 petition paper entitled "PETITION TO EXPUNGE INFORMATION" and patent owner's December 7, 2010 petition paper entitled "PETITION TO EXPUNGE INFORMATION UNDER 37 C.F.R. § 1.59 AND MPEP 724.05" are **dismissed**.

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

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

03-21-2011

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MAILED

JAN 05 2012

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(FOR THIRD PARTY REQUESTER)

In re Deng et al.
Reexamination Proceeding
Control No. : 95/000,384
Filed: July 9, 2008
Patent No. 6,829,672

: DECISIONS ON
: PETITIONS
: UNDER 37 CFR 1.181

This is a decision addressing third party requester's petition, dated December 22, 2010 and patent owner's opposition petition, dated December 30, 2010.

The petitions are before the Director of the Central Reexamination Unit for decision.

SUMMARY

The third party requester's December 22, 2010 petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

The patent owner's December 30, 2010 opposition petition is GRANTED to the extent that the requester's petition is dismissed.

Brief Statement of Relevant Facts

1. Patent No. 6,829,672 (the '672 patent) issued on December 7, 2004.

2. A request for reexamination, assigned Control No. 95/000,384 (the '384 proceeding), was filed by a Third Party Requester on July 9, 2008.

3. Reexamination was ordered in the '384 reexamination proceeding on September 30, 2008.

4. An Office action on the merits was mailed on November 3, 2008.

5. Prosecution continued in the reexamination proceeding, and on January 13, 2010, an Action Closing Prosecution (ACP) was mailed. The ACP rejected claims 1-22.

6. On March 15, 2010, the patent owner timely filed a response to the January 13, 2010 ACP. The response included several declarations filed under 37 CFR 1.131 or 1.132.

7. On April 13, 2010, the third party requester timely filed comments.

8. On September 7, 2010, a Right of Appeal Notice (RAN) was mailed. The RAN did not state that patent owner's declarations, filed on March 15, 2010, are entered into the proceeding record or otherwise address the declarations. The RAN maintained the rejections of claims 1-22 as set forth in the ACP.

9. On October 7, 2010, the patent owner filed a Notice of Appeal, which contained informalities. On December 3, 2010, patent owner filed a corrected Notice of Appeal.

10. On December 7, 2010, the patent owner filed an appeal brief, which contained informalities. See the notice mailed December 21, 2010.

11. On December 22, 2010, the third party requester filed the petition under 37 CFR 1.181 and 1.182.

12. On December 30, 2010, the patent owner filed the opposition petition to requester's December 22, 2010 petition.

Discussion

The third party requester (petitioner) requests supervisory review of the examiner's actions in the RAN, dated September 7, 2010. Specifically, petitioner requests a new RAN that clearly states that the declarations filed on March 15, 2010 were not entered into the record. The petitioner argues that the RAN, dated September 7, 2010, did not enter the March 15, 2010 declarations and the decision to not enter the declarations is proper because patent owner fail to make a sufficient showing under 37 CFR 1.116.

The request to review the RAN is <u>dismissed</u> as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

...

DECISION

Although the December 22, 2010 petition contains statements that an alternative relief under 37 CFR 1.182, the petition is being decided solely under 37 CFR 1.181. In other words, the requester's combined petition under 37 CFR 1.181 and 1.182 is deemed improper because it combines two distinct petitions, which is not compliant with 37 CFR 1.4. Therefore, any requested relief under 37 CFR 1.182 is procedurally dismissed under 37 CFR 1.4. In summary, this decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in issuing the Right of Appeal Notice.

The petitioner's petition, treated under 37 CFR 1.181, requests review of the Right of Appeal Notice, dated September 7, 2010. The petitioner filed the petition on December 22, 2010. The action from which relief is requested is the Right of Appeal Notice, which was mailed on September 7, 2010. Therefore, the petition was filed over **two** months from the mailing date of the action (September 7, 2010) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. The requester's petition under 37 CFR 1.181, filed December 22, 2010, is **dismissed** as untimely for the reasons discussed above.

2. The December 30, 2010 patent owner's opposition petition is **granted** to the extent that the requester's petition is dismissed.

3. Telephone inquiries related to this decision should be directed to Matthew Brooks, Supervisory Patent Examiner, at (571) 272-8112.

Irem Yucel, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,384	07/09/2008	6829672	237325-000005	4170

84310 7590 03/02/2012

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405 Lexington Avenue
New York, NY 10174

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

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 SanDisk Corporation
v.
Netac Technology Co., Ltd.

Reexamination Control No. 95/000,384
Patent 6,829,672
Technology Center 3900

DECISION ON PETITIONS

This is a decision on patent owner's "Expedited Petition to Extend Page Limit for Rebuttal Brief under 37 C.F.R. § 1.183," filed February 17, 2012 (present petition). In the present petition, patent owner requests extension of the 7,000 word limit of 37 C.F.R. §1.943(c) to permit up to 30 pages. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on February 17, 2012.
See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. On July 9, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,829,672.

2. Reexamination was ordered on September 30, 2008, and a non-final Office action was mailed on November 3, 2008.

3. Prosecution was conducted and on September 7, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Patent owner filed a corrected Notice of Appeal on December 3, 2010, appealing the rejections of claims 1-22.

5. Patent owner filed an appellant brief on January 21, 2011.

6. Requester filed a respondent brief on February 21, 2011.

7. On January 17, 2012, an examiner's answer was mailed.

8. Patent owner filed a rebuttal brief on February 17, 2012, that is stated to be no more than 30 pages, and is accompanied by the present petition.

DISCUSSION

In the present petition, patent owner requests extending the limits of 37 C.F.R. § 1.943(c), which limits patent owner's rebuttal brief to fifteen pages or 7,000 words in length. The patent owner's rebuttal brief of February 17, 2012, is stated to be not more than 30 pages. Extension of the limits is requested for the following reasons stated by patent owner:

(1) The examiner issued 52 rejections, over 12 references separately, and in combination, including numerous complex issues.

(2) The examiner's rejections largely adopt the arguments and suggestions provided by the third party requester without narrowing or refining the issues at hand; incorporated by reference and relied upon the

various claim charts and arguments of the requester, which collectively consist of 120 pages; and the Request for *Inter Partes* Reexamination is 99 pages long. As a result, the patent owner is obligated to address each and every argument and suggestion so adopted to avoid waiver.

(3) The examiner failed to discuss the majority of the evidence in the reexamination record, which included 59 separately numbered exhibits submitted by and on behalf of the inventors. This necessitates a lengthy discussion by the patent owner to identify this unconsidered evidence and explain how it supports the inventors' assertions of conception and diligence in reducing the invention to practice.

(4) Patent owner's petition to submit a 60 page appellant brief and requester's petition to submit a 30 page respondent brief were both granted.

(5) The respondent brief disputed all of the issues in the appellant brief and presented a number of additional issues.

(6) The examiner's answer simply adopted the ACP and RAN without narrowing or refining any of the issues.

RELEVANT AUTHORITY

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. § 1.943(c) provides:

> Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in

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

ANALYSIS

Patent owner's rebuttal brief, filed on February 17, 2012, is stated to be no more than 30 pages. It exceeds the page and word limit of 37 C.F.R. § 1.943(c).

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous rejections which are appealed, issues concerning conception and diligence in reduction to practice, as well as separate issues of obviousness. The reasons (1)-(3) set forth *supra,* previously were found in this specific case to provide a persuasive showing that this situation is extraordinary and that justice requires that more pages/words be allotted to the briefs. Since patent owner's appellant brief and the requester's respondent brief were permitted to be twice the length permitted by 37 C.F.R. § 1.943(c), it is deemed equitable similarly to permit the patent owner's rebuttal brief to be up to 30 pages or 14,000 words.

The present petition is **granted,** and the rebuttal brief of February 17, 2012, is entered.

DECISION

In view of the foregoing, the present petition is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,386 > 90/010053	08/01/2008	7223236	7553.70003B	7471

60683 7590 05/07/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/07/2011

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000386 → 90/010053
PATENT NO. : 7223236
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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In re Brown
Inter partes Reexamination Proceeding
Control No: 95/000,386
Filing Date: August 1, 2008
For: U.S. Patent No.: 7,223,236

In re Brown
Ex Parte Reexamination Proceeding
Control No. 90/010,053
Filing Date: November 9, 2007
For: U.S. Patent No. 7,223,236

DECISION DISMISSING PETITION TO TERMINATE MERGED PROCEEDINGS

This decision addresses the following papers:

- The patent owner's December 2, 2010 paper entitled "Notification of Conclusion of Prior or Concurrent Proceeding in *Inter Partes* Reexamination under 37 C.F.R. § 1.985 and Request for Termination of *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)", taken as a petition under 37 CFR 1.182 to terminate the present merged proceeding (the December 2, 2010 patent owner petition);

- The patent owner's January 13, 2011 petition entitled "Petition to Suspend and Transfer Jurisdiction", taken as a petition under 37 CFR 1.182 to suspend the present merged proceeding (the January 13, 2011 patent owner petition); and

- The requester's January 3, 2011 opposition to the December 2, 2010 petition, entitled "Inter partes Third Party Requester's Response to Patent Owner's 02-Dec-2010 Notification and Request for Termination of Inter Partes Reexamination" (the January 3, 2011 *inter partes* requester opposition).

The December 2, 2010 and January 13, 2011 patent owner petitions, the January 3, 2011 *inter partes* requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fees under 37 CFR 1.17(f) for patent owner's December 2, 2010 and January 13, 2011 petitions under 37 CFR 1.182, respectively, have been paid.

SUMMARY

The December 2, 2010 patent owner paper, which is taken as a petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding, is **dismissed**.

The January 13, 2011 patent owner petition, which is taken as a petition under 37 CFR 1.182 to suspend the present merged proceeding until the December 2, 2010 petition has been decided, and to transfer jurisdiction to the Office of Patent Legal Administration, is **dismissed as moot**.

DECISION

The December 2, 2010 Patent Owner Petition and the January 3, 2011 Inter Partes Requester Opposition

The patent owner argues that termination of the present merged proceeding is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,223,236 (the '236 patent), was the subject of a civil action in district court, i.e., *Health Hero Network, Inc. v. Alere Medical, Inc.,* Case No. 1:07-cv-05031, in the United States District Court for the Northern District of Illinois, Eastern Division. In support of its petition to terminate the present merged proceeding, the patent owner submits a copy of a "Notification of Docket Entry" by the

district court, which is a record of a stipulated order of dismissal by the court, and which states (emphasis added):

> MINUTE entry before Honorable Amy J. St. Eve: Pursuant to the parties' joint stipulation, all claims between the parties, *with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement)*, are dismissed with prejudice. All pending dates and deadlines are stricken. Civil case terminated. Mailed notice (kef,)

The patent owner provides evidence that the defendant in the civil action, Alere Medical, Inc., is a wholly owned subsidiary of Inverness Medical Innovations, Inc., who is the real party in interest in the *inter partes* reexamination proceeding control no. 95/000,386.[1] The requester in *ex parte* reexamination proceeding control no. 90/010,053 is Alere Medical, Inc., as stated in the "Request for Ex Parte Reexamination Transmittal Form", filed on November 9, 2007.

Thus, each requester in the merged proceeding was a party, or was in privy with a party, in the civil action, which satisfies item no.1.

Item nos. 2-4, however, have not been satisfied. The stipulated order of dismissal states that all claims are dismissed "*with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement"*. A copy of the parties' settlement agreement has *not* been provided for the record by the patent owner. The patent owner appears to provide a definition of "Field" on page 2 of the December 2, 2010 petition, and further states that "[t]he inclusion of the exception with respect to the "Field" *is believed* to provide for defense of allegations that might be made by an entity that was not a party to the civil action and, therefore, could not be bound by the settlement and/or dismissal with prejudice." Without a copy of the parties' settlement agreement, however, the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised, or could be raised, in the merged proceeding, or whether the court's stated exception refers to an entity that was not a party to the civil action, as argued by the patent owner. Furthermore, as argued by the *inter partes* requester,[2] the issue of invalidity can later be raised "in the defense of an assertion of patent infringement", as stated by the court's order. Therefore, the stipulated order of dismissal, on its face, does not appear to be "final" as to issues which could be raised in the merged proceeding.

For the reasons given above, the present petition fails to satisfy item no. 2.

Regarding item no. 3, the issue of invalidity does not appear to have been actually litigated in the present case. The present case appears to solely involve a dismissal with prejudice (with exceptions, as discussed *infra*). While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later

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[1] See Exhibit C, attached to the present petition. Exhibit C is a paper, entitled "Alere Medical Inc.'s Supplemental Notification of Affiliates Under Local Rule 3.2", filed by the defendant/requester in the litigation. See also page 2 of the requester's January 3, 2011 opposition, in which the requester states that the defendant in the litigation is a subsidiary of the *inter partes* requester.

[2] See the *inter partes* requester's January 3, 2011 opposition.

litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). Furthermore, the patent owner in the present case *points to no language in the court's dismissal or in the related settlement agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue.* Thus, as also argued by the *inter partes* requester in its January 3, 2011 opposition, there is nothing in the documents submitted by the patent owner that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met. Thus, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Health Hero Network* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination, as required by 35 U.S.C. 317(b).

For the reasons given above, the present petition fails to satisfy item no. 3.

Regarding item no. 4, the patent owner has the burden of showing that the prior art and any other issues raised in the merged proceeding were available to the requester/defendant and could have been placed in the litigation. If the joint stipulation reflected in the district court's order was entered at a sufficiently early stage in the litigation, such that the requester could have introduced the prior art and any other issues present in the merged proceeding into the litigation, had the litigation not been terminated by the district court's May 17, 2010 order, then the prior art and any other issues present in the instant merged proceeding "could have been raised" in the litigation proceeding. The patent owner, however, has not provided this showing, such as, for example, a copy of the district court's docket for the litigation.

For the reasons given above, the present petition fails to satisfy item no. 4.

Accordingly, patent owner's December 2, 2010 petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding is **dismissed**.

The Office notes that even if the *inter partes* reexamination proceeding, control no. 95/000,386, would be subsequently terminated, the *ex parte* reexamination proceeding would still continue, since it is not subject to the estoppel provisions of 35 U.S.C. 317.

The January 13, 2011 Patent Owner Petition

The patent owner requests that the Office suspend the present merged proceeding until the December 2, 2010 petition has been decided, and further requests that jurisdiction be transferred to the Office of Patent Legal Administration (OPLA).

In view of the present decision on the December 2, 2010 petition, patent owner's January 13, 2011 petition, which is taken as a petition under 37 CFR 1.182, is **dismissed as moot**.

CONCLUSION

- The December 2, 2010 patent owner petition under 37 CFR 1.182 to terminate the present merged proceeding is **dismissed**.
- The January 13, 2011 patent owner petition under 37 CFR 1.182 to suspend the present merged proceeding and to transfer jurisdiction to OPLA is **dismissed as moot**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

5-05-2011
Kenpet8

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,386 + 90/010053	08/01/2008	7223236	7553.70003B	7471

60683 7590 09/08/2011

HEALTH HERO NETWORK, INC.
2400 GENG ROAD, SUITE 200
PALO ALTO, CA 94303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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Date: 9-8-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING
P.O. BOX 7037
ATLANTA, GA 30357-0037

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000386 → 90/010053
PATENT NO. : 7223236
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 08 2011

CENTRAL REEXAMINATION UNIT

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Palo Alto, CA 94303

Womble, Carlyle, Sandridge & Rice, PLLC (For *Inter Partes* Requester)
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1900 University Avenue
Suite 200
Palo Alto, CA 94303

In re Brown
Inter partes Reexamination Proceeding
Control No: 95/000,386
Filing Date: August 1, 2008
For: U.S. Patent No.: 7,223,236

In re Brown
Ex Parte Reexamination Proceeding
Control No. 90/010,053
Filing Date: November 9, 2007
For: U.S. Patent No. 7,223,236

DECISION DISMISSING PETITION TO TERMINATE MERGED PROCEEDINGS

This decision addresses the following papers:

- The patent owner's July 7, 2011 petition entitled "Renewed Petition Under 37 CFR 1.182 for Termination of Merged Inter Partes and Ex Partes [sic] Reexaminations Pursuant to 35 U.S.C. §317(B) and 37 C.F.R. §1.907(B)" (patent owner's renewed petition to terminate);

- The requester's August 8, 2011 opposition to patent owner's July 7, 2011 petition, entitled "Inter partes Third Party Requester's Response to Patent Owner's 07-Jul-2011 Renewed Petition Under 37 CFR 1.182 for Termination of Merged Inter Partes and Ex Parte Reexaminations Pursuant to 35 U.S.C. §317(B) and 37 C.F.R. §1.907(B)" (the August 8, 2011 *inter partes* requester opposition); and

- The patent owner's September 1, 2011 petition entitled "Petition under 37 CFR 1.182 for an Order to Show Cause Why Documents Cannot Be Submitted" (patent owner's petition for an order to show cause).

The July 7, 2011 and September 1, 2011 patent owner petitions, the August 8, 2011 *inter partes* requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The July 7, 2011 renewed patent owner petition under 37 CFR 1.182 is **dismissed**.

The September 1, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

Inter partes reexamination proceeding control no. 95/000,386 is **not terminated**, and prosecution of the present merged proceeding **will continue**.

DECISION

Patent Owner's July 7, 2011 Renewed Petition under 37 CFR 1.182

In response to the Office's May 7, 2011 decision dismissing patent owner's December 2, 2010 petition to terminate the present merged proceeding, the patent owner renews its petition to terminate, arguing that termination of the present merged proceeding is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

In the renewed petition, the patent owner points out that the Office determined, in its earlier decision of May 5, 2011, that element 1 was satisfied. This determination, which is not contested by the requester, is maintained.

Regarding elements 2-3, the Office determined, in its earlier decision of May 5, 2011, that these elements were not satisfied. Upon reconsideration, this determination is maintained.

Regarding element 2, the stipulated order of dismissal[1] in *Health Hero Network, Inc. v. Alere Medical, Inc.*, Case No. 1:07-cv-05031, in the United States District Court for the Northern District of Illinois, Eastern Division, states that all claims are dismissed "*with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement"*. A copy of the parties' settlement agreement has not been provided for the record by the patent owner. In its December 2, 2011 petition, the patent owner appears to have provided a definition of "Field", and further stated that "[t]he inclusion of the exception with respect to the "Field" *is believed* to provide for defense of allegations that might be made by an entity that was not a party to the civil action and, therefore, could not be bound by the settlement and/or dismissal with prejudice." Without a copy of the parties' settlement agreement, however, the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised, or could have been raised, in the merged proceeding, or whether the court's stated exception refers to an entity that was not a party to the civil action, as argued by the patent owner. Furthermore, as argued by the *inter partes* requester,[2] the issue of invalidity can later be raised "in the defense of an assertion of patent infringement", as stated by the court's order. Therefore, the stipulated order of dismissal, on its face, does not appear to be "final" as to issues which could have been raised in the merged proceeding.

Regarding element 3, the issue of invalidity does not appear to have been actually litigated in the present case. The present case appears to solely involve a dismissal with prejudice (with exceptions, as discussed *infra*). While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). Furthermore, the patent owner in the present case *points to no language in the court's dismissal or in the related settlement agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue*. Thus, as also argued by the *inter partes* requester in its January 3, 2011 opposition, there is nothing in the documents submitted by the patent owner that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met. Thus, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Health Hero Network* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination, as required by 35 U.S.C. 317(b).

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[1] The stipulated order of dismissal, which is included in the court's "Notification of Docket Entry", states (emphasis added):

> MINUTE entry before Honorable Amy J. St. Eve: Pursuant to the parties' joint stipulation, all claims between the parties, *with the exception of any claim that has been raised or could be raised in the defense of an assertion of patent infringement in the "Field" (as that term is defined in the Parties' Settlement Agreement)*, are dismissed with prejudice. All pending dates and deadlines are stricken. Civil case terminated. Mailed notice (kef)

[2] See the *inter partes* requester's January 3, 2011 and August 8, 2011 oppositions.

With respect to elements 2 and 3, the patent owner newly asserts, in its renewed petition, that it is unable to submit a copy of the parties' settlement agreement because the agreement is designated "confidential/attorney eyes only", and therefore cannot be disclosed without the consent of the requester. The patent owner newly requests the Office to issue a show cause order "setting a time period and specific information requests to facilitate an agreement between both the Patent Owner and the 3rd party requester with respect to which portions of the parties' settlement agreement may be submitted to Office [sic] to meet the information request".

However, where, as here, it is not clear whether the court's decision is final, the burden is on the patent owner, and not on the Office, to show that the court's stipulated order is a final decision, i.e., that all appeals have been exhausted. In this instance, the patent owner can submit its request to the court to facilitate the agreement between the parties with respect to which portions of the parties' settlement agreement may be submitted to the Office (see, *infra*, the discussion of patent owner's September 1, 2011 petition). The patent owner may then submit the court's decision, and any redacted settlement agreement permitted by the court, to the Office.

Furthermore, regarding element 3, even with a copy of the settlement agreement, there is nothing of record showing that the court's order amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the civil action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met.

For the reasons given above, elements 2 and 3 have not been shown to be satisfied by the present renewed petition.

Regarding element 4, the Office determined, in its May 7, 2011 decision, that this element was not satisfied. However, the patent owner has now submitted, with its present renewed petition, a copy of the district court's docket, showing that the district court's order was entered at a sufficiently early stage in the litigation, such that the requester could have introduced the prior art and any other issues present in the merged proceeding into the litigation, had the litigation not been terminated by the district court's May 17, 2010 order. Furthermore, the requester, in its August 8, 2011 opposition, states that it does not dispute that this element has been satisfied. Thus, the patent owner has sufficiently shown that the prior art and any other issues present in the instant merged proceeding were either raised or could have been raised by the requester in the civil action.

For the reasons given above, element 4 has been shown to be satisfied by the present renewed petition.

In summary, elements 1 and 4 have been shown to be satisfied, and elements 2 and 3 have not been shown to be satisfied.

For the first time, in its July 7, 2011 renewed petition, the patent owner newly raised the issue of whether it is able to submit the parties' settlement agreement to the Office, and newly requested the Office to issue a show cause order. Patent owner's submission on September 1, 2011 of a separate petition under 37 CFR 1.182 for an order to show cause, which is addressed *infra*,

provides evidence that patent owner agrees that the request to issue a show cause order, and the issue of its ability to submit the parties' settlement agreement to the Office, is newly raised, requiring a separate petition. For this reason, patent owner's July 7, 2011 renewed petition is dismissed, rather than denied.

Accordingly, patent owner's July 7, 2011 renewed petition under 37 CFR 1.182 to terminate the present merged reexamination proceeding is **dismissed**.

The patent owner also requests reconsideration of whether the *ex parte* reexamination proceeding would still continue even if the *inter partes* reexamination proceeding were to be terminated. In particular, the patent owner requests that the basis for the severance be fully explained. The patent owner points to 37 CFR 1.565(c), and specifically to 37 CFR 1.989(b), which states that the merged proceeding is governed by 37 CFR 1.902 through 1.997. The patent owner argues that the present merged proceeding is thus governed by 37 CFR 1.907, which provides for termination of the reexamination proceeding. The patent owner further argues that *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d (Fed. Cir. 1988) "does not appear to be dispositive, because the court in *Ethicon* does not appear to have been dealing with a merged proceeding as here".

However, the Office has determined, in the present decision, that the patent owner has not provided a sufficient showing that the provisions of 35 U.S.C. 317(b) have been met. For this reason, the present *inter partes* reexamination proceeding will not be terminated.

Regarding the requested explanation of the basis for the severance of the merged proceeding in the event that the *inter partes* reexamination proceeding were to be terminated, which is not the case here, note that an *ex parte* reexamination proceeding is not subject to the estoppel provisions of 35 U.S.C. 317, which specifically govern *inter partes* reexamination proceedings. 37 CFR 1.907, which tracks the statutory language, only applies to *inter partes* reexamination proceedings, including the present *inter partes* reexamination proceeding that is part of the present merged proceeding. Thus, if an *inter partes* reexamination proceeding, that is merged with an *ex parte* reexamination proceeding, were to be terminated, the merger would be severed, and the *ex parte* reexamination proceeding would continue. Furthermore, regarding the newly severed *ex parte* reexamination proceeding, *Ethicon* is dispositive. The court in *Ethicon* expressly held that the Office is not bound by a court's decision upholding a patent's validity:

> To the extent that [former] MPEP § 2286 states that the PTO is bound by a court's decision upholding a patent's validity, it is incorrect.

The *Ethicon* court noted that the district courts and the Office use different standards of proof in determining invalidity, and thus, on the same evidence, could quite correctly come to different conclusions. Specifically, invalidity in a district court must be shown by "clear and convincing" evidence, whereas in the Office, it is sufficient to show unpatentability by a "preponderance of the evidence." If sufficient reasons are present, claims held valid by the court may be rejected in an *ex parte* reexamination proceeding. See current MPEP 2286.

Thus, even if the present *inter partes* reexamination proceeding, control no. 95/000,386, were to be terminated, which is not the case here, the present *ex parte* reexamination proceeding, control

no. 90/010,053, would still continue. In any event, the present *inter partes* reexamination proceeding is **not terminated**, and prosecution of the present merged proceeding **will continue**.

Patent Owner's September 1, 2011 Petition Under 37 CFR 1.182

Patent owner requests that the Office issue an order to show cause, "setting a time period and specific information requests to facilitate an agreement between both the Patent Owner and the 3rd party requester with respect to which portions of the parties' settlement agreement may be submitted to the Office to meet the information request". However, as stated *supra*, the patent owner can easily submit its request to the court to facilitate the agreement between the parties with respect to which portions of the parties' settlement agreement may be submitted to the Office. The patent owner may then submit the court's decision, and any redacted settlement agreement permitted by the court, to the Office.

The patent owner has its remedy in court, and the Office will follow the court's decision. It is inappropriate to request that the Office resolve an issue that should properly be before the court.

Accordingly, patent owner's September 1, 2011 petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

- The July 7, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- The September 1, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- *Inter partes* reexamination proceeding control no. 95/000,386 is **not terminated**, and prosecution of the present merged proceeding **will continue**.
- Any further correspondence with respect to this matter should be addressed as follows:

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

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

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

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

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

9-06-2011

United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

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Black Lowe & Graham, PLLC (Courtesy Copy)
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In re Brown et al	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,396	:	**ON**
Filing Date: September 23, 2008	:	**PETITION**
For: U.S. Patent No.: 6,516,236	:	

This decision addresses:

- The patent owner petition under 37 CFR 1.182, filed on September 28, 2010, entitled "Petition Requesting Termination of the Reexamination Proceedings"(the September 28, 2010 patent owner petition);

- The patent owner paper, filed on October 8, 2010, entitled "Patent Owner's Request to Withdraw Its Petition Filed on September 28, 2010" (the October 8, 2010 request to withdraw the September 28, 2010 petition);

- The *sua sponte* analysis by the Office whether to terminate the present proceeding; and

- The power of attorney filed by the patent owner on January 27, 2009 (the January 27, 2009 power of attorney).

The September 28, 2010 patent owner petition, the October 8, 2010 request to withdraw the September 28, 2010 petition, the January 27, 2009 power of attorney, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

SUMMARY

The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b). Accordingly, the present proceeding **will not be terminated**, and **prosecution will continue** in due course.

The January 27, 2009 power of attorney is **ineffective**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

37 CFR 1.907(b) provides:

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

DECISION

I. The September 28, 2010 Patent Owner Petition is Withdrawn, and the October 8, 2010 Patent Owner Request Is Granted-In-Part

The patent owner requests, in its October 8, 2010 paper, that the September 28, 2010 petition to terminate the present proceeding be withdrawn. The Office, via this decision, has *sua sponte* determined not to terminate the present proceeding for the reasons discussed *infra*. Consequently, there is no reason why patent owner's October 8, 2010 request to withdraw its September 28, 2010 petition should not be granted. Accordingly, the September 28, 2010 patent owner petition is withdrawn, and will not be considered.

The patent owner, however, has also requested, in its October 8, 2010 paper, that the September 28, 2010 petition be expunged from the record. Such a request must be filed as a petition under 37 CFR 1.183, and must be accompanied by a showing of the extraordinary circumstances, such that justice requires expungement of the September 28, 2010 petition, as well as the $400 petition fee. The patent owner, however, has not filed a petition under 37 CFR 1.183, and has not provided any showing of extraordinary circumstances. For these reasons, the September 28, 2010 patent owner petition, although it is withdrawn, will not be expunged from the record, and will remain in the file. The September 28, 2010 patent owner petition, however, will not be considered.

The patent owner has also requested, in its October 8, 2010 paper, a refund of the petition fee for the September 28, 2010 petition. A request for a refund, however, must be filed separately pursuant to 37 CFR 1.4(c), which 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.

Furthermore, the patent owner is reminded of the provisions of 37 CFR 1.26(a), which provide, in pertinent part:

> . . . A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid . . . will not entitle a party to a refund of such fee.

The patent owner, in its October 8, 2010 paper, requests a refund of the fee for the petition, the withdrawal of which is also requested by the patent owner in the same paper. Pursuant to 37 CFR 1.26(a), however, a party who wishes to withdraw a paper, i.e., a filing, for which the fee was paid, is not entitled to a refund of such fee. For these reasons, patent owner's October 8, 2010 request for refund is **dismissed**.

Accordingly, the October 8, 2010 patent owner request is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

II. *Sua Sponte* Analysis Whether the Proceeding Will Not Be Terminated

The September 28, 2010 patent owner petition has drawn the Office's attention to the issue of whether the present proceeding should be terminated under 35 U.S.C. 317(b), in view of two orders by the United States District Court, Eastern District of Texas Marshall Division (the district court's orders), dismissing, with prejudice, all claims and counterclaims in suit, and directing that the parties shall bear their own costs. See *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009).

The district court's two orders, however, also grant "the parties' Joint Motions to Vacate the Court's October 19, 2009 Order" (D. E. 204 and D.E. 23, respectively), "Reopen the Case, and then Dismiss the Case with Prejudice". To date, however, the Office has not received copies of the parties' joint motions to vacate, and of the court's October 19, 2009 order. These copies are necessary to determine whether the court, or the parties, intended the dismissal to resolve the issue of invalidity of at least one claim of the patent under reexamination.

The first sentence of 35 U.S.C. 317(b) provides, in pertinent part (emphasis added):

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

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

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

The Third Party Requester Was a Party to the Litigation

The patent owner has provided copies of two orders by the United States District Court for the Eastern District of Texas, Marshall Division (district court) on November 20, 2009, between the patent owner/plaintiff, ROY-G-BIV, and requester/co-defendant GE Fanuc Intelligent Platforms, Inc., the real party in interest in the present reexamination proceeding. [1] Thus, the third party requester was a party in the litigation.

[1] See Exhibit 2, attached to the present petition.

The Decision is Final

In *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009), the district court ordered that "Plaintiff ROY-G-BIV Corporations claims are DISMISSED WITH PREJUDICE and Defendants . . . GE Fanuc Intelligent Platforms, Inc.'s counterclaims are DISMISSED WITH PREJUDICE . . ." , and that each party should bear its own attorney's fees and costs.

In view of the specific facts and circumstances of the present case, the November 20, 2009 district court judgment is order to be a final decision within the meaning of the statute.

There Is No Decision That Requester/Co-defendant Did Not Sustain Its Burden of Proving the Invalidity of Any Patent Claim in Suit

Office records fail to reveal any evidence that the issue of invalidity of at least one claim of the patent under reexamination was resolved by the court's decision. The present record only includes copies of the district court's dismissal with prejudice. While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). <u>There is no language in the court's orders that suggest that the parties, or the court, intended the dismissal to resolve the invalidity issue</u>. Thus, there is nothing in the documents of record that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving invalidity had not been met.

For the reasons given above, there is no evidence of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination. Thus, Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b).

The Office Need Not Address Whether Issues Raised in the Reexamination Proceeding Are Identical to Those Raised or Could Have Been Raised in Litigation

Because there is no evidence of record of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination as required by statute, the Office need not address whether the issues raised in the reexamination proceeding are identical to those which were raised or could have been raised in the earlier litigation.

Accordingly, the present proceeding **<u>will not be terminated</u>**, and **<u>prosecution will continue</u>** in due course.[2]

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[2] The Office notes that the patent owner, in its September 28, 2010 petition, calls attention to reexamination control no. 95/000,186, in which the Office granted a petition to terminate the reexamination proceeding. In 95/000,186,

III. The January 27, 2009 Power of Attorney by the Patent Owner is Ineffective

The official correspondence address for the patent owner in a reexamination proceeding is the correspondence address which is recorded *in the patent file*. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, i.e., the file for application no. 10/021,669. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file appears in the caption of this decision.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 27, 2009 power of attorney by the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/021,669, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as it appears in the caption of this decision.

CONCLUSION

- The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**.
- The September 28, 2010 patent owner petition **will not be expunged** from the record, and **will remain in the file**.
- The patent owner's request for refund is **dismissed**.
- The present proceeding **will not be terminated**, and **prosecution will continue** in due course.

---

however, the court's consent judgment expressly stated that the requester/defendant "agrees that [the patent under reexamination is] "valid and enforceable". Thus, the court's consent judgment in 95/000,186 essentially states that the requester/codefendant did not sustain its burden of proving the invalidity of the claims in suit. In the present case, the court's order does not contain such a statement. The patent owner also calls attention to reexamination control no. 95/000,274, in which guidance was expressly provided for filing a petition to terminate a reexamination proceeding, i.e., that the showing must be adequate to establish whether the third party requester has not sustained its burden of proving the invalidity of any patent claim in suit (see page 7 of the October 8, 2008 "Decision Dismissing Petition to Sever Proceedings and Granting Partial Waiver of 37 CFR 1.955" in 95/000,274). By contrast, as explained *supra*, there is nothing in the documents of record in the present proceeding that amounts to a final decision by a federal court that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Finally, the patent owner calls attention to reexamination control no. 95/000,163, in which the Office granted a petition to terminate the reexamination proceeding. Office records, however, fail to include a copy of the court's order of dismissal in the file of 95/000,163. In any event, to whatever extent that the present decision differs from the earlier decision rendered in 95/000,163, Office policy regarding termination of *inter partes* reexamination proceedings has been reevaluated in light of relevant case law, since the date of mailing of the earlier decision.

- The January 27, 2009 power of attorney is **ineffective**. A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 27, 2009 power of attorney.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/021,669, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as it appears in the caption of this decision.

- The present proceeding is being referred to the Central Reexamination Unit (CRU) for further consideration in due course.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

/ Kenneth M. Schor /

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

1-25-11
Kenpet8/

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,397	09/23/2008	6941543	RGRX-6-1009	3058

25315 7590 01/26/2011

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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ST. LOUIS, MO 63102-2740

Date:

MAILED

JAN 26 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000397
PATENT NO. : 6941543
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
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William J. Zychlewicz (For Requester)
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MAILED
JAN 26 2011
CENTRAL REEXAMINATION UNIT

Black Lowe & Graham, PLLC (For Patent Owner)
701 Fifth Avenue
Suite 4800
Seattle, WA 98104

In re Brown et al	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,397	:	**ON**
Filing Date: September 23, 2008	:	**PETITION**
For: U.S. Patent No.: 6,941,543	:	

This decision addresses:

- The patent owner petition under 37 CFR 1.182, filed on September 28, 2010, entitled "Petition Requesting Termination of the Reexamination Proceedings"(the September 28, 2010 patent owner petition);

- The patent owner paper, filed on October 8, 2010, entitled "Patent Owner's Request to Withdraw Its Petition Filed on September 28, 2010" (the October 8, 2010 request to withdraw the September 28, 2010 petition); and

- The *sua sponte* analysis by the Office whether to terminate the present proceeding.

The September 28, 2010 patent owner petition, the October 8, 2010 request to withdraw the September 28, 2010 petition, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

SUMMARY

The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b). Accordingly, the present proceeding **will not be terminated**, and **prosecution will continue** in due course.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

37 CFR 1.907(b) provides:

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

DECISION

I. The September 28, 2010 Patent Owner Petition is Withdrawn, and the October 8, 2010 Patent Owner Request Is Granted-In-Part

The patent owner requests, in its October 8, 2010 paper, that the September 28, 2010 petition to terminate the present proceeding be withdrawn. The Office, via this decision, has *sua sponte* determined not to terminate the present proceeding for the reasons discussed *infra*. Consequently, there is no reason why patent owner's October 8, 2010 request to withdraw its September 28, 2010 petition should not be granted. Accordingly, the September 28, 2010 patent owner petition is withdrawn, and will not be considered.

The patent owner, however, has also requested, in its October 8, 2010 paper, that the September 28, 2010 petition be expunged from the record. Such a request must be filed as a petition under

37 CFR 1.183, and must be accompanied by a showing of the extraordinary circumstances, such that justice requires expungement of the September 28, 2010 petition, as well as the $400 petition fee. The patent owner, however, has not filed a petition under 37 CFR 1.183, and has not provided any showing of extraordinary circumstances. For these reasons, the September 28, 2010 patent owner petition, although it is withdrawn, will not be expunged from the record, and will remain in the file. The September 28, 2010 patent owner petition, however, will not be considered.

The patent owner has also requested, in its October 8, 2010 paper, a refund of the petition fee for the September 28, 2010 petition. A request for a refund, however, must be filed separately pursuant to 37 CFR 1.4(c), which 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.

Furthermore, the patent owner is reminded of the provisions of 37 CFR 1.26(a), which provide, in pertinent part:

> . . . A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid . . . will not entitle a party to a refund of such fee.

The patent owner, in its October 8, 2010 paper, requests a refund of the fee for the petition, the withdrawal of which is also requested by the patent owner in the same paper. Pursuant to 37 CFR 1.26(a), however, a party who wishes to withdraw a paper, i.e., a filing, for which the fee was paid, is not entitled to a refund of such fee. For these reasons, patent owner's October 8, 2010 request for refund is **dismissed**.

Accordingly, the October 8, 2010 patent owner request is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

II. *Sua Sponte* Analysis Whether the Proceeding Will Not Be Terminated

The September 28, 2010 patent owner petition has drawn the Office's attention to the issue of whether the present proceeding should be terminated under 35 U.S.C. 317(b), in view of two orders by the United States District Court, Eastern District of Texas Marshall Division (the district court's orders), dismissing, with prejudice, all claims and counterclaims in suit, and directing that the parties shall bear their own costs. See *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009).

The district court's two orders, however, also grant "the parties' Joint Motions to Vacate the Court's October 19, 2009 Order" (D. E. 204 and D.E. 23, respectively), "Reopen the Case, and then Dismiss the Case with Prejudice". To date, however, the Office has not received copies of the parties' joint motions to vacate, and of the court's October 19, 2009 order. These copies are

necessary to determine whether the court, or the parties, intended the dismissal to resolve the issue of invalidity of at least one claim of the patent under reexamination.

The first sentence of 35 U.S.C. 317(b) provides, in pertinent part (emphasis added):

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

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

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

The Third Party Requester Was a Party to the Litigation

The patent owner has provided copies of two orders by the United States District Court for the Eastern District of Texas, Marshall Division (district court) on November 20, 2009, between the patent owner/plaintiff, ROY-G-BIV, and requester/co-defendant GE Fanuc Intelligent Platforms, Inc., the real party in interest in the present reexamination proceeding. [1] Thus, the third party requester was a party in the litigation.

The Decision is Final

In *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009), the district court ordered that "Plaintiff ROY-G-BIV Corporations claims are DISMISSED WITH PREJUDICE and Defendants . . . GE Fanuc Intelligent Platforms, Inc.'s counterclaims are DISMISSED WITH PREJUDICE . . .", and that each party should bear its own attorney's fees and costs.

In view of the specific facts and circumstances of the present case, the November 20, 2009 district court judgment is order to be a final decision within the meaning of the statute.

There Is No Decision That Requester/Co-defendant Did Not Sustain Its Burden of Proving the Invalidity of Any Patent Claim in Suit

Office records fail to reveal any evidence that the issue of invalidity of at least one claim of the patent under reexamination was resolved by the court's decision. The present record only

[1] See Exhibit 2, attached to the present petition.

includes copies of the district court's dismissal with prejudice. While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). There is no language in the court's orders that suggest that the parties, or the court, intended the dismissal to resolve the invalidity issue. Thus, there is nothing in the documents of record that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving invalidity had not been met.

For the reasons given above, there is no evidence of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination. Thus, Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b).

The Office Need Not Address Whether Issues Raised in the Reexamination Proceeding Are Identical to Those Raised or Could Have Been Raised in Litigation

Because there is no evidence of record of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination as required by statute, the Office need not address whether the issues raised in the reexamination proceeding are identical to those which were raised or could have been raised in the earlier litigation.

Accordingly, the present proceeding **will not be terminated**, and **prosecution will continue** in due course.[2]

---

[2] The Office notes that the patent owner, in its September 28, 2010 petition, calls attention to reexamination control no. 95/000,186, in which the Office granted a petition to terminate the reexamination proceeding. In 95/000,186, however, the court's consent judgment expressly stated that the requester/defendant "agrees that [the patent under reexamination is] "valid and enforceable". Thus, the court's consent judgment in 95/000,186 essentially states that the requester/codefendant did not sustain its burden of proving the invalidity of the claims in suit. In the present case, the court's order does not contain such a statement. The patent owner also calls attention to reexamination control no. 95/000,274, in which guidance was expressly provided for filing a petition to terminate a reexamination proceeding, i.e., that the showing must be adequate to establish whether the third party requester has not sustained its burden of proving the invalidity of any patent claim in suit (see page 7 of the October 8, 2008 "Decision Dismissing Petition to Sever Proceedings and Granting Partial Waiver of 37 CFR 1.955" in 95/000,274). By contrast, as explained *supra*, there is nothing in the documents of record in the present proceeding that amounts to a final decision by a federal court that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Finally, the patent owner calls attention to reexamination control no. 95/000,163, in which the Office granted a petition to terminate the reexamination proceeding. Office records, however, fail to include a copy of the court's order of dismissal in the file of 95/000,163. In any event, to whatever extent that the present decision differs from the earlier decision rendered in 95/000,163, Office policy regarding termination of *inter partes* reexamination proceedings has been reevaluated in light of relevant case law, since the date of mailing of the earlier decision.

CONCLUSION

- The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**.

- The September 28, 2010 patent owner petition **will not be expunged** from the record, and **will remain in the file**.

- The patent owner's request for refund is **dismissed**.

- The present proceeding **will not be terminated**, and **prosecution will continue** in due course.

- The present proceeding is being referred to the Central Reexamination Unit (CRU) for further consideration in due course.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

/ Kenneth M. Schor /

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

1-25-11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,398	09/23/2008	6513058	RGRX-6-1007	3059

25315 7590 01/26/2011

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SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2011

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MAILED

JAN 26 2011

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Seattle, WA 98104

In re Brown et al	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,398	:	**ON**
Filing Date: September 23, 2008	:	**PETITION**
For: U.S. Patent No.: 6,513,058	:	

This decision addresses:

- The patent owner petition under 37 CFR 1.182, filed on September 28, 2010, entitled "Petition Requesting Termination of the Reexamination Proceedings"(the September 28, 2010 patent owner petition);

- The patent owner paper, filed on October 8, 2010, entitled "Patent Owner's Request to Withdraw Its Petition Filed on September 28, 2010" (the October 8, 2010 request to withdraw the September 28, 2010 petition);

- The *sua sponte* analysis by the Office whether to terminate the present proceeding; and

- The power of attorney filed by the patent owner on January 27, 2009 (the January 27, 2009 power of attorney).

The September 28, 2010 patent owner petition, the October 8, 2010 request to withdraw the September 28, 2010 petition, the January 27, 2009 power of attorney, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

SUMMARY

The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b). Accordingly, the present proceeding **will not be terminated**, and **prosecution will continue** in due course.

The January 27, 2009 power of attorney is **ineffective**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

37 CFR 1.907(b) provides:

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

DECISION

I. The September 28, 2010 Patent Owner Petition is Withdrawn, and the October 8, 2010 Patent Owner Request Is Granted-In-Part

The patent owner requests, in its October 8, 2010 paper, that the September 28, 2010 petition to terminate the present proceeding be withdrawn. The Office, via this decision, has *sua sponte* determined not to terminate the present proceeding for the reasons discussed *infra*. Consequently, there is no reason why patent owner's October 8, 2010 request to withdraw its September 28, 2010 petition should not be granted. Accordingly, the September 28, 2010 patent owner petition is withdrawn, and will not be considered.

The patent owner, however, has also requested, in its October 8, 2010 paper, that the September 28, 2010 petition be expunged from the record. Such a request must be filed as a petition under 37 CFR 1.183, and must be accompanied by a showing of the extraordinary circumstances, such that justice requires expungement of the September 28, 2010 petition, as well as the $400 petition fee. The patent owner, however, has not filed a petition under 37 CFR 1.183, and has not provided any showing of extraordinary circumstances. For these reasons, the September 28, 2010 patent owner petition, although it is withdrawn, will not be expunged from the record, and will remain in the file. The September 28, 2010 patent owner petition, however, will not be considered.

The patent owner has also requested, in its October 8, 2010 paper, a refund of the petition fee for the September 28, 2010 petition. A request for a refund, however, must be filed separately pursuant to 37 CFR 1.4(c), which 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.

Furthermore, the patent owner is reminded of the provisions of 37 CFR 1.26(a), which provide, in pertinent part:

> . . . A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid . . . will not entitle a party to a refund of such fee.

The patent owner, in its October 8, 2010 paper, requests a refund of the fee for the petition, the withdrawal of which is also requested by the patent owner in the same paper. Pursuant to 37 CFR 1.26(a), however, a party who wishes to withdraw a paper, i.e., a filing, for which the fee was paid, is not entitled to a refund of such fee. For these reasons, patent owner's October 8, 2010 request for refund is **dismissed**.

Accordingly, the October 8, 2010 patent owner request is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**. The September 28, 2010 patent owner petition, however, **will not be expunged** from the record, and **will remain in the file**. The patent owner's request for refund is **dismissed**.

II. *Sua Sponte* Analysis Whether the Proceeding Will Not Be Terminated

The September 28, 2010 patent owner petition has drawn the Office's attention to the issue of whether the present proceeding should be terminated under 35 U.S.C. 317(b), in view of two orders by the United States District Court, Eastern District of Texas Marshall Division (the district court's orders), dismissing, with prejudice, all claims and counterclaims in suit, and directing that the parties shall bear their own costs. See *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009).

The district court's two orders, however, also grant "the parties' Joint Motions to Vacate the Court's October 19, 2009 Order" (D. E. 204 and D.E. 23, respectively), "Reopen the Case, and then Dismiss the Case with Prejudice". To date, however, the Office has not received copies of the parties' joint motions to vacate, and of the court's October 19, 2009 order. These copies are necessary to determine whether the court, or the parties, intended the dismissal to resolve the issue of invalidity of at least one claim of the patent under reexamination.

The first sentence of 35 U.S.C. 317(b) provides, in pertinent part (emphasis added):

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

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

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

The Third Party Requester Was a Party to the Litigation

The patent owner has provided copies of two orders by the United States District Court for the Eastern District of Texas, Marshall Division (district court) on November 20, 2009, between the patent owner/plaintiff, ROY-G-BIV, and requester/co-defendant GE Fanuc Intelligent Platforms, Inc., the real party in interest in the present reexamination proceeding. [1] Thus, the third party requester was a party in the litigation.

[1] See Exhibit 2, attached to the present petition.

The Decision is Final

In *ROY-G-BIV Corporation v. FANUC Ltd. et al*, Case No. 2:07-CV-418-DF (E.D. Texas, November 20, 2009), the district court ordered that "Plaintiff ROY-G-BIV Corporations claims are DISMISSED WITH PREJUDICE and Defendants . . . GE Fanuc Intelligent Platforms, Inc.'s counterclaims are DISMISSED WITH PREJUDICE . . .", and that each party should bear its own attorney's fees and costs.

In view of the specific facts and circumstances of the present case, the November 20, 2009 district court judgment is order to be a final decision within the meaning of the statute.

There Is No Decision That Requester/Co-defendant Did Not Sustain Its Burden of Proving the Invalidity of Any Patent Claim in Suit

Office records fail to reveal any evidence that the issue of invalidity of at least one claim of the patent under reexamination was resolved by the court's decision. The present record only includes copies of the district court's dismissal with prejudice. While such a dismissal will bar a subsequent suit, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, *Federal Practice and Procedure*, § 2373 (2008). <u>There is no language in the court's orders that suggest that the parties, or the court, intended the dismissal to resolve the invalidity issue</u>. Thus, there is nothing in the documents of record that amounts to a decision that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Instead, the action appears to have been dismissed without there ever being an assessment of whether the party sustained its burden, and without the parties agreeing, through a stipulated judgment or otherwise, that the burden of proving invalidity had not been met.

For the reasons given above, there is no evidence of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination. Thus, Office records fail to show that, under the present facts and circumstances, termination of the present proceeding is mandated by 35 U.S.C. 317(b).

The Office Need Not Address Whether Issues Raised in the Reexamination Proceeding Are Identical to Those Raised or Could Have Been Raised in Litigation

Because there is no evidence of record of a final decision by a federal court that the requester/co-defendant in *ROY-G-BIV Corporation* did not sustain its burden of proving invalidity of any claim in suit of the patent under reexamination as required by statute, the Office need not address whether the issues raised in the reexamination proceeding are identical to those which were raised or could have been raised in the earlier litigation.

Accordingly, the present proceeding **<u>will not be terminated</u>**, and **<u>prosecution will continue</u>** in due course.[2]

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[2] The Office notes that the patent owner, in its September 28, 2010 petition, calls attention to reexamination control no. 95/000,186, in which the Office granted a petition to terminate the reexamination proceeding. In 95/000,186,

III. The January 27, 2009 Power of Attorney by the Patent Owner is Ineffective

The official correspondence address for the patent owner in a reexamination proceeding is the correspondence address which is recorded *in the patent file*. See 37 CFR 1.33(c) and MPEP 2622. Office records fail to reveal that a change of correspondence address was received in the patent file, i.e., the file for application no. 09/795,777. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file appears in the caption of this decision.

A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 27, 2009 power of attorney by the patent owner. In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/795,777, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as it appears in the caption of this decision.

CONCLUSION

- The October 8, 2010 patent owner request to withdraw the September 28, 2010 petition is **granted-in-part**, to the extent that the September 28, 2010 patent owner petition is **withdrawn**, and **will not be considered**.
- The September 28, 2010 patent owner petition **will not be expunged** from the record, and **will remain in the file**.
- The patent owner's request for refund is **dismissed**.
- The present proceeding **will not be terminated**, and **prosecution will continue** in due course.

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however, the court's consent judgment expressly stated that the requester/defendant "agrees that [the patent under reexamination is] "valid and enforceable". Thus, the court's consent judgment in 95/000,186 essentially states that the requester/codefendant did not sustain its burden of proving the invalidity of the claims in suit. In the present case, the court's order does not contain such a statement. The patent owner also calls attention to reexamination control no. 95/000,274, in which guidance was expressly provided for filing a petition to terminate a reexamination proceeding, i.e., that the showing must be adequate to establish whether the third party requester has not sustained its burden of proving the invalidity of any patent claim in suit (see page 7 of the October 8, 2008 "Decision Dismissing Petition to Sever Proceedings and Granting Partial Waiver of 37 CFR 1.955" in 95/000,274). By contrast, as explained *supra*, there is nothing in the documents of record in the present proceeding that amounts to a final decision by a federal court that the requester/party did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. 317(b). Finally, the patent owner calls attention to reexamination control no. 95/000,163, in which the Office granted a petition to terminate the reexamination proceeding. Office records, however, fail to include a copy of the court's order of dismissal in the file of 95/000,163. In any event, to whatever extent that the present decision differs from the earlier decision rendered in 95/000,163, Office policy regarding termination of *inter partes* reexamination proceedings has been reevaluated in light of relevant case law, since the date of mailing of the earlier decision.

- The January 27, 2009 power of attorney is **ineffective**. A courtesy copy of this decision will be mailed to the correspondence address indicated on the January 27, 2009 power of attorney.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/795,777, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as it appears in the caption of this decision.

- The present proceeding is being referred to the Central Reexamination Unit (CRU) for further consideration in due course.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

/ Kenneth M. Schor /

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

1-25-11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,402	01/26/2009	6,442,573 B1	F0657.70000US00	1370

22804 7590 09/15/2010

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES, CA 90067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

MAILED

SEP 15 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000402
PATENT NO. : 6442573
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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SEP 15 2010

CENTRAL REEXAMINATION UNIT

THE HECKER LAW GROUP
1925 CENTURY PARK EAST
SUITE 2300
LOS ANGELES CA 90067

(For Patent Owner)

HUNTER D. KEETON
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(For Third Party Requester)

In re Schiller et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,402
Filed: January 26, 2009
For: U.S. Patent No. 6,442,573

DECISION GRANTING PETITION UNDER § 1.183

This is a decision on the September 9, 2010 patent owner petition pursuant to 37 C.F.R. § 1.183 requesting waiver of the rules for extension of time to file an appellant's brief.

The patent owner petition is before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.183 is **granted**.

BACKGROUND

- On January 26, 2009, a corrected request for *inter partes* reexamination of U.S. Patent Number 6,442,573 B1, originally submitted on October 15, 2008, by third party requester Frame Media Inc. was accorded a filing date, and the resulting reexamination proceeding was assigned control number 95/000,402 ("the '402 proceeding").

- Prosecution progressed until, on May 4, 2010, a Right of Appeal Notice was issued by the Office. The Notice refused entry of a December 31, 2009 amendment and affidavit as noncompliant with § 1.116, and refused entry of patent owner comments submitted on December 31, 2009 as not addressing issues raised in a December 4, 2009 ACP.

- On June 4, 2010, patent owner filed the following petitions:
    - A petition entitled "PETITION PURSUANT TO 37 CFR 1.181 REQUESTING RECONSIDERATION OF THE EXAMINER'S EXPUNGEMENT OF THE PATENT OWNER'S RESPONSE UNDER 37 CFR 1.951 TO THE ACTION CLOSING PROSECUTION."
    - A petition filed under 37 C.F.R. § 1.183, requesting entry of a corrected claim amendment, entry of a correctly scanned affidavit, and extension of time to file an appeal brief.
- Also on June 4, 2010, Notices of Appeal were filed by both the patent owner and the third party requester.
- On July 27, 2010, the Office issued a decision granting the June 4, 2010 patent owner petition to the extent that waived § 41.66(a) to the extent that the time for to file both the patent owner and third party requester Appellant's Briefs was extended to run 30 days from the previously extended due date; i.e., through September 17, 2010.
- On September 9, 2010, patent owner filed the instant petition seeking relief under § 1.183 to permit an extension of time to file an Appellant's Brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 314 (c) states:

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

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.37 states, in pertinent part:

> (a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

> (e) The time periods set forth in this section **are extendable under** the provisions of § 1.136 of this title for patent applications and **§ 1.550(c) of this title for ex parte reexamination proceedings**. (Emphasis added)

37 C.F.R. § 41.61(b) states:

> (1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
> (2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 C.F.R. § 41.66 states, in pertinent part: .

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on September 9, 2010. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for "waiver the deadline for filing an appeal brief." Petition at 1. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended.

Pursuant to 37 C.F.R. § 41.66(a), the time for filing an appellant's brief is two months from the expiration of the time for filing (by the last party entitled to do so) a Notice of appeal or Notice of cross appeal. Once a party has filed a Notice of appeal, the other party has a 14 day period in which to file a Notice of cross-appeal, pursuant to § 41.61(b). In the present proceeding, Notices of appeal were filed by both parties on June 4, 2010. Therefore, the time for patent owner petitioner to file an Appellant's Brief was due to expire on August 18, 2010. In a July 27, 2010 decision, the Office waived § 41.66(a) to the extent that the time for to file both the patent owner and third party requester Appellant's Briefs was extended to run 30 days from the previous due date; i.e., through September 17, 2010. The outstanding petition under 37 C.F.R. § 1.181 is currently under consideration by the Office.

Waiver of a rule under 37 C.F.R. § 1.183 requires a showing of extraordinary circumstances such that justice requires relief through rule waiver. Furthermore, 35 U.S.C. § 314(c) mandates that the Office conduct *inter partes* proceedings with special dispatch within the Office.

In this instance, patent owner, in his petition, has not provided any explicit showing of extraordinary circumstances supporting waiver of the rule. Looking to the record of the proceeding, patent owner's instant petition for extension of time is filed to obtain the results of (a decision on) the petition under § 1.181. A decision on the § 1.181 petition has not yet been rendered. In the event patent owner were to have filed an Appellant's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the due date; i.e., October 17, 2010. In the interests of equity and uniformity, third party requester's time period to submit an Appellant's Brief is *sua sponte* extended to run 30 days from the due date; i.e., October 17, 2010.

If the petition under § 1.181 has not yet been decided at the point where the time for patent owner to file an Appellant's Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review. It is noted that this is the second extension of time granted in this proceeding to file Appellant's briefs. As waiver of a rule to permit such extensions must be consistent with the law that requires the Office to conduct *inter partes* proceedings with special dispatch, further extensions should not be assumed to be granted absent a showing of extraordinary circumstances in the petition.

CONCLUSION

1. The patent owner petition for extension of time filed September 9, 2010 for filing an Appellant's Brief is **granted to the extent stated above.**

2. The time for to file both the patent owner and third party requester Appellant's Briefs is extended to run **30 days** from the previously extended due date; i.e., through October 17, 2010.

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

September 15, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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(FOR PATENT OWNER)

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CENTRAL REEXAMINATION UNIT

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(FOR THIRD PARTY REQUESTER)

In re Schiller et al.	: **DECISION**
Reexamination Proceeding	: **ON**
Control No. : 95/000,402	: **PATENT OWNER'S**
Filed: January 26, 2009	: **PETITION**
Patent No. 6,442,573	: **UNDER 37 CFR 1.181**

This is a decision addressing Patent Owner's petition, filed June 4, 2010, under 37 CFR 1.181 requesting that the amendment dated December 31, 2009 be entered into the record and/or not be expunged from the proceeding record. This decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in denying entry of the amendment and expunging the December 31, 2009 response in the Right of Appeal Notice.

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is GRANTED-IN-PART.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,442,573 (the '573 patent) issued on August 27, 2002.

2. A corrected request for reexamination, assigned Control No. 95/000,402 (the '402 proceeding), was filed by a third party Requester on January 26, 2009.

3. Reexamination was ordered in the '402 reexamination proceeding on March 30, 2009. The order determined that a substantial new question of patentability was not raised for claim 6 of the '573 patent. An Office action on the merits was mailed on the same day. The Office action contained rejections of patent claims 1-5, 7-12, and 17, and confirmed claims 13-16.

4. On May 22, 2009, Patent Owner filed a response to the Office action by the examiner. The response did not amend claims or propose new claims and was not supported by evidentiary declarations.

5. On June 19, 2009, the Requester filed comments on the Patent Owner's response, which included arguments supporting the rejections set forth in the first Office action and arguments against non-adopted proposed rejections.

6. On August 31, 2009, the Office mailed a second non-final Office action. This action included rejections for claims 1-5 and 7-17.

7. On September 25, 2009, Patent Owner filed a response to the Office action by the examiner. The response amended claims 2, 4, 5, 8, and 13-16 and proposed new claims 18-20, and was supported by a declaration under 37 CFR 1.131 ("the Schiller declaration"). The amendments were not in a format compliant with Office regulations. On October 5, 2009, Patent Owner submitted a corrected set of proposed amendments.

8. On October 26, 2009, the Requester filed comments on the Patent Owner's response, which included arguments supporting the rejections set forth in the first Office action and arguments against the patentability of the new and amended claims.

9. On December 4, 2009, the Office mailed an Action Closing Prosecution (ACP). The ACP continued to reject patent claims 1-3, 5, 7-12, and 17 and added new rejections for newly proposed claim 18 and 19. The ACP indicated claims 4 and 13-16, as amended, patentable, and newly proposed dependent claim 20 as having allowable subject matter.

10. On December 31, 2009, Patent Owner filed a response to the ACP. The response included new amendments to claims 3, 4, 5, 7, 8, 13, 19 and 20, and a supplemental declaration under 37 CFR 1.131.

11. On February 1, 2010, the Requester filed comments.

12. On May 4, 2010, the Office mailed a Right of Appeal Notice (RAN). The RAN denied entry of and expunged the Patent Owner's December 31, 2009 response, and maintained the rejection of claims 1-3, 5, 7-12, and 17-19 and the determination of patentability for claims 4, 13-16, and 20.

13. On June 4, 2010, the Patent Owner filed the instant petition under 37 CFR 1.181. The Patent Owner also filed a petition under 37 CFR 1.183, which was decided in separate decision.

14. On June 4, 2010, the Patent Owner also filed a Notice of Appeal.

15. To date, prosecution has advanced to the situation where both Patent Owner and third party Requester have filed their appeal and respondent briefs.

DECISION UNDER 37 CFR 1.181

The Patent Owner (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to have the December 31, 2009 amendment entered into the proceeding record. Petitioner specifically requests that the director find that the RAN improperly denied entry of the December 31, 2009 proposed amendment and also improperly expunged the December 31, 2009 response from the proceeding record. See, e.g., pages 4-24 of the petition.

In response to petitioner's general arguments for entering the December 31, 2009 proposed amendment in this reexamination proceeding, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN) and/or an action closing prosecution (ACP). The petition does not state that the examiner failed to follow Office policies and procedures in his determination that the amendments were not compliant with Office regulations, that the amendment to claim 5 raises new issues, and that the supplemental declaration was defective, and does not allege that the RAN was premature. It is noted that Patent Owner has submitted a proposed amendment in response to the RAN with a petition[1] under 37 CFR 1.183 requesting entry of this proposed amendment. The record shows that the examiner appropriately followed Office rules and procedures in the determination to not enter the December 31, 2009 proposed amendment and issue a RAN, and did not categorically deprive the petitioner of its statutory rights to present amendments and evidence in reexamination proceedings.

In the petition, Patent Owner alleges that the examiner erred in deciding not to enter the proposed post-ACP amendment. Specifically, Patent Owner argues that the post-ACP

[1] That request in the petition under 37 CFR 1.183 was dismissed by the Office in July 2010.

amendment should have been entered because "the equities of the situation." The petition states that it is "manifestly unjust" to deny entry of the post-ACP amendments and that the examiner should have used his discretion to reopen prosecution under the policies set forth in MPEP 2673.01, subsection II. These grounds, raised by the Patent Owner, do not show that the determination to not enter the December 31, 2009 proposed amendment was in error. The record is clear that the examiner had the discretion to enter or not enter the December 31, 2009 proposed amendment. The examiner needs only to state a reasonable basis for denying entry, and upon review of the record, the record supports the examiner's analysis. In other words, the record does not show that the examiner's actions were arbitrary and capricious. Specifically, the examiner did make a showing of why entry of the amendment would raise new issues, would not reduce issues for appeal, did not have the required showing why it was not presented earlier, and/or be an undue burden as required by 37 CFR 1.116 and MPEP 2673. See pages 2-3 of the RAN. In regards to the supplemental declaration, the examiner explained that the Patent Owner did not present good and sufficient reasons for why the supplemental declaration was not earlier presented, which is a requirement under 37 CFR 1.951(a) and 1.116. In other words, the Patent Owner's explanation in the December 31, 2009 response was not sufficient. Specifically, the examiner explained that the reasons presented in the ACP for why the Schiller declaration was not effective were not new "requirements" being issued. In accordance with Office procedures, Patent Owner bears the burden to rebut the determination that the reference is prior art, and the examiner must explain why declaration is effective or ineffective to remove a prior art reference. See MPEP 715 *et seq*. This explanation does not set forth new requirements, but instead creates a record to establish why the Schiller declaration did not meet the requirements of 37 CFR 1.131. In summary, the examiner explained why the post-ACP amendment and supplemental declaration would not be entered (e.g., because of the proposed amendments are not compliant with Office regulations, introduces new issues, does not clarify issues for appeal, etc.). Accordingly, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered in accordance with the statutory mandate of special dispatch.

The petition also states that the examiner erred in expunging the response of December 31, 2009. Upon review of the record, it is not clear that the December 31, 2009 response did not comply with the requirement in 37 CFR 1.951 to be limited to issues raised in the ACP. For example, as explained on pages 14-16 of the petition, the record supports that Patent Owner's remarks in the December 31, 2009 response are addressing issues raised in the ACP. Therefore, the record shows that the remarks in the December 31, 2009 response comply with the scope requirements of 37 CFR 1.951 and should not be expunged from the record for this reason. Accordingly, the December 31, 2009 response and the February 1, 2010 third party Requester's comments will be part of the proceeding record as non-entered papers. In other words, neither the Patent Owner's December 31, 2009 response nor the February 1, 2010 third party Requester's comments will be entered for the reasons explained in the RAN and in this decision.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in

the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP amendments. Furthermore, it is determined that the December 31, 2009 response complied with the requirement in 37 CFR 1.951 because it appears to be limited to issues raised in the ACP. The December 31, 2009 response and the February 1, 2010 comments will be part of the proceeding record as non-entered papers. Therefore, the Patent Owner's petition is granted-in-part.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed June 4, 2010, is GRANTED-IN-PART for the reasons discussed above. In summary, Patent Owner's request to enter the December 31, 2009 response is denied and Patent Owner's request to reverse the expungement of the December 31, 2009 response is granted.

2. The December 31, 2009 Patent Owner's response and the February 1, 2010 third party Requester's comments will no longer be expunged and will be part of the proceeding record as non-entered papers.

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

Irem Yücel, Director
Technology Center 1600

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The Hecker Law Group
1925 Century Park East
Suite 2300
Los Angeles, CA 90067

For Patent Owner

MAILED

AUG 29 2011

CENTRAL REEXAMINATION UNIT

Hunter D. Keeton
Wolf, Greenfield & Sacks
600 Atlantic Avenue
Boston, MA 02210-2206

For Third Party Requester

Inter Partes Reexamination Proceeding
Control No. 95/000,402
Filed: January 26, 2009
For: U.S. Patent No. 6,442,573

DECISION ON PATENT OWNER'S PETITION UNDER 37 CFR 1.181

This is a decision on the "Petition Pursuant to 37 CFR 1.181 Invoking the Supervisory Authority of The Director of the USPTO" filed July 22, 2011, requesting the Director to direct the examiner to act with special dispatch to either re-open prosecution pursuant to MPEP 2676 or issue an examiner's Answer pursuant to MPEP 2677.

The petition is dismissed as being moot.

The record reveals that an Examiner's Answer was mailed August 26, 2011. Accordingly the petition is being 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

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SEP 29 2011

Edmund J. Walsh
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Ave.
Boston, MA 02210-2206

In re Application of	:	
Schiller	:	
Control No. 95/000,402	:	DECISION ON PETITION
Filed: September 21,2011	:	TO WITHDRAW
Attorney Docket No. F0657.70000US00	:	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 September 21, 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 Edmund J. Walsh on behalf of all attorneys of record who are associated with customer No. 32,950.

All attorneys/agents associated with the Customer Number 32,950 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: Frame Media, Inc.
C/O Barry Kallander
Kallander Group, Inc.
282 Central Street, Unit 9
Hudson, MA 01749

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on 09/21/11[].

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	95/000,402-Conf. #1370
	Filing Date	January 26, 2009
	First Named Inventor	Dean Schiller
	Art Unit	3992
	Examiner Name	M. E. Heneghan
	Attorney Docket Number	F0657.70000US00

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

[x] 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: _____

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:	

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:

Certificate of Electronic Filing Under 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with 37 CFR § 1.6(a)(4).

Dated: September 21, 2011

Signature: Sheryl E. Mackey

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: _____

OR

B. ☒ ~~Inventor or Assignee~~ Third Party Requester Name	Frame Media, Inc., c/o Barry Kallander, KallanderGroup, Inc.						
Address	282 Central Street, Unit 9						
City	Hudson	State	MA	Zip	01749	Country	USA
Telephone	978-562-0767			Email	barry@kallandergroup.com		
I am authorized to sign on behalf of myself and all withdrawing practitioners.							
Signature							
Name	Edmund J. Walsh			Registration No.	32,950		
Address	Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue						
City	Boston	State	MA	Zip	02210-2206	Country	USA
Date	September 21, 2011			Telephone No.	617.646.8000		

NOTE: ***Withdrawal is effective when approved rather than when received.***

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 08/10/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/10/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PATENT GROUP
c/o DLA PIPER US LLP
203 N. LASALLE STREET, SUITE 1900
CHICAGO, IL 60601

Date: MAILED
AUG 10 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

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AUG 10 2010
CENTRAL REEXAMINATION UNIT

PATENT GROUP
DLA PIPER LLP
203 N. LASALLES ST., SUITE 1900
CHICAGO, IL 60601

(For Third Party Requester)

In re Kummer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,403
Filed: September 26, 2008
For: U.S. Patent No. 7,411,129 B2

DECISION
GRANTING PETITION
UNDER § 1.183

This is a decision on the July 31, 2010 patent owner petition entitled "SECOND RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR § 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 for rule waiver and an extension of time is **granted** to the extent specified below.

BACKGROUND

- On September 26, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,403 ("the '403 proceeding").
- Prosecution progressed until, on March 30, 2010, a Right of Appeal Notice was issued by the Office.
- On April 29, 2010, patent owner filed the following petitions:

- A petition entitled "PETITIONS REQUESTING ENTRY OF AMENDMENT AND CONTINUED REEXAMINATION UNDER 37 C.F.R. §§ 1.181 & 1.182."
- A petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On April 30, 2010, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.
- On May 14, 2010, third party requester filed a Notice of cross-appeal to the Board of Patent Appeals and Interferences.
- On May 27, 2010, the Office issued a decision dismissing the April 29, 2009 patent owner petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," as being premature.
- On June 30, 2010, patent owner filed a petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."
- On July 7, 2010, the Office issued a decision granting the June 30, 2010 petition to waive § 1.183 and extend the patent owner's period for filing an Appellant's Brief to run through August 13, 2010.
- On July 14, 2010, the third party requester filed an Appellant's Brief and certified service on that date to the patent owner.
- On July 31, 2010, patent owner filed the instant petition entitled "SECOND RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.
>
> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on July 31, 2010, subsequent to the patent owner filing of a Notice of Appeal on April 30, 2010, and a previous Office decision which extended the time to file a patent owner's Appellant's Brief to run until August 13, 2010. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for waiver of the prohibition of extensions of time for filing an appellant's brief and for filing a respondent's brief to third party requester's July 14, 2010 Appellant's Brief. Petition at 1. Under 37 C.F.R. § 41.66, the time for filing an appellant's (or respondent's) brief may not be extended.

The time for patent owner to file an appellant's brief has been extended to run through August 13, 2010. The time for patent owner to file a respondent's brief is one month from the date of service of the third party requester's appellant's brief, pursuant to 37 C.F.R. § 41.66(b). In the present proceeding, third party requester's Appellant's Brief was filed on July 14, 2010. Therefore, the time for patent owner petitioner to file an Respondent's Brief is due to expire on August 14, 2010.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) the petition under § 1.181 and § 1.182. The outstanding petition under 37 C.F.R. § 1.181 and § 1.182 is currently under consideration by the Office. A decision on the § 1.181 and § 1.182 petition has not yet been rendered. In the event patent owner were to have filed an Appellant's Brief or Respondent's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should the petition under § 1.181 and § 1.182 be granted.

Under the current facts and circumstances of the proceeding, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit an Appellant's Brief is extended to run 30 days from the previously extended due date; i.e., September 12, 2010. Furthermore, an extension of time under 37 C.F.R. § 1.183 is granted to the extent that patent owner petitioner's time period to submit a Respondent's Brief is extended to run 30 days from the due date; i.e., September 13, 2010.

If the petition under § 1.181 and § 1.182 has not yet been decided at the point where the time for patent owner to file an Appellant's (and Respondent's) Brief becomes less than two weeks prior to the deadline as extended, then petitioner may file a petition for an additional extension of time. In that event, petitioner is advised to contact Michael Cygan at the phone number given below in the contact information to inform the Office that the petition for an additional extension of time is being filed, in order to expedite its review.

CONCLUSION

1. The patent owner petition for extension of time filed July 31, 2010 for filing an Appellant's Brief is **granted to the extent stated above.**

2. The time for to file an Appellant's Brief is extended to run **30 days** from the previously extended due date; i.e., through September 12, 2010.

3. The time for to file an Respondent's Brief is extended to run **30 days** from the due date; i.e., through September 13, 2010.

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

August 9, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 08/11/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/11/2010

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CHICAGO, IL 60601

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS TX 75201-4761	:	(For Patent Owner)
PATENT GROUP C/O DLA PIPER US LLP 203 N. LASALLE ST., SUITE 1900 CHICAGO, IL 60601	:	(For Third Party Requester)
In re: KUMMER *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/000,403 Deposited on: 26 September 2008 For: US Patent No. 7,411,129	:	DECISION DISMISSING PETITION 37 CFR §§ 1.181 & 1.182

This is a decision on the patent owner's petition dated 29 April 2010, which are entitled "Petitions Requesting Entry of Amendment and for Continued Reexamination Under 37 CFR §§ 1.181 & 1.182" requesting that the Office reconsider refusal to enter the proposed claim amendments.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,411,129 B2 issued on 12 August 2008
- A request for *inter partes* reexamination of US Patent no. 7,411,129 B2 was filed by a third party requester on 26 September 2008 and assigned control number 95/000,403.
- *Inter partes* proceeding control no. 95/000,403 was ordered 05 December 2008.
- On 05 December 2008 a non-Final Office action was mailed.
- The prosecution continued with an Action Closing Prosecution mailed 01 July 2009 .
- The patent owner submitted proposed claim amendments and remarks on 01 September 2009.
- The Right of Appeal Notice was mailed 30 March 2010 informing the patent owner that the claim amendments would not be entered because they raised issues under 35 USC § 112 and that the amendments do not place the claims in better condition for appeal by reducing the issues pursuant to 37 CFR § 116.
- On 29 April 2010 the instant petition was filed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.4(c) Nature of Correspondence states:

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

37 CFR § 1.181(a) Petition to the Director.

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

37 CFR § 1.182 Questions not specifically provided for.

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

DECISION

The petition raises multiple issues which are distinct inquiries which may be addressed by different branches of the Office, as such, this is an improper paper not in compliance with 37 CFR § 1.4(c). In view of the fact that the petition improperly combines multiple, distinct subjects of inquiry in a single paper, the petition is dismissed under 37 CFR § 1.4(c). For example, petitions filed under 37 CFR 1.181 are handled by the Central Reexamination Unit whereas, petitions filed under 37 CFR §§ 1.182 are handled by the Office of Patent Legal Administration.

CONCLUSION

1. The above named petition dated 29 April 2010 is hereby dismissed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 09/13/2010

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2010

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CHICAGO, IL 60601

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
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1601 ELM ST
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(For Patent Owner)

PATENT GROUP
DLA PIPER LLP
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CHICAGO, IL 60601

(For Third Party Requester)

In re Kummer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,403
Filed: September 26, 2008
For: U.S. Patent No. 7,411,129 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.183**

This is a decision on the September 9, 2010 patent owner petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR § 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 a continued suspension of time to file an Appellant's Brief and a Respondent's Brief is **dismissed.**

BACKGROUND

- On September 26, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,403 ("the '403 proceeding").

- Prosecution progressed until, on March 30, 2010, a Right of Appeal Notice was issued by the Office.

- On April 29, 2010, patent owner filed the following petitions:

- A petition entitled "PETITIONS REQUESTING ENTRY OF AMENDMENT AND CONTINUED REEXAMINATION UNDER 37 C.F.R. §§ 1.181 & 1.182."
- A petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On April 30, 2010, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.
- On May 14, 2010, third party requester filed a Notice of cross-appeal to the Board of Patent Appeals and Interferences.
- On May 27, 2010, the Office issued a decision dismissing the April 29, 2009 patent owner petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," as being premature.
- On June 30, 2010, patent owner filed a petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."
- On July 7, 2010, the Office issued a decision granting the June 30, 2010 petition to waive § 1.183 and extend the patent owner's period for filing an Appellant's Brief to run through August 13, 2010.
- On July 14, 2010, the third party requester filed an Appellant's Brief and certified service on that date to the patent owner.
- On July 31, 2010, patent owner filed at petition entitled "SECOND RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."
- On August 10, 2010, the Office issued a decision granting the July 31, 2010 petition to waive § 1.183 and extend the patent owner's period for filing an Appellant's Brief to run through September 12, 2010, and the period for filing a Respondent's Brief to run through September 13, 2010.
- On August 11, 2010, the Office issued a decision dismissing the April 29, 2010 petition filed under 37 C.F.R. §§ 1.181 and 1.182.
- On August 31, 2010, patent owner filed petitions entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED EXAMINATION" and "RENEWED PETITION UNDER 37 C.F.R. § 1.181 REQUESTING ENTRY OF AMENDMENT."
- On September 9, 2010, patent owner filed the instant petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.
>
> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

DECISION

The present patent owner petition for an extension of time was filed on September 9, 2010, subsequent to the patent owner filing of a Notice of Appeal on April 30, 2010, and previous Office decisions which extended the time to file a patent owner's Appellant's Brief to run until September 12, 2010, and the time to file a Respondent's Brief to run until September 13, 2010. Patent owner filed the instant petition under 37 C.F.R. § 1.183 for waiver of the prohibition of extensions of time for filing an appellant's brief and for filing a respondent's brief to third party requester's July 14, 2010 Appellant's Brief. Petition at 1. Under 37 C.F.R. § 41.66, the time for filing an appellant's (or respondent's) brief may not be extended.

While the applicable rule, 37 C.F.R. § 1.183, provides an avenue for such an extension through waiver of the rule forbidding time extensions, such waiver may only be granted in an "extraordinary situation" such that "justice requires" an extension of time. However, the determination of an "extraordinary situation" must take into account the Office's statutory mandate for special dispatch in reexamination proceedings, which places a limit upon the amount

of time in which the Office will take an action, e.g., through rule waiver, which will result in delay in the proceeding.

In this instance, patent owner has filed a petition for extension of time to obtain the results of (a decision on) renewed petitions under § 1.181 and § 1.182. The outstanding renewed petitions under 37 C.F.R. § 1.181 and § 1.182 are currently under consideration by the Office. Decisions on the renewed § 1.181 and § 1.182 petitions have not yet been rendered. In the event patent owner were to have filed an Appellant's Brief or Respondent's Brief to keep the proceeding pending, in this case, that filing would cause an unnecessary expenditure of resources by the Central Reexamination Unit (CRU) to consider a brief that could become moot, should either of the petitions under § 1.181 and § 1.182 be granted. Patent owner also states that resources will be unnecessarily expended by the parties should briefing be required prior to a decision on the petitions.

The sufficiency of the risk of "unnecessary expenditure of resources" to give rise to an "extraordinary situation" is weighed in these situations against the amount of delay added to the proceedings, and that weighing is a strongly fact-specific inquiry. It is noted that two extensions of time have previously been granted in this proceeding, delaying the appeal process in excess of two months.

Additionally, the previous extension of time ran through September 12, 2010 for Appellant's Brief and through September 13 for Respondent's brief. The instant petition was not filed until Thursday, September 9, despite the clear notice, in the petition decision of August 10, 2010, that any further request for extension should be filed no less than two weeks prior to the due dates (i.e., filed on or before August 30 or August 31, respectively). The extremely late filing of the instant petition virtually precludes a decision on the petition, and notice to the parties, prior to the due dates for the filing of the briefs. Since the proceedings are not stayed by the filing of a petition, the late filing of the instant petition may not prevent expenditure of resources by the patent owner to file a brief that then need be considered by the CRU. Thus patent owner has not persuasively established the existence of an "extraordinary situation" that may be remedied by the requested rule waiver.

Furthermore, although patent owner has not yet received a decision on the merits of either petition, patent owner's failure to fully comply with 37 C.F.R. § 1.4(c) caused the dismissal of the earlier-filed petition on those grounds. Due to patent owner's complicity in causing the delay in consideration of the petitions on their merits, justice does not now require the Office to take remedial action by delaying the proceedings.

Under the current facts and circumstances of the proceeding, there exists no extraordinary situation such that justice requires remediation through a further extension of time. Therefore, the instant petition for an extension of time under 37 C.F.R. § 1.183 is dismissed.

CONCLUSION

1. The patent owner petition for extension of time filed September 9, 2010 for filing an Appellant's Brief and a Respondent's Brief is **dismissed.**

2. The time for to file an Appellant's Brief runs from the previously extended due date; i.e., through September 12, 2010.

3. The time for to file an Respondent's Brief runs from the previously extended due date; i.e., through September 13, 2010.

4. Jurisdiction over the reexamination proceeding is being forwarded to the CRU for further handling and examination not inconsistent with this decision.

5. 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

September 13, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,403	09/26/2008	7411129	125448-41	3849

32914 7590 10/22/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/22/2010

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CHICAGO, IL 60601

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000403
PATENT NO. : 7411129
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM STREET DALLAS, TX 75201	: : : : :	(For Patent Owner)
PATENT GROUP DLA PIPER LLP 203 N. LASALLES ST. SUITE 1900 CHICAGO, IL 60601	: : : :	(For Third Party Requester)
In re: Kummer *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/000,403 Deposited: September 26, 2008 For: U.S. Patent No.: 7,411,129 B2	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on September 9, 2010 entitled "RENEWED PETITION UNDER 37 CFR § 1.181 REQUESTING ENTRY OF AMENDMENT" and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to enter an amendment, filed September 1, 2009 after the Action Closing Prosecution, which was denied entry by the examiner.

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

The petition under 37 CFR § 1.181is denied with respect to entry of the amendment.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,411,129 issued on August 12, 2008.
- A request for *inter partes* reexamination was filed on September 26, 2008 and assigned control number 95/000,403.
- Reexamination was ordered and prosecution progressed until, on July 1, 2010, an Action Closing Prosecution was issued.
- On September 1, 2010, the Patent owner filed a post-ACP amendment.
- On March 30, 2010, the examiner issued a Right of Appeal Notice that denied entry of the post-ACP amendment.
- On April 29, 2010, Patent owner filed a Notice of Appeal along with a petition for reconsideration of refusal of entry of the amendment. This petition was dismissed under 37 CFR § 1.4(c) in a decision dated August 11, 2010.
- On September 9, 2010, the instant petition was filed in response to that decision, limiting the petition to being filed under 37 CFR § 1.181.
- Various other petitions have been filed and decided since the issuance of the RAN, none of which are relevant to the instant decision.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.951 Options after Office action closing prosecution in *inter partes* reexamination (in part):

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

37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):

(b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

DECISION

The Patent owner ["petitioner"] states that the post-ACP amendment should have been entered because it presents the claims in better form for consideration on appeal. Claim 1 is representative and originally required the step of introducing sufficient lubricant to "reduce the amount of force required to pull the cable during its installation." The amendment changed this to introducing sufficient lubricant to provide "a measured reduction in the amount of force required to pull the cable during its installation."

The examiner declined entry, stating that the amendment "does not place [the claims] in better form for consideration on appeal," that it "raises issues of 35 U.S.C. 112 first and second paragraphs" and additionally that "entry of such an amendment would necessitate that the Office put forth a modified rejection of" the claims. RAN p. 2.

As an initial issue, the post-ACP amendment is improper as it does not comply with 37 CFR 1.530(f) & 1.530(i). That is, it makes amendments relative to the prior amendment, rather than relative to the patent. In the response filed February 5, 2009, claim 1 was amended to add material at the end of paragraph (a), and claim 4 was amended to add material in paragraph (b). The newly added material was properly underlined in the February 2009 amendment, but was no longer underlined in the post-ACP amendment. This alone is enough to preclude consideration of the post-ACP amendment, as it is a non-compliant amendment.

Turning to the merits of the amendment, an amendment after ACP must comply with one of 37 CFR 1.116(b)(1)-(3). Subsection (1) is clearly inapplicable as the amendment does more than cancel claims. Subsection (3) is also inapplicable, as petitioner has not provided any argument, either in the petition or in the original post-ACP response, as to why the amendment was necessary and not earlier presented. The requisite "showing" is therefore not present. In the petition it is argued that the amendment presents the claims in better form for consideration on appeal, therefore it is only subsection (2) that will be addressed.

The thrust of petitioner's argument is that the post-ACP amendment does no more than expressly recite what was already implicit in the claims. Petitioner argues that the claims previously required a step to reduce the amount of force required to pull the cable during its installation, and that "[t]his necessarily means that to determine whether such reduction in required pulling force has occurred, there must impliedly be some kind of measurement." Petition p. 4. Petitioner later argues that "the required reduction of force is not just some arbitrary reduction; it must be that reduction which is actually perceived by the cable installer, i.e., the required reduction of force must be measureable. Thus, the unamended claims already impliedly require that the reduction of the amount of force required to install the cable be a *measured* reduction." *Id.* p. 5. These arguments are not persuasive.

The claims prior to the amendment never required any measurement of the force or the reduction in force. The claims never required that the installer be able to perceive any change in force. All the claims require is that the force required to pull the cable during installation would be at one level prior to introduction of lubricant, and would be at a lesser level after introduction of lubricant. Any reduction meets the claim, whether it be measured, perceived, or not. The installer need not determine if any reduction has occurred, the reduction merely has to have actually occurred. In contrast, the post-ACP claims, particularly as argued by the petitioner, require some sort of measurement, some sort of determination that the reduction has occurred. But reduction is reduction, whether measured or not, therefore the amendment raises new issues and the examiner was correct to say that the amendment does not merely place the claims in better form for appeal.

The petition additionally did not address the statement by the examiner that he agreed with the Requester that the amendment raises issues of 35 U.S.C. first and second paragraphs. While petitioner did state at page 4 that the term "measured" has literal support in the specification, the Requester had additionally argued, as apparently agreed to by the examiner, that a "measured reduction" is vague and ambiguous. *See* Comments filed September 30, 2009 p. 5. At the very least this is a colorable argument and is an issue that has not been resolved. An amendment that raises further issues that require resolution does not place the claims in better form for appeal.

Upon review of the entire record, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered. The amendment

raises different issues than those present in the claims previously, therefore it does more than simply present the claims in better form for appeal. 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 amendment filed September 1, 2009. The petition is denied.

CONCLUSION

1. The petition under 37 CFR § 1.181 for entry of the post-ACP amendment filed September 1, 2010 is denied.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

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

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Kummer et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,403
Filed: September 26, 2008
For: U.S. Patent No. 7,411,129 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.182**

This is a decision on the August 31, 2010 patent owner petition entitled "RENEWED PETITION UNDER 37 CFR § 1.182 REQUESTING 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.**

BACKGROUND

- On September 26, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,403 ("the '403 proceeding").

- Prosecution progressed until, on March 30, 2010, a Right of Appeal Notice was issued by the Office.

- On April 29, 2010, patent owner filed the following petitions:

    - A petition entitled "PETITIONS REQUESTING ENTRY OF AMENDMENT AND CONTINUED REEXAMINATION UNDER 37 C.F.R. §§ 1.181 & 1.182."

- A petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief.

- On April 30, 2010, patent owner filed a Notice of appeal to the Board of Patent Appeals and Interferences.

- On May 14, 2010, third party requester filed a Notice of cross-appeal to the Board of Patent Appeals and Interferences.

- On May 27, 2010, the Office issued a decision dismissing the April 29, 2009 patent owner petition entitled "PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183," as being premature.

- On June 30, 2010, patent owner filed a petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

- On July 7, 2010, the Office issued a decision granting the June 30, 2010 petition to waive § 1.183 and extend the patent owner's period for filing an Appellant's Brief to run through August 13, 2010.

- On July 14, 2010, the third party requester filed an Appellant's Brief and certified service on that date to the patent owner.

- On July 31, 2010, patent owner filed at petition entitled "SECOND RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 CFR. § 1.183."

- On August 10, 2010, the Office issued a decision granting the July 31, 2010 petition to waive § 1.183 and extend the patent owner's period for filing an Appellant's Brief to run through September 12, 2010, and the period for filing a Respondent's Brief to run through September 13, 2010.

- On August 11, 2010, the Office issued a decision dismissing the April 29, 2010 petition filed under 37 C.F.R. §§ 1.181 and 1.182.

- On August 31, 2010, patent owner filed the instant petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.182 REQUESTING CONTINUED EXAMINATION" and a petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.181 REQUESTING ENTRY OF AMENDMENT."

- On September 9, 2010, patent owner filed a petition entitled "RENEWED PETITION REQUESTING SUSPENSION OF RULES UNDER 37 C.F.R. § 1.183."

- On September 13, 2010, the Office issued a decision dismissing the September 9, 2010 patent owner petition under § 1.183.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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)

37 C.F.R. § 41.66 states, in pertinent part:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

DECISION

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

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of 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 reexamination proceeding must further the handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution after the ACP to enter the September 1, 2009 claim amendments denied entry by the Office on March 30, 2010. 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 amendment would act to put the claims "in condition for allowance;"[2] *i.e.*, finding the claims patentable.

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[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.
[2] Petition at 4.

Patent owner supports the claim that the amendment would put the claims in condition for finding the claims patentable by stating that the proposed amendment "does not constitute the addition of a new limitation to these claims;" rather, the proposed "amendment is merely to make express that which is already implied." Patent owner, in his petition, contends that the amendment does not contain any limitation that was not already inherently required by the claims. Therefore, the proposed amendment, in patent owner's view, does not alter the scope of the claims.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a newly made statement in the ACP. In this case, the record is to the contrary. As recounted by petitioner at page 2 of the instant petition, the issue for which the amendment is stated to address arose in the initial Office action. In this first Office action on the merits of the proceeding, issued on December 5, 2008, the examiner presented a rejection based on the inherent disclosure of a certain limitation.[3] Patent owner petitioner "traversed the inherency rejection (2/5/2009 Response)" in patent owner's response to the first Office action on the merits, and chose not to amend the claims to address the inherency issue. Thus, patent owner had the opportunity to address this issue prior to the closing of prosecution, and chose not to.

Furthermore, to the extent that patent owner petitioner is contending that the examiner, in addressing patent owner's February 5, 2009 response, raised a new issue in the ACP, 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 via such a petition under § 1.181, filed on the same date as the instant petition under § 1.182, and setting forth identical arguments for entry of the proposed amendment. 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. [4]

Therefore, the instant patent owner petition is **dismissed**.

It is noted that the present patent owner petition for continued examination was filed on August 31, 2010, subsequent to third party requester's filing of an Appellant's Brief on July 14, 2010, and to the patent owner filing of a Notice of Appeal on April 30, 2010, and previous Office decisions which extended the time to file a patent owner's Appellant's Brief to run until September 12, 2010, and the time to file a Respondent's Brief to run until September 13, 2010. The time for filing such briefs has now expired.

---

[3] It is also to be noted that the original September 26, 2008 request for reexamination presented the same inherency interpretation; see page 7 of the request.

[4] 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.

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 the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

October 19, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 11/18/2010
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,407	10/21/08	7140443	069669-003

EXAMINER
KAUFMAN, JOSEPH A.

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ART UNIT	PAPER
3993	

DATE MAILED: MAILED

NOV 18 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CENTRAL REEXAMINATION UNIT

Bracewell & Giuliani LLP
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Houston TX 77002-2770

(For Patent Owner)

Morgan Lewis & Bockius LLP
1111 Pennsylvania Avenue NW
Washington, DC 20004

(For Third Party Requester)

In re Beierbach et al.	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/000,407	: **DISMISSING PETITION**
Filed: October 21, 2008	: **UNDER § 1.182**
For: U.S. Patent No. 7,140,443 B2	:

This is a decision on the October 27, 2010 patent owner petition entitled "PETITION REQUESTING 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 October 21, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,407 ("the '407 proceeding"). An order granting reexamination was mailed on January 14, 2009, and an Office action rejecting claims 1-3, 5-17, 19-42, 51-59, and 61-69 and confirming claims 4, 18, 43-50, 60, and 70, was mailed on January 26, 2009.

- Prosecution progressed until, on January 20, 2010, an Action Closing Prosecution (ACP) was issued by the Office.

- On February 19, 2010, patent owner filed comments along with a petition for waiver of page limits; third party requester filed comments on March 22, 2010. On May 6, 2010,

the Office dismissed the February 19, 2010 petition, and expunged both comments submissions.

- On May 21, 2010, patent owner submitted comments to the ACP, including a proposed amendment to claims 1, 3-8, 10, 12, 15, 26, and 36-38, cancellation of claims 2, 9, and 11, and proposed new claims 71-88. Some claims that stand rejected in the ACP, including original independent patent claims 13, 27, 51, 55, and 59, and certain claims depending therefrom, are not proposed to be amended. Claims 26 and 38 are proposed to be amended despite the finding of patentability for those claims in the ACP.

- On June 21, 2010, third party requester filed comments in response to the patent owner comments.

- On September 28, 2010, the Office issued a Right of Appeal Notice (RAN), refusing entry of the proposed amendment, rejecting claims 1-17, 19-25, 27-37, 39-42, 51-59, and 61-69 and confirming or finding patentable claims 18, 26, 38, 43-50, and 60.

- On October 27, 2010, patent owner filed the following papers:

    - A petition entitled "PETITION TO ENTER CLAIM AMENDMENTS FILED IN THE "PATENT OWNER'S RESPONSE TO OFFICE ACTION CLOSING PROSECUTION," DATED MAY 21, 2010," requesting entry of the May 21, 2010 claim amendments under 37 C.F.R § 1.181.
    - A petition entitled "FURTHER PETITION REQUESTING CORRECTED RIGHT OF APPEAL NOTICE," requesting a new RAN under 37 C.F.R § 1.181.
    - The instant petition entitled "PETITION REQUESTING CONTINUED EXAMINATION."
    - A Notice of Appeal.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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)

37 C.F.R. § 41.66 states, in pertinent part:

> (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.
>
> (b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

DECISION

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

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

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than

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

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 an *inter partes* 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." To be consistent with the Office's duty to handle reexamination proceedings with "special dispatch," the Office will not take action, such as by reopening prosecution in a proceeding, that would result in unwarranted delay in the proceeding. Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding should consider whether the amendment or evidence submission addresses an issue that has newly arisen in the reexamination proceeding, rather than one that arose earlier in the proceeding, such that the grant of the petition would sanction an unjustified delay in the proceeding.

In this instance, patent owner petitions for reopening of prosecution after the RAN to enter the May 21, 2010 claim amendments denied entry by the Office on September 28, 2010. Patent owner seeks relief under the provisions of the March 2005 Notice discussed above. Patent owner's plea for relief is grounded in the position that entry of the amendment would act to "eliminate [the] complex matrix of proposed rejections and replace it with a single issue."[2] Patent owner alleges that the need for the proposed amendments was brought about by a claim construction order of January 5, 2010, in copending litigation of the subject patent.[3]

Patent owner has not shown how the proposed amendment addresses an issue that has newly arisen <u>in the reexamination proceeding</u> such that patent owner had no previous opportunity to address that issue. Patent owner's reason for the necessity of requesting entry of the May 21, 2010 proposed claim amendments is that a district court issued, on January 5, 2010, a claim construction order in a copending litigation. However, patent owner does not provide sufficient explanation as to why such a claim construction in a separate district court proceeding would require entry of the proposed amendments, including the proposed new claims, <u>in the reexamination proceeding</u>.[4] Additionally, patent owner has not specified any action taken in the

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[2] Petition at 5.

[3] *Id.* at 3.

[4] At the present time, due to claim amendments, the claims under reexamination are not identical to those in the parallel litigation. Indeed, the patent owner's proposal of amendments in the reexamination proceeding ensure that the proceedings will remain distinct from each other, since the litigation addresses only the claims as patented. Were the proposed amendment to be entered, there would presumably be a greater difference between the claims in the reexamination proceeding and those in the litigation proceeding.

reexamination proceeding by the examiner which would justify the entry and consideration of the proposed amendments after prosecution has been closed in the proceeding.[5] Rather than presenting a showing of how some issue had newly arisen in the reexamination proceeding, the petition relies only on action in a separate proceeding. As recounted by petitioner at page 2 of the instant petition, the issue for which the amendment is stated to address, i.e., a claim construction in a district court, arose in the related litigation proceeding – not in the reexamination proceeding. While both proceedings may address the same issue, that of the validity of the claims of the patent, each proceeding progresses simultaneously along separate paths.[6]

Additionally, patent owner has not met the burden of explaining in what manner the issues would be simplified for appeal. Although the petition stated that the multitude of rejections would be replaced with a "single issue," the patent owner did not show how any rejection, let alone each ground of rejection, would be altered in such a way that the issues would be simplified. The petition does not address the individual rejections except for a lengthy chart of the combinations of references used. Patent owner has merely alleged that the issue would be "whether the reference includes a pipe handling device that is attached to the pipe engaging apparatus," which is alleged to be lacking in any of the documents cited by the Office. Even assuming those statements to be true, the argument in the petition supports a conclusion that the proposed amendment would shift the rejections to a different issue – rather than to <u>simplify</u> the issues in the proceeding. The petition does not allege that any rejection would be overcome through entry of the proposed amendment, only that there will be a new issue, presumably never before contemplated in the reexamination proceeding, of whether the multitude of references teach or make obvious the newly recited limitation. Furthermore, the petition also fails to address the rationales for the Office's refusal to enter the proposed amendment, listed at page 3 of the September 28, 2010 RAN, in such a way to show that entry of the proposed amendment is a *bona fide* attempt to simplify, rather than to increase, the issues in the proceeding.[7]

In view of these facts, the petition fails to 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. Accordingly, petitioner has not persuasively demonstrated a *bona fide* attempt to simplify issues for appeal.

Furthermore, patent owner is concurrently seeking identical relief via such a petition under § 1.181, filed on the same date as the instant petition under § 1.182. As the relief for which patent owner seeks has been provided for elsewhere in the regulations for this particular situation, relief under § 1.182 would be inappropriate under the facts and circumstances of this proceeding.

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[5] It is noted that the May 21, 2010 amendments would propose to amend claims 26 and 38 – despite the Office having found these claims patentable.

[6] *See Sony Computer Entertainment v. Dudas*, 2006 U.S. Dist. LEXIS 36856 at 19; 85 U.S.P.Q.2D (BNA) 1594 ("AIPA's reciprocal estoppel provisions make clear that parties challenging validity determinations are free to pursue *inter partes* review from the PTO and litigation simultaneously").

[7] The RAN presents two reasons for non-entry of the proposed amendment; neither was addressed in the instant petition except to dismiss those reasons as "conclusory assertions." Petition at 3.

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 the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

November 17, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 02/17/2011
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date: MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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(For Patent Owner)

MAILED

FEB 17 2011

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004

(For Third Party Requ)

CENTRAL REEXAMINATION UNIT

In re Beierbach *et al.*	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,407	:	**DISMISSING**
Filing Date: October 21, 2008	:	**PETITIONS**
For: U.S. Patent No.: 7,140,443	:	

This is a decision on the following patent owner petitions:

- The patent owner petition entitled "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)," filed on November 24, 2010;
- The patent owner petition entitled "PETITION TO SUSPEND THE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.937," filed on November 24, 2010;
- The patent owner petition entitled "PETITION TO VACATE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.913," filed on December 2, 2010; and
- The patent owner petition entitled "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)," filed on December 2, 2010.

The above-identified patent owner petitions are taken as petitions filed under 37 CFR 1.182, and they are before the Office of Patent Legal Administration.

SUMMARY

The above-identified patent owner petitions under 37 CFR 1.182 to respectively terminate, suspend and vacate *inter partes* reexamination proceeding control no. 95/000,407 are all **dismissed** for the reasons set forth herein.

BACKGROUND

1. U.S. Patent No. 7,140,443 ("the '443 patent") issued to Beierbach *et al.* on November 28, 2006, and was assigned to Tesco Corporation (hereinafter "patent owner").

2. The '443 patent is currently the subject of litigation ("the concurrent litigation") styled *Tesco Corporation v. Weatherford International, Inc; National Oilwell Varco, L.P.; Offshore Energy Services, Inc; and Frank's Casing Crew and Rental Tools, Inc.*, Case No. 4:08-CV-02531, filed on August 19, 2008, in the U.S. District Court for the Southern District of Texas ("the district court").

3. On October 21, 2008, a request for *inter partes* reexamination of all of the claims of the '443 patent (*i.e.*, claims 1-70) was filed by a third party requester, in which Weatherford International, Inc. is identified as the real party in interest (hereinafter "requester"). The request was assigned control number 95/000,407 ("the '407 proceeding").

4. On January 14, 2009, the Office issued an order granting *inter partes* reexamination in the '407 proceeding. A non-final Office action on the merits was mailed on January 26, 2009.

5. The '407 proceeding progressed the point where, on September 28, 2010, the Office mailed a right of appeal notice ("RAN"), stating that unamended claims 18, 43-50 and 60 are confirmed, amended claims 26 and 38 are patentable, and claims 1-17, 19-25, 27-37, 39-42, 51-59 and 61-70 are rejected.

6. On October 26, 2010, the district court issued a "STIPULATION AND ORDER OF DISMISSAL" ("the stipulation and order of dismissal"), upon consent of patent owner and requester in the concurrent *Tesco* litigation.

7. On October 27, 2010, patent owner filed a notice of appeal in the '407 proceeding, appealing the rejection of claims 1-17, 19-25, 27-37, 39-42, 51-59 and 61-70.

8. The concurrent litigation between patent owner and the remaining co-defendants (*i.e.*, National Oilwell Varco, L.P.; Offshore Energy Services, Inc; and Frank's Casing Crew and Rental Tools, Inc.) remains pending before the district court.[1] On November 11, 2010, a jury verdict with respect to patent owner and the remaining co-defendants was entered.

9. On November 24, 2010, patent owner filed, in the '407 proceeding, the instant "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)" and the instant "PETITION TO SUSPEND THE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.937."

10. On December 2, 2010, patent owner filed, in the '407 proceeding, the instant PETITION TO VACATE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.913" and the

[1] It appears from the district court's docket that, as of the date of this decision, the concurrent litigation has entered the post-trial motions stage.

instant "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)."

11. On December 23, 2010, patent owner filed an appellant's brief in the '407 proceeding.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314(c) provides:

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

35 U.S.C. § 317(b) provides:

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

37 CFR 1.907(b) provides:

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

37 CFR 1.913 provides:

> Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a

> request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501

37 CFR 1.937(a) provides:

> 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.

DECISION

I. The November 24, 2010 and December 2, 2010 Patent Owner Petitions to Terminate *Inter Partes* Reexamination

On November 24, 2010, and on December 2, 2010, patent owner filed a petition entitled "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)" ("petition to terminate"). In the November 24, 2010 petition to terminate, petitioner asserts that termination of the '407 proceeding is required by 35 U.S.C. § 317(b) as a result of the parties' settlement agreement and the district court's October 26, 2010 stipulation and order of dismissal. In particular, petitioner asserts that the stipulation and order of dismissal is a final, non-appealable decision with respect to requester, regarding all of the claims in the litigation, and that the stipulation and order of dismissal, dismissing requester's defenses and counterclaims of invalidity "with prejudice," establishes that requester did not meet its burden of showing invalidity of any of the claims in litigation.[2] Additionally, in the December 2, 2010 petition to terminate, petitioner asserts that the "Form 8-K," filed by patent owner with the U.S. Securities and Exchange Commission (SEC) on November 2, 2010, shows that the district court action is dismissed with prejudice and that patent owner and requester have cross-licensed the '443 patent.[3] Petitioner also asserts that the "Form 8-K" document shows that patent owner and requester are now in "privity" and that, as addressed in its concurrently-filed petition to vacate the '407 proceeding pursuant to 37 CFR 1.913, requester is no longer a "third party."[4]

1. Factors In Determining Whether A Reexamination Proceeding Must Be Terminated Pursuant to 35 U.S.C. § 317(b)

The first sentence of 35 U.S.C. § 317(b) provides, in pertinent part:

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

[2] *See* patent owner's November 24, 2010 petition to terminate at pages 2-4.
[3] *See* patent owner's December 2, 2010 petition to terminate at page 2.
[4] *See id.*

that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

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

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

2. 35 U.S.C. § 317(B) Does Not Permit Termination Of The '407 Proceeding

In this instance, no final decision has been entered against requester that requester did not sustain its burden of proving the invalidity of any patent claim in suit, as expressly required by 35 U.S.C. § 317(b). Instead, the parties mutually agreed to settle their differences with regard to the '443 patent. Further, on October 26, 2010, the district court entered a stipulation and order of dismissal, between patent owner/plaintiff, Tesco Corporation, and requester/co-defendant, Weatherford International, Inc., which did not address the merits of either party's contentions with respect to the '443 patent, as explained in more detail below. Therefore, estoppel pursuant to 35 U.S.C. § 317(b) does not attach in this instance.

In the stipulation and order of dismissal, the district court ordered that "Tesco's infringement claims against Weatherford are hereby dismissed with prejudice," "Weatherford's defenses and counterclaims are hereby dismissed with prejudice," and "Tesco and Weatherford shall each bear their own attorney fees and costs incurred in connection with this action." The district court's stipulation and order of dismissal fails to state, however, that requester did not sustain its burden of proving the invalidity of any patent claim in suit. There is no language that suggests that the parties, or the district court, intended the October 26, 2010 stipulation and order of dismissal to *resolve* the invalidity issues raised by requester's defenses and counterclaims. The stipulation and order of dismissal merely states that requester's defenses and counterclaims are dismissed with prejudice. While such a dismissal may be viewed as barring a subsequent suit by the bound party, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, Federal Practice and Procedure, § 2373 (2008). The action against requester appears to have been dismissed without there ever being an assessment of whether requester sustained its burden, and without the parties agreeing, through stipulation or otherwise, that requester had not met its burden of proving invalidity of any patent claim in suit.[5]

Moreover, while the "Form 8-K," filed by patent owner with the SEC on November 2, 2010, provides information regarding the terms of the parties' settlement, the filing of the "Form 8-K" with the SEC is not, itself, a decision that has been entered in a civil action. The information

[5] *See* patent owner's December 2, 2010 petition to terminate at page 4 (stating, "The Patent Owner and the Requester settled their differences prior to the trial phase of the co-pending litigation.")

filed with the SEC in the "Form 8K" does not change the nature of the district court's stipulation and order dismissal as to whether the district court's dismissal is deemed a final decision against the requester that the requester did not sustain its burden of proving the invalidity of any claim in suit.

The Office's record for the present proceeding fails to reveal any evidence that the issue of invalidity of any claim of the patent under reexamination was resolved by the district court's October 26, 2010 stipulation and order of dismissal. Thus, there is nothing in the documents of record that amounts to a final decision that has been entered against requester that requester did not sustain its burden of proving the invalidity of any patent claim in suit, as required by 35 U.S.C. § 317(b); accordingly, the Office need not address whether the issues raised in the '407 proceeding are identical to those which were raised or could have been raised in the earlier concurrent litigation.[6]

In view of the above and under the present facts and circumstances, 35 U.S.C. § 317(b) does not mandate, nor permit, termination of the '407 proceeding, and patent owner's November 24, 2010 and December 2, 2010 petitions under 37 CFR 1.182 to terminate the '407 proceeding are **dismissed**.

II. The December 2, 2010 Patent Owner Petition to Vacate *Inter Partes* Reexamination

In the December 2, 2010 petition to vacate, petitioner requests that the '407 proceeding be vacated pursuant to 37 CFR 1.913. In particular, petitioner asserts that "[u]nder 37 C.F.R. § 1.913, a privy of the Patent Owner like Weatherford cannot request or maintain a reexamination proceeding because Weatherford is no longer a 'third party.'"[7] In support of its assertion that requester is a privy of the patent owner, petitioner states that, as evidenced by the "Form 8-K" filed with the SEC on November 2, 2010, patent owner and requester have cross-licensed the '443 patent, which is under reexamination in the '407 proceeding, and that, "[a]s a licensee of the Patent Owner, in regard to the patent that is the subject of this reexamination proceeding, the Requester and Patent Owner share an identity of interests in a basic legal right – specifically the right to practice the claimed invention of the '443 patent."[8]

1. 37 CFR 1.913 Did Not Preclude Requester From Filing The Request For *Inter Partes* Reexamination in the '407 Proceeding

37 CFR 1.913 provides that any person, other than the patent owner or its privies may, at any time during the period of enforceability of a patent file a request for *inter partes* reexamination.

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[6] It is further noted that not all claims under reexamination are part of the litigation. Petitioner patent owner alleges that "[r]equester could have raised invalidity issues with respect to every claim" in the subject patent. (Petitions at page 4) However, in the petitions to terminate, petitioner does not make any reference to the record of the litigation and the instant reexamination proceeding to establish that prior art and issues that were raised for the claims under reexamination were raised in the litigation. Nor does the petitioner identify which issues raised in the reexamination were not part of the litigation and provide an adequate explanation establishing that such issues could have been raised in the litigation.

[7] December 2, 2010 petition to vacate at page 2.

[8] *Id.* at pages 2-3 (further asserting that Weatherford's agreement to purchase a portion of its "casing drive" drilling equipment requirements from patent owner is also evidence that Weatherford is in privity with the patent owner.)

Assuming, for the sake of argument, that in cross-licensing the '443 patent, pursuant to the parties' settlement agreement, requester would be deemed to have become a privy of the patent owner on October 26, 2010, petitioner has not set forth any evidence that requester was a privy of the patent owner on October 21, 2008, when the request for *inter partes* reexamination of the '443 patent was filed on behalf of the requester. Accordingly, in this instance, requester was not precluded from filing its October 21, 2008 request for reexamination of the '443 patent and, thus, there is no need for the Office to evaluate whether the terms of the non-exclusive cross-licensing agreement in this instance establishes that the patent owner and requester "share an identity of interests in a basic legal right" that gives rise to a relationship of privity between the patent owner and requester.

2. 37 CFR 1.913 Does Not Preclude The Office From Maintaining The '407 Proceeding

Moreover, 37 CFR 1.913 does not preclude the Office from now maintaining the '407 proceeding, even if it is established that requester became a privy of the patent owner subsequent to the filing of the October 21, 2008 request for *inter partes* reexamination. Only if the estoppel provision of 35 U.S.C. § 317(b) is satisfied, would the Office be prohibited from maintaining an *inter partes* reexamination that was filed *by the requester or its privies*. The question of privity raised by 35 U.S.C. § 317(b), however, pertains to privity between a later requester and an *inter partes* requester or litigant in a prior concluded proceeding - not privity between requester and patent owner.

The question of privity raised by 35 U.S.C. § 317(b) clearly is not meant to pertain to estoppel based on a privity established between a requester and patent owner after the request was made. If it were, a patent owner could simply enter into a contract establishing privity with the requester and end any *inter partes* reexamination. There is no evidence anywhere in the legislative history for *inter partes* reexamination that such was Congress' intent. To the contrary, the legislative history of 35 U.S.C. § 317 provides:

> Sec. 4604. Optional inter partes Reexamination Procedure *****
> . . . if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity, or if a final decision in an inter partes reexamination instituted by the requester is favorable to patentability, after any appeals, that third-party requester cannot thereafter request inter partes reexamination on the basis of issues which were or which could have been raised . . . . (145 Cong. Rec. S14720, (Nov. 17, 1999)) (Emphasis added).

35 U.S.C. § 317 is directed to prohibition and termination of *inter partes* reexamination based on estoppel of an adversarial third party requester, or a privy having an adversarial interest – not the patent owner.

Accordingly, under the present facts and circumstances, 37 CFR 1.913 does not mandate vacating the '407 proceeding, and patent owner's December 2, 2010 petition under 37 CFR 1.182 to vacate the '407 proceeding is **dismissed**.

III. The November 24, 2010 Patent Owner Petition to Suspend *Inter Partes* Reexamination

In the November 24, 2010 petition to suspend, petitioner requests that the '407 proceeding be suspended pursuant to 37 CFR 1.937. In particular, petitioner asserts there is good cause to suspend the '407 proceeding for the following reasons: (1) there are no outstanding responses to Office actions due in the '407 proceeding; (2) the concurrent litigation in the district court is at an advanced stage as a jury verdict has been rendered with regard to the remaining co-defendants, and requester's defenses of invalidity have been dismissed with prejudice; (3) the documents cited in the concurrent litigation "are virtually identical" to the documents cited in the '407 proceeding; and (4) the claims asserted by patent owner in the concurrent litigation (*i.e.*, claims 13, 18, 25, 27, 43, 55 and 59) have not been amended and are subject to reexamination in the '407 proceeding.[9]

1. Factors In Determining Whether To Suspend An *Inter Partes* Reexamination Proceeding For "Good Cause"

35 U.S.C. § 314(c) expressly allows for the suspension of an *inter partes* reexamination proceeding within the Office "for good cause," notwithstanding that *inter partes* reexamination proceedings are to be conducted with "special dispatch." Pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 1.987, which implements the statutory provision, the USPTO Director has authority to determine circumstances amounting to "good cause" for suspension of an *inter partes* reexamination proceeding, and to do so on a case-by-case basis. MPEP § 2684.04 (V) states in-part:

> The statute authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.
>
> Where requester (or requester's privies) is also a party to ongoing or concluded litigation to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.

MPEP § 2684.04 (V) provides factors to be considered in determining whether it is appropriate to suspend action in the reexamination, based on litigation in which <u>the reexamination requester is a party to the litigation</u>.

2. Petitioner Has Not Established "Good Cause" To Suspend The '407 Proceeding

In this instance, the MPEP § 2684.04 (V) factors to be considered in determining whether it is appropriate to suspend action in the reexamination are not applicable, because patent owner has

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[9] *See* November 24, 2010 petition to suspend at pages 2-4.

stated that requester is no longer a party to the concurrent litigation.[10] Therefore, statutory estoppel pursuant to 35 U.S.C. § 317(b) will never attach in the '407 proceeding upon resolution of the concurrent litigation with respect to the remaining co-defendants, who are not reexamination requesters of the '407 proceeding.

Further, a final holding of claim validity upon resolution of the concurrent litigation with respect to the remaining co-defendants would not have any effect on the '407 proceeding.[11] Only if all of the claims of the '443 patent are found to be invalid upon resolution of the concurrent litigation, would the reexamination prosecution be terminated and the '407 proceeding be concluded.[12] In this instance, however, all of the claims subject to reexamination in the '407 proceeding (*i.e.*, claims 1-70) are not subject to the concurrent litigation.[13] Accordingly, in the event of a final holding (after all appeals) of invalidity or unenforceability with respect to some of the claims of the '443 patent upon resolution of the concurrent litigation, the claims held invalid or unenforceable will be withdrawn from consideration in the '407 proceeding, but the reexamination will continue as to any remaining claims of the '443 patent that were not asserted in the concurrent litigation.

Suspension of the '407 reexamination from its on-appeal stage pending resolution of the concurrent litigation with respect to the remaining co-defendants, therefore, would impede treatment of the claims of the '443 patent that are not subject to the concurrent litigation with special dispatch in the reexamination. There is a public interest in the outcome of the '407 proceeding, and the public has a right to have that proceeding conducted with special dispatch, rather than have prosecution in this instance delayed in favor of the concurrent litigation which, at most, could have the effect of terminating the reexamination prosecution with respect to only some, but not all, of the claims of the '443 patent. In short, there would be no waste of Office resources that might not need to be expended in continuing '407 proceeding, because the consideration of the issues must continue in the '407 proceeding at least with respect to any claims not asserted by patent owner in the concurrent litigation.

In *Ethicon v. Quigg*,[14] the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had "authority to stay reexamination pending the outcome of district court litigation."[15] The Federal Circuit held that an indefinite suspension, granted under the authority of 37 C.F.R. § 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. § 305 of conducting reexamination

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[10] *See* November 24, 2010 petition to suspend at page 2 (stating "On October 26, 2010, the Patent Owner and requester reached a settlement agreement in the District Court Action, and the Court entered a Stipulation and Order of Dismissal....")

[11] *See* MPEP § 2686.04 (IV) (stating, "The issuance of a final Court decision **upholding validity** during an *inter partes* reexamination, where the person who filed the request **was not a party to the litigation**, will have no binding effect on the examination of the reexamination.")

[12] *See* MPEP § 2684.04 (V) (stating, "A *final Court holding of invalidity/unenforceability* is binding on the Office.")

[13] *See* the February 17, 2010 district court document in the concurrent litigation entitled "PLAINTIFF TESCO CORPORATION'S NOTICE OF SERVICE OF ASSERTED CLAIMS AND FINAL INFRINGEMENT CONTENTIONS" (stating that patent owner has asserted claims 13, 18, 25, 27, 43, 55 and 59 of the '443 patent in the concurrent litigation), a copy of which was submitted by petitioner as an attachment to the November 24, 2010 petition to suspend.

[14] *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).

[15] *Id.* at 1425.

proceedings in the Office with special dispatch. Petitioner has requested an indefinite suspension in this *inter partes* reexamination proceeding, which, by statute, also must be conducted with special dispatch. The *inter partes* reexamination statute (35 U.S.C. § 314(c)) provides an exception to the mandate that reexamination proceedings be conducted with special dispatch where "otherwise provided by the Director for good cause"; thus, the Director may grant a suspension in *inter partes* reexamination for "good cause." However, in view of the discussion above, the facts and circumstances in this instance do not support a finding of good cause pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 1.987 to suspend the '407 proceeding.

Therefore, patent owner's November 24, 2010 petition under 37 CFR 1.182 to suspend the '407 proceeding is **dismissed**, and the '407 proceeding will be continued with special dispatch within the Office.

CONCLUSION

1. The November 24, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

2. The November 24, 2010 patent owner petition under 37 CFR 1.182 to suspend *inter partes* reexamination is **dismissed**.

3. The December 2, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

4. The December 2, 2010 patent owner petition under 37 CFR 1.182 to vacate *inter partes* reexamination is **dismissed**.

5. Telephone inquiries related to this decision should be directed to Nicole Dretar Haines, Legal Advisor, (571) 272-7717, or in her absence, or, in her absence, Pinchus M. Laufer, Senior Legal Advisor, at 571-272-7726.

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

2-15-11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 02/25/2011
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:

MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

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(For Patent Owner)

MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

(For Requester)

In re Beierbach et al.	:	
Reexamination Proceeding	:	**DECISION ON PETITIONS**
Control No.: 95/000,407	:	**UNDER 37 CFR 1.181**
Filed: October 21, 2008	:	
For: U.S. Patent No.: 7,140,443	:	

This is a decision on three petitions under 37 CFR 1.181 filed by the patent owner on October 6, 2010 and October 27, 2010. The petitions are a request to the Director to exercise her discretion pursuant to 37 CFR 1.181 and order entry of the proposed amendment dated May 21, 2010 and a corrected Office action in place of the Right of Appeal Notice (RAN) issued on September 28, 2010.

The petitions under 37 CFR 1.181 are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The three petitions under 37 CFR 1.181 to invoke the supervisory authority of the Director dated October 6 and 27, 2010 are denied with respect to withdrawing the RAN dated September 28, 2010 and entry of the May 21, 2010 proposed amendment in the *Inter Partes* reexamination proceeding 95/000,407.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,140,443 (hereinafter, the '443 patent) issued on November 28, 2006.

2. On October 21, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,407 ("the '407 proceeding").

3. An order granting reexamination was mailed on January 14, 2009, and an Office action rejecting claims 1-3, 5-17, 19-42, 51-59, and 61-69 and confirming claims 4, 18, 43-50, 60, and 70, was mailed on January 26, 2009.

4. Prosecution progressed until, on January 20, 2010, an Action Closing Prosecution (ACP) was issued by the Office.

5. On February 19, 2010, patent owner filed comments along with a petition for waiver of page limits; third party requester filed comments on March 22, 2010.

6. On May 6, 2010, the Office dismissed the February 19, 2010 petition, and expunged both comments submissions.

7. On May 21, 2010, patent owner submitted comments to the ACP, including a proposed amendment to claims 1, 3-8, 10, 12, 15, 26, and 36-38, cancellation of claims 2, 9, and 11, and proposed new claims 71-88. Some claims that stand rejected in the ACP, including original independent patent claims 13, 27, 51, 55, and 59, and certain claims depending therefrom, are not proposed to be amended. Claims 26 and 38 are proposed to be amended despite the finding of patentability for those claims in the ACP.

8. On June 21, 2010, third party requester filed comments in response to the patent owner comments.

9. On September 28, 2010, the Office issued a Right of Appeal Notice (RAN), refusing entry of the proposed amendment, rejecting claims 1-17, 19-25, 27-37, 39-42, 51-59, and 61-69 and confirming or finding patentable claims 18, 26, 38, 43-50, and 60.

10. On October 6, 2010, patent owner filed the instant petition entitled "PETITION TO REISSUE RIGHT OF APPEAL NOTICE," requesting a new RAN under 37 C.F.R § 1.181 [hereinafter "Petition I"].

11. On October 27, 2010, patent owner filed the following papers:
    - o The instant petition entitled "PETITION TO ENTER CLAIM AMENDMENTS FILED IN THE "PATENT OWNER'S RESPONSE TO OFFICE ACTION CLOSING PROSECUTION," DATED MAY 21, 2010," requesting entry of the May 21, 2010 claim amendments under 37 C.F.R § 1.181 [hereinafter "Petition II"].

o The instant petition entitled "FURTHER PETITION REQUESTING CORRECTED RIGHT OF APPEAL NOTICE," requesting a new RAN under 37 C.F.R § 1.181 [hereinafter "Petition III"].
o A petition entitled "PETITION REQUESTING CONTINUED EXAMINATION." This petition was addressed in a decision dated November 18, 2010.
o A Notice of Appeal.

DECISION

The patent owner (petitioner) states that the RAN dated September 28, 2010 is defective, because the RAN refers to papers that have been expunged from the record and fails to clearly and correctly set forth the grounds of rejection. See, e.g., pages 2-3 of Petition I and pages 2-4, 14, & 29-32 of Petition III. Patent owner also states that the RAN erred in not entering their proposed amendments because the May 21, 2010 amendment does not create an undue burden, reduces issues for appeal, or otherwise met the requirements for entry. See pages 3-6 of Petition II. Because of these grounds, petitioner requests that a corrected Office action should replace the RAN dated September 28, 2010 and that the May 21, 2010 proposed amendment should be entered.

In response to petitioner's general arguments for reopening prosecution or reissuing a new RAN, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN) and/or an action closing prosecution (ACP). While it is true that the examiner mistakenly referred to the papers dated February 19, 2010 and March 22, 2010, which were expunged from the record by the decision of May 6, 2010, such a minor error does not raise to the level to require that prosecution be reopened, which would be in direct contradiction to the statutory mandate of special dispatch. Specifically, the minor error is clear on its face and the same references to the expunged papers equally apply to the replacement papers filed on May 21, 2010 and June 21, 2010. Therefore, the minor error is easily recognizable and the record, on the whole, is clear. For example, anyone reviewing the record would realize that the citations to the expunged papers should have been to the replacement papers filed on May 21, 2010 and June 21, 2010. See footnote 1 on page 3 of Petition II in which patent owner recognizes that the replacement papers are equally applicable. In other words, the issues raised or addressed in the expunged papers are also present in the replacement papers. Moreover, the record in this reexamination proceeding is long and complex with numerous petitions and petition decisions of record. For example, there were five petition decisions mailed between April 20, 2010 and July 29, 2010. Given the facts of this proceeding and the fact that the statutory mandate of special dispatch must not be ignored, it is not justifiable

to further delaying prosecution to require correction of such a minor error. This decision is further notice that any citation to the expunged papers dated February 19, 2010 and March 22, 2010 in the RAN is to the replacement papers filed on May 21, 2010 and June 21, 2010, respectively.

In regards to the other grounds put forth by the petitioner that the RAN is defective, such grounds of argument presented in the petitions address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issue of whether the examiner set forth a proper *prima facie* showing of obviousness and used the correct standard in evaluating a declaration filed under 37 CFR 1.131 are appealable issues, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's actions will not be addressed in this decision.

Therefore, the record shows that the examiner followed the statutory mandate of "special dispatch" by issuing the RAN because the RAN did not introduce any new grounds of rejection. In other words, the record shows that the RAN was not premature. Accordingly, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an RAN, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

In regard to entry of the May 21, 2010 proposed amendment, the petitions have not shown that the examiner did not follow Office regulations and procedures in denying entry of the amendments. The RAN set forth specific reasons why the post-ACP amendment did not comply with 37 CFR 1.116, and therefore, was not entered into the proceeding record. See page 3 of the RAN. Specifically, the proposed amendment to claims 1 and 33 introduced new issues that would require further consideration and did not simply issues for appeal. Therefore, the examiner explained the "undue burden" as stated in MPEP 2673. For these reasons, the examiner followed Office procedures and policies. Patent owner states that the examiner was not clear which amendments would not be entered. See pages 2-3 of Petition II. However, it is standard Office policy that amendment papers are entered, or not entered, as a whole. See MPEP 714.20. Therefore, the examiner need not specify which claim amendments are entered or not because the entire proposed amendment paper filed May 21, 2010 is not entered. For this same reason, it was not possible for the examiner to only enter amendments that the patent owner asserts only fixes typographical or other minor errors. Accordingly, the examiner did not abuse his discretion by the decision to not enter the post-ACP amendment dated May 21, 2010.

In the petition, petitioner argues that the post-ACP amendment should be entered and prosecution reopened because the post-ACP amendment complies with the requirements of 37 CFR 1.116(b)(3) and would not be an undue burden. See pages 3-7 of Petition II. However, the record shows that the post-ACP amendment clearly does more than merely cancel claims, adopt examiner's suggestions, remove issues for appeal, or in some other way require only a cursory review by the examiner. For example, as discussed in the November 18, 2010 decision, patent owner did not show how any rejection would be altered in such a way that the issues for appeal

would be simplified. In addition, the examiner showed why entry of the amendment would be an undue burden as required by 37 CFR 1.116. See page 3 of the RAN. Specifically, the examiner explained how entry of the post-ACP amendment would raise new issues and not simply issues for appeal. Furthermore, as discussed in the November 18, 2010 decision, patent owner has not specified any action taken in the reexamination proceeding by the examiner which would justify the entry and consideration of the proposed amendments dated May 21, 2010. Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." In addition, there is copending litigation, which is ongoing. Therefore, advancing prosecution with "special dispatch" is even more important in this proceeding. 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 amendments and to issue a RAN. Accordingly, the patent owner's petitions, as it relates to issuing a corrected action and entry of the May 21, 2010 proposed amendment, are denied.

CONCLUSION

1. The October 6 and 27, 2010 petitions under 37 CFR 1.181 for reconsideration of the RAN dated September 28, 2010 and for entry of the May 21, 2010 proposed amendment are **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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 03/04/2011
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2011

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 Weatherford International Inc. v. Tesco Corporation

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Reexamination Control No. 95/000,407
Patent 7,140,443
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 to Waive the Requirements of 37 C.F.R. § 1.943(c)," filed December 23, 2010 ("present petition"). In the petition of December 23, 2010, patent owner requests extension of the 30 page limit of 37 C.F.R. § 1.943(c), to permit up to either 100 pages or up to 40 pages for the appellant brief. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's credit card on December 23, 2010, along with the appeal brief fee.

FINDINGS

1. On October 21, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,140,443.

2. Reexamination was ordered on January 14, 2009, and a non-final Office action was mailed on January 26, 2009.

3. Patent owner filed a response to the non-final Office action on July 27, 2009, and requester filed comments in reply to the patent owner's response and to the non-final Office action on August 26, 2009, within the 75 page limit extended by the petition decision of April 20, 2009, and as clarified by the decision of July 10, 2009.

4. On January 20, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the ACP on May 21, 2010, and requester filed comments in reply to the ACP and patent owner's response on June 21, 2010, within the 50 page limit pursuant to 37 C.F.R. §1.943(b).

6. On September 28, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent owner filed a Notice of Appeal on October 27, 2010.

8. Patent Owner filed an appellant brief on December 23, 2010, accompanied by the present petition.

DISCUSSION

In the present petition, patent owner requests waiver of the 37 C.F.R. § 1.943(c) requirement, which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief of December 23, 2010, is numbered pages 1-40, plus appendices. It includes

hundreds of pages of attachments, some of which contain substantive argument. A certificate of page and word count for the appellant brief does not appear to have been included with the brief.

Extension of the page limit is requested for the following reasons as stated by petitioner:

(1) The sheer volume of material presented against the Patentee, the complexity of the subject matter, the complexity of the legal issues, the complexity of the proposed grounds of rejection, and the copending litigation create an extraordinary situation that warrants a suspension of the 30 page limit.

(2) The volume of material incorporated by reference into the RAN is voluminous.

(3) The RAN is fatally defective, as it does not set forth a proper clear basis for appeal, thus the patent owner has to make unwarranted and unreasonable assumptions regarding the basis for the proposed grounds of rejection adopted by the examiner.

(4) The proposed rejections of grounds 6, 7, 10, 12, 19-22, 24-29, 34, 35, 39, 40, 47-50, 54, 55, 65, 72, 74, 81-84, and 86-88 violate MPEP 2617 I and create massive complexity.

(5) The RAN incorrectly applies the constructive reduction to practice standard to patent owner's actual reduction to practice thereby creating undue legal complexity.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

37 CFR 41.67 provides:

(a) (1) Appellant(s) may once, within time limits for filing set forth in § 41.66, file a brief and serve the brief on all other parties to the proceeding in accordance with § 1.903 of this title.

(2) The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(b) An appellant's appeal shall stand dismissed upon failure of that appellant to file an appellant's brief, accompanied by the requisite fee, within the time allowed under § 41.66(a).

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. 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.

(vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims to be reviewed on appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(xi) *Certificate of service.* A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence

filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

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

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

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

ANALYSIS

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. The only exceptions

have been the patent owner response and requester comments in reply to the non-final Office action. These were both extended by the petition decision of April 20, 2009, permitting up to 75 pages for only the next immediate response/comments. On May 5, 2009, the patent owner essentially re-submitted the same response by shrinking the font size enough to fit within the extended 75 page limit (which document is expunged from record). The extension of page limit was clarified in a decision mailed on July 10, 2009, which stipulated that the response/comments must be double-spaced, and in a 12 point font. Patent owner's response and third party requester's comments in reply to the ACP, were both within the 50 page limit. However, the appellant brief is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses.

Patent owner's appellant brief filed on December 23, 2010, is numbered pages 1-40, which count toward the limit of 30 pages and 14,000 words. However, it is noted that such appellant brief is not double-spaced and in a 12 point font, per the decision of July 10, 2009. It also includes multiple Exhibits, which contain copies of Office actions and responses to the brief. Such Exhibits count as substantive remarks and are included in the page count. This causes the page count of the appellant brief of December 23, 2010, to far exceed 100 pages.

Petitioner's reasons provided in support of waiving the page/word limits focus on the volume of material presented against the Patentee, the complexity of the subject matter, the complexity of the legal issues, the complexity of the proposed grounds of rejection, and the copending litigation. Petitioner states that the number of pages of text used by the examiner to detail the basis for the grounds of rejection adopted by the

examiner in the RAN is 400 pages, which petitioner contends should warrant relief from the 30 page limit. Petitioner asserts that these numerous rejections based on various combinations of a multitude of references forces patent owner to respond to and rebut a total of 854 different combinations of references used by the examiner in the RAN, as explained in detail in the present petition. Petitioner urges that these matters are complex and create an extraordinary situation that warrants a suspension of the 30 page limit. Petitioner has not explained how the appellant brief economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. In fact, for the reasons noted above, the appellant brief filed with the present petition far exceeds the extended page limit requested by petitioner.

The record reveals that the examiner incorporated the ACP into the RAN, and also incorporated portions of the *inter partes* reexamination request. It also reveals that there are numerous rejections, including a plurality of rejections based on various combinations of eight (8) references. While these arguments have merit, it is noted that a substantial portion of the ACP sets forth withdrawn rejections and non-adopted rejections, *i.e.,* positions favorable to patent owner. Such favorable issues reduce the substantive length of the ACP that the patent owner would need to address in the appellant brief. It is true that the use of eight references in several different combinations may cause a challenge in following all of the nuances of each rejection. At the same time, the number of references that appellant would need to distinguish from the claimed invention is limited to a relatively small number. Therefore, this does not create an extraordinary

situation, nor justify the need for a significant number of additional pages of arguments.

Given the facts in this specific case, a persuasive showing has not been made that this situation is extraordinary nor that justice requires that more pages/words be allotted to appellant's brief. The request to extend the page limit for appellant's brief to 100 pages, or to 40 pages, is **denied**. The appellant's brief of December 23, 2011, is not entered.

DECISION

Petitioner is given one opportunity to file a corrected appellant brief in compliance with of 37 C.F.R. § 1.943(c), within a non-extendable time period of 30 days/one month (whichever is longer) from the mailing date of this decision. Failure to timely file a compliant appellant's brief will result in dismissal of the appeal.

If a corrected appellant's brief is timely received, a respondent's brief is due within one month of the certificate of service date of the appellant's brief pursuant to 37 C.F.R. § 41.66(b).

In view of the foregoing, the present petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,407	10/21/2008	7140443	069669-003	2662

35979 7590 07/27/2011
BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2011

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

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:
MAILED
JUL 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000407
PATENT NO. : 7140443
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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(For Patent Owner)

MAILED

JUL 27 2011

CENTRAL REEXAMINATION UNIT

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach *et al.*	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,407	:	**DISMISSING**
Filing Date: October 21, 2008	:	**PETITION**
For: U.S. Patent No.: 7,140,443	:	

This is a decision on the patent owner petition entitled "PETITION FOR REHEARING OF THE PETITIONS TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b) PREVIOUSLY FILED ON NOVEMBER 24, 2010 AND DECEMBER 2, 2010," filed on March 15, 2011.

The patent owner petition is taken as a petition filed under 37 CFR 1.182, and is before the Office of Patent Legal Administration.

The patent owner petition under 37 CFR 1.182 is **dismissed** for the reasons set forth herein.

BACKGROUND

1. U.S. Patent No. 7,140,443 ("the '443 patent") issued to Beierbach *et al.* on November 28, 2006, and was assigned to Tesco Corporation (hereinafter "patent owner").

2. The '443 patent is currently the subject of litigation ("the concurrent litigation") styled *Tesco Corporation v. Weatherford International, Inc; National Oilwell Varco, L.P.; Offshore Energy Services, Inc; and Frank's Casing Crew and Rental Tools, Inc.*, Case No. 4:08-CV-02531, filed on August 19, 2008, in the U.S. District Court for the Southern District of Texas ("the district court").

3. On October 21, 2008, a request for *inter partes* reexamination of all of the claims of the '443 patent (*i.e.*, claims 1-70) was filed by a third party requester, in which Weatherford

International, Inc. is identified as the real party in interest (hereinafter "requester"). The request was assigned control number 95/000,407 ("the '407 proceeding").

4. On January 14, 2009, the Office issued an order granting *inter partes* reexamination in the '407 proceeding. A non-final Office action on the merits was mailed on January 26, 2009.

5. The '407 proceeding progressed the point where, on September 28, 2010, the Office mailed a right of appeal notice ("RAN"), stating that unamended claims 18, 43-50 and 60 are confirmed, amended claims 26 and 38 are patentable, and claims 1-17, 19-25, 27-37, 39-42, 51-59 and 61-70 are rejected.

6. On October 26, 2010, the district court issued a "STIPULATION AND ORDER OF DISMISSAL" ("the stipulation and order of dismissal"), upon consent of patent owner and requester in the concurrent *Tesco* litigation.

7. On October 27, 2010, patent owner filed a notice of appeal in the '407 proceeding, appealing the rejection of claims 1-17, 19-25, 27-37, 39-42, 51-59 and 61-70.

8. The concurrent litigation between patent owner and the remaining co-defendants (*i.e.*, National Oilwell Varco, L.P.; Offshore Energy Services, Inc; and Frank's Casing Crew and Rental Tools, Inc.) remains pending before the district court.[1] On November 11, 2010, a jury verdict with respect to patent owner and the remaining co-defendants was entered.

9. On November 24, 2010, patent owner filed, in the '407 proceeding, the following petition papers: "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)" and "PETITION TO SUSPEND THE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.937."

10. On December 2, 2010, patent owner filed, in the '407 proceeding, the following petition papers: "PETITION TO VACATE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.913" and "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)."

11. On December 23, 2010, patent owner filed an appellant's brief in the '407 proceeding.

12. On February 17, 2011, the Office mailed a decision dismissing the two patent owner petitions of November 24, 2010 and the two patent owner petitions of December 2, 2010.

13. On March 15, 2011, patent owner filed the instant "PETITION FOR REHEARING OF THE PETITIONS TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b) PREVIOUSLY FILED ON NOVEMBER 24, 2010 AND DECEMBER 2, 2010" ("the renewed petition under 37 CFR 1.182").

---

[1] It appears from the district court's docket that, as of the date of this decision, the concurrent litigation has entered the post-trial motions stage.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314(c) provides:

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

35 U.S.C. § 317(b) provides:

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

37 CFR 1.907(b) provides:

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

37 CFR 1.913 provides:

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

37 CFR 1.937(a) provides:

> 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.

DECISION

On March 15, 2011, patent owner filed the instant renewed petition under 37 CFR 1.182, requesting reconsideration of the November 24, 2010 and December 2, 2010 patent owner petitions to terminate the '407 proceeding.

I. The Office's February 17, 2011 Decision

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

1. Whether the third party requester was a party in the civil action;
2. Whether a final decision (*i.e.*, after all appeals) has been entered against the requester <u>that the requester had not sustained its burden of proving the invalidity of any claim in suit of the patent under reexamination</u>; and
3. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

In the Office's February 17, 2011 decision dismissing patent owner's November 24, 2010 and December 2, 2010 petitions to terminate the '407 proceeding, the Office determined that no final decision has been entered against requester that requester did not sustain its burden of proving the invalidity of any patent claim in suit, as expressly required by 35 U.S.C. § 317(b). Regarding the October 26, 2010 stipulation and order of dismissal, between patent owner/plaintiff, Tesco Corporation, and requester/co-defendant, Weatherford International, Inc., the Office stated on page 5 of the February 17, 2011 decision:

> In the stipulation and order of dismissal, the district court ordered that "Tesco's infringement claims against Weatherford are hereby dismissed with prejudice," "Weatherford's defenses and counterclaims are hereby dismissed with prejudice," and "Tesco and Weatherford shall each bear their own attorney fees and costs incurred in connection with this action." The district court's stipulation and order of dismissal fails to state, however, that requester did not sustain its burden of proving the invalidity of any patent claim in suit. There is no language that suggests that the parties, or the district court, intended the October 26, 2010 stipulation and order of dismissal to *resolve* the invalidity issues raised by requester's defenses and counterclaims. The stipulation and order of dismissal merely states that requester's defenses and counterclaims are dismissed with

> prejudice. While such a dismissal may be viewed as barring a subsequent suit by the bound party, it does not itself "establish any facts to which the doctrine of collateral estoppel can be applied in a later litigation on a different claim." Wright & Miller, Federal Practice and Procedure, § 2373 (2008). The action against requester appears to have been dismissed without there ever being an assessment of whether requester sustained its burden, and without the parties agreeing, through stipulation or otherwise, that requester had not met its burden of proving invalidity of any patent claim in suit. [footnote omitted]

Thus, it was determined that the record for the '407 proceeding "fails to reveal any evidence that the issue of invalidity of any claim of the patent under reexamination was resolved by the district court's October 26, 2010 stipulation and order of dismissal."[2]

II. The Patent Owner's Renewed Petition to Terminate *Inter Partes* Reexamination

In the renewed petition under 37 CFR 1.182, petitioner patent owner asserts reasons why the district court's October 26, 2010 stipulation and order of dismissal is a "final decision" within the meaning of 35 U.S.C. 317(b). As to the finality of the October 26, 2010 stipulation and order of dismissal, petitioner states that "[t]he dismissal with prejudice is more than a settlement between the parties. It is a court order that prevents the Requester from raising the issue of patent validity in any forum. It is also non-appealable. Therefore, it is final."[3] Further, petitioner asserts that "[i]t is of no matter that a trial proceeded against [the other defendants] because the plain language of the statute refers to a party in the Reexamination Proceedings" and "[t]he only 'party' is the Requester" so "the Dismissal is a final decision with respect to the Requester."[4]

Also, in the renewed petition under 37 CFR 1.182, petitioner asserts reasons why the record establishes that the requester did not meet its burden of proving invalidity. For example, petitioner asserts that "[t]he Requester could not have met its burden of showing the claims to be invalid because the Requesters' defenses of invalidity were dismissed, with prejudice, prior to the trial."[5] Petitioner also asserts that the Office's February 17, 2011 decision was "inaccurate" in indicating that the basis for dismissing the November 24, 2010 and December 2, 2010 petitions to terminate "was that the Dismissal failed to state '... that the [Requester] did not sustain its burden of proving the invalidity of any patent claim in suit.'"[6] In particular, petitioner asserts that "[t]he Dismissal entered by the Court dismissed, *with prejudice*, all of the counterclaims and invalidity defenses of the Requestor, Weatherford, asserted in the District Court Action" and that "the Requester did not meet its burden of proving the invalidity of the patent claims prior to the Dismissal, and cannot do so now as these claims have been dismissed *with prejudice*."[7] Thus, petitioner asserts that "the effect of the Dismissal, *with prejudice*, is that the Requester failed to sustain its burden of proving the invalidity of any patent claim in suit."[8]

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[2] See February 17, 2011 decision at page 6.
[3] March 15, 2011 renewed petition under 37 CFR 1.182 at page 4.
[4] Id. at page5.
[5] Id at pages 4-5.
[6] Id. at page 5.
[7] Id.
[8] Id.

Moreover, petitioner asserts that the October 26, 2010 stipulation and order of dismissal resulted from "an agreement between the Patent Owner and the Requester – that the invalidity defenses of the Requester were to be dismissed *with prejudice*."[9] Thus, petitioner asserts that "[s]uch an agreement can only reasonably be viewed as an agreement between the Patent Owner and the Requester that the Requester has not sustained its burden of proving invalidity of the claims of the patents in suit" and that "[h]ad the Requester sustained the burden of proving invalidity, it would not have agreed to dismiss its claims with prejudice."[10] Additionally, petitioner asserts that "the Requester can never sustain its burden of proving invalidity because it cannot reassert these invalidity claims under any circumstances."[11]

Petitioner further asserts that "the OPLA reliance on 'collateral estoppel' as being the standard is unsupported in the statutory language of 35 U.S.C. § 317(b)" but that "Requester is nonetheless collaterally estopped from further challenging the validity of the claims of the patents-in-suit in the present reexamination proceeding."[12] Furthermore, petitioner asserts that the October 26, 2010 stipulation and order of dismissal also has a res judicata effect.[13]

Petitioner also asserts that requester raised or could have raised each of the issues that it raised in the '407 proceeding because it had the burden of proving invalidity of all of the claims of the '443 patent.[14] Specifically, petitioner asserts that requester raised the issues of invalidity of all of the claims of the '443 patent as counterclaims to the patent owner's assertions of infringement, and the October 26, 2010 stipulation and order of dismissal dismissed the requester's defenses and counterclaims "with prejudice."[15] Petitioner states that "[a]t the time of the Dismissal, it is undisputed that the requester had not proven the patent claims to be invalid – despite having had the full opportunity and the burden to prove such invalidity."[16]

III. Analysis and Findings

A. Final decision entered against the requester in a civil action

In this instance, there is no dispute that that the third party requester was a party to the concurrent litigation and that the district court's October 26, 2010 stipulation and order of dismissal is a final decision (*i.e.*, "not appealable") that has been entered against the third party

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[9] Id. at page 6.
[10] Id.
[11] Id.
[12] Id. at page 5, citing *Montana v. United States*, 440 U.S. 147, 153-154 (1979) ("Under collateral estoppel, once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in subsequent suits based on a different cause of action involving a party to the prior litigation...To preclude parties from contesting matters that they have had a full and fair opportunity to litigate protects their adversaries from the expense and vexation attending multiple lawsuits, conservers judicial resources, and fosters reliance on judicial action by minimizing the possibility of inconsistent decisions.").
[13] Id. at page 6, citing *Warfield v. The Travelers Insurance Co.*, 267 F,3d 538, 542 (6th Cir. 2001) ("a voluntary dismissal with prejudice operates as a final adjudication on the merits and has a res judicata effect.")
[14] Id., citing pages 8-10 of requester's April 17, 2009 "WEATHERFORD INTERNATIONAL, INC.'S ORIGINAL ANSWER TO PLAINTIFF'S THIRD AMENDED COMPLAINT AND COUNTERCLAIMS."
[15] Id. at pages 6-7.
[16] Id. at page 7.

requester in the litigation. For the reasons set forth herein in section III(B), the Office maintains its position, however, that the October 26, 2010 stipulation and order of dismissal is not a final decision against the requester that the requester had not sustained its burden of proving the invalidity of any of the patent claims in suit pursuant to 35 U.S.C. § 317(b).

B. No final decision that the requester did not sustain its burden of proving the invalidity of any patent claim in suit

As stated in the Office's February 17, 2011 decision, there is nothing in the documents of record in the '407 proceeding that amounts to a final decision that has been entered in a civil action against requester *that requester did not sustain its burden of proving the invalidity of any patent claim in suit*, as required by 35 U.S.C. § 317(b). While petitioner asserts that "the effect" of the October 26, 2010 stipulation order and dismissal, dismissing requester's defenses and counterclaims with prejudice, is that requester failed to sustain its burden of proving the invalidity of any patent claim in suit, the October 26, 2010 stipulation order and dismissal fails to state such.

Further, while the patent owner asserts that the parties filed a joint stipulation with the district court that the invalidity defenses of the requester were to be dismissed with prejudice, resulting in the October 26, 2010 stipulation and order of dismissal, patent owner points to no language of the joint stipulation establishing that requester had not sustained its burden of proving the invalidity of any patent claim in suit and merely states that the joint stipulation "can only reasonably be viewed as an agreement between the parties that requester had not sustained its burden of proving the invalidity of any patent claim in suit."[17] However, because patent owner and requester executed and filed the joint stipulation prior to trial, the district court's stipulation and order of dismissal can just as reasonably be viewed as an agreement between the parties that the patent owner failed to establish that the requester infringed the patent owner's patent, absent any agreement between the parties as to the validity of the patent or that, for purely business purposes, it was economically advantageous for one or both of the parties to settle the litigation. The language of the court's dismissal, in such cases, could be identical to the language of the court's dismissal in the present case. There is nothing in the documents submitted by the patent owner that would evidence the parties' intent at settlement, or the court's intent in dismissing all of the claims and counterclaims with prejudice. That is, the patent owner has submitted no evidence to suggest that the court, or the parties, conducted an assessment of whether the requester sustained its burden, and that the parties specifically agreed, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met.[18]

The Office disagrees with petitioner's assertion that "[a]t the time of the Dismissal, it is undisputed that the requester did not meet its burden of showing invalidity of any of the claims of the patents in suit in the District Court Action – despite having had a full opportunity and the

[17] Id. at page 6.

[18] Similarly, the "Form 8-K," filed by patent owner with the SEC on November 2, 2010, provides information regarding the terms of the parties' settlement, such as cross-licensing and purchasing provisions, but the "Form 8-K" itself is not evidence of whether the requester sustained its burden, or that the parties specifically agreed, through a stipulated judgment or otherwise, that the burden of proving claim invalidity had not been met.

burden to prove such invalidity."[19] Rather, at the time of the October 26, 2010 stipulation and order of dismissal, a jury verdict had not yet been rendered in the concurrent litigation, which verdict was not entered with respect to patent owner and the remaining co-defendants until November 11, 2010.[20] Thus, by entering into a settlement agreement with patent owner prior to a jury verdict being entered, requester avoided a district court determination on whether requester sustained its burden of proving it defenses and counterclaims of invalidity. That is, at the time of the October 26, 2010 stipulation and order of dismissal, the district court had not yet made a determination on whether requester sustained its burden of proving requester's defenses and counterclaims of invalidity. Nor has petitioner established that the joint stipulation between patent owner and requester included a determination that requester had not met its burden with respect to proving requester's defenses and counterclaims of invalidity, only that the parties agreed that requester's defenses and counterclaims of invalidity be dismissed with prejudice.

Additionally, the reference in the Office's February 17, 2011 decision to collateral estoppel was made to illustrate that the district court's October 26, 2010 stipulation and order of dismissal does not itself establish any facts as to whether claims of the '443 patent were found to be valid or invalid. The Office agrees with petitioner that the language of 35 U.S.C. § 317(b) governs termination of an *inter partes* reexamination proceeding, not collateral estoppel (*i.e.*, issue preclusion). The provisions of the *inter partes* reexamination statute do not expressly incorporate the doctrine of issue preclusion or the doctrine of res judicata (*i.e.* claim preclusion). 35 U.S.C. 317(b), which stands by itself, incorporates only elements of each doctrine. Claim preclusion refers to "the effect of foreclosing any litigation of matters that never have been litigated, because of a determination that they should have been advanced in an earlier suit." 18 Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice and Procedure § 4402 (2d ed. 2002).[21] Issue preclusion refers to "the effect of foreclosing relitigation of matters that have once been litigated and decided." Wright, Miller & Cooper § 4402. The principle distinction between claim preclusion and issue preclusion is that the former forecloses litigation of matters that have *never been litigated.*[22] 35 U.S.C. 317(b) prohibits a requester from requesting, and the Office from maintaining, an *inter partes* reexamination of a patent claim on the basis of issues which the requester *raised, or could have raised*, in a civil action as defined in the statute. In other words, the statute forecloses *inter partes* reexamination on the basis of issues that have been litigated (*i.e.*, raised), which is an element of issue preclusion. The statute also forecloses *inter partes* reexamination on the basis of issues that have not been litigated, but *should have been advanced* (*i.e.*, *could have been raised*), which is the primary element of claim preclusion. The statute, however, does not incorporate the entirety of either doctrine.

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[19] March 15, 2011 renewed petition under 37 CFR 1.182 at page 7.

[20] Thus, it is not clear how patent owner is relying on the jury verdict form, a copy of which was submitted as Exhibit 4. Moreover, the jury verdict form appears to indicate that the jury found that at least some of the claims of the '443 patent are invalid.

[21] See also *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362; 55 USPQ2d 1854 (Fed. Cir. 2000), quoting *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1, 104 S.Ct. 892 (1984).

[22] See, e.g., *Black's Law Dictionary,* definition of "claim preclusion", quoting Charles Alan Wright, *The Law of Federal Courts,* §100A, at 723.

C. Whether the issues raised in the '407 proceeding are the same issues that were raised or could have been raised by the requester in the civil action need not be addressed

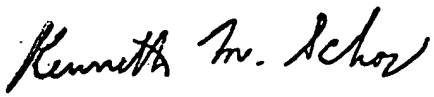
While petitioner presented reasons why it believes requester "did, or could have, raised each of the issues [in the civil litigation] that it raised in the present reexamination proceeding," [23] the Office need not address in detail whether the issues raised in the '407 proceeding are identical to those which were raised or could have been raised in the earlier concurrent litigation because, for the reasons set forth herein, petitioner has not established that a final decision has been entered in a civil action against requester that requester did not sustain its burden of proving the invalidity of any patent claim in suit. However, in the event a renewed petition is filed, such renewed petition should make reference to the record of the litigation and to the record of the instant reexamination proceeding to establish that prior art and issues that were raised for the claims under reexamination were raised in the litigation, and should identify, if applicable, which issues raised in the reexamination were not part of the litigation and provide an adequate explanation establishing that such issues could have been raised in the litigation. In such case, patent owner should provide a discussion of when the third party requester became aware of any prior art raised in the reexamination proceeding but not raised in the civil action and the status of the civil action at the time that the third party requester became aware of this prior art, to establish that the issue "could have been raised" by the third party requester in the context of the litigation.

In view of the above and under the present facts and circumstances, 35 U.S.C. § 317(b) does not mandate, nor permit, termination of the '407 proceeding, and patent owner's March 15, 2011 renewed petition under 37 CFR 1.182 to terminate the '407 proceeding is **dismissed**.

CONCLUSION

1. Patent owner's March 15, 2011 renewed petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

2. Telephone inquiries related to this decision should be directed to Nicole D. Haines, Legal Advisor, (571) 272-7717, or in her absence, or, in her absence, Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726.



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

7-26-11

[23] See March 15, 2011 renewed petition under 37 CFR 1.182 at pages 6-7.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,408	10/27/2008	6835887	017594-0000042	9553

909 7590 06/03/2011

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,408	010/27/08	6835887	2202A/529

EXAMINER
GAGLIARDI, ALBERT J..

ART UNIT	PAPER
3992	

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

DATE MAILED:

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JUN 03 2011

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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JUN 03 2011

CENTRAL REEXAMINATION UNIT

PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102	: : : :	(For Patent Owner)
BROMBURG & SUNSTEIN 125 SUMMER STREET BOSTON, MA 02110-1618	: : :	(For Third Party Requester)
In re: Devecka *Inter Partes* Reexamination Proceeding Control No.: 95/000,408 Deposited: October 27, 2008 For: U.S. Patent No.: 6,835,887	: : : : :	DECISION ON PETITION

This is a decision on a petition filed by the patent owner on February 18, 2011, entitled: "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING THAT THE THIRD PARTY REQUESTER'S JANUARY 19, 2011 SUBMISSION BE DEEMED IMPROPER AND EXPUNGED FROM THE RECORD" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion to review the allegedly improper entry of a paper into the record. The petition is being treated as a petition under 37 CFR § 1.181.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,835,887 issued on December 28, 2004.
- A request for *inter partes* reexamination was filed on October 27, 2008 and assigned control no. 95/000,408.
- *Inter partes* reexamination was ordered and prosecution progressed until an Action Closing Prosecution was mailed November 18, 2010.
- On December 20, 2010, patent owner responded to the ACP.
- On January 19, 2011, the third party requester filed comments.
- On February 18, 2011, patent owner filed the instant petition.
- On May 11, 2011, the Office issued a Right of Appeal Notice. The examiner denied entry of the patent owner's post-ACP amendment.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

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

37 CFR § 1.951 Options After Office Action Closing Prosecution in *Inter Partes* Reexamination

(a) After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing

prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

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

MPEP § 2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive Comments

IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2) . . . . If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments. No additional opportunity will be given for the third party requester to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.

DECISION

Patent owner ["petitioner"] argues that the third party requester's comments filed January 19, 2011 are improper and should be expunged from the record. The argument appears to be that the prior art cited in the comments should have been presented earlier and does not meet the requirements of 37 CFR § 1.948(a)(3), which the third party relied upon as permitting its submission.

As a procedural matter, the petition was filed under 37 CFR § 1.182, which is reserved for questions that are not provided for in the regulations. The Office considers petitions to strike a paper as being properly filed under 37 CFR § 1.181, as this is considered the invocation of supervisory authority of the Director to review the allegedly improper entry of a paper into the record. Such a petition is therefore provided for elsewhere in the regulations and is not proper under 37 CFR § 1.182. The petition is treated as a petition under 37 CFR § 1.181.

In the Right of Appeal Notice, the examiner denied entry of patent owner's post-ACP amendment. The third party requester's comments were drawn to the claims as amended in that non-entered submission. It is not entirely clear to what extent the examiner considered the comments, as they were not mentioned in the RAN. And, given that the patent owner's amendment was not entered, the petition is somewhat moot, as the comments and proposed rejections are drawn to claims that are not presently pending. Nevertheless, the petition is decided on the merits.

35 U.S.C. § 314(b)(2) only permits third party comments "addressing the action of the Office or the patent owner's response thereto." *See also* 37 CFR § 1.947 ("These comments shall be limited to issues raised by the Office action or the patent owner's response."). Accordingly, MPEP 2672(IV) directs that a comments submission filed after an ACP that goes beyond the scope of the patent owner's response or the ACP will be returned and/or expunged from the record. That section also states that no additional opportunity will be given to correct the defect in a post-ACP comments submission.

Turning back to the merits, the third party newly proposes that claims 1-52 be rejected as obvious over new combinations of references, replacing the Melody Blaster reference with the Kennedy references. Such new proposals, however, do not in any way address or respond to any issues raised in the ACP or the patent owner's response.

In the ACP, the examiner did not reject the claims over prior art, explaining why the third party requester's proposals were not adopted. The examiner found that the Melody Blaster and Weiss references, which were asserted by the third party as teaching certain limitations, do not in fact teach those limitations. The third party requester was free to argue in its comments why, in its opinion, the examiner was mistaken and the references do indeed teach the limitations. Instead, the third party replaced Melody Blaster with the Kennedy references.

The issue raised in the Office action was whether Melody Blaster or Weiss teach the particular limitations of the claims. The issue raised in the Office action was NOT whether *any* prior art might teach those limitations. In an analogous situation, the MPEP states:

> As to [rebutting a finding of fact by the examiner], 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of

> record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

MPEP 2666.05. Thus, a finding of fact that a reference lacks a limitation is not a finding of fact that no reference teaches the limitation. In the same way, the "issue raised" by refusing to adopt a rejection because a reference lacks a limitation is simply that—the issue of whether the reference shows the limitation. It is not an issue of whether any reference can be found to show the limitation. Proposing a new rejection in place of the non-adopted rejection therefore goes beyond the scope of the issues raised in the Office action, which is not permitted by the rules.

The third party requester's proposed rejections in the comments are not limited to the issues raised in the ACP and patent owner's response thereto. The submission of January 19, 2011 was therefore improper and is expunged from the record. Accordingly, the petition is granted.

CONCLUSION

1. The petition filed February 18, 2011 is granted. The third party comments filed January 19, 2011 are expunged from the record and the third party has no opportunity to correct the defective submission.

2. Jurisdiction returns to the examiner for consideration of patent owner's response to the ACP. An Office action will issue in due course.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the Eric Keasel at (571) 272-4929 or Jessica Harrison at (571) 272-4449.

Mark Reinhart
SPE, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,408	10/27/2008	6835887	017594-0000042	9553

909 7590 08/15/2011

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EXAMINER

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BOSTON, MA 02110-1618

Date:

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AUG 15 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000408
PATENT NO. : 6835887
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102	: : : :	(For Patent Owner)

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AUG 15 2011

CENTRAL REEXAMINATION UNIT

BROMBURG & SUNSTEIN 125 SUMMER STREET BOSTON, MA 02110-1618	: : :	(For Third Party Requester)

In re: Devecka *Inter Partes* Reexamination Proceeding Control No.: 95/000,408 Deposited: October 27, 2008 For: U.S. Patent No.: 6,835,887	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on June 20, 2011, entitled: "PETITION UNDER 37 C.F.R. § 1.181 – REQUEST TO ENTER AMENDMENTS AFTER ACTION CLOSING PROSECUTION AND TO RE-OPEN PROSECUTION" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion to review the examiner's denial of entry of patent owner's amendment and further requests that prosecution be reopened.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is the opposition filed by the third party requester on July 5, 2011. The petition is denied-in-part and dismissed-in-part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,835,887 issued on December 28, 2004.
- A request for *inter partes* reexamination was filed on October 27, 2008 and assigned control no. 95/000,408.
- *Inter partes* reexamination was ordered and prosecution progressed until an Action Closing Prosecution was mailed November 18, 2010.
- On December 20, 2010, patent owner responded to the ACP.
- On January 19, 2011, the third party requester filed comments.
- On May 11, 2011, the Office issued a Right of Appeal Notice. The examiner denied entry of the patent owner's post-ACP amendment.
- On June 3, 2011, the Office issued a decision expunging the January 19th comments submission as improper.
- On June 20, 2011 patent owner filed the instant petition. Petitions under 37 CFR §§ 1.182 and 1.183 were also filed; these will be addressed separately. A Notice of Appeal was also filed by patent owner.
- On July 5, 2011, the third party filed the opposition to the instant petition. It also filed a Notice of Cross Appeal.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.116 Amendments and Affidavits or Other Evidence After Final Action and Prior to Appeal (in part)

(b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

***

(e) An affidavit or other evidence submitted after . . . 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.

37 CFR § 1.951 Options After Office Action Closing Prosecution in *Inter Partes* Reexamination (in part)

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

DECISION

Patent owner ["petitioner"] argues that its amendment filed December 20, 2010 after the Action Closing Prosecution ["ACP"] should have been entered, and requests either that prosecution be reopened for considering the amendment, or that it be entered for purposes of appeal. As the examiner's action was in accordance with Office policy and regulations, the denial of entry was not improper and will not be disturbed by supervisory review.

The entry of amendments filed after ACP is governed by 37 CFR § 1.116(b), which permits entry in three situations. In the Right of Appeal Notice mailed May 20, 2011 ["RAN"] the examiner thoroughly analyzed the amendment in light of 37 CFR § 1.116(b) and determined that the amendment would not be entered. *See* RAN pp. 2-6. The examiner stated that 37 CFR § 1.116(b)(1) clearly did not apply as there was no cancellation of claims or previous requirement

of form; § 1.116(b)(2) did not apply because the amendment raises new patentability issues, thus not presenting the claims in better form for appeal; and § 1.116(b)(3) did not apply because there was no reason the amendment could not have been presented earlier. Despite this analysis, petitioner states the amendment should be entered. Petitioner's arguments go toward whether § 1.116(b)(2) and/or (3) are satisfied.

Petitioner first states that amendment could not have been presented earlier because it was submitted in response to a rejection first made in the ACP. Petition p. 5. This is apparently an argument that 37 CFR § 1.116(b)(3) permits entry of the amendment. While it is true that these rejections were first presented in the ACP, this does not mean that the patent owner could not have presented the amendment prior to ACP. That is, it was *patent owner* who presented an earlier amendment with claims that did not comply with 35 U.S.C. § 112, necessitating a new rejection in the ACP, and nothing prevented patent owner from instead presenting the instant amendment at that time. This is not like a case where a patent owner is first made aware of new prior art rejecting claims in an ACP; such a situation might very well be a good and sufficient reason why the amendment was necessary and not earlier presented because patent owner had no notice of such art and could, for the first time, amend to overcome that art rejection. But patent owner always has notice that 35 U.S.C. § 112 is a requirement of patentability, and it is not unreasonable to expect that it should have complied with that statutory requirement earlier. As stated by the examiner, there was nothing preventing patent owner from submitting the present amendment prior to ACP, rather than the one it submitted. This is not to say that patent owner should have read the examiner's mind and known that a rejection was forthcoming. Rather, it was patent owner's responsibility to present claims that were patentable under 35 U.S.C. § 112, and patent owner was aware of the § 112 requirements when it made its earlier amendment.

Petitioner next argues that the amendment was a *bona fide* effort to advance prosecution. Petition pp. 6-7. Be that as it may, whether an amendment is a *bona fide* effort to advance prosecution has no bearing on the whether it satisfies the requirements of 37 CFR § 1.116. Petitioner does state several times in this section that various proposed amendments reduce issues for appeal, thus apparently alleging the amendment satisfies 37 CFR § 1.116(b)(2). But the examiner found in the RAN that the amendment actually raises new and different issues of patentability. This point is addressed in the next paragraph, and the Director agrees that new issues are raised. An amendment does not place the claims in better form for appeal, even if it reduces issues, if it also raises new issues requiring further examination.

Petitioner finally argues that the examiner's description of the alleged new issues raised in the amendment are not clear. Petition pp. 7-8. This argument is important because if there really are no new issues, then 37 CFR § 1.116(b)(2) might be satisfied. Petitioner, however, did not

address all of the points noted by the examiner as raising new issues.[1] For example, as noted by the examiner in the RAN, the amendment removed the limitation from claim 1 that "the user-controllable music input source device comprises a guitar-like device having a plurality of buttons," moving this limitation to dependent claim 10. While the definiteness of this term was at issue previously, the change does not remove this issue from appeal, as it is still a part of the claims, just now as dependent claim 10. Furthermore, the removal of this limitation from claim 1 broadens the claim, and all claims dependent therefrom. It is notable that all of the pending claims included this (or a similar) limitation at the time of the ACP, the first time when no claims were rejected over prior art. Patent owner had argued prior to ACP that many of the references in this proceeding lacked this limitation, and it is apparent that many of the references do not concern "guitar-like" devices. The examiner is therefore correct that this broadening of the claims would require additional consideration, for the examiner would have to determine if the decisions favorable to patentability remain as in the ACP or need to be changed. Given this need for further consideration, the claims are not in better form for appeal.

Additionally, even if the other new issues set forth by the examiner are unclear, as argued by petitioner, this does not mean the claims are in better form for appeal. It is not the examiner's burden to prove the claims as amended are unpatentable, or even that they are in *worse* form for appeal. The regulation permits admission only if the claims presented are in <u>better</u> form for appeal. The examiner has at least set forth colorable arguments as to why new issues are raised; the fact that new issues are raised (even if such issues might have ultimately been resolved in favor of petitioner), means the claims are not in better form for appeal and may not be admitted.

In light of the above, the examiner has sufficiently shown that the amendment filed after ACP did not satisfy the requirements for entry set forth in 37 CFR § 1.116(b), and the arguments to the contrary are not persuasive. It was therefore not improper for the examiner to deny entry of the amendment. As an alternative grounds of relief petitioner requests reopening of prosecution for consideration of the amendment. Given that the examiner did not improperly deny entry, prosecution will not be reopened. To the extent the petition requests entry of the amendment or reopening of prosecution, it is <u>denied</u>.

Supplemental Kitchen Declaration

Petitioner additionally questions whether the Supplemental Kitchen Declaration filed with the amendment has been entered, and as part of the relief sought requests entry of this declaration. *See* Petition p. 2 n.1; p. 8. While the examiner clearly denied entry of the amendment, he did not explicitly state whether the Supplemental Kitchen Declaration was entered.

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[1] This is not an invitation to petition again to address the point below. Any and all arguments should have been included in the original petition, and the time to petition is passed. *See* 37 CFR § 1.181(f).

It appears that the Supplemental Kitchen Declaration has indeed been entered into the record. First, the examiner drew a distinction between the amendment and the remainder of the response, and stated only that the amendment was not entered. RAN p. 2 ("The proposed amendment *accompanying Patent Owner's response* has not been entered.") (emphasis added). Furthermore, the examiner never mentioned the portion of 37 CFR § 1.116 that relates to declarations, subsection (e), therefore it could not have been denied entry for failing to comply with § 1.116. Most telling, however, is that the examiner actually addressed the Supplemental Kitchen Declaration. It was mentioned by name at page 31 of the RAN, and at page 37 the examiner stated that his discussion was "based on full consider[ation] of both the Patent Owner's arguments and the submitted Declarations." The examiner would not consider things that were not entered into the record, therefore it is implied that the Supplemental Kitchen Declaration has been entered. As the examiner did not deny entry of the declaration, and said that it was considered, the Director finds that it has been entered. Thus, to the extent that the petition requests entry of the Supplemental Kitchen Declaration, it is dismissed as moot.

Accordingly, the examiner's action denying entry of the December 20, 2010 amendment was not improper. To the extent petitioner request entry of the amendment or reopening of prosecution, the petition is denied. The Supplemental Kitchen Declaration filed with the amendment was addressed and considered by the examiner, therefore it has been entered. To the extent the petition requests entry of this declaration, it is dismissed as moot.

CONCLUSION

1. The petition filed June 20, 2011 is denied-in-part and dismissed-in-part. Patent owner's amendment filed December 20, 2010 remains not entered and prosecution is not reopened. The Supplemental Kitchen Declaration filed with the amendment was already considered by the examiner and therefore it was implicitly entered.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,408	10/27/2008	6835887	017594-0000042	9553

909 7590 10/04/2011

PILLSBURY WINTHROP SHAW PITTMAN, LLP (NV)
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/04/2011

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

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Date:

MAILED
OCT 04 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000408
PATENT NO. : 6835887
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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OCT 04 2011

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Devecka
Inter Partes Reexamination Proceeding
Control No. 95/000,408
Filed: October 27, 2008
For: U.S. Patent No. 6,835,887

: **DECISION**
: **DISMISSING PETITIONS**
: **UNDER § 1.182 & 1.183**

This is a decision on the June 20, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION" and the September 26, 2011 patent owner petition entitled "PATENT OWNER'S PETITION FOR EXTENSION OF TIME TO FILE APPEAL BRIEF PURSUANT TO 37 C.F.R. § 1.183."

The patent owner petitions are before the Office of Patent Legal Administration.

The petitions under 37 C.F.R. §§ 1.182 and 1.183 are **dismissed.**

PERTINENT BACKGROUND

- On October 27, 2008, a request for *inter partes* reexamination of claims 1-9 of U.S. Patent 6,835,887 was filed by a third party requester. This proceeding was accorded control number 95/000,408("the '408 proceeding"). Reexamination was ordered on January 9, 2009, and a non-final Office action was issued on June 1, 2009, rejecting claims 1-9 over prior art under 35 U.S.C. §§ 102 and 103. The '887 patent is the subject of concurrently pending reissue application 11/646,617.

- On August 3, 2009, patent owner filed amendments to original claims 1-9 and new claims 10-52. Third party requester filed comments on September 2, 2009.

- On November 18, 2010, the Office mailed an action closing prosecution (ACP) in which all 52 claims were rejected as failing to comply with the written description requirement and as being indefinite under 35 U.S.C. § 112.

- On December 20, 2010, patent owner filed proposed amendments to claims 1, 7-9, 10, 12, 15-17, 20, 21, 24, 31, 33, 37-39, 42, 43, and 46.

- Prosecution progressed until, on May 20, 2011, a Right of Appeal Notice (RAN) was issued by the Office, in which patent claims 1-52 were rejected as failing to comply with the written description requirement and as being indefinite under 35 U.S.C. § 112. The proposed amendments filed on December 20, 2010 were denied entry as failing to reduce or simplify issues for appeal.

- On June 20, 2011, patent owner filed a Notice of appeal and the following petitions:

    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.181 requesting reconsideration of the examiner's decision to close prosecution.
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.182 – REQUEST FOR CONTINUED REEXAMINATION."
    - The instant petition entitled "PETITION UNDER 37 CFR § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until after decisions are issued on the co-filed § 1.181 and § 1.182 petitions.

- On August 15, 2011, the Office issued a decision dismissing requester's June 20, 2011 petition under § 1.181.

- On August 23, 2011, the Office issued a decision granting requester's June 20, 2011 petition under § 1.183 to the extent that the time for a party to file an appellant's brief until October 5, 2011.

- On September 26, 2011, patent owner filed the instant petition under § 1.183 requesting waiver of 37 C.F.R. § 41.67 to permit extension of time to file the Appellant's Brief.

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)

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

The § 1.182 Petition

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

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

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

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 which grants continuation of prosecution in a reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to present claim amendments that purport to respond to new rejections set forth in the November 18, 2010 ACP, such that the amendments could not have been earlier anticipated, and that entry of such would advance prosecution.

Patent owner's December 20, 2010 response includes a submission directed towards the entry of claim amendments as described in patent owner's instant petition. The examiner has refused entry of these amendments as raising new issues of indefiniteness/lack of written description. As one example, the examiner stated that the amendment adding "pads or buttons" in claim 1 in not supported by the written description.

Patent owner's June 20, 2011 petition does not address all of the concerns raised by the examiner in the RAN in support of the decision to refuse entry of the December 20, 2010 proposed amendment. While the petition addresses the indefiniteness issues raised by the examiner in the RAN, the petition fails to address the written description issues raised by the examiner in the RAN. For example, the petition does not address where and how the amendment adding "pads or buttons" in claim 1 is supported by the written description.[2]

It is noted that the proposed amendment would broaden certain claims by removing limitations such as "at a correct time" and "an additional user-controllable musical input source device." Removal of limitations from the claims could result in new prior art issues being raised where

[2] The examiner's decision to refuse entry of the amendment was reviewed by the examiner's supervisor in a decision on the June 20, 2011 petition under § 1.181. That decision, mailed on August 15, 2011, also stated that the petition under § 1.181 failed to address all issues raised by the examiner in the RAN.

none currently exist.

As such, entry of the amendment would, on the basis of the facts of record in the file, not act to simplify or reduce entry of issues in the proceeding such that the issues in the proceeding would be better defined for appeal or issuance of a reexamination certificate.

Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the instant patent owner petition under § 1.182 is **dismissed**. It is noted that examination of the '887 patent at issue continues in reissue application 11/646,617, currently under a non-final action.

The § 1.183 Petition

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.

Patent owner petitioner filed the instant petition to request that the time for filing an appellant's Brief be extended until patent owner's petition under § 1.182 has been acted upon. Patent owner's petition under § 1.182 is being dismissed in the present decision. Patent owner petitioner's § 1.182 petition has thus been answered before the due date for filing an appellant's brief which is not due until October 5, 2011, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition under § 1.183 is **dismissed** to the extent that the requested 30 day extension is not granted. However, in view of the circumstances of the present proceeding, the time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision (October 18, 2011).

CONCLUSION

1. The patent owner petitions under §§ 1.182 and 1.183 are **dismissed.**

2. The time for a party to file an Appellant's Brief is due to expire on October 5, 2011. In view of the circumstances of the present proceeding, the time to file an Appellant's Brief under § 41.66(a) is extended to run through a date that is two weeks from the mailing date of this decision.

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 the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

October 4, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,408	10/27/2008	6835887	017594-0000042	9553

909 7590 10/04/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/04/2011

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Date:
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OCT 04 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000408
PATENT NO. : 6835887
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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OCT 04 2011

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(For Third Party Requester)

In re Devecka
Inter Partes Reexamination Proceeding
Control No. 95/000,408
Filed: October 27, 2008
For: U.S. Patent No. 6,835,887

: **DECISION**
: **DISMISSING OPPOSITION**
: **UNDER § 1.182 & 1.183**

This is a decision on the July 5, 2011 third party requester petition entitled "Third Party Requester's Opposition Petition Under 37 C.F.R. §§ 1.182 and § 1.183 to Oppose Patent Owner's Petitions Under 37 C.F.R. § 1.181 and Under 37 C.F.R. § 1.183."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the third party opposition petition is **refused entry** and **expunged** from the file.

BACKGROUND

- On October 27, 2008, a request for *inter partes* reexamination of claims 1-9 of U.S. Patent 6,835,887 was filed by a third party requester. This proceeding was accorded control number 95/000,408("the '408 proceeding"). Reexamination was ordered on January 9, 2009, and a non-final Office action was issued on June 1, 2009, rejecting claims 1-9 over prior art under 35 U.S.C. §§ 102 and 103. The '887 patent is the subject of concurrently pending reissue application 11/646,617.

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    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.181 requesting reconsideration of the examiner's decision to close prosecution.
    - A petition entitled "PETITION UNDER 37 C.F.R. § 1.182 – REQUEST FOR CONTINUED REEXAMINATION."
    - A petition entitled "PETITION UNDER 37 CFR § 1.183," requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until after decisions are issued on the co-filed § 1.181 and § 1.182 petitions.

- <u>On July 5, 2011, third party requester filed the instant petition entitled "Third Party Requester's Opposition Petition Under 37 C.F.R. §§ 1.182 and § 1.183 to Oppose Patent Owner's Petitions Under 37 C.F.R. § 1.181 and Under 37 C.F.R. § 1.183."</u>

- On August 15, 2011, the Office issued a decision dismissing requester's June 20, 2011 petition under § 1.181.

- On August 23, 2011, the Office issued a decision granting requester's June 20, 2011 petition under § 1.183 extending the time for filing an Appellant's Brief, by either or both parties, until October 5, 2011.

- On September 26, 2011, patent owner filed a further petition under § 1.183 requesting waiver of 37 C.F.R. § 41.67 to permit an additional extension of time to file the Appellant's Brief.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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. § 1.181 provides, in pertinent part:

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

37 C.F.R. § 1.951(a) provides:

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

37 C.F.R. § 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.

MPEP 2667 (II)(B)(3) states:

Thus, for example, in instances where there is a right to file an opposition to a petition, any such opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party, to ensure consideration. Any such opposition that is filed after the two-week period will remain in the record, even though it is not considered.

DECISION

With respect to the July 5, 2011 requester paper opposing patent owner's petition under 37 CFR 1.181, neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to request continued reexamination or a patent owner's petition seeking review of action taken by an examiner in an action closing prosecution. Neither a request for continued reexamination nor a petition for supervisory review is a response to an "Office action on the merits." Rather, such

petitions address formal requirements and are matters within the discretion of the Office in balancing the equities as to the "special dispatch" requirement and the needs of a specific situation. Stated differently, as pointed out above, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to provide relief not expressly provided for by the rules and a petition to request supervisory review. The subject matter of such petitions are clearly matters within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute.

While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition that requests continuing reexamination. No mechanism has been provided for the third party requester to file a paper, such as the present paper, that is in response to an event other than a patent owner response to an Office action. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

A third party requester's opposition to a patent owner's petition requesting review of a decision dismissing a request for continuing reexamination is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is also not permitted as a submission of written comments to a patent owner's response to an Office action, since such third party written comments are the subject of a separate paper. Third party requester's opposition to patent owner's petition is therefore not enterable into the record.

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office,[1] the consideration of a request for continued reexamination (including a review of a decision on the request) is clearly within the Office's jurisdiction,[2] and the Office may exercise its discretion to grant such relief to provide a limited reopening of prosecution. Therefore, the requester's June 8, 2011 opposition is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

Furthermore, the patent owner petition under § 1.181 was dismissed in a decision mailed August 15, 2011, thus rendering moot any opposition to the granting of that petition.

---

[1] Compare the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act. Such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding.

[2] As to a patent owner's petition requesting continuing reexamination being a matter within the jurisdiction of the Office, 35 U.S.C. § 314(a) provides that reexamination will be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133." The Office clearly has the authority to reopen prosecution, in exercising its discretion.

Further note that 37 C.F.R. § 1.4(c) requires that each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. The instant petition, which is directed towards two separate subjects, is therefore inappropriate in view of § 1.4(c).

Finally, the instant opposition paper was filed on July 5, 2011, more than two weeks from the June 20, 2011 service of the patent owner petitions on the third party requester. As MPEP 2667 (II)(B)(3) sets a two-week period in which oppositions may be filed, where such oppositions are proper, the instant opposition paper would be untimely even if it were a proper opposition.

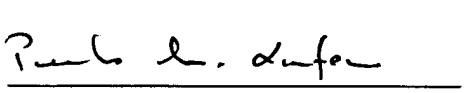
In view of the above, the opposition will be refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a) - "[I]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's July 5, 2011 opposition to the patent owner's petitions filed on June 20, 2011 does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the requester's paper opposing patent owner's request for revival will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. The third party opposition petition is **refused entry** and **expunged** from the file.

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



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

October 4, 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.
95/000,409	10/27/2008	6369313	2202A/530	6024

909 7590 04/01/2011

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date: MAILED
APR 01 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000409
PATENT NO. : 6369313
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Commissioner for Patents
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(For Patent Owner)

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN VA 22102

(For Requester)

SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

MAILED
APR 01 2011
CENTRAL REEXAMINATION UNIT

In re: Devecka
Reexamination Proceeding
Control No. 95/000,409
Request Deposited: October 27, 2008
For: U.S. Patent No. 6,369,313

DECISION DISMISSING PETITION

The *inter partes* reexamination is before the Central Reexamination Unit to address the January 5, 2011 patent owner paper entitled "PETITION UNDER 37 C.F.R. §1.182 REQUESTING THAT THE THIRD PARTY REQUESTER'S DECEMBER 6, 2010 SUBMISSION BE DEEMED IMPROPER AND EXPUNGED FROM THE RECORD."

As the office has not yet issued the next office action, the request is **dismissed as premature**.

CONCLUSION

1. The Patent Owner petition is **dismissed as premature**.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,409	10/27/2008	6369313	2202A/530	6024

909 7590 10/20/2011

Pillsbury Winthrop Shaw Pittman, LLP (NV)
PO Box 10500
McLean, VA 22102

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date: MAILED
OCT 20 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000409
PATENT NO. : 6369313
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Patent Owner)

MAILED

OCT 20 2011

CENTRAL REEXAMINATION UNIT

BROMBURG & SUNSTEIN
125 SUMMER STREET
BOSTON, MA 02110-1618

(For Third Party Requester)

In re: Devecka
Inter Partes Reexamination Proceeding
Control No.: 95/000,409
Deposited: October 27, 2008
For: U.S. Patent No.: 6,369,313

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 – REQUEST TO ENTER AMENDMENTS AFTER ACTION CLOSING PROSECUTION AND TO RE-OPEN PROSECUTION" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion to review the examiner's denial of entry of patent owner's amendment and further requests that prosecution be reopened.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is the opposition filed by the third party requester on May 18, 2011, to the extent it applies to the petition. The petition is denied-in-part and dismissed-in-part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,369,313 issued on April 9, 2002.
- A request for *inter partes* reexamination was filed on October 27, 2008 and assigned control no. 95/000,409.
- *Inter partes* reexamination was ordered and prosecution progressed until an Action Closing Prosecution was mailed October 4, 2010.
- On November 4, 2010, patent owner responded to the ACP.
- On April 5, 2011, the Office issued a Right of Appeal Notice. The examiner denied entry of the patent owner's post-ACP amendment.
- On May 5, 2011 patent owner filed the instant petition. Petitions under 37 CFR §§ 1.182 and 1.183 were also filed; these will be addressed separately. A Notice of Appeal was also filed by patent owner.
- On May 18, 2011, the third party filed the opposition to the instant petition. It also filed a Notice of Cross Appeal.
- On July 18, 2011, the third party filed its brief.
- The Office has not acted on the §§ 1.182 and 1.183 petitions, but patent owner has not filed a brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR § 1.116 Amendments and Affidavits or Other Evidence After Final Action and Prior to Appeal (in part)

(b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

***

(e) An affidavit or other evidence submitted after . . . 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.

37 CFR § 1.951 Options After Office Action Closing Prosecution in *Inter Partes* Reexamination (in part)

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

DECISION

Patent owner ["petitioner"] argues that its amendment filed November 4, 2010 after the Action Closing Prosecution ["ACP"] should have been entered, and requests either that prosecution be reopened for considering the amendment, or that it be entered for purposes of appeal. As the examiner's action was in accordance with Office policy and regulations, the denial of entry was not improper and will not be disturbed by supervisory review.

The entry of amendments filed after ACP is governed by 37 CFR § 1.116(b), which permits entry in three situations. In the Right of Appeal Notice mailed April 5, 2011 ["RAN"] the examiner thoroughly analyzed the amendment in light of 37 CFR § 1.116(b) and determined that the amendment would not be entered. *See* RAN pp. 2-8. The examiner stated that 37 CFR § 1.116(b)(1) clearly did not apply as there was no cancellation of claims or previous requirement

of form; § 1.116(b)(2) did not apply because the amendment raises new patentability issues, thus not presenting the claims in better form for appeal; and § 1.116(b)(3) did not apply because there was no reason the amendment could not have been presented earlier. Despite this analysis, petitioner states the amendment should be entered. Petitioner's arguments go toward whether § 1.116(b)(2) and/or (3) are satisfied.

Petitioner first states that amendment could not have been presented earlier because it was submitted in response to rejections first made in the ACP. Petition p. 5. This is apparently an argument that 37 CFR § 1.116(b)(3) permits entry of the amendment. While it is true that these rejections were first presented in the ACP, this does not mean that the patent owner could not have presented the amendment prior to ACP. That is, it was *patent owner* who presented an earlier amendment with claims that did not comply with 35 U.S.C. §§ 112 and 314, necessitating new rejections in the ACP, and nothing prevented patent owner from instead presenting the instant amendment at that time. This is not like a case where a patent owner is first made aware of new prior art rejecting claims in an ACP; such a situation might very well be a good and sufficient reason why the amendment was necessary and not earlier presented because patent owner had no notice of such art and could, for the first time, amend to overcome that art rejection. But patent owner always has notice that 35 U.S.C. §§ 112 and 314 are requirements of patentability, and it is not unreasonable to expect that it should have complied with the statutory requirements earlier. As stated by the examiner, there was nothing preventing patent owner from submitting the present amendment prior to ACP, rather than the one it submitted. This is not to say that patent owner should have read the examiner's mind and known that a rejection was forthcoming. Rather, it was patent owner's responsibility to present claims that were patentable under 35 U.S.C. §§ 112 and 314, and patent owner was aware of the statutory requirements when it made its earlier amendment.

Petitioner next argues that the amendment was a *bona fide* effort to advance prosecution. Petition pp. 5-6. Be that as it may, whether an amendment is a *bona fide* effort to advance prosecution has no bearing on the whether it satisfies the requirements of 37 CFR § 1.116. Petitioner does state several times in this section that various proposed amendments reduce issues for appeal, thus apparently alleging the amendment satisfies 37 CFR § 1.116(b)(2). But the examiner found in the RAN that the amendment actually raises new and different issues of patentability. This point is addressed in the next paragraph, and the Director agrees that new issues are raised. An amendment does not place the claims in better form for appeal, even if it reduces issues, if it also raises new issues requiring further examination.

Petitioner next argues that the examiner's description of the alleged new issues raised by the amendment are not clear. Petition pp. 7-8. This argument is important because if there really are no new issues, then 37 CFR § 1.116(b)(2) might be satisfied. Petitioner, however, did not

address all of the points noted by the examiner as raising new issues.[1] The examiner cited numerous alleged new issues, yet the petition only argues that a few of these are unclear. *Compare* RAN pp. 3-8 (mentioning approximately twelve new issues) *with* Petition p. 7 (mentioning only three claims in regards to allegedly unclear new issues). Even if petitioner is correct that the new issues set forth by the examiner are unclear, this does not mean the claims are in better form for appeal. It is not the examiner's burden to prove the claims as amended are unpatentable, or even that they are in *worse* form for appeal, to deny entry. The regulation permits admission only if the claims presented are in better form for appeal. The examiner has at least set forth colorable arguments as to why new issues are raised; the fact that new issues are raised (even if such issues might have ultimately been resolved in favor of petitioner), means the claims are not in better form for appeal and may not be admitted.

Petitioner finally argues that the RAN includes a new rejection that could have been presented earlier, and patent owner has not yet had an opportunity to respond to this rejection. Petition p. 8. Petitioner points to the examiner's statement on p. 4 of the RAN as to the proposed amendment of claim 77: "the proposed amendment raises the issue of indefiniteness because the nature of a "keyboard-like" device is unclear." It should be understood that this statement is not a rejection as argued by petitioner; it is merely part of the examiner's reasoning for not entering the amendment. Nowhere in the actual rejections of the RAN did the examiner find "keyboard-like device" or the like to be unclear or indefinite. Frankly, patent owner need not even respond to this statement by the examiner, as it is not a part of any rejection; therefore whether or not patent owner has had an opportunity to respond to this statement is meaningless. Petitioner might argue that this is further evidence of the lack of clarity of the examiner's statement of the new issues, but again it is not the examiner's burden to show the claims are in worse form for appeal, and this does not address the other various new issues given by the examiner.

In light of the above, the examiner has sufficiently shown that the amendment filed after ACP did not satisfy the requirements for entry set forth in 37 CFR § 1.116(b), and the arguments to the contrary are not persuasive. It was therefore not improper for the examiner to deny entry of the amendment. As an alternative grounds of relief petitioner requests reopening of prosecution for consideration of the amendment. Given that the examiner did not improperly deny entry, prosecution will not be reopened. To the extent the petition requests entry of the amendment or reopening of prosecution, it is denied.

Supplemental Kitchen Declaration

Petitioner additionally questions whether the Supplemental Kitchen Declaration filed with the amendment has been entered, and as part of the relief sought requests entry of this declaration.

---

[1] This is not an invitation to petition again to address the point below. Any and all arguments should have been included in the original petition, and the time to petition is passed. *See* 37 CFR § 1.181(f).

See Petition p. 2 n.1; p. 8. While the examiner clearly denied entry of the amendment, he did not explicitly state whether the Supplemental Kitchen Declaration was entered.

It appears that the Supplemental Kitchen Declaration has indeed been entered into the record. First, the examiner drew a distinction between the amendment and the remainder of the response, and stated only that the amendment was not entered. RAN p. 2 ("The proposed amendment *accompanying Patent Owner's response* has not been entered.") (emphasis added). Furthermore, the examiner never mentioned the portion of 37 CFR § 1.116 that relates to declarations, subsection (e), therefore it could not have been denied entry for failing to comply with § 1.116. Most telling, however, is that the examiner actually addressed this at page 31 of the RAN, where the examiner stated that his discussion was "based on full consider[ation] of both the Patent Owner's arguments and the submitted Declarations." The examiner would not consider things that were not entered into the record, therefore it is implied that the Supplemental Kitchen Declaration has been entered. As the examiner did not deny entry of the declaration, and said that it was considered, the Director finds that it has been entered. Thus, to the extent that the petition requests entry of the Supplemental Kitchen Declaration, it is dismissed as moot.

Accordingly, the examiner's action denying entry of the November 4, 2010 amendment was not improper. To the extent petitioner requests entry of the amendment or reopening of prosecution, the petition is denied. The Supplemental Kitchen Declaration filed with the amendment was considered by the examiner, therefore it has been entered. To the extent the petition requests entry of this declaration, it is dismissed as moot.

CONCLUSION

1. The petition filed May 5, 2011 is denied-in-part and dismissed-in-part. Patent owner's amendment filed November 4, 2010 remains not entered and prosecution is not reopened. The Supplemental Kitchen Declaration filed with the amendment was already considered by the examiner and therefore it was implicitly entered.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,410	10/27/2008	6225547	090336	3077

38834 7590 11/18/2011

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
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WASHINGTON, DC 20036

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Konami Digital Entertainment Co., Ltd.
v.
745 LLC

Reexamination Control 95/000,410
Patent 6,225,547 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37 C.F.R. § 1.183," filed October 7, 2011 ("Petition"). The Petition "requests that the restrictions under 37 C.F.R. § 1.943(c) for Appeal Briefs submitted in *Inter Partes* Reexamination be waived for the limited purpose of entering the concurrently filed Appeal Brief." Petition 1.

FINDINGS

1. On May 1, 2001, the Office issued Patent 6,225,547 B1 ("'547 patent"), which presently is assigned to Konami Digital Entertainment Co., Ltd. ("Konami").

2. On October 27, 2008, Third Party Requester 745 LLC ("745") filed a request for *inter partes* reexamination of the '547 patent and the Office assigned reexamination control number 95/000,410 to this proceeding.

3. On January 16, 2009, the Office granted 745's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-24 of the '547 patent.

4. The proceeding progressed to a point where, on June 23, 2011, the Office issued a Right of Appeal Notice (RAN), allowing claims 25, 26, 29, 30, 46 and 55, and rejecting claims 1-24, 27, 28, 31-45, 47-54 and 56-62.

5. The RAN is 50 pages, cites 11 references, and "incorporates by reference 27 pages of the third-party request which incorporates an additional 5 pages from the requester's expert declaration, making the total length 82 pages." Petition 2.

6. On July 25, 2011, 745 filed a Notice of Appeal under 37 C.F.R. § 41.61.

7. On August 8, 2011, Konami filed a Notice of Cross Appeal.

8. On October 7, 2011, Konami filed an Appellant Brief ("Appeal Brief for the Patent Owner") and the present Petition.

9. On October 11, 2010, 745 filed an Appellant Brief ("Appeal Brief by Third Party Requester").

10. Konami's Appellant Brief is 53 pages and "is estimated to be approximately 14,800 words with an additional 2700 words included from portions of the Declarations attached in the Evidence Appendix . . . . Thus, the approximate total word count is 17,500." Petition 1 (footnote omitted).

RELEVANT LEGAL AUTHORITY

With respect to the length of briefs filed in *inter partes* reexamination appeals, 37 C.F.R. § 1.943(c) specifies that:

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

Further, as noted in the Petition, MPEP § 2667 specifies that:

> Any affidavit or declaration (or a clearly defined portion thereof) that contains opin[i]on(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943.

With respect to waiver of the rules, 37 C.F.R. § 1.183 provides:

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

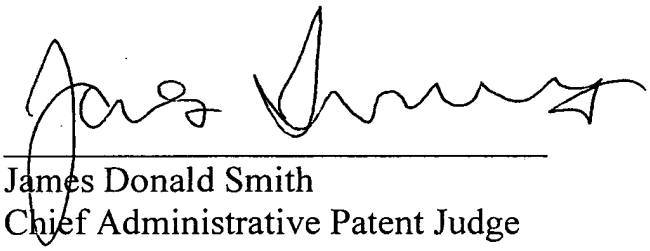
ANALYSIS

Konami seeks a waiver of the page/word limits of 37 C.F.R. § 1.943(c) for its Appellant Brief. Konami states that its Brief contains approximately 17,500 words – approximately 25% over the rule-specified 14,000 words. It is obvious that the RAN is lengthy and cites a number of

references in making multiple rejections. It is also obvious, however, that Konami added at least 38 claims during the reexamination proceeding. Thus, Konami, by adding multiple claims during the reexamination proceeding, is responsible for the lengthy RAN and multiple rejections, and has not demonstrated that an extraordinary situation exists where justice requires waiver of the rules.

DECISION

In view of the foregoing, Konami's Petition is DENIED, and Konami, having filed a non-compliant appellant brief, is given one month from to file a compliant brief.



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