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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.
95/000,411	11/06/2008	6,597,854	065484-0008B	4667

23552 7590 02/17/2011

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

PANDUIT CORP.,
Requester

v.

ADC TELECOMMUNICATIONS, INC.,
Patent Owner

Appeals 2011-003896, 2011-003295, 2011-003296, 2011-003297
Reexamination Control 95/000,411, 95/000,412, 95/000,413, 95/000,415
Patent 6,597,854, 6,868,220, 7,167,625, 6,925,242
Technology Center 3999

DECISION ON PETITION

This is a decision on Requester Panduit Corp's. "Request to Bring Physical Samples," filed February 14, 2011 ("Request").

Requester "requests authorization to bring two physical samples to the [hearings in the subject appeals], which are all scheduled to be heard on Wednesday, March 9, 2011, at 10:00 a.m., in Hearing Room A." Request, p. 1. The Request will be treated as a petition to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3.

FINDINGS

1. A combined oral hearing has been scheduled for all four appeals on March 9, 2011 at 10:00 a.m. in Hearing Room A of the Board of Patent Appeals and Interferences.

2. Requester represents that it is requesting permission to bring two samples to the hearing. One of the samples is represented to be a commercial embodiment of the Patent Owner's product,that is "supported in each of the patents subject to reexamination." The other sample is represented to be a "three-dimensional model of the device that [Requester] Panduit believes to be described in U.S. Patent No. 5,872,336 to Long." Request, p. 1.

RELEVANT AUTHORITY

In respect to evidence referred to at an oral hearing, 37 C.F.R. § 41.73(e) specifies:

> 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.

DISCUSSION

Based on Requester's representations that of the two samples it is seeking to bring to the hearing, one is a device covered by the patents at issue in these proceedings and the other is a model of a device taught in the prior art of record in these proceedings, such samples do not appear at this time to constitute new evidence.

DECISION

In view of the foregoing, the Request is GRANTED. Requester may bring the two samples described in the Request to the oral hearing on March 9, 2011. The judges of the panel at the hearing retain the discretion to handle the evidence in an appropriate manner, notwithstanding this decision.

James T. Moore
Acting Chief Administrative Patent Judge

Appeal 2011-003896, 2011-003295, 2011-003296, 2011-003297
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Counsel for Patent Owner:
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Alexandria, VA 22320-4850

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95/000,412	11/06/2008	6,868,220	065484-0014	8084

23552 7590 02/17/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,413	12/02/2008	7167625	065484-0016	9150

7590 02/17/2011

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MERCHANT & GOULD P.C.
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MINNEAPOLIS, MN 55402-0903

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95/000,415	11/06/2008	6925242	065484-0015	7623

23552 7590 02/17/2011

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Appeal 2011-003896, 2011-003295, 2011-003296, 2011-003297
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,417	02/13/2009	6904370	MODA 0004	8264

64194 7590 02/28/2011

DOWELL BAKER, P.C.
201 MAIN STREET
SUITE 710
LAFAYETTE, IN 47901

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOODCOCK WASHBURN LLP
CIRA CENTRE
2929 ARCH STREET, 12th FLOOR
PHILADELPHIA, PA 19104-2891

Date:
MAILED
FEB 28 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000417
PATENT NO. : 6904370
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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DOWELL BAKER, P.C.
201 MAIN STREET
SUITE 710
LAFAYETTE IN 47901

(For Patent Owner)

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

(For *Inter Partes* Requester)

COOLEY, GODWARD & KRONISH LLP
ATTN: PATENT GROUP
777 6th STREET NW, SUITE 1100
WASHINGTON, DC 20001

(For *Ex Parte* Requester)

MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,417
Filed: February 13, 2009
For: U.S. Patent No. 6,904,370

Ex Parte Reexamination Proceeding
Control No. 90/010,857
Filed: February 11, 2010
For: U.S. Patent No. 6,904,370

DECISION,
SUA SPONTE,
TO MERGE
REEXAMINATION
PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. On June 7, 2005, U.S. Patent No. 6,904,370 (the '370 patent) issued to Levinson *et al.* with 31 claims.

2. On February 13, 2009, a request for *inter partes* reexamination of all the claims in the '370 patent was filed by a third party requester and real party in interest, Moda Technology Partners, Inc. The request was assigned control number 95/000,417 (the '417 proceeding).

3. On April 10, 2009, *inter partes* reexamination was ordered for all the claims of the '370 patent in the '417 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

4. On June 22, 2009, a non-final Office action was mailed in the '417 proceeding, claims 6-7, 9-21, and 25-31 of the '370 patent were confirmed and claims 1-5, 8 and 22-24 of the '370 patent were rejected.

5. On August 21, 2009, patent owner timely filed, in the '417 proceeding, an amendment and response to the June 22, 2009 Office action, adding new claims 32-34. No claims were amended or canceled.

6. On September 23, 2009, third party request timely filed comments.

7. On February 11, 2010, a request for *ex parte* reexamination of all the claims in the '370 patent was filed by a third party requester. The request was assigned control number 90/010,857 (the '10857 proceeding).

8. On May 14, 2010, *ex parte* reexamination was ordered for all the claims of the '370 patent in the '10857 proceeding.

9. On October 6, 2010, the Office issued a notice of defective paper in the *inter partes* reexamination requiring a replacement copy of the August 21, 2009 patent owner response to include the underlining of all claim amendments.

10. On November 1, 2010, patent owner filed a corrected copy of the August 21, 2009 response in the '417 proceeding.

11. To date, no Office action has issued in the '10857 *ex parte* proceeding, and no further Office action has issued in the '417 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for the same claims of the same patent. One of the proceedings (the '10857 proceeding) is an *ex parte* proceeding. The other proceeding (the '417 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. In addition, the period for filing the patent owner's statement in the *ex parte* proceeding has expired. Therefore, consideration of merger is ripe at this point in time.

MPEP 2686.01 points out:

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in

> its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/010,857 and 95/000,417 proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

New claims 32-34 have been proposed in the '417 proceeding, while there is no amendment in the '10857 proceeding. Thus, the claims are not currently the same in both proceeding files. Accordingly, a copy of claims 32-34 from the amendment in the *inter partes* reexamination proceeding is being placed in the *ex parte* reexamination IFW file, and is being entered in the *ex parte* reexamination. Claims 1-34 will be addressed in the next Office action on the merits for the now merged proceeding. Such action is appropriate in this situation, because the *inter partes* reexamination requester has already had an opportunity to comment on the amendment in the *inter partes* reexamination and has done so.

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560, *i.e.* the *ex parte* requester does not obtain any new rights.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues

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

raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

The *inter partes* requester does not have a right to comment on any issue raised outside the confines of the statute, *e.g.* issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02 and 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, the *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN as to the rejections the third party requester proposed in the *inter partes* reexamination request (not as to the rejections proposed in the *ex parte* reexamination request), and any that the *inter partes* third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

> No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by *the* examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, an appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the requester did not propose in the *inter partes* reexamination request, or during the merged proceeding) can be proposed by the *inter partes* third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

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

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

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

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,417 and *ex parte* Reexamination Control No. 90/010,857 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

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

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

February 25, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,418	11/25/2008	7377324	069669-0003	4212

74954 7590 10/20/2010

Bracewell & Giuliani LLP
711 Louisiana Street
Suite 2300
Houston, TX 77002-2770

EXAMINER	
ART UNIT	PAPER NUMBER

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1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

Date:
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OCT 2 1 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000418
PATENT NO. : 7377324
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.

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BRACEWELL & GIULIANI LLP (For Patent Owner)
711 LOUISIANA STREET
SUITE 2300
HOUSTON, TX 77002-2770

MAILED

OCT 21 2010

CENTRAL REEXAMINATION UNIT

MORGAN LEWIS & BOCKIUS LLP (For Requester)
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

In re Beierbach et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/000,418	:	FOR REOPENING
Filed: November 25, 2008	:	PROSECUTION
For: U.S. Patent No.: 7,377,324	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on September 17, 2010. The petition is entitled "PETITION UNDER 37 C.F.R. § 1.181 TO REQUEST CORRECTED OFFICE ACTION," and is a request to the Director to exercise her discretion pursuant to 37 CFR 1.181 and order a corrected Office action in place of the Action Closing Prosecution issued on August 18, 2010.

The petition under 37 CFR 1.181 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated September 17, 2010 is denied with respect to withdrawing the ACP dated August 18, 2010 in the *Inter Partes* reexamination proceeding 95/000,418.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,377,324 (hereinafter, the '324 patent) issued on May 27, 2008.

2. A request for *inter partes* reexamination, assigned control No. 95/000,418, was filed by a third party requester on November 25, 2008.

3. *Inter partes* reexamination was ordered for the '418 reexamination proceeding on February 10, 2009. On the same day, a non-final Office action was mailed in the '418 reexamination proceeding.

4. Prosecution advance and on January 20, 2010, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

5. On February 18, 2010, the patent owner filed a 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.

6. On March 18, 2010, the February 18, 2010 petition was granted to the extent that the examiner should issue a corrected action.

7. On August 18, 2010, a corrected ACP was mailed. The ACP repeated the same rejections issued in the February 10, 2009 Office action.

8. On September 17, 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.

DECISION

The patent owner (petitioner) states that the ACP dated August 18, 2010 does not clearly develop the issues of patentability, because the ACP fails to clearly state each ground of rejection. Patent owner points to MPEP 2617 and to actions in other reexamination proceedings. See pages 2-3 of the petition. Patent owner also states that the ACP fails to set forth a rationale to combine the references for each obviousness rejection. Because of these grounds, petitioner requests that a corrected Office action should replace the ACP dated August 18, 2010.

First, upon review of the record, it is noted that the ACP contains the same rejections in the same format as presented in the non-final action of February 10, 2009.[1] Therefore, the action that the petitioner is requesting relief from is the non-final Office action, dated February 10, 2009, because this is the first action in which the same issue was present. The statutory requirement for "special dispatch" mandates that petitioner timely presents issues in order for prosecution in this proceeding to conclude in an expeditious manner. See 35 U.S.C. 314(c). In other words, allowing a party to wait to petition issues present in a non-final action until after the examiner closes prosecution in reexamination proceedings would be clearly against the statutory mandate of "special dispatch." Accordingly, this petition under 37 CFR 1.181 must have been filed within two months of the February 10, 2009 non-final action (e.g., April 10, 2009) to be considered timely filed.

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.)

In other words, this petition is untimely to request relief from the examiner's actions in the ACP because the ACP merely restates the same rejections[2] of the non-final action of February 10, 2009. It is further noted that petitioner did not complain about the grouping of the obviousness rejections in the February 18, 2010 petition under 37 CFR 1.181, which also requested a corrected Office action.

Even if this petition is deemed timely filed as being a petition requesting relief from the August 20, 2010 ACP, the grounds of argument presented in the petition addresses 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 is an appealable issue, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's actions 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

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[1] The August 18, 2010 ACP used the same format of alternative secondary references as in the ACP dated January 20, 2010, but petitioner patent owner did not bring forth the issue in the February 18, 2010 petition.

[2] The only change in the rejections from the non-final action to the August 18, 2010 ACP is to the paragraph reference numerals. The bases for all of the rejections remained the same.

encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution (ACP). The record shows that the examiner followed the statutory mandate of "special dispatch" by issuing the ACP because the ACP did not introduce any new grounds of rejection. Therefore, the record shows that the ACP was not premature. Accordingly, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the petition, as it relates to issuing a corrected action, is denied.

CONCLUSION

1. The September 17, 2010 petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated August 18, 2010 is **denied**.

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

Irem Yuksel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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74954 7590 01/04/2011

Bracewell & Giuliani LLP
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ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2011

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000418
PATENT NO. : 7377324
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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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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(For Patent Owner)

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WASHINGTON, DC 20004

(For Third Party Requester)

In re Beierbach *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,418
Filed: November 25, 2008
For: U.S. Patent No. 7,377,324

DECISION GRANTING IN-PART PETITIONS UNDER 37 CFR 1.183

This is a decision addressing patent owner's two September 17, 2010 petition papers entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)" ("the petitions under 37 CFR 1.183").

The petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, the petitions under 37 CFR 1.183 are granted in-part.

BACKGROUND

1. On May 27, 2008, U.S. Patent No. 7,377,324 ("the '324 patent") issued to Beierbach *et al.*

2. On November 25, 2008, a request for *inter partes* reexamination of the '324 patent was filed by a third party requester, which request was assigned control no. 95/000,418 ("the '418 proceeding.")

3. On February 10, 2009, the Office issued an order granting *inter partes* reexamination in the '418 proceeding, concurrently with a non-final Office action on the merits.

4. The '418 proceeding progressed to the point where, on August 18, 2010, the Office issued an Action Closing Prosecution ("ACP").

5. On September 17, 2010, patent owner filed a patent owner submission under 37 CFR 1.951(a) ("the 1.951(a) submission").[1]

6. Concurrently, on September 17, 2010, patent owner filed a first petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)," requesting waiver of the 37 CFR 1.943(b) page limit with respect to its 1.951(a) submission, which petition was accompanied by Exhibits A-D.[2] On the same day, patent owner filed a second petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)," requesting waiver of the 37 CFR 1.943(b) page limit with respect to its 1.951(a) submission, which petition was accompanied by Exhibits A-D and a "STATEMENT REGARDING 'PETITION UNDER 37 C.F.R 1.183 TO WAIVE THE REQUIREMENT OF 37 C.F.R. § 1.943(b)' FILED ON 09/17/2010" ("the statement regarding the petitions" as to why two copies of the petition were submitted).[3]

7. Also, on September 17, 2010, patent owner filed a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.181 TO REQUEST CORRECTED OFFICE ACTION" ("the petition under 37 CFR 1.181"), requesting that the August 18, 2010 ACP be withdrawn as defective.

8. On October 20, 2010, third party requester filed comments under 37 CFR 1.951(b).

9. On October 21, 2010, the Central Reexamination Unit (CRU) issued a decision denying patent owner's September 17, 2010 petition under 37 CFR 1.181.

DECISION

Relevant Statutes, Rules, and Examining 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

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[1] The 1.951(a) submission was accompanied by the following attachments: (1) a January 5, 2010 court "Memorandum and Order" from a co-pending litigation, (2) a copy of an April 6, 2009 patent owner response filed in 95/001,119, (3) a copy of an April 6, 2009 patent owner response filed in 95/001,114, and (4) copies of two patent documents.

[2] Exhibits A-D accompanying the first petition under 37 CFR 1.183 are copies of documents already of record in the '418 proceeding (i.e., a copy of the August 18, 2010 ACP, a copy of the November 25, 2008 request for *inter partes* reexamination, a copy of third party requester's October 28, 2009 comments submission, and a copy of the Office's July 29, 2010 petition decision). Patent owner need not have submitted copies of documents that are already of record in the '418 proceeding (i.e., Exhibits A-D) as reference to the date and title of such documents is sufficient to identify them in the IFW of the '418 proceeding.

[3] In the statement regarding the petitions, patent owner states that the second petition under 37 CFR 1.183 and accompanying Exhibits A-C are identical to the first petition under 37 CFR 1.183 and accompanying Exhibits A-C. Patent owner further states that "the document uploaded as Exhibit D" accompanying the first petition under 37 CFR 1.183 was not the correct document, and that the correct Exhibit D document (i.e., a copy of the Office's September 14, 2009 petition decision) accompanied the second petition under 37 CFR 1.183.

> 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.

37 CFR 1.951(a) provides (emphasis added):

> 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.

Analysis and Findings

This is a decision addressing the two September 17, 2010 patent owner petitions under 37 CFR 1.183.[4] In the petitions under 37 CFR 1.183, patent owner requests waiver of the 37 CFR 1.943(b) page limit for patent owner's 1.951(a) submission responsive to the August 18, 2010 ACP.[5] In particular, patent owner requests: (i) a 100-page limit for patent owner's 1.951(a) submission, and (ii) if the request for a 100-page limit is granted, that patent owner be given an opportunity to revise and resubmit its September 17, 2010 1.951(a) submission.[6] In the alternative, patent owner requests a page limit of "at least 66 pages."[7]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of waiver of the rule, patent owner asserts that "[t]he sheer volume of material presented against the Patentee, the complexity of the subject matter, and the co-pending litigation create an extraordinary situation that warrants a suspension of the 50-page limit."[8] In particular, patent owner asserts that "[i]t is inappropriate to limit the Patentee to 50 pages to respond to a 45 page Action Closing Prosecution that references both a 167 page Request for Reexamination and a 50 page Requester's Comments" and that, "at a minimum, there are 120 pages of material included

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[4] Because the two September 17, 2010 patent owner petitions under 37 CFR 1.183 are not identical (i.e., Exhibit D is different), both petitions are being considered in this decision.

[5] Petitions under 37 CFR 1.183 at page 6.

[6] Id. at page 7.

[7] Id. On its face, patent owner's September 17, 2010 1.951(a) submission is 66-pages, however, not included in this page count are pages of the attachment documents that may be counted against the page limit pursuant to MPEP § 2667(I)(A)(2).

[8] Id. at pages 1-2.

in the Action Closing Prosecution."[9] Additionally, patent owner asserts that the number of rejections and references cited also support waiver of the page limit.[10]

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 "Patentee has prepared a 66 page Response to the Action Closing Prosecution" and that "Patentee made a good faith effort to use word economy and appropriately reference the record."[11] 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 August 18, 2010 ACP, the nature of the rejections, and the number of references relied upon therein.

Based on the specific facts set forth in the instant petitions 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, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.[12] Patent owner's request for waiver of 37 CFR 1.943(b) to permit a 100-page submission (i.e., 50 extra pages), however, is not justified, as patent owner has not substantiated its need for 50 additional pages beyond stating that "this is less than the number of pages than was granted for Patentee's [September 28, 2009] response" and that the extra pages would afford patent owner an opportunity "to more thoroughly explain the arguments."[13] In addition, it is expected patent owner will be able to choose the best arguments without a need to unduly elaborate on them in the absence of a specific, detailed showing of extraordinary circumstances justifying an expansion of the arguments. Further, it has been determined that patent owner's request for 66 pages is insufficient as pages of the attachments to the 1.951(a) submission count against the page limit. However, in the interest of special dispatch, pursuant to 35 U.S.C. 314(c), the petitions under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) are granted in-part to the extent of permitting patent owner's 1.951(a) submission to exceed the page limit by 20 pages, as the total number of pages of patent owner's 1.951(a) submission that count toward the page limit is 70 pages.[14] This waiver makes patent owner's September 17, 2010 1.951(a) submission page-length compliant.

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[9] Id. at pages 2-3 (further stating that "[a] response limited to 50 pages would mean less than 2 response pages per claim.")

[10] Id. at pages 3-4 (stating that "some rejections create compound rejections by cross-referencing previous rejections within the Office Action," and that the ACP "refers to 9 separate references," where "[m]any of the rejections reference multiple references.")

[11] Id. at page 6. In the 1.951(a) submission, patent owner references arguments that are already of record in the '418 proceeding as opposed to repeating them.

[12] It is noted that, on its face, the August 18, 2010 ACP is 45 pages in length, but relies on incorporation by reference of approximately 84 pages from the request for *inter partes* reexamination in the '418 proceeding to set forth the rejections, as well as at least 30 pages from requester's comments.

[13] Petitions under 37 CFR 1.183 at pages 6-7.

[14] On its face, the remarks portion of patent owner's 1.951(a) submission is 66-pages. Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments as to how an outstanding/proposed rejection is overcome appear are included against the page limit count. Additionally, 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count. Thus, 58 pages of the remarks portion of the 1.951(a) submission count toward the page limit as the 1 page cover sheet and the 7 pages of claim

ADDITIONAL DISCUSSION

In the instant petitions under 37 CFR 1.183, patent owner also requests, in the event waiver of 37 CFR 1.943(b) is not granted, that the Office accept a patent owner submission having a "font size of less than 12 point and a line spacing of less than 1.5."[15] In view of the instant decision to waive the page limit of 37 CFR 1.943(b) for patent owner's September 17, 2010 1.951(a) submission, patent owner's request is dismissed. All parties to a reexamination proceeding are reminded that pursuant to 37 CFR 1.943(a) and 37 CFR 1.52, all papers must conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and must have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition, pursuant to 37 CFR 1.52(a)(1)(v). Papers with an unduly small font size or margins, single-spacing, and/or an unusual font type may be deemed to be improper if the paper is not found to comply with 37 CFR 1.52.

Patent owner further requests that the August 18, 2010 ACP "be reissued in a concise format that does not utilize a cross-references, compound rejection format."[16] A request for withdrawal of the August 18, 2010 ACP is a request for supervisory review of an action taken by the examiner in the '418 proceeding and is properly filed as a petition under 37 CFR 1.181, not as a petition under 37 CFR 1.183. When different forms of relief are being requested in a single petition, such petition would normally be considered improper under 37 CFR 1.4(c).[17] However, in the interest of special dispatch, pursuant to 35 U.S.C. 314(c), patent owner's petitions under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) have been considered and addressed in this decision. Accordingly, patent owner's petition under 37 CFR 1.181 is dismissed under 37 CFR 1.4(c), as each distinct subject must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects that are considered by different areas of the Office.

CONCLUSION

1. The petitions under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) are granted in-part to the extent of permitting patent owner's September 17, 2010 1.951(a) submission to exceed the regulatory 50-page limit by 20 pages. This waiver makes patent owner's 1.951(a) submission page-length compliant.

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amendments are excluded from the page limit count. Additionally, patent owner arguments as to how an outstanding/proposed rejection is overcome reference approximately 10 pages of the "Memorandum and Order" attachment and 2 pages of the April 6, 2009 patent owner response in 95/001,119 attachment, which pages are being counted toward the page limit pursuant to MPEP § 2667(I)(A)(2). Because arguments from the April 6, 2009 patent owner response in 95/001,114 attachment were inserted directly into the text of the remarks portion of the 1.951(a) submission, no pages from that attachment are being counted toward the page limit.

[15] Petition under 37 CFR 1.183 at page 6.

[16] Id.

[17] 37 CFR 1.4(c) states, "Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering paper dealing with different subject."

2. Telephone inquires related to the present decision should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717.

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

01-03-2011
Kenpet8/

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
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REEXAMINATION CONTROL NO. : 95000418
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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 Requester)

CENTRAL REEXAMINATION UNIT

In re Beierbach *et al.*
Inter partes Reexamination Proceeding
Control No: 95/000,418
Filing Date: November 25, 2008
For: U.S. Patent No.: 7,377,324

DECISION
DISMISSING
PETITIONS

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. 95/000,418 are all **dismissed** for the reasons set forth herein.

BACKGROUND

1. U.S. Patent No. 7,377,324 ("the '324 patent") issued to Beierbach *et al.* on May 27, 2008, and was assigned to Tesco Corporation (hereinafter "patent owner").

2. The '324 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 November 25, 2008, a request for *inter partes* reexamination of all of the claims of the '324 patent (*i.e.*, claims 1-34) 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 95/000,418 ("the '418 proceeding").

4. On February 10, 2009, the Office issued an order granting *inter partes* reexamination in the '418 proceeding, concurrently with a non-final Office action on the merits.

5. The '418 proceeding progressed the point where, on August 18, 2010, the Office mailed an action closing prosecution ("ACP"), confirming unamended claim 4 and rejecting claims 1-3 and 5-34.

6. On September 17, 2010, patent owner filed a submission under 37 CFR 1.951(a) responsive to the August 18, 2010 ACP, as well as two petition papers entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)" ("the petitions under 37 CFR 1.183").

7. On October 20, 2010, requester filed comments under 37 CFR 1.951(b).

8. 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.

9. 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.

10. On November 24, 2010, patent owner filed, in the '418 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."

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[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.

11. On December 2, 2010, patent owner filed, in the '418 proceeding, the instant PETITION TO VACATE REEXAMINATION PROCEEDING PURSUANT TO 37 C.F.R. § 1.913" and the instant "PETITION TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35 U.S.C. § 317(b)."

12. On January 4, 2011, the Office mailed a decision granting in-part patent owner's September 17, 2010 petitions under 37 CFR 1.183 and making patent owner's September 17, 2010 submission under 37 CFR 1.951(a) page-length compliant.

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 '418 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 '324 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 '418 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:

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[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.*

> 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 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 '418 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 '324 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 '324 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]

[5] *See* patent owner's December 2, 2010 petition to terminate at page 3 (stating, "The Patent Owner and the Requester settled their differences prior to the trial phase of the co-pending litigation.")

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 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 '418 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 '418 proceeding, and patent owner's November 24, 2010 and December 2, 2010 petitions under 37 CFR 1.182 to terminate the '418 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 '418 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 '324 patent, which is under reexamination in the '418 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 '324 patent."[8]

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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.)

1. 37 CFR 1.913 Did Not Preclude Requester From Filing The Request For *Inter Partes* Reexamination in the '418 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. Assuming, for the sake of argument, that in cross-licensing the '324 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 November 25, 2008, when the request for *inter partes* reexamination of the '324 patent was filed on behalf of the requester. Accordingly, in this instance, requester was not precluded from filing its November 25, 2008 request for reexamination of the '324 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 '418 Proceeding

Moreover, 37 CFR 1.913 does not preclude the Office from now maintaining the '418 proceeding, even if it is established that requester became a privy of the patent owner subsequent to the filing of the November 25, 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 '418 proceeding, and patent owner's December 2, 2010 petition under 37 CFR 1.182 to vacate the '418 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 '418 proceeding be suspended pursuant to 37 CFR 1.937. In particular, petitioner asserts there is good cause to suspend the '418 proceeding for the following reasons: (1) there are no outstanding responses to Office actions due in the '418 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 '418 proceeding; and (4) the claims asserted by patent owner in the concurrent litigation have not been amended and are subject to reexamination in the '418 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.

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[9] *See* November 24, 2010 petition to suspend at pages 2-4. Petitioner states on page 3 of the petition that "the Patent Owner asserted Claims 13, 18, 25, 27, 43, 55 and 59." It is noted that this listing of claims appears to be the claims of the '443 patent that were asserted in the litigation, not the claims of the '324 patent, which is the subject of the '418 proceeding.

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 the reexamination requester is a party to the litigation.

2. Petitioner Has Not Established "Good Cause" To Suspend The '418 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 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 '418 proceeding upon resolution of the concurrent litigation with respect to the remaining co-defendants, who are not reexamination requesters of the '418 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 '418 proceeding.[11] Only if all of the claims of the '324 patent are found to be invalid upon resolution of the concurrent litigation, would the reexamination prosecution be terminated and the '418 proceeding be concluded.[12] In this instance, however, all of the claims subject to reexamination in the '418 proceeding (*i.e.*, claims 1-34) 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 '324 patent upon resolution of the concurrent litigation, the claims held invalid or unenforceable will be withdrawn from consideration in the '418 proceeding, but the reexamination will continue as to any remaining claims of the '324 patent that were not asserted in the concurrent litigation.

Suspension of the '418 reexamination from its advanced stage pending resolution of the concurrent litigation with respect to the remaining co-defendants, therefore, would impede treatment of the claims of the '324 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 '418 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 '324 patent. In short, there would be no waste of Office resources that might not need to be expended in continuing the '418 proceeding, because the consideration of the issues must continue in the '418 proceeding at least with respect to any claims not asserted by patent owner in the concurrent litigation.

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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 1, 4, 12, 14, 17 and 27 of the '324 patent in the concurrent litigation), a copy of which was submitted by petitioner as an attachment to the November 24, 2010 petition to suspend.

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 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 '418 proceeding.

Therefore, patent owner's November 24, 2010 petition under 37 CFR 1.182 to suspend the '418 proceeding is **dismissed**, and the '418 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/

[14] *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).
[15] *Id.* at 1425.

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,418	11/25/2008	7377324	069669-0003	4212

74954 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.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
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FEB 25 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO.: 95000418
PATENT NO. : 7377324
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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MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Beierbach et al.
Reexamination Proceeding
Control No.: 95/000,418
Filed: November 25, 2008
For: U.S. Patent No.: 7,377,324

DECISION ON PETITION TO REFUSE TO CONSIDER AND EXPUNGE UNDER 37 CFR 1.182

This is a decision on a petition filed by the patent owner on October 29, 2010. The petition is entitled "PETITION UNDER 37 C.F.R. § 1.182 TO REFUSE TO CONSIDER AND EXPUNGE "WEATHERFORD'S REPLY TO TESCO'S RESPONSE TO THE OFFICE ACTION CLOSING PROSECUTION MAILED 8/18/2010" and is a request that the Director refuse to consider and expunge the requester's reply filed October 20, 2010. Patent owner maintains that third party requester's response is untimely.

The petition under 37 CFR 1.182 is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The third party requester's petition is dismissed as premature.

BACKGROUND

1. U.S. Patent No. 7,377,324 (hereinafter, the '324 patent) issued on May 27, 2008.

2. A request for *inter partes* reexamination, assigned control No. 95/000,418, was filed by a third party requester on November 25, 2008.

3. *Inter partes* reexamination was ordered for the '418 reexamination proceeding on February 10, 2009. On the same day, a non-final Office action was mailed in the '418 reexamination proceeding.

4. Prosecution advanced and on January 20, 2010, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

5. On February 18, 2010, the patent owner filed a 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.

6. On March 18, 2010, the February 18, 2010 petition was granted to the extent that the examiner should issue a corrected action.

7. On August 18, 2010, a corrected ACP was mailed. The ACP repeated the same rejections issued in the February 10, 2009 Office action.

8. On September 17, 2010, the patent owner filed a 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 October 21, 2010, the petition under 37 CFR 1.181 was denied.

10. On October 29, 2010, the patent owner filed the above-mentioned petition.

DECISION

As pointed out, the patent owner-filed present petition is a petition under 37 CFR 1.182 to refuse to consider and expunge the third party requester's response filed October 20, 2010. However, there has been no decision by the examiner to either enter or not enter the third party requester's response of October 20, 2010. Accordingly, it is premature to issue a decision regarding entry or refusal to enter the third party requester's response of October 20, 2010 because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed.

CONCLUSION

1. The October 29, 2010 patent owner's petition under 37 CFR § 1.182, is dismissed.

2. Should the examiner enter the third party requester's October 20, 2010 response into the record, the patent owner would be free to submit a petition under 37 CFR 1.182.

3. Telephone inquiries related to this decision should be directed 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.
95/000,418	11/25/2008	7377324	069669-0003	4212

74954 7590 07/27/2011

Bracewell & Giuliani LLP
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Suite 2300
Houston, TX 77002-2770

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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. : 95000418
PATENT NO. : 7377324
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 Third Party Requester)

MAILED

JUL 27 2011

CENTRAL REEXAMINATION UNIT

In re Beierbach *et al.*
Inter partes Reexamination Proceeding
Control No: 95/000,418
Filing Date: November 25, 2008
For: U.S. Patent No.: 7,377,324

DECISION DISMISSING PETITION

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. 7,377,324 ("the '324 patent") issued to Beierbach *et al.* on May 27, 2008, and was assigned to Tesco Corporation (hereinafter "patent owner").

2. The '324 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 November 25, 2008, a request for *inter partes* reexamination of all of the claims of the '324 patent (*i.e.*, claims 1-34) 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 95/000,418 ("the '418 proceeding").

4. On February 10, 2009, the Office issued an order granting *inter partes* reexamination in the '418 proceeding, concurrently with a non-final Office action on the merits.

5. The '418 proceeding progressed the point where, on August 18, 2010, the Office mailed an action closing prosecution ("ACP"), confirming unamended claim 4 and rejecting claims 1-3 and 5-34.

6. On September 17, 2010, patent owner filed a submission under 37 CFR 1.951(a) responsive to the August 18, 2010 ACP, as well as two petition papers entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE REQUIREMENTS OF 37 C.F.R. § 1.943(b)" ("the petitions under 37 CFR 1.183").

7. On October 20, 2010, requester filed comments under 37 CFR 1.951(b).

8. 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.

9. 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.

10. On November 24, 2010, patent owner filed, in the '418 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."

11. On December 2, 2010, patent owner filed, in the '418 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)."

12. On January 4, 2011, the Office mailed a decision granting in-part patent owner's September 17, 2010 petitions under 37 CFR 1.183 and making patent owner's September 17, 2010 submission under 37 CFR 1.951(a) page-length compliant.

13. 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.

14. On March 15, 2011, patent owner filed the instant "PETITION FOR REHEARING OF THE PETITIONS TO TERMINATE REEXAMINATION PROCEEDING PURSUANT TO 35

[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.

U.S.C. § 317(b) PREVIOUSLY FILED ON NOVEMBER 24, 2010 AND DECEMBER 2, 2010" ("the renewed petition under 37 CFR 1.182").

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 '418 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 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.

In the Office's February 17, 2011 decision dismissing patent owner's November 24, 2010 and December 2, 2010 petitions to terminate the '418 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 '418 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 page 5.
[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 '418 proceeding because it had the burden of proving invalidity of all of the claims of the '324 patent.[14] Specifically, petitioner asserts that requester raised the issues of invalidity of all of the claims of the '324 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 requester in the litigation. For the reasons set forth herein in section III(B), the Office maintains

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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.

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 '418 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 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

[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.

[19] March 15, 2011 renewed petition under 37 CFR 1.182 at page 7.

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 '324 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.

C. Whether the issues raised in the '418 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

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[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 '324 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.

[23] See March 15, 2011 renewed petition under 37 CFR 1.182 at pages 6-7.

Office need not address in detail whether the issues raised in the '418 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 '418 proceeding, and patent owner's March 15, 2011 renewed petition under 37 CFR 1.182 to terminate the '418 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

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1131 7590 07/15/2011

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000424
PATENT NO. : 6623846
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNIT

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901 North Glebe Road, 11th Floor
Arlington, VA 22203

(For Patent Owner)

Intellectual Property Group
Fredrikson & Byron, PC
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402

(For Third Party Requester)

Michael Best & Friedrich LLP
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Chicago, IL 60601

(Courtesy Copy)

In re Laird
Inter Partes Reexamination Proceeding
Control No. 95/000,424
Filed: December 19, 2008
For: U.S. Patent No. 6,623,846 B2

: **DECISION**
: **DISMISSING PETITIONS**
: **UNDER §§ 1.182 and 1.183**

This is a decision on the June 13, 2011 patent owner petitions entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED EXAMINATION AND ENTRY OF AMENDMENT AFTER ACTION CLOSING PROSECUTION" and "PETITION UNDER 37 CFR § 1.183 FOR WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME TO FILE APPELLANT'S BRIEF."

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 September 23, 2003, U.S. Patent No. 6,623,846 B2 ("the '846 patent) was issued to Laird having 15 claims.

- On December 19, 2008, a request for *inter partes* reexamination was filed by the third party requester, the real party in interest being Cardinal CG Company, and the resulting reexamination proceeding was assigned control number 95/000,424 ("the '424 proceeding").

- On February 5, 2009, reexamination was ordered for claims 1-15 of the '846 patent. On the same date, an Office action was mailed, rejecting claims 1-15, including obviousness rejections based in part on the teaching of a Joret reference as to a layer comprising silicon oxynitride.[1]

- Prosecution continued, until on April 15, 2010, an Office Action Closing Prosecution (ACP) was mailed, rejecting pending claims 1, 3-6, and 8-22, including obviousness rejections based in part on the teaching of Joret as to a layer comprising silicon oxynitride.[2]

- Prosecution continued further, until on January 13, 2011, a second Office Action Closing Prosecution (ACP) was mailed, rejecting pending claims 1, 3-6, and 8-22, including obviousness rejections based in part on the teaching of Joret as to a layer comprising silicon oxynitride.[3]

- On February 14, 2011, patent owner filed a response to the January 13, 2011 (second) ACP pursuant to 37 C.F.R. § 1.951(a). The response presented proposed claim amendments including replacing "layer comprising silicon oxynitride" with "layer consisting essentially of silicon oxynitride" and directed cancellation of claims 15 and 16, and entry of new claim 23.

- On March 15, 2011, third party requester filed comments pursuant to 37 C.F.R. § 1.951(b).

- On May 13, 2011, a Right of Appeal Notice (RAN) was mailed, refusing entry of the proposed amendments and claim cancellation filed with patent owner's February 14 response.

- On June 13, 2011, patent owner filed the instant petitions under §§ 1.182 and 1.183 for the purpose of requesting entry of proposed claim amendments, entry of a new claim 23, and proposed cancellation of claims 16 and 17 as submitted on February 14, 2011 and refused entry in the Right of Appeal Notice of May 13, 2011, and for waiver of rules to permit an extension of time for the petition under § 1.182 to be answered. On the same date, patent owner filed a Notice of Appeal.

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[1] *See, e.g.*, pages 7-8.
[2] *See, e.g.*, pages 13-18.
[3] *See, e.g.*, pages 14-21.

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."[4] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, 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 its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to cancel claims 16 and 17, thereby reducing the number of issues before the Board, and to amend claims pursuant to the non-entered amendment of February 14, 2011, to allegedly overcome rejections based upon the Joret reference to thereby eliminate 50% of the rejections/issues remaining in the proceeding.

With respect to the proposed cancellation of claims 16 and 17, claims may be cancelled by matter of right, where such cancellation does not affect the scope of any other pending claim in the proceeding, after an ACP (37 C.F.R. § 1.116(b)(1)), after a RAN (37 C.F.R. § 1.116(d)(2)), or after an appeal is filed (37 C.F.R. § 41.63(a)). As patent owner may cancel claims 16 and 17 as a matter of right (if submitted as a separate paper), such cancellation does not support reopening of prosecution.

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[4] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

To be consistent with the requirement of special dispatch, the showing of a *bona fide* effort made during the proceeding must explain why the need for the patent owner's proposed response could not have been anticipated earlier, and only became apparent as a result of a new issue arising at, or subsequent to, the close of prosecution in the proceeding. In this case, the record is to the contrary. It is apparent from the prosecution history that the issue for which the proposed amendments and new claims are stated to address arose in the initial Office action of February 5, 2009, at which time the examiner first addressed the issue of whether the Joret reference teaches a layer comprising silicon oxynitride.[5]

Although patent owner chose to pursue other avenues of traversing the rejections in patent owner's responses to the initial Office action and to the first ACP, patent owner could have *also* presented new claims having the scope of the presently proposed amendments, in addition to the other avenues of traversing the rejected claims. Patent owner could have presented these claim amendments, or new claims having the scope of these amendments, in patent owner's responses to either the non-final Office action or to the first ACP, and all issues could have been resolved together. The need for the instant amendment, including the presentation of new claims having the currently desired scope, to define over the examiner's rejection could have been anticipated following the first Office action, and entry at this stage would run counter to the requirement of special dispatch.

Furthermore, the RAN stated that entry of the February 14, 2011 amendment would not overcome the art rejections of record. Contrary to petitioner's assertions, the number of issues presented to the Board would therefore remain the same even if the February 14, 2011 amendment were entered, because the examiner has stated that he would maintain rejections of the currently rejected claims.[6] The number of issues presented on appeal to the Board would therefore remain constant regardless of whether the February 14, 2011 amendment is entered.

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**.

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. Such relief may not involve waiver of any statutory requirement.

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 petition has thus been answered prior to the due date for filing an appellant's brief, causing the question of any waiver of the rules to become moot. Therefore, the instant patent owner petition under § 1.183 is **dismissed**.

---

[5] *See, e.g.*, pages 14-21.

[6] *See* May 13, 2011 RAN at page 4.

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 6,623,846 patent file is that of Nixon & Vanderhye, PC 901 North Glebe Road, 11th Floor, Arlington, VA 22203. However, the correspondence address of record in the reexamination file is that of Michael Best & Friedrich LLP, Two Prudential Plaza, 180 North Stetson Avenue, Suite 2000, Chicago, IL 60601. As a courtesy, this decision is being mailed to both addresses.

The address of Nixon & Vanderhye, PC, 901 North Glebe Road, 11th Floor, Arlington, VA 22203, will be the sole address used in future correspondence, until a change in correspondence address in the 6,623,846 patent file is made in accordance with 37 CFR 1.33(c).

CONCLUSION

1. The patent owner petitions under §§ 1.182 and 1.183 are **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

July 14, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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(For Patent Owner)

James J Foster
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(For Third Party)

In re: Allen *et alia*
Inter Partes Reexamination Proceeding
Control No. 95/000,425
Deposited on: 23 December 2008
For: US Patent No. 7,220,022 B2

DECISION
DISMISSING
PETITION
37 CFR §§ 1.181, 1.182, 1.183
1.137(b) & 1.958(b)

In re: Allen *et alia*
Ex Parte Reexamination Proceeding
Control No. 90/009,292
Deposited on: 02 October 2008
For: US Patent No. 7,220,022 B2

This is a decision on the patent owner's petition dated 16 and 17 June 2010, which are entitled "Petition Under 37 CFR [§] 1.181 or, in the Alternative Under 37 CFR [§] 1.182 or, in the Alternative Under 37 CFR [§] 1.183 for Relief in Inter-Partes Reexam Regarding Notice of Intent to Issue Reexamination Certificate" and "Request for Reconsideration for Withdrawal of Notice of Intent to Issue Reexamination Certificate or, in the Alternative, Petition for Revival Under 37 CFR §§ 1.137(b) & 1.958(b)" requesting that the Office withdraw the Notice of Intent to Issue Reexamination Certificate.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,220,022 B2 issued on 22 May 2007
- A request for *ex parte* reexamination of US Patent no. 7,220,022 B2 was filed by a third party requester on 02 October 2008 and assigned control number 90/009,292.
- Ex parte proceeding control no. 90/009,292 was ordered 30 October 2008.

- A request for *inter partes* reexamination was filed concerning the '2002 patent and assigned control no. 95/000,425 on 23 December 2008.

- *Inter partes* reexamination was ordered in 95/000,425 on 17 February 2009.

- *Sua Sponte* merger of proceedings 95/000,425 & 90/009,292 was mailed on 24 July 2009

- On 04 September 2009 a non-Final Office action was mailed.

- The patent owner filed a response with claim amendments on 04 December 2009.

- A Notice of Defective Paper was mailed on 17 December 2009 which instructs the patent owner that improper correction would result in termination of the proceeding according to 37 CFR § 1.957.

- On 09 February 2010 the third party requester responded to the patent owner's submission.

- The examiner mailed a Notice of Intent to Issue Reexamination Certificate since the patent owner's response remained non compliant.

- On 16 and 17 July 2010 the instant petitions were filed.

CITATION OF RELEVENT AUTHORITY

37 CFR § 1.4(c) Nature of Correspondence states:

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

37 CFR § 1.181(a) Petition to the Director.

> (a) · Petition may be taken to the Director:
> (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

37 CFR § 1.182 Questions not specifically provided for.

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

37 CFR § 1.183 Suspension of rules.

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

37 CFR § 1.137(b) Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent.

> (b) Unintentional . If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 CFR § 1.958(b) Petition to revive *inter partes* reexamination prosecution terminated for lack of patent owner response.

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

DECISION

The petition raises multiple issues which are distinct inquiries which may be addressed by different branches of the Office, as such, this is an improper paper not in compliance with 37 CFR § 1.4(c). In view of the fact that the petition improperly combines multiple, distinct subjects of inquiry in a single paper, the petition is dismissed under 37 CFR § 1.4(c). For example, petitions filed under 37 CFR 1.181 are handled by the Central Reexamination Unit whereas, petitions filed under 37 CFR §§ 1.182, 1.183 & 1.137(b), 1.958(b)are handled by the Office of Patent Legal Administration.

CONCLUSION

1. The above named petitions dated 16 and 17 July 2010 is hereby dismissed.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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Wolf Greenfield & Sacks, P.C.
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Boston, MA 02210-2206

In re Mark R. Allen et al.
Ex Parte Reexamination Proceeding
Control No. 90/009,292
Filed: October 2, 2008
For: U.S. Patent No. 7,220,022

In re Mark R. Allen et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,425
Filed: December 23, 2008
For: U.S. Patent No. 7,220,022

DECISION
GRANTING PETITION
UNDER 37 CFR 1.137(b)
AND VACATING
CERTIFICATE

This is a decision on the October 8, 2010 patent owner petition titled "Re-Petition Under 37 CFR 1.182, 1.183 and Petition For Revival Under 1.137(b) and 1.958(b) For Relief In Inter-Partes Reexam Regarding Issuance Of Reexamination Certificate 7,220,022 C1." The October 8, 2010 patent owner petition is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action and revive the present terminated merged reexamination proceeding ("the October 8, 2010 patent owner petition to revive").

The October 8, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The October 8, 2010 patent owner petition is **granted** as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action.

Reexamination Certificate No. C1 7,220,022 issued September 7, 2010, for the present merged proceeding, and the June 4, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued for the present merged proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.4(c) provides:

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

37 CFR 1.137 provides, in pertinent part:

> (b) *Unintentional.* If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:
>
> (1) The reply required to the outstanding Office action or notice, unless previously filed;
> (2) The petition fee as set forth in § 1.17(m);
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....
>
> *****

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

37 CFR 1.943(b) provides:

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

37 CFR 1.945(a) provides, in pertinent part:

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

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

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

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

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

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

*****

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

DECISION

Improper Petition Under 37 CFR 1.4(c)

The October 8, 2010 patent owner petition paper titled "Re-Petition Under 37 CFR 1.182, 1.183 and Petition For Revival Under 1.137(b) and 1.958(b) For Relief In Inter-Partes Reexam Regarding Issuance Of Reexamination Certificate 7,220,022 C1" requests multiple forms of relief. When more than one form of relief is requested in a single petition, such petition is improper under 37 CFR 1.4(c).

However, in the interest of both equity and special dispatch, 37 CFR 1.4(c) is being waived in this instance to the extent that the October 8, 2010 patent owner petition paper is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action and revive the present terminated merged reexamination proceeding. As such, the petition is grantable for the reasons set forth below.

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), this merged reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a compliant response to the December 17, 2009 Notice Re Defective Paper In Inter Partes Reexamination.[1] MPEP 2666.60 states that the patent owner will be given a time period of one month or thirty days, whichever is longer, from the mailing date of the notice of defective paper or the time remaining in the response period set in the last Office action, to respond to the notice. A response to the December 17, 2009 Notice was not

[1] *See*: MPEP 2666.60.

filed until October 8, 2010, which was untimely.[2] However, for the purpose of evaluating whether the October 8, 2010 patent owner petition to revive is a grantable petition, patent owner's submission of the October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination satisfies item (1).[3]

The 37 CFR 1.137(b)(2) petition fee of $1,620.00 was charged to patent owner on November 26, 2010, thereby satisfying item (2).

A proper statement under 37 CFR 1.137(b)(3) is presented at page 8 of the October 8, 2010 patent owner petition to revive, which satisfies item (3).

Accordingly, the October 8, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 7,220,022 issued for the present merged proceeding on September 7, 2010. Based on the granting of the petition to revive, both the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued on June 4, 2010, and the reexamination certificate are hereby **vacated**.

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

> All reference to Reexamination Certificate No. C1 7,220,022 to Mark R. Allen of Encinitas, CA (US) et al. for JACKETED LED ASSEMBLIES AND LIGHT STRINGS CONTAINING SAME, appearing in the *Official Gazette* of September 7, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. 37 CFR 1.4(c) is being *sua sponte* waived in this instance to the extent that the October 8, 2010 patent owner petition paper is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to an Office action

2. The October 8, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.

3. The termination of prosecution noted in the June 4, 2010 NIRC, and the NIRC itself, are **vacated**.

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[2] Patent owner's October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination contains 32 pages of arguments (excluding amendments) and, when combined with the 17-page Kuppler affidavit, meets the 37 CFR 1.943 50-page limit for response.

[3] This decision is not directed to the persuasiveness and propriety of the arguments presented in the October 8, 2010 response as to each of the rejections set forth in the September 4, 2009 Office action; such is the examiner's province.

4. The *Inter Partes* Reexamination Certificate issued September 7, 2010, is **vacated**.

5. The Office of Patent Publications will take action with respect to the 7,220,022 patent consistent with this decision.

5. Patent owner's October 8, 2010 Corrected Response To Notice Re Defective Paper In Inter Partes Reexamination is hereby entered in the record, thus triggering a comment right for the *inter partes* third party requester under 37 CFR 1.947. Accordingly, the *inter partes* third party requester may file comments to patent owner's response under 37 CFR 1.947 within **30 days** of the mailing date of this decision.

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

/Kenneth M. Schor/

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

02/15/2011

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,427
Patent 7,214,536
Technology Center 3900

JAN 0 6 2011

OARD OF PATENT APPE
AND INTERFERENCES

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.943(c) for Patent Owner's Appeal Brief," filed December 10, 2010, and a decision on patent owner's replacement "Petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.943(c) for Patent Owner's Appeal Brief," filed December 15, 2010. Petitioner requests waiver of the 30 page/14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief, indicated in the first petition to be not more than 52 pages, and indicated in the replacement petition to be not more than 58 pages. The petition fees of $400 in accordance with 37 C.F.R. § 41.20(a) for each petition were charged to petitioner's credit card on December 10, 2010, and to petitioner's deposit account on December 15, 2010, respectively, as well as the appeal brief fee.

FINDINGS

1. On March 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,214,536.

2. Reexamination was ordered and a non-final Office action was mailed on May 27, 2009.

3. Patent owner filed a response to the Office action on August 27, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on September 28, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On January 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on March 8, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on April 7, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On September 16, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 15, 2010, appealing the rejections of claims 1-17.

8. On December 10, 2010, patent owner filed the first petition without an appellant brief; and on December 15, 2010, patent owner filed a petition to replace the petition filed on December 10, 2010, which was accompanied by an appellant brief ("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 stated to be not more than 58 pages, and it was filed with the present petition.

Waiver is requested for the following reasons:

(1) The Right of Appeal Notice addresses 44 adopted grounds of rejection and is 91 pages long.

(2) Under 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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."

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.

37 C.F.R. § 41.67(c)(vii) provides:

(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.

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.

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 this appeal have been within the respective page limit requirements for responses. However, the appellant brief filed subsequent to appeal is significantly longer than even those prior responses. The rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief is 58 pages, which is far in excess of the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous proposed rejections which were adopted. However, prior to appeal, the examiner included the rejections in the non-final Office action and the Action Closing Prosecution. These rejections were addressed in significantly fewer pages (*i.e.*, 44 pages) in patent owner's responses of August 27, 2009, and March 8, 2010, than in the appellant brief (58 pages).

Patent owner asserts that the length of appellant's brief is due to the substantial length of the Right of Appeal Notice (RAN), because the examiner's explanation for the 44 grounds of rejection being appealed is 91 pages long. Patent owner also cites portions of 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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." While these are all 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 present petition appears to be treating waiver of the rule as a *pro forma* exercise in that the petition provides little or no 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 C.F.R. § 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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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,427	03/18/2009	7214536	2000706.00134US1	2761

22852 7590 03/23/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,427
Patent 7,214,536
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition Pursuant to 37 C.F.R. § 1.181 and/or § 1.183 to Strike Portions or Entirely Deny Entry of Appellant's Appeal Brief," filed February 11, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of February 4, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's credit card on February 11, 2011. Patent owner filed an opposition to the petition on February 28,

2011. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner's deposit account, per the authorization on page 6 of the opposition.

FINDINGS

1. On March 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,214,536.

2. Reexamination was ordered and a non-final Office action was mailed on May 27, 2009.

3. Patent owner filed a response to the Office action on August 27, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on September 28, 2009.

4. On January 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on March 8, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on April 7, 2010.

6. On September 16, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 15, 2010, appealing the rejections of claims 1-17.

8. Patent Owner filed an appellant brief on February 4, 2011.

9. Requester filed the present petition on February 11, 2011.

10. Patent owner filed an opposition to the petition on February 28, 2011.

11. On March 4, 2011, requester filed a respondent brief.

DISCUSSION

In the present petition, third party requester requests that the patent owner's appellant brief of February 4, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner asserts that the appellant's brief contains a "Figure 1" at page 14, a "Figure 2" at page 25, and a "Figure 3" at page 28, which have not been previously entered nor considered. Petitioner alleges that these new figures contain numerous errors and distortions relating to the teachings of the key prior art references, and that respondent cannot easily counter these new figures using only the evidence of record. Petitioner purports that to most effectively respond to the "new evidence," that respondent would cite new references and/or obtain new declarations of experts explaining why the figures are false and misleading. Petitioner proposes that the figures have not been counted towards the page limit or word limit for appellant's brief, yet they present a "visual argument" which would have required many pages and many thousands of words to present verbally. Petitioner speculates that appellants are using newly created figures as if they were evidence of record in an unfair means of avoiding the page and word limits for the appellant's brief set forth in 37 C.F.R. § 1.943(c). Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief. Petitioner also asserts that the appellant's brief includes an evidence appendix that contains declarations by experts which were submitted in other *inter partes* reexaminations. Petitioner states that none of these

exhibits were entered into the record by the examiner, because they are not noted as considered in the RAN and they do not appear on a Form PTO/SB/08 or a PTO-892 Form.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 provides:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

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. § 41.63(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).

37 C.F.R. § 41.67(c)(2) provides:

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.

37 C.F.R. § 41.68(a)(1) provides:

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.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner's arguments focus on the "new figures" in appellant's brief relating to the teachings of the key prior art references, and assert that respondent cannot easily counter these new figures using only the evidence of record. Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in

rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief.

However, a review of the record reveals that the requester filed a respondent brief on March 4, 2011, stated to be within the word limit pursuant to 37 C.F.R. § 1.943(c). The respondent brief was timely filed and contains arguments concerning the "new figures." Petitioner has characterized the "new figures" in appellant's brief as "visual arguments." However, 37 C.F.R. § 41.67 does not preclude an appellant from presenting new or visual arguments in a brief. Petitioner criticizes appellant's efforts to comply with 37 C.F.R. § 1.943(c), by consolidating the appellant brief. With regard to the exhibits asserted not be cited on the Form PTO/SB/08 or PTO—892 Form, it is noted that the exhibits were submitted in response to the ACP (Exhibits 70, 72). The RAN includes reference at the top of page 75 to pages 19-37 of the March 8, 2010, response to the ACP, which discuss the declarations in question. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of the rules pursuant to C.F.R. § 1.183

The appellant brief of February 4, 2011, has been entered. Requester has already filed their one respondent brief pursuant to 37 C.F.R. § 41.68 in reply to the appellant brief on March 4, 2011. A persuasive showing has not been made that this situation is extraordinary nor that justice requires the relief requested by petitioner. The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

Jurisdiction of this *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

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.
95/000,427	03/18/2009	7214536	2000706.00134US1	2761

22852 7590 04/13/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,427	03/18/09	7214536	

WILMERHALE BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER
BRUMBACK, BRENDA G.

ART UNIT	PAPER
3991	

DATE MAILED:

MAILED

APR 13 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(FOR PATENT OWNER)

MAILED

APR 13 2011

CENTRAL REEXAMINATION UNIT

WILMER CUTLER PICKERING
HALE & DORR LLP
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(FOR THIRD PARTY
REQUESTER)

In re Dujon et al.
Reexamination Proceeding
Control No. : 95/000,427
Filed: March 18, 2009
Patent No. 7,214,536

: **DECISION**
: **DISMISSING**
: **PATENT OWNER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 19, 2010 patent owner petition, entitled "Petition under 37 C.F.R. § 1.181 for Director to Accept the Declarations of Claude Jacq, Ph.D." The petition is requesting that the replacement declarations of Claude Jacq of March 19, 2010 be entered into the proceeding record.

The patent owner's petition is dismissed as moot.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,214,536 (the '536 patent) issued on May 8, 2007.

2. A request for reexamination, assigned Control No. 95/000,427 (the '427 proceeding), was filed by a third party requester on March 18, 2009.

3. Reexamination was ordered in the '427 reexamination proceeding on May 27, 2009. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on March 8, 2010, patent owner filed a response to the Action Closing Prosecution (ACP) by the examiner. The response was supported by two declarations under 37 CFR 1.132 by Claude Jacq.

5. On March 19, 2010, patent owner filed the instant petition under 37 CFR 1.181, and replacement declarations by Claude Jacq. The replacement declarations included the same content as the March 8, 2010 declarations, but also included the paragraph required by 35 U.S.C. 25.

6. On April 7, 2010, third party requester filed comments to the patent owner's response and the ACP, including declaration evidence.

7. On September 16, 2010, the Office mailed a Right of Appeal (RAN) that entered the original March 8, 2010 declarations and March 19, 2010 replacement declarations.

DECISION

As pointed out, the patent owner filed a March 19, 2010 petition, which is a petition requesting entry of the concurrently filed replacement declarations under 37 CFR 1.132 into the proceeding record. On September 16, 2010, the Office mailed a RAN that entered patent owners original and replacement declarations by Claude Jacq. See, e.g., page 3 of the RAN. As stated above, the only difference between the original declarations, dated March 8, 2010, and the replacement declarations, dated March 19, 2010, is that the replacement declarations included the paragraph required by 35 U.S.C. 25(b). The relief requested by the March 19, 2010 petition has already been given by the September 16, 2010 Office action. Thus, the patent owner's March 19, 2010 petition is moot, and hereby, dismissed.

CONCLUSION

1. The March 19, 2010 patent owner's petition is dismissed as moot.

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

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,427	03/18/2009	7214536	2000706.00134US1	2761

22852 7590 04/20/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/20/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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BOSTON, MA 02109

Date:
MAILED
APR 20 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000427
PATENT NO. : 6378202
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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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BOSTON, MA 02109

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000427
PATENT NO. : 6378202
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(FOR PATENT OWNER)

MAILED

APR 2 0 2011

CENTRAL REEXAMINATION UNIT

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(FOR THIRD PARTY
REQUESTER)

In re Dujon et al.
Reexamination Proceeding
Control No. : 95/000,427
Filed: March 18, 2009
Patent No. 7,214,536

: DECISION UNDER
: 37 CFR 1.181 FOR
: WITHDRAWAL OF
: OPPOSITION FILED
: FEBRUARY 28, 2011

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 28, 2011 patent owner petition, entitled "Request for Withdrawal of Opposition Petition under § 1.181 to Deny Requester's Petition." The petition is requesting that the February 28, 2011 opposition petition be withdrawn from the record in light of the March 23, 2011 decision by the Board of Patent Appeals and Interferences (BPAI).

The patent owner's petition is denied.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,214,536 (the '536 patent) issued on May 8, 2007.

2. A request for reexamination, assigned Control No. 95/000,427 (the '427 proceeding), was filed by a third party requester on March 18, 2009.

3. Reexamination was ordered in the '427 reexamination proceeding on May 27, 2009. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on February 4, 2011, patent owner filed an appellant brief.

5. On February 11, 2011, third party requester filed a petition to expunge patent owner's appellant brief.

6. On February 28, 2011, patent owner filed a petition to oppose requester's petition to expunge patent owner's appellant brief.

7. On March 23, 2011, the Office mailed a decision that denied the requester's petition of February 11, 2011. The decision also addressed the opposition petition of February 28, 2011.

8. On March 28, 2011, patent owner filed the instant petition under 37 CFR 1.181 to withdraw the opposition petition of February 28, 2011.

DECISION

As pointed out, the patent owner filed a March 28, 2011 petition, which is a petition withdrawal of the opposition petition of February 28, 2011. On March 23, 2011, the Office mailed a decision that denied the requester's petition of February 11, 2011. The decision also addressed the opposition petition of February 28, 2011. See pages 1-2 of the March 23, 2011 decision. Therefore, the request to withdraw the February 28, 2011 opposition petition is untimely because a decision addressing the opposition petition was of record prior to the request for withdrawal. No Office resources would be saved by withdrawing the February 28, 2011 opposition petition, as asserted in the March 28, 2011 petition. In fact, more Office resources would be required to withdraw an opposition petition for which a decision was been rendered. Thus, the patent owner's March 28, 2011 petition is hereby denied.

CONCLUSION

1. The March 28, 2011 patent owner's petition is denied.

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

Irem Yucel, Director
Technology Center 1600

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CENTRAL REEXAMINATION U

BorgWarner Inc c/o Patent Central LLC
1401 Hollywood Boulevard : (For Patent Owner)
Hollywood, FL 33020

Alston & Bird LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000 : (For Third Party Requester)
Charlotte, NC 28280

In re Decker *et al.* :
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,431 : **DISMISSING PETITION**
Filed: January 29, 2009 : **UNDER 37 C.F.R. § 1.182**
For: U.S. Patent No. 6,663,347 B2 :

This is a decision on the August 24, 2011 patent owner petition entitled "PETITION UNDER 37 CFR §1.182 FOR CONTINUED REEXAMINATION OR, IN THE ALTERNATIVE, PETITION UNDER 37 CFR §1.183 FOR WITHDRAWAL OF FINALITY OF ACP."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On January 29, 2009, a request for *inter partes* reexamination of claims 1-7 of U.S. Patent Number 6,663,347 B2, having 7 claims, was deposited by the third party requester. The resulting reexamination proceeding was assigned control number 95/000,431 ("the '431 proceeding").

- On March 18, 2009, reexamination was ordered.

- On January 13, 2010, an Office action rejecting claims 1-7 was issued.

- On April 13, 2010, patent owner submitted a response addressing the April 1, 2010 Office action. No claim amendments were made. Third party requester filed comments on May 11, 2010.

- On June 24, 2011, an Action Closing Prosecution (ACP) was issued, rejecting claims 1-7.

- On August 24, 2011, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR § 1.182 FOR CONTINUED REEXAMINATION OR, IN THE ALTERNATIVE, PETITION UNDER 37 CFR §1.183 FOR WITHDRAWAL OF FINALITY OF ACP." The petition requested that prosecution be reopened as a continued reexamination, or that the ACP be withdrawn and a new non-final Office Action issue, and that new evidence be entered into the proceeding.

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. § 1.116(e) provides:

> An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

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 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 available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. Any action by the Office in an *inter partes* reexamination proceeding, including action taken in response to a petition under § 1.182, must be consistent with its mandate under 35 U.S.C. 314 that reexamination proceedings must be conducted "with special dispatch within the Office."

1. Other Avenues For Seeking Entry of the Evidence Are Available

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.116(e) provides for the entry of evidence after an ACP and prior to issuance of a right of appeal notice. Since patent owner's submission may be addressed through § 1.116(e), i.e., relief is still possible under one of the rules of practice, consideration of the present petition under 37 C.F.R. § 1.182 is premature.

The August 24, 2011, patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of an evidence submission. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.116(e), or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

For the instant petition to be proper for consideration and not premature, the instant petition must be filed (1) after entry of the evidence has been denied by the examiner in an action, and (2)(a) without a petition under 37 C.F.R § 1.181 that could moot the petition under 37 C.F.R. § 1.182, or (2)(b) after, within two months after, if such a § 1.181 petition is timely (within 2 months of refusal of entry) and dismissed (and reconsideration is not requested) or denied. Since other avenues for entry of the evidence exist under the regulations, relief under § 1.182 which is designed for situations not otherwise provided for would not be appropriate under the facts and circumstances of the instant proceeding.

Similarly, petitioner's request for relief under the alternative ground of § 1.183 is a request for extraordinary relief that may not be granted where other avenues of relief are available.

---

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

Furthermore, 37 C.F.R. 1.4(c) requires that distinct inquiries be raised in separate papers. For these reasons, petitioner's alternate ground of relief is raised prematurely and not in accordance with § 1.4(c), and is dismissed.

2. The Submission Must Advance, Not Delay, the Proceeding

Patent owner's petition does not present persuasive reasons why the Office should act to delay the proceeding in spite of its statutory mandate to handle reexamination proceedings with special dispatch. In accordance with the special dispatch requirement on the Office's handling of the proceeding, 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.

Patent owner's arguments, in the instant petition, are that that "evidence is based upon recent events and could not have been presented earlier," and that the examiner has not previously fully addressed the issues raised by petitioner in response to the examiner's rejections.

With respect to the first rationale that the evidence could not have been presented earlier, such rationale is not persuasive. The petition does not mention when the evidence first became available. Nor has the evidence been submitted in the form of an affidavit under § 1.132, such that facts are provided in such a manner that the Office can properly weigh the merits of the evidence, including whether or not the evidence could have been submitted earlier. For this reason, petitioner's argument that the evidence could not have been presented earlier is not properly supported.

With respect to the second rationale, that the examiner has not fully addressed issues raised by petitioner, such rationale is not persuasive as to relief under § 1.182. This rationale goes towards whether a specific action taken by an examiner, not related to the substantive merits of a claim, was proper in this proceeding. Such an argument is addressable by a petition under § 1.181, and is therefore not addressable in a petition under § 1.182.

On balance, petitioner has not shown how the proceeding would be advanced by entry of the desired evidence submission, such that the delay resulting from reopening of prosecution would be justified. Action by the Office to reopen the prosecution under § 1.182 would not be in furtherance of the Office's handling of the proceeding with special dispatch, and thus would not be appropriate under the facts and circumstances of the instant proceeding.

In summary, relief under § 1.182 is inappropriate as (1) the situation is not one that is "not specifically provided for" as required under § 1.182, (2) petitioner does not support the contention that the evidence could not have been presented earlier, and (3) an Office action to grant relief due to allegations of examiner error would be addressed under § 1.181 rather than § 1.182 or § 1.183. Accordingly, the petition is **dismissed**.

CONCLUSION

1. The instant petition under 37 C.F.R. § 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

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 31, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,431	01/29/2009	6,663,347	038569/340597	5913

71274 7590 11/17/2011

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000431
PATENT NO. : 6663347
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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HOLLYWOOD FL 33020-5237

(For Patent Owner)

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NOV 17 2011

CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/000,431
Filed: January 21, 2009
For: U.S. Patent No. 6,663,347

DECISION DISMISSING PETITION FOR WAIVER OF 37 CFR 1.955 FOR ONE-TIME INTERVIEW

This is a decision on patent owner's "PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)," filed on August 24, 2011.

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

The petition is dismissed.

BACKGROUND

1. On October 7, 2003, U.S. Patent No. 6,663,347 ("the '347 patent") issued to Decker *et al.*

2. On January 29, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/000,431 ("the '431 proceeding").

3. On March 18, 2009, reexamination was ordered in the '431 proceeding.

4. On June 24, 2011, the Office issued an Action Closing Prosecution (ACP) in the '431 proceeding.

5. On August 11, 2011, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" in the '431 proceeding.

6. On August 24, 2011, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," addressing the June 24, 2011 ACP.

7. Concurrently on August 24, 2011, patent owner filed the instant petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in 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 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

In the August 24, 2011 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's August 11, 2011 withdrawal from participation in the '431 proceeding.[1]

In patent owner's petition under 37 CFR 1.183, patent owner has requested waiver of § 1.955 and requests an interview with the Examiner, which is taken as a request for a single interview.[2] In support of its request for waiver of 37 CFR 1.955, patent owner states that because third party requester has withdrawn from participating in the proceeding, only one party—the patent owner will now participate in the proceeding before Office."[3] Patent owner asserts that because the third party requester will no longer participate in the present proceeding, waiver of 37 CFR 1.955 should be granted because the Office has granted such in other proceedings with a non-participating third party requester.[4] Patent owner asserts the interview would be beneficial in

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[1] Petition under 37 CFR 1.183 at pages 1-2.
[2] Id.
[3] Id.
[4] Id. at page 2. See Reexamination Control. No. 95/000,142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. See also Reexamination Control. No. 95/000,274 Decision dated October 8, 2008, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. See also Reexamination Control. No. 95/000,283 Decision dated

advancing prosecution because (1) the technology is highly refined and fraught with hidden complexities; (2) the inventors are experts in the field and have a wealth of experience; (3) petitioner would be "pleased" to discuss the reasons for the present claim language and how the language is used to avoid the prior art. No specific and relevant technical feature that is at issue is cited for discussion in the interview, no support for the assertion the inventors are experts is provided and no specific claim language or prior art of record is cited by patent owner. Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview, expedited resolution of outstanding issues will be promoted in keeping with the statutory special dispatch requirements.[5] Accordingly, patent owner requests waiver of 37 CFR 1.955 and an interview with the examiner.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it." Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, third party requester has stated on the record that it is withdrawing from the '431 *inter partes* reexamination proceeding.[6] Thus, only a single party (patent owner) will now participate in the '431 proceeding, and any interview that might be permitted in the proceeding. Accordingly, patent owner asserts in the instant petition that the best way to resolve the remaining issues out of fairness is to permit the conduct of an interview rather than closing prosecution.[7]

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office, patent owner makes the assertion that the Office has granted such a waiver request on the same facts of the present proceeding to that of *inter partes* reexamination control nos.

September 17, 2008, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview.

[5] Id.

[6] *See* August 11, 2011, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" (stating only that Requester "will not further participate in the reexamination proceeding." and asserting that "Requester's withdrawal from participation does not indicate that Requester agrees or disagrees with the statements made by the Patent Owner, nor is it any reflection on the merits of its previous submissions." The August 11, 2011 third party requester withdrawal paper does not include any documentation of any settlement between the parties nor does it expressly state that the third party requester is waiving any statutory rights allowed under the Patent Laws, Rules and operating procedures of the Patent Office.)

[7] Petition under 37 CFR 1.183 at page 2.

95/000,142 (the '142 proceeding),[8] 95/000,274 (the '274 proceeding) and 95/000,283 (the '283 proceeding), where 37 CFR 1.955 was waived and a single interview was granted.[9] Patent owner, cites only to the proceedings in general and does not cite to the specific Office decisions in each proceeding, nor does patent owner provide any of the facts and circumstances regarding each proceeding[10] incident with the grant decisions, and makes no correlation of the facts between the present proceeding and either of the cited proceedings. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. Regarding the '142 proceeding, that proceeding has been vacated. Therefore, all Office issued papers in the proceeding are also vacated. Accordingly, the '142 proceeding need not be discussed further. Regarding the '274 proceeding, an interview was granted based upon evidence on the record that the third party requester would not participate, had expressly waived all rights in the proceeding and would not be prejudiced by the conduct of an interview. Regarding the '283 proceeding, an interview was granted in a merged *ex parte* and *inter partes* reexamination proceeding because the Office concluded that there was substantial evidence on the record that not only was there a notice of non-participation, but also that the now non-participating third party requester would not be prejudiced by the conduct of an *ex parte* interview on the merits by the patent owner.[11]

Patent owner has not demonstrated that the requester would not be prejudiced by the conduct of the interview. Furthermore, patent owner has not focused upon matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner has not (1) identified the specific and relevant technical feature that is at issue is cited for discussion in the interview; (2) provided support for the assertion the inventors are experts; and (3) cited the specific claim language and prior art of record that is at issue and for discussion during an interview. Thus, patent owner has not sufficiently focus the issues to be addressed at the interview, and instead constitutes a generic indication to discuss the technology, the claims and the prior art.

Should patent owner correct the matters identified immediately above, it will be determined whether permitting a single interview to be conducted at this point in the '431 *inter partes* proceeding would be expected to assist the Office in expeditiously resolving the proceeding.[12] If patent owner chooses to present a petition to address the above-identified matter, patent owner is to immediately renew it, to support the Office's statutory requirement (35 U.S.C. § 314(c)) to conduct *inter partes* reexaminations with special dispatch.

CONCLUSION

1. Patent owner's August 24, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.

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[8] On September 11, 2009 the '142 proceeding was vacated and on November 19, 2009 the proceeding closed from public view.

[9] Petition under 37 CFR 1.183 at page 2.

[10] Id.

[11] *Inter partes* Reexamination Control. No. 95/000,283 petition decision dated September 17, 2008 at page 8.

[12] The '431 proceeding appears ready for examiner action following patent owner's August 24, 2011 response to the June 24, 2011 ACP.

2. Any questions concerning this communication should be directed to 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

11-16- 2011
Keninterview/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,431	01/29/2009	6,663,347	038569/340597	5913

71274 7590 04/03/2012

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/03/2012

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CHARLOTTE, NC 28280-4000

Date: 4-3-12

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000431
PATENT NO. : 6663347
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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BORGWARNER INC. C/O PATENT CENTRAL LLC (For Patent Owner)
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HOLLYWOOD FL 33020-5237

ALSTON & BIRD LLP (For Third Party Requesters)
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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280

Inter Partes Reexamination Proceeding
Control No. 95/000,431
Filed: January 21, 2009
For: U.S. Patent No. 6,663,347

DECISION GRANTING PETITION

This is a decision on patent owner's petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)," filed on December 3, 2011.

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

No fee is required for the renewed petition under 37 CFR 1.183.[1]

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On December 16, 2003, U.S. Patent No. 6,663,347 ("the '347 patent") issued to Decker *et al.*

2. On January 29, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/000,431 ("the '431 proceeding").

3. On March 18, 2009, reexamination was ordered in the '431 proceeding.

4. Prosecution progressed to the point that an Action Closing Prosecution (ACP) was issued on June 24, 2011.

5. On August 11, 2011, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" in the '431 proceeding.

[1] *See* November 18, 2011 decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.

6. On August 24, 2011, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," addressing the June 24, 2011 ACP.

7. Concurrently, on August 24, 2011, patent owner filed a petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

8. On November 17, 2011, the Office mailed a decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.

9. On December 3, 2011, patent owner filed the instant petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Renewed Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In the December 3, 2011 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, to conduct a single interview. The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.[2] The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."[3] Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '431 *inter partes* reexamination proceeding.[4] Thus, only a single party (patent owner) will now participate in the '431 *inter partes* reexamination proceeding, and in any interview that might be permitted in the proceeding. Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '431 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '431 *inter partes* proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office prior to issuance of the next Office action, patent owner asserts that, given the complexity of the subject technology (turbocharger technology), an interview would enhance the understanding of the technology and the relevant patentability issues.[5] Patent owner asserts the expertise of the inventors would enhance the understanding of the technology and the presently claimed invention, with support regarding inventor expertise, to assist the Office in addressing the outstanding issues in the proceeding.[6] Further, patent owner has identified the critical technical and claim language issues for discussion in the interview, which may result in advancement of prosecution with special dispatch.[7]

In view of the particular facts and circumstances set forth herein, in this instance, the record in the '431 *inter partes* reexamination proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Thus, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that a single interview will be permitted. It is noted, however, that there are no established regulatory or practice guidelines

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[2] 65 FR at 76768.
[3] 65 FR at 76769.
[4] *Requester's Notice to the Patent Office*, filed August 11, 2011 (stating "Requester hereby notifies the Office that it has entered into a settlement agreement with the patent owner and will not further participate in this reexamination proceeding.")
[5] Initial petition under 37 CFR 1.183.
[6] Renewed petition under 37 CFR 1.183 at pages 3-5.
[7] Renewed petition under 37 CFR 1.183 at pages 2-3.

to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted to the extent that patent owner satisfies the following preliminary requirements.[8]

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.

2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the June 24, 2011 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be

[8] The requirements and guidelines are analogous to those set forth in MPEP 2281 for interviews in *ex parte* reexamination proceedings.

mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.

2. All papers filed by patent owner in the '431 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's December 3, 2011 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the June 24, 2011 Office action.

3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

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

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

April 2, 2012

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.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 11/18/2011

BORGWARNER INC. C/O PATENT CENTRAL LLC
1401 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020-5237

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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

Date:

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434
PATENT NO. : 6629556
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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(For Patent Owner)

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
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CHARLOTTE, NC 28280

(For Third Party Requester)

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No.: 95/000,434
Filed: January 21, 2009
For: U.S. Patent No. 6,629,556

DECISION DISMISSING PETITION FOR WAIVER OF 37 CFR 1.955 FOR ONE-TIME INTERVIEW

This is a decision on patent owner's "PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)," filed on August 24, 2011.

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

The petition is dismissed.

BACKGROUND

1. On October 7, 2003, U.S. Patent No. 6,629,556 ("the '556 patent") issued to Decker *et al.*

2. On January 29, 2009, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/000,434 ("the '434 proceeding").

3. On March 30, 2009, reexamination was ordered in the '434 proceeding.

4. On June 24, 2011, the Office issued an Action Closing Prosecution (ACP) in the '434 proceeding.

5. On August 11, 2011, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" in the '434 proceeding.

6. On August 24, 2011, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," addressing the June 24, 2011 ACP.

7. Concurrently on August 24, 2011, patent owner filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 314 provides, in 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 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Patent Owner's Petition under 37 CFR 1.183

In the August 24, 2011 petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester's August 11, 2011 withdrawal from participation in the '434 proceeding.[1]

In patent owner's petition under 37 CFR 1.183, patent owner has requested waiver of § 1.955 and requests an interview with the Examiner, which is taken as a request for a single interview.[2] In support of its request for waiver of 37 CFR 1.955, patent owner states that because third party requester has withdrawn from participating in the proceeding, only one party—the patent owner will now participate in the proceeding before Office."[3] Patent owner asserts that because the third party requester will no longer participate in the present proceeding, waiver of 37 CFR 1.955 should be granted because the Office has granted such in other proceedings with a non-participating third party requester.[4] Patent owner asserts the interview would be beneficial in

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[1] Petition under 37 CFR 1.183 at pages 1-2.

[2] Id.

[3] Id.

[4] Id. at page 2. See Reexamination Control. No. 95/000,142 Decision dated April 17, 2007, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. See also Reexamination Control. No. 95/000,274 Decision dated October 8, 2008, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview. See also Reexamination Control. No. 95/000,283 Decision dated

advancing prosecution because (1) the technology is highly refined and fraught with hidden complexities; (2) the inventors are experts in the field and have a wealth of experience; (3) petitioner would be "pleased" to discuss the reasons for the present claim language and how the language is used to avoid the prior art. No specific and relevant technical feature that is at issue is cited for discussion in the interview, no support for the assertion the inventors are experts is provided and no specific claim language or prior art of record is cited by patent owner. Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview, expedited resolution of outstanding issues will be promoted in keeping with the statutory special dispatch requirements.[5] Accordingly, patent owner requests waiver of 37 CFR 1.955 and an interview with the examiner.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making had proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form. The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it." Thus, the key basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, third party requester has stated on the record that it is withdrawing from the '434 *inter partes* reexamination proceeding.[6] Thus, only a single party (patent owner) will now participate in the '434 proceeding, and any interview that might be permitted in the proceeding. Accordingly, patent owner asserts in the instant petition that the best way to resolve the remaining issues out of fairness is to permit the conduct of an interview rather than closing prosecution.[7]

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office, patent owner makes the assertion that the Office has granted such a waiver request on the same facts of the present proceeding to that of *inter partes* reexamination control nos.

September 17, 2008, wherein the Office granted a patent owner request for a waiver of 37 CFR 1.955 for a single interview.

[5] Id.

[6] *See* August 11, 2011, third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" (stating only that Requester "will not further participate in the reexamination proceeding." and asserting that "Requester's withdrawal from participation does not indicate that Requester agrees or disagrees with the statements made by the Patent Owner, nor is it any reflection on the merits of its previous submissions." The August 11, 2011 third party requester withdrawal paper does not include any documentation of any settlement between the parties nor does it expressly state that the third party requester is waiving any statutory rights allowed under the Patent Laws, Rules and operating procedures of the Patent Office.)

[7] Petition under 37 CFR 1.183 at page 2.

95/000,142 (the '142 proceeding),[8] 95/000,274 (the '274 proceeding) and 95/000,283 (the '283 proceeding), where 37 CFR 1.955 was waived and a single interview was granted.[9] Patent owner, cites only to the proceedings in general and does not cite to the specific Office decisions in each proceeding, nor does patent owner provide any of the facts and circumstances regarding each proceeding[10] incident with the grant decisions, and makes no correlation of the facts between the present proceeding and either of the cited proceedings. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. Regarding the '142 proceeding, that proceeding has been vacated. Therefore, all Office issued papers in the proceeding are also vacated. Accordingly, the '142 proceeding need not be discussed further. Regarding the '274 proceeding, an interview was granted based upon evidence on the record that the third party requester would not participate, had expressly waived all rights in the proceeding and would not be prejudiced by the conduct of an interview. Regarding the '283 proceeding, an interview was granted in a merged *ex parte* and *inter partes* reexamination proceeding because the Office concluded that there was substantial evidence on the record that not only was there a notice of non-participation, but also that the now non-participating third party requester would not be prejudiced by the conduct of an *ex parte* interview on the merits by the patent owner.[11]

Patent owner has not demonstrated that the requester would not be prejudiced by the conduct of the interview. Furthermore, patent owner has not focused upon matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner has not (1) identified the specific and relevant technical feature that is at issue is cited for discussion in the interview; (2) provided support for the assertion the inventors are experts; and (3) cited the specific claim language and prior art of record that is at issue and for discussion during an interview. Thus, patent owner has not sufficiently focus the issues to be addressed at the interview, and instead constitutes a generic indication to discuss the technology, the claims and the prior art.

Should patent owner correct the matters identified immediately above, it will be determined whether permitting a single interview to be conducted at this point in the '434 *inter partes* proceeding would be expected to assist the Office in expeditiously resolving the proceeding.[12] If patent owner chooses to present a petition to address the above-identified matter, patent owner is to immediately renew it, to support the Office's statutory requirement (35 U.S.C. § 314(c)) to conduct *inter partes* reexaminations with special dispatch.

CONCLUSION

1. Patent owner's August 24, 2011 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.

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[8] On September 11, 2009 the '142 proceeding was vacated and on November 19, 2009 the proceeding closed from public view.

[9] Petition under 37 CFR 1.183 at page 2.

[10] Id.

[11] *Inter partes* Reexamination Control. No. 95/000,283 petition decision dated September 17, 2008 at page 8.

[12] The '434 proceeding appears ready for examiner action following patent owner's August 24, 2011 response to the June 24, 2011 ACP.

2. Any questions concerning this communication should be directed to 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

11-16- 2011
Keninterview/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,434	01/29/2009	6629556	038569/340590	6529

71274 7590 04/02/2012

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000434 + 90009083
PATENT NO. : 6629556
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

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(For Patent Owner)

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
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CHARLOTTE, NC 28280

(For Third Party Requesters)

MAILED
APR 02 2012
CENTRAL REEXAMINATION UNIT
CENTRAL REEXAMINATION UNIT

Ex parte Reexamination Proceeding
Control No. 90/009,083
Filed: April 18, 2008
For: U.S. Patent No. 6,629,556

Inter Partes Reexamination Proceeding
Control No. 95/000,434
Filed: January 21, 2009
For: U.S. Patent No. 6,629,556

DECISION GRANTING PETITION

This is a decision on patent owner's petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)," filed on December 3, 2011.

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

No fee is required for the renewed petition under 37 CFR 1.183.[1]

The petition under 37 CFR 1.183 is granted to the extent set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On October 7, 2003, U.S. Patent No. 6,629,556 ("the '556 patent") issued to Decker *et al.*

2. On April 18, 2008, a request for *ex parte* re-examination, assigned control number 90/009,083 (the '9083 proceeding) was filed, by Honeywell Int'l.[2]

3. On May 28, 2008, the Office ordered re-examination in the '9083 proceeding.

[1] *See* November 18, 2011 decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.
[2] An incomplete request was first deposited on March 18, 2008,

4. On January 29, 2009, a request for *inter partes* re-examination was filed by a third party requester, which request was assigned control no. 95/000,434 ("the '434 proceeding"). Honeywell Int'l was identified as the real party-in-interest.

5. On March 30, 2009, re-examination was ordered in the '434 proceeding.

6. On November 12, 2009, the Office issued a decision *sua sponte* merging the '9083 and '434 proceedings.

7. On June 24, 2011, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

8. On August 11, 2011, the '434 third party requester filed a paper entitled "THIRD PARTY REQUESTER'S WITHDRAWAL FROM THE PROCEEDING" in the merged proceeding.

9. On August 24, 2011, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," responsive to the June 24, 2011 ACP.

10. Concurrently, on August 24, 2011, patent owner filed a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

11. On November 18, 2011, the Office mailed a decision dismissing patent owner's August 24, 2011 petition under 37 CFR 1.183.

12. On December 3, 2011, patent owner filed the instant petition paper entitled, "RENEWED PETITION UNDER 37 CFR § 1.183 TO WAIVE RULE 1.955 (REQUEST FOR INTERVIEW)."

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.955 provides:

> There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

Renewed Request to Waive the 37 CFR 1.955 Prohibition of Interviews

In the December 3, 2011 renewed petition under 37 CFR 1.183, patent owner requests waiver of the requirements of 37 CFR 1.955, prohibiting interviews in an *inter partes* reexamination proceeding, to conduct a single interview. The instant petition has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

A review of the *Notice of Final Rule Making, Rules to Implement Optional Inter Partes Reexamination Proceedings*, 65 FR 76755 (Dec. 7, 2000), 1242 *Off. Gaz. Pat. Office* 12 (Jan. 2, 2001) (final rule) reveals that the Notice of Proposed Rule Making proposed implementation of a regulation that would have permitted interviews in *inter partes* reexamination proceedings. In the final rule, however, the Office decided to preclude both *ex parte* and *inter partes* interviews in an *inter partes* reexamination proceeding, and accordingly published 37 CFR 1.955 in its present form.[3] The Office concluded that, for a variety of reasons, "[n]o matter what the structure of the interview, the presence of a third party requester (or a separate interview with the requester) will complicate the reexamination proceeding and significantly delay it."[4] Thus, the basis for the present 37 CFR 1.955 proscription of all and any interviews in an *inter partes* reexamination proceeding was that the presence of two (or more) parties in the proceeding would interfere with the Office's ability to conduct an *inter partes* reexamination proceeding with special dispatch as mandated by 35 U.S.C. § 314.

In this instance, however, third party requester has stated on the record that it will not further participate in the '434 *inter partes* reexamination proceeding.[5] Thus, only a single party (patent owner) will now participate in the '434 *inter partes* reexamination proceeding, and in any interview that might be permitted in the proceeding. Based on the present facts and circumstances, it is found that permitting an interview to be conducted at this point in the '434 *inter partes* proceeding would not be anticipated to potentially hinder the ability of the Office to conduct the '434 *inter partes* proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.

In support of its request for waiver of 37 CFR 1.955 to conduct a single interview with the Office prior to issuance of the next Office action, patent owner asserts that, given the complexity of the subject technology (turbocharger technology), an interview would enhance the understanding of the technology and the relevant patentability issues.[6] Patent owner asserts the expertise of the inventors would enhance the understanding of the technology and the presently claimed invention, with support regarding inventor expertise, to assist the Office in addressing the

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[3] 65 FR at 76768.
[4] 65 FR at 76769.
[5] *Requester's Notice to the Patent Office*, filed August 11, 2011 (stating "Requester hereby notifies the Office that it has entered into a Settlement Agreement with the patent owner and will not further participate in this reexamination proceeding.")
[6] Initial petition under 37 CFR 1.183.

outstanding issues in the proceeding.[7] Further, patent owner has identified the critical technical and claim language issues for discussion in the interview, which may result in advancement of prosecution with special dispatch.[8]

In view of the particular facts and circumstances set forth herein, in this instance, the record in the '434 *inter partes* reexamination proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceedings, and the Office. Thus, patent owner's renewed petition under 37 CFR 1.183 is granted to the extent that a single interview will be permitted. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted to the extent that patent owner satisfies the following preliminary requirements.[9]

Requirements and Guidelines for Conducting Interview

A. Preliminary Requirements

1. Promptly upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which the examiner is directed to consider based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.

2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview.

3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

---

[7] Renewed petition under 37 CFR 1.183 at pages 3-5.
[8] Renewed petition under 37 CFR 1.183 at pages 2-3.
[9] The requirements and guidelines are analogous to those set forth in MPEP 2281 for interviews in *ex parte* reexamination proceedings.

B. Guidelines for Conducting the Interview

1. The interview must be conducted in the Office at such times, within Office hours as examiner may designate. The interview will not be permitted at any other time or place, without the authority of the Director.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is free to extend the interview, at the examiner's sole discretion.

3. The interview should be attended by the conferees who signed the June 24, 2011 Office action, or their substitutes (if the conferees are not reasonably available).

4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto. A copy of the interview summary should be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original will be made of record in the Image File Wrapper for the proceeding.

C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed either as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper filed within one month from the date of the interview, whichever is later.

2. All papers filed by patent owner in the '434 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

CONCLUSION

1. Patent owner's December 3, 2011 renewed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is granted to the extent that a single interview will be permitted, upon compliance with the Preliminary Requirements set forth above.

2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the June 24, 2011 Office action.

3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

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

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

March 30, 2012

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Michael J. Lyons : (For Patent Owner)
MORGAN, LEWIS & BOCKIUS :
2 Palo Alto Square :
3000 El Camino Real, Suite 700 :
Palo Alto, CA. 94306 :

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

Perry R. Clark, Esq. :
Law Offices of Perry R. Clark : (For Third Party
825 San Antonio Rd., Ste. 206 : Requester)
Palo Alto, CA. 94303 :

:

In re: Higuchi :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,438 :
For: U.S. Patent No.: 6,421,210 :

This is a decision on a petition filed by the Patent Owner: a petition filed on October 2nd, 2009, entitled "PETITION TO EXPUNGE INFORMATION UNDER 37 C.F.R. § 1.59(b)".

The petition is **GRANTED**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,421,210 issued on July 16, 2002.
- A request for *inter partes* reexamination was February 6, 2009 and assigned control no. 95/000,438.
- *Inter partes* reexamination was ordered on May 4, 2009.
- A Non-Final Office Action was mailed on May 4, 2009.

- Patent Owner filed a Petition for Termination of Reexamination Proceedings dated June 30, 2009 which was dismissed on September 25, 2009.

- The Patent Owner filed a Petition under 37 C.F.R. § 1.59(b) "petition" on October 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.59 Expungement of information or copy of papers in application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

MPEP § 724.05 Petition To Expunge Information or Copy of Papers in Application File

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned.

DECISION

The Patent Owner ("Petitioner") requests that material (Information Disclosure Statement) on October 2, 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 § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) **a clear identification of the information to be expunged without disclosure of the details thereof**; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or **subject to a protective order**, and that the information has not been otherwise made public; (C) **a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted**; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Petitioner requests that the following confidential documents be expunged from the record: (1) "Redacted Sealed Declaration of Kiyonori Hida In Support of Plaintiff's Motion for Default Judgment Against Defendants Daewoo Electronics Company Ltd. and Daewoo Electronics Corporation of America, Inc.," Case No. 04-1830 JCS, September 16, 2005, pgs. 1-4; (2) "Redacted Supplemental Expert Report of Paul K. Meyer," Case No. 04-1830 JCS, April 9, 2007, pgs. 1-4; (3) "Deposition of Dong-Han Kang," Case No. 04-1830 JCS, January 24, 2007, pgs. 315-471; (4) "Deposition of Dong-Han Kang," Case No. 04-1830 JCS, January 25, 2007, pgs. 472-614; and (5) "Deposition of Dong-Han Kang," Case No. 04-1830 JCS, January 26, 2007, pgs. 615-758.

The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

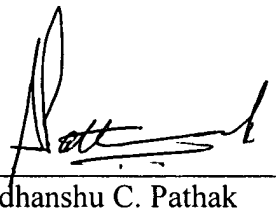
Petitioner is required to retain the expunged material(s) for the life of the patent on which the instant reexamination proceeding is based on.

The expunged material has been removed from the file.

CONCLUSION

1. The petition filed October 2, 2009, is **granted**.

2. Telephone inquiries with regard to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Specialist (SPRS) in the Central Reexamination Unit, Art Unit 3992, at (571) 272-5509.



Sudhanshu C. Pathak
SPRS, CRU

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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.
95/000,440	03/18/2009	7381804	03369/7001505-000	2649

22852 7590 12/03/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C. 20005

Date: MAILED
DEC 0 3 2010
CENTRAL REEXAMINATION U

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000440
PATENT NO. : 7381804
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 on Petition for Extension of Time in Reexamination	Control No.:95/000,440 USPN 7,381,804

1. THIS IS A DECISION ON THE PETITION FILED December 2, 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 November 4, 2010, which sets a one-month period for filing a response thereto, be extended by two weeks.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☒ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION RESPONSE IS DUE DECEMBER 18, 2010

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,440	03/18/2009	7381804	03369/7001505-000	2649

22852 7590 01/11/2012

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER	
ART UNIT	PAPER NUMBER

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SUITE 800
WASHINGTON, D.C. 20005

Date: MAILED

JAN 11 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000440
PATENT NO. : 7381804
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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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(FOR PATENT OWNER)

MAILED

JAN 11 2012

CENTRAL REEXAMINATION UNIT

ROTHWELL, FIGG, ERNST
& MANBECK, P.C.
1425 K STREET N.W.
SUITE 800
WASHINGTON, D.C. 20005

(FOR THIRD PARTY REQUESTER)

In re Osslund
Reexamination Proceeding
Control No. : 95/000,440
Filed: March 18, 2009
Patent No. 7,381,804

: DECISION ON
: PETITION
: UNDER 37 CFR 1.181

This is a decision addressing patent owner's petition, filed December 20, 2010, under 37 CFR 1.181, requesting that prosecution be reopened.

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

SUMMARY

Patent owner's petition is denied.

STATEMENT OF RELEVANT FACTS

1. Patent No. 7,381,804 (the '804 patent) issued on June 3, 2008.

2. A request for reexamination, assigned Control No. 95/000,440 (the '440 proceeding), was filed by a third party requester on March 18, 2009.

3. Reexamination was ordered in the '440 reexamination proceeding on May 13, 2009.

4. An Office action on the merits was mailed on the same day, May 13, 2009.

5. On April 28, 2010, patent owner timely filed a replacement response to the Office action by the examiner. The response included arguments and two declarations filed under 37 CFR 1.132.

6. On May 28, 2010, third party requester filed comments, which included two declarations under 37 CFR 1.132.

7. On November 4, 2010, the Office mailed an Action Closing Prosecution (ACP).

8. On December 20, 2010, patent owner filed a response to the ACP and the instant petition under 37 CFR 1.181.

9. On January 19, 2011, the requester filed comments.

10. On October 5, 2011, the Office mailed a Right of Appeal Notice (RAN).

11. On November 4, 2011, patent owner filed a Notice of Appeal.

12. On January 4, 2012, the patent owner filed an Appeal Brief.

DECISION

The patent owner (petitioner) states that they are seeking relief under 37 CFR 1.181 to have prosecution reopened because the ACP was premature. Patent owner specifically states the follow reasons to support their request to reopen prosecution:

1. The ".. ACP is silent regarding the parties' positions relating to the 'Earlier Analog' rejection;"
2. The "... ACP has mischaracterized Owner's arguments;" and
3. The "... ACP did not fully address Owner's position relating to the 'Earlier Secondary Structures' and 'Earlier Sequence Alignment' rejections.

See pages 3-4 of the petition.

In response to Patent Owner'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 an action closing prosecution (ACP). MPEP 2671 *et seq.* provides the guidelines for examiners in responding to a response after the first Office action, which is the situation under review in this proceeding. As stated below, upon review of the record, the record shows that the examiner followed the appropriate guidelines in MPEP 2671 *et seq.* Therefore, petitioner's argument that the ACP is premature because the examiner did not follow guidelines in MPEP 2671 *et seq.* is not persuasive.

The record shows that the first Office action, which issued May 13, 2009, clearly stated the position of the examiner regarding the art cited by the requestor against the claims. Patent owner was informed that submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced. The next Office action was, as intended, an ACP and maintained the same rejections of claims 1-8. The patent owner's arguments that generally advance that the ACP is premature are without merit. The record shows that the same body of prior art was applied against the claims in both the first Office action and the ACP. The ACP addressed the arguments and evidence submitted by the patent owner and requester in response to the first Office action. Specifically, the record shows that the ACP addressed arguments and evidence presented by the patent owner. See pages 17-20 of the ACP. The petition fails to specifically point towards any argument that was not addressed, but only generally asserts that the examiner did not fully understand or appreciate their arguments. These general assertions are not sufficient to show that the examiner did not follow Office procedure in addressing the patent owner's arguments and evidence. In conclusion, the record shows that the ACP did not present any new rejections and responded to the patent owner's response and the third party requester's comments.

Furthermore, the grounds of argument (e.g., Grounds 1-3 listed above) presented in the petition address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. For example, the issues of whether the rejections and response to arguments presents sufficient rationale (e.g., have a reasonable expectation of success, whether the combination is predictable, or involves hindsight) are appealable issues, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's decisions will not be addressed in this decision.

The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments, evidence, and arguments in reexamination proceedings. It is further noted that patent owner's arguments and evidence submitted in response to the ACP were entered and addressed in the RAN.

In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. 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, is denied.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed December 20, 2010, is denied for the reasons discussed above.

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

Irem Yucel, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 01/24/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,443
Patent 6,833,252
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.943(c) for Patent Owner's Appeal Brief," filed December 10, 2010. Petitioner requests waiver of the 30 page/14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief, indicated in the petition to be not more than 34 pages. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a), and the appeal brief fee, accompanied the petition.

FINDINGS

1. On March 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,833,252.

2. Reexamination was ordered and a non-final Office action was mailed on May 27, 2009.

3. Patent owner filed a response to the Office action on August 27, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on September 28, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On January 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on March 8, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on April 7, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On September 16, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 15, 2010, appealing the rejections of claims 1-18.

8. On December 10, 2010, patent owner filed the present petition, which was not accompanied by an appellant brief.

9. Patent Owner filed an appellant brief on December 15, 2010.

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 stated to be not more than 34 pages, but the pages are numbered 1-40.

Waiver is requested for the following reasons:

(1) The Right of Appeal Notice addresses 22 adopted grounds of rejection and is 38 pages long.

(2) Under 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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."

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.

37 C.F.R. § 41.67(c)(vii) provides:

(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.

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.

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 this appeal have been within the respective page limit requirements for responses. However, the appellant brief filed subsequent to appeal is significantly longer than even those prior responses. The rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief is in excess of the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous proposed rejections which were adopted. However, prior to appeal, the examiner included the rejections in the non-final Office action and the Action Closing Prosecution. In previous responses, these rejections were addressed in significantly fewer pages than the limits set for patent owner's responses, see, *e.g.*, the responses of August 27, 2009, and March 8, 2010.

Patent owner asserts that the length of appellant's brief is due to the substantial length of the Right of Appeal Notice (RAN), because the examiner's explanation for the 22 grounds of rejection being appealed is 38 pages long. Patent owner also cites portions of 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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." While these are all 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 present 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 C.F.R. § 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 03/21/2011

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WASHINGTON, DC 20001-4413

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2011

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 Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,443
Patent 6,833,252
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Request for Reconsideration of Requirement for Corrected Appeal Brief," filed February 17, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of December 15, 2010, be entered as being in compliance with 37 C.F.R. § 1.943(c) in view of the "Certificate of Compliance" which indicated that the appellant brief complied with the word count limitation. The petition fee of $400 in accordance with 37 C.F.R. § 1.20(a), has been charged to petitioner's Deposit Account No. 06-0916, as authorized on page 3 of the present petition.

FINDINGS

1. On March 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,833,252.

2. Reexamination was ordered and a non-final Office action was mailed on May 27, 2009.

3. Prosecution was conducted and on September 16, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Patent Owner filed a Notice of Appeal on October 15, 2010, appealing the rejections of claims 1-18.

5. On December 10, 2010, patent owner filed a petition requesting waiver of 37 C.F.R. § 1.943(c) to permit entry of an appellant brief exceeding the page limit, which was not accompanied by an appellant brief.

6. Patent Owner filed an appellant brief on December 15, 2010.

7. Requester filed a respondent brief on January 18, 2011.

8. On January 24, 2011, a decision denying the previous petition and requiring a corrected appellant brief was mailed.

9. On January 27, 2011, an "*Inter Partes* Reexamination Notification re: Brief" was mailed, indicating that the appellant brief of December 15, 2010, is not in compliance with 37 C.F.R. § 1.943(c), because it exceeds the page limit/word count limit.

10. The present petition was filed on February 17, 2011.

DISCUSSION

In the present petition, patent owner requests that the patent owner's appellant brief of December 15, 2010, be entered as being in compliance

with 37 C.F.R. § 1.943(c) in view of the "Certificate of Compliance." Petitioner asserts that this certificate indicated that the appellant brief complied with the word count limitation. Pursuant to 37 C.F.R. § 1.943(c), an appellant brief is limited to thirty pages or 14,000 words in length.

A detailed review of the record reveals that the patent owner's appellant brief of December 15, 2010, is numbered pages 1-40. Scanned separately from the brief and identified as non-patent literature, a certificate of word count was located, stating that the appellant brief is 11,027 words.

The present petition is **granted.**

The appellant brief of December 15, 2010, is entered. A respondent brief was filed on January 18, 2011.

DECISION

In view of the foregoing, the Petition is GRANTED.

Jurisdiction of the instant *inter partes* reexamination is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 03/21/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,443
Patent 6,833,252
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition Pursuant to 37 C.F.R. § 1.181 or § 1.183 to Strike Portions or Entirely Deny Entry of Appellant's Appeal Brief," filed March 11, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of December 15, 2010, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's credit card on March 11, 2011.

FINDINGS

1. On March 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,833,252.

2. Reexamination was ordered and a non-final Office action was mailed on May 27, 2009.

3. Patent owner filed a response to the Office action on August 27, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on September 28, 2009.

4. On January 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on March 8, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on April 7, 2010.

6. On September 16, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 15, 2010, appealing the rejections of claims 1-18.

8. On December 10, 2010, patent owner filed a petition requesting waiver of 37 C.F.R. § 1.943(c) to permit entry of an appellant brief exceeding the page limit, which was not accompanied by an appellant brief.

9. Patent Owner filed an appellant brief on December 15, 2010.

10. Requester filed a respondent brief on January 18, 2011.

11. On January 24, 2011, a decision denying the previous petition and requiring a corrected appellant brief was mailed.

12. On January 27, 2011, an "*Inter Partes* Reexamination Notification re: Brief" was mailed, indicating that the appellant brief of December 15, 2010,

is not in compliance with 37 C.F.R. § 1.943(c), because it exceeds the page limit/word count limit.

13. A petition requesting reconsideration of the requirement for a corrected appellant brief was filed by patent owner on February 17, 2011.

14. The present petition was filed by third party requester on March 11, 2011.

DISCUSSION

In the present petition, third party requester requests that the patent owner's appellant brief of December 15, 2010, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner asserts that the appellant's brief contains a "Figure 1" at page 11, a "Figure 2" at page 22, and a "Figure 3" at page 25, which have not been previously entered nor considered. Petitioner alleges that these new figures contain numerous errors and distortions relating to the teachings of the key prior art references, and that respondent cannot easily counter these new figures using only the evidence of record. Petitioner purports that to most effectively respond to the "new evidence," that respondent would cite new references and/or obtain new declarations of experts explaining why the figures are false and misleading. Petitioner proposes that the figures have not been counted towards the page limit or word limit for appellant's brief, yet they present a "visual argument" which would have required many pages and many thousands of words to present verbally. Petitioner speculates that appellants are using newly created figures as if they were evidence of record in an unfair means of avoiding the page and word limits for the appellant's

brief set forth in 37 C.F.R. § 1.943(c). Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 provides:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

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. § 41.63(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).

37 C.F.R. § 41.67(c)(2) provides:

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.

37 C.F.R. § 41.68(a)(1) provides:

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.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner's arguments focus on the "new figures" in appellant's brief relating to the teachings of the key prior art references, and assert that respondent cannot easily counter these new figures using only the evidence of record. Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in

rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief.

However, a review of the record reveals that the requester filed a respondent brief on January 18, 2011, within the page limit pursuant to 37 C.F.R. § 1.943(c). The respondent brief was timely filed and contains arguments concerning the "new figures." The present petition was filed more than two months from the filing of the appellant brief in question, and therefore is not timely filed pursuant to 37 C.F.R. § 1.181(f). Petitioner has characterized the "new figures" in appellant's brief as "visual arguments." However, 37 C.F.R. § 41.67 does not preclude an appellant from presenting new or visual arguments in a brief. Petitioner criticizes appellant's efforts to comply with 37 C.F.R. § 1.943(c), by consolidating the appellant brief. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of the rules pursuant to C.F.R. § 1.183.

The appellant brief of December 15, 2010, has been entered in a petition decision mailed on the same date herewith. Requester has already filed their one respondent brief pursuant to 37 C.F.R. § 41.68 in reply to the appellant brief. A persuasive showing has not been made that this situation is extraordinary nor that justice requires the relief requested by petitioner. The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

Jurisdiction of this *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,443	03/18/2009	6833252	2000706.00135US1	9804

22852 7590 04/13/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/ BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:
MAILED

APR 13 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000443
PATENT NO. : 6833252
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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MAILED

APR 13 2011

CENTRAL REEXAMINATION UNIT

FINNEGAN, HENDERSON, FARABOW,
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901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

(FOR PATENT OWNER)

WILMER CUTLER PICKERING
HALE & DORR LLP
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BOSTON, MA 02109

(FOR THIRD PARTY
REQUESTER)

In re Dujon et al.
Reexamination Proceeding
Control No. : 95/000,443
Filed: March 18, 2009
Patent No. 6,833,252

: **DECISION**
: **DISMISSING**
: **PATENT OWNER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 19, 2010 patent owner petition, entitled "Petition under 37 C.F.R. § 1.181 for Director to Accept the Declarations of Claude Jacq, Ph.D." The petition is requesting that the replacement declarations of Claude Jacq of March 19, 2010 be entered into the proceeding record.

The patent owner's petition is dismissed as moot.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,833,252 (the '252 patent) issued on December 21, 2004.

2. A request for reexamination, assigned Control No. 95/000,443 (the '443 proceeding), was filed by a third party requester on March 18, 2009.

3. Reexamination was ordered in the '443 reexamination proceeding on May 27, 2009. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on March 8, 2010, patent owner filed a response to the Action Closing Prosecution (ACP) by the examiner. The response was supported by two declarations under 37 CFR 1.132 by Claude Jacq.

5. On March 19, 2010, patent owner filed the instant petition under 37 CFR 1.181, and replacement declarations by Claude Jacq. The replacement declarations included the same content as the March 8, 2010 declarations, but also included the paragraph required by 35 U.S.C. 25.

6. On April 7, 2010, third party requester filed comments to the patent owner's response and the ACP, including declaration evidence.

7. On September 16, 2010, the Office mailed a Right of Appeal (RAN) that entered the original March 8, 2010 declarations and March 19, 2010 replacement declarations.

DECISION

As pointed out, the patent owner filed a March 19, 2010 petition, which is a petition requesting entry of the concurrently filed replacement declarations under 37 CFR 1.132 into the proceeding record. On September 16, 2010, the Office mailed a RAN that entered patent owners original and replacement declarations by Claude Jacq. See, e.g., pages 3 and 25 of the RAN. As stated above, the only difference between the original declarations, dated March 8, 2010, and the replacement declarations, dated March 19, 2010, is that the replacement declarations included the paragraph required by 35 U.S.C. 25(b). The relief requested by the March 19, 2010 petition has already been given by the September 16, 2010 Office action. Thus, the patent owner's March 19, 2010 petition is moot, and hereby, dismissed.

CONCLUSION

1. The March 19, 2010 patent owner's petition is dismissed as moot.

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

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,444	03/03/2009	6623381	634.0004.RXUS10	6222

24492 7590 09/15/2011

EXAMINER	

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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 Acushnet Company
v.
Callaway Golf Company

Reexamination Control No. 95/000,444
~~Patent 6,623,381~~
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Under 37 C.F.R. § 1.137(b) and § 1.958(b) to Accept Late Papers," filed June 23, 2011 (petition). Petitioner requests that the Office accept patent owner's late-filed rebuttal brief and request for oral hearing that accompany this petition. The petition fee of $1,620 in accordance with 37 C.F.R. § 1.17(m) was charged to petitioner's deposit account on June 24, 2011, along with the request for oral hearing fee.

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FINDINGS

1. On March 3, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,623,381, which was assigned Control No. 95/000,444.

2. On May 26, 2009, reexamination was ordered and a non-final action was mailed.

3. Prosecution was conducted and on August 12, 2010, a Right of Appeal Notice was mailed.

4. Patent owner filed a Notice of Appeal on September 13, 2010.

5. Patent owner filed an appellant brief on November 15, 2010.

6. Requester filed a respondent brief on December 15, 2010.

7. On January 31, 2011, an examiner's answer was mailed.

8. Requester filed a change of correspondence address on March 23, 2011.

9. On May 4, 2011, an appeal docketing notice was mailed.

10. Patent owner filed the instant petition on June 23, 2011, accompanied by a rebuttal brief and a request for oral hearing.

DISCUSSION

In the petition under 37 C.F.R. § 1.137(b) and § 1.958(b) of June 23, 2011, patent owner requests that the Office accept the late-filed rebuttal brief and request for oral hearing that accompany the petition.

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RELEVANT AUTHORITY

37 C.F.R. § 1.137(b) provides:

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

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

37 C.F.R. § 1.958 provides:

(a) If a response by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable. A grantable petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a).

(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 C.F.R. § 41.66(d) provides:

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.

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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.

(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.

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37 C.F.R. § 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.

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(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.

ANALYSIS

Patent owner's petition under 37 C.F.R. § 1.137(b) and § 1.958(b) has been considered fully. Petitioner requests that the Office accept patent owner's late-filed rebuttal brief and request for oral hearing that accompany the petition. A review of the record reveals that the instant *inter partes* reexamination is docketed as an appeal at the Board of Patent Appeals and Interferences (BPAI) and is awaiting a decision on appeal. Because the instant *inter partes* reexamination is currently pending, neither 37 C.F.R. § 1.137(b) nor § 1.958(b) are applicable.

As stated in 37 C.F.R. § 41. 66(d) "[a]ny 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." Pursuant to 37 C.F.R. § 41.71(a), "[w]ithin one month of the examiner's answer, any appellant may once file a rebuttal brief." In accordance with 37 C.F.R. § 41.73(b),

> [i]f 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 examiner's answer was mailed on January 31, 2011, and the patent owner's rebuttal brief and request for oral hearing were filed via the

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Office's electronic filing system (eFS) on June 23, 2011. Therefore, the rebuttal brief and the request for oral hearing are not timely filed and are **not entered**.

The present petition is **denied**.

A decision on the appeal will be based on the appellant and respondent briefs.

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

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CENTRAL REEXAMINATION UNIT

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In re Michelson et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,446
Filed: May 20. 2009
For: U.S. Patent No. 6,428,542 B1 :

DECISION
GRANTING PETITIONS
UNDER 1.182 AND 1.183

This is a decision on the May 28, 2010 patent owner petitions entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUEST FOR CONTINUED REEXAMINATION." and "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 REQUEST FOR A WAIVER OF THE PROHIBITION AGAINST THE SUBMISSION OF AN AMENDMENT AFTER A RIGHT OF APPEAL NOTICE, AND ENTRY/CONSIDERATION OF A NEW PROPOSED AMENDMENT."

The patent owner petitions are before the Office of Patent Legal Administration.

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

The petitions are **granted to the extent set forth below**.

BACKGROUND

1. On March 9, 2009, a request for *inter partes* reexamination of claims 1-4, 13, 17-20, 27, 28, 32-36, 45, 49-52, 59, 60, 64, 65, 70-74, 76, 79, 82, 83, 87, 89, 90, 96, 97, 100-102, 108, and 109 of U.S. Patent Number 6,428,542 was deposited by the third party requester; the resulting reexamination proceeding was assigned control number 95/000,446 ("the '446 proceeding"), and given a filing date of May 20, 2009, the date that the filing requirements of 37 C.F.R. § 1.915 were satisfied.

2. On June 30, 2009, an order granting reexamination of the above-listed claims of the '542 patent was mailed in the '446 proceeding.

3. Prosecution in the proceeding progressed, and on February 17, 2010, an action closing prosecution (ACP) was mailed, rejecting all of the pending claims (1-14, 17-20, 27, 28,

32-46, 49-52, 57, 59, 60, 64, 67, 69, 71-74, 76-79, 82-91, 96, 97, 100-102, 108, 109, and 124-164).

4. On March 17, 2010, patent owner submitted a timely amendment and remarks under 37 C.F.R. § 1.951(a) after the February 17, 2010 ACP. The amendment included cancellation of claims 20, 43, 49, 52, 72, 79, 88, 90, 140, 161, and 163, and amendments to claims 1, 2, 8, 9, 15, 25, 29-42, 44-48, 50, 51, 53-64, 66-69, 71, 73-78, 80-87, 100, 125, 126, 128-132, 136-138, 142, 144-150, 155-157, 162, and 164.

5. On April 16, 2010, third party requester submitted timely comments after patent owner's response in accordance with 37 C.F.R. § 1.951(b).

6. On April 28, 2010, a right of appeal notice (RAN) was mailed by the Office, stating that the patent owner has not met the burden of showing good and sufficient reasons why the March 17, 2010 amendment is necessary and was not presented earlier, informing patent owner that the amendment would not be entered, and informing the third party that the comments dated April 16, 2010 including new proposed rejections would not be entered. The RAN repeated the claim rejections set forth in the March 17, 2010 ACP.

7. On May 28, 2010, the instant petitions entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUEST FOR CONTINUED REEXAMINATION." and "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 REQUEST FOR A WAIVER OF THE PROHIBITION AGAINST THE SUBMISSION OF AN AMENDMENT AFTER A RIGHT OF APPEAL NOTICE, AND ENTRY/CONSIDERATION OF A NEW PROPOSED AMENDMENT" were filed, seeking continuation of the reexamination proceeding and entry of the amendments and cancellations of the claims set forth in an accompanying proposed amendment.

8. Also on May 28, 2010, patent owner filed a Notice of appeal, and a petition under 37 CFR § 1.183 seeking an extension of time for filing an appellant's brief.

9. On June 7, 2010, third party requester filed a Notice of cross-appeal.

10. On July 27, 2010, the Office issued a decision granting the May 28, 2010 patent owner petition under 37 CFR § 1.183, extending the time to file appellant's briefs to run through September 6, 2010.

PERTINENT REGULATIONS

37 C.F.R. § 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director,

subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

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).

DECISION

The May 28, 2010 patent owner petitions are filed under 37 C.F.R. § 1.182, requesting continued prosecution for entry and consideration of an amendment previously denied entry, and under 37 C.F.R. § 1.183, for waiver of the prohibition of the submission of an amendment after an appeal notice. The petitions under §§ 1.182 and 1.183 request consideration of the newly proposed amendment via issuance of one of the following: a new non-final action, an ACP, or a RAN.

37 C.F.R. § 1.182 provides for relief that is not currently provided by an existing rule. 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 an action closing prosecution in an *inter partes* reexamination proceeding.

The § 1.182 petition procedure was created to address a need for an amendment or evidence submission, the need for which did not become apparent until the issuance of the final rejection or action closing prosecution. The filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. In keeping with the requirement of special dispatch, a petition under 37 C.F.R. § 1.182 for continued reexamination must show how granting the petition would further the prosecution of the reexamination proceeding. Prosecution may be furthered by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. Furthermore, patent owner should set forth reasons why the need for the submission did not become apparent until the issuance of the final rejection or action closing prosecution.

On May 28, 2010, the patent owner timely filed the instant petitions. First, at the current stage of the proceedings, no regulation specifically provides for the entry of patent owner's submission to continue reexamination, thereby meeting the "situations not specifically provided for" language

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

in § 1.182. Second, with respect to reasons why the need for the amendment could not have been anticipated earlier, patent owner states that the amendment was in response to rejections first set forth in the ACP. The instant submission includes an amendment intended to address issues, such as the rejections based upon 35 U.S.C. §§ 101, 102, and 112, first raised in the ACP. *See, e.g.*, the April 28, 2010 RAN at 5. In this instance, based on the totality of the circumstances, the patent owner has met the burden of presenting evidence why the need for the submission could not have been anticipated earlier. Third, the requirement that the amendment has been previously denied entry is deemed to have been met. The petition was filed after a RAN in an *inter partes* reexamination proceeding to seek entry of a similar amendment not previously considered, and entry of the amendment was denied in the RAN.

Fourth, the effect of entry of the amendment is determined to be in accordance with furthering the prosecution by reducing issues for appeal or by placing the claims in condition for the issuance of a reexamination certificate. Entry of the May 28, 2010 amendment would cancel claims 20, 43, 49, 52, 72, 79, 88, 90, 140, 161, and 163. Entry of the amendment would also address the rejections based upon 35 U.S.C. §§ 101, 102, and 112 that were first raised in the ACP. When viewed as a whole, the May 28, 2010 amendment, which cancels some claims and amends others in response to rejections newly raised in the ACP, and in accordance with the examiner's comments in the April 28, 2010 RAN, is deemed to further prosecution by simplifying or reducing issues for appeal.

Finally, the effect of entry of the amendment is determined to be in accordance with conducting the proceeding with special dispatch. In the instant case, a notice of appeal was filed concurrently with the instant petition, on May 28, 2010, to keep the proceeding pending. While the patent owner and third party requester have filed notices of appeal, an appellate brief and an examiner's answer has not been filed. Therefore, in this case, continuation of examination through entry of the May 28, 2010 amendment would best serve the efficient resolution of the question of patentability arising from the art of record.

For these reasons, the petitions under § 1.182 are deemed to satisfy the requirements set forth in the Notice. In accordance with patent owner's request, and to best further special dispatch of this proceeding, the prohibition against an amendment in response to a RAN, set forth in § 1.953(c), is hereby waived as requested in patent owner's petition under § 1.183. Prosecution of the proceeding is reopened to the following extent:

Jurisdiction over the instant reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for entry[2] of the May 28, 2010 response, and subsequently to await submission of any third party comments under 37 C.F.R. § 1.951(b) regarding the May 28, 2010 patent owner amendment. Following the submission of third party requester comments, or the lapse of the thirty day time period for third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the May 28, 2010 amendment and any third party comments that comply with 37 C.F.R. § 1.951. The examiner will then issue an Office action which may be a new RAN

CONCLUSION

- The petitions are **granted to the extent set forth herein**.
- The prosecution of the present '446 *inter partes* reexamination proceeding is continued to the extent set forth above. **No further continuation of the present reexamination proceeding will be granted, absent a showing of extraordinary circumstances.**
- The prohibition against an amendment in response to a RAN, set forth in § 1.953(c), is hereby waived to the extent that the May 28, 2010 amendment will be entered by the CRU. The CRU will await submission of third party comments, or the expiration of the time for same, and then jurisdiction of the proceeding will be transferred to the examiner for consideration of both the amendment and any third party comments.
- **Third party requester has thirty (30) days from the date of mailing of this decision to submit comments pursuant to 37 CFR 1.951(b).**
- Jurisdiction over the reexamination proceeding is being forwarded to the CRU 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 18, 2010

[2] This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,446
Filed: May 20, 2009
For: U.S. Patent No. 6,428,542

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

This is a decision on the third party requester's paper entitled "PETITION UNDER 37 C.F.R. §1.183 TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. §1.943" (the petition under 37 CFR 1.183), filed on October 6, 2011.

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

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

BACKGROUND

1. On August 6, 2002, U.S. Patent Number 6,428,542 (the '542 patent) issued to Gary K. Michelson.

2. On March 9, 2009, a request for an *inter partes* reexamination of the '542 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,446 (the '446 proceeding).

3. On May 20, 2009, third party requester filed a corrected request for an *inter partes* reexamination of the '542 patent in the '446 proceeding, and the '446 proceeding was assigned a filing date of May 20, 2009.

4. On June 30, 2009, the Office issued an order granting *inter partes* reexamination of the '542 patent in the '446 proceeding.

5. Prosecution of the '446 proceeding progressed to the point where, on September 29, 2010, the Office issued a Right of Appeal Notice.

6. On October 29, 2010, third party requester filed a notice of appeal.

7. The appeal in the '446 proceeding progressed to the point where, on August 5, 2011, the Board of Appeals and Interferences (the Board) issued a decision affirming-in-part and reversing-in-part the examiner's non-adoption of proposed rejections of the pending claims of the '542 patent in the '446 proceeding.

8. On September 6, 2011, the patent owner filed a "REQUEST TO REOPEN PROSECUTION BEFORE THE EXAMINER UNDER 37 CFR § 41.77(b)(1)," concurrently with an amendment, amending pending claims and presenting 16 new claims.

9. On October 6, 2011, requester filed a comments submission, including a declaration under 37 CFR 1.132 by Dr. Gary L. Lowery, M.D., Ph.D., concurrently with the instant petition under 37 CFR 1.183.

DECISION

I. 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.

II. Third Party Requester October 6, 2011 Petition under 37 CFR 1.183

On October 6, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of a comments submission of up to 73 pages.[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

[1] Third party requester petition under 37 CFR 1.183 at page 1, stating: "Although Third Party Comments total 63 pages, the Requester is also providing an accompanying Declaration of Dr. Gary L. Lowery, M.D., Ph.D., under 37 C.F.R. § [1.132]. Thus the total combined page count ... is 73 pages."

extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In support of waiver of the rule, requester asserts that "waiver of the 50-page limit for third party comments is justified in view of the significant expansion of the proceedings caused by the Patent Owner's amendment filed on September 6, 2011, following the decision of the Board of Appeals and Patent Interferences."[2] In particular, requester asserts that, in the amendment, patent owner presents two new independent claims, each adding multiple features never previously considered during reexamination and reciting claim elements that extend several pages in length, in addition to multiple new dependent claims.[3] Additionally, requester states that "[t]hese new independent claims necessitated new grounds for rejection and accompanying claim charts...."[4] Requester further asserts that, "beyond adding the new claims, the Patent Owner made substantial amendments to the previously reexamined claims--increasing the total number of independent claims from five to eighteen."[5]

Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, and accompanying declaration and claim charts, which in total exceed 50 pages. Requester asserts that "[i]n a good faith effort to reduce the length of the accompanying Third Party Comments, the Requester elected to no longer contest many of these amended claims" but "[n]evertheless, the enormity of the contested claims (both in quantity and in individual length) and the relevant facts provided by the Lowery Declaration resulted in the accompanying Third Party Comments being greater than fifty pages."[6] However, requester asserts that it "has made a good faith effort to remove any redundant textual arguments from the Third Party Comments while still addressing the new issues raised by the Patent Owner's amendment."[7]

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, 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. Each determination of 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 is made on a case-by-case basis. In determining whether a document such

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[2] Id.
[3] See id.
[4] Id. at pages 1-2 and 4.
[5] Id. at page 2.
[6] Id.
[7] Id. at page 5.

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 this instance, the October 6, 2011 comments submission includes 63 pages of remarks and claim charts (excluding the title page and table of contents). Additionally, the comments submission includes a 10-page declaration by Dr. Gary L. Lowery (the Lowery declaration). Based on the guidance set forth above, the Lowery declaration is deemed to include legal argument (*e.g.*, as to the obviousness of the claims) and is subject to the regulatory page limit count. The claim charts are also subject to the regulatory page limit count. Based on the individual facts and circumstances of this case such as, for example, the 16new claims added by patent owner, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester's October 6, 2011 comments submission exceeds the regulatory page limit by up to 23 pages.

Accordingly, requester's October 6, 2011 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 third party requester's October 6, 2011 comments submission to exceed the regulatory page limit by up to 23 pages. This waiver makes third party requester's October, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's October 6, 2011 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 requester's October 6, 2011 comments submission to exceed the page limit by up to 23 pages. **This waiver makes requester's October 6, 2011 comments submission page-length compliant**.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.

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

12-15-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,446	05/20/2009	6428542	101.0056-02REX	7890

22882 7590 03/02/2012

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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 NuVasive, Inc.
Requester
v.
Warsaw Orthopedic, Inc.
Patent Owner

Reexamination Control No. 95/000,446
Patent 6,428,542
Technology Center 3900

DECISION ON PETITION

This is a decision on requester's "Petition under 37 C.F.R. § 1.182 to Oral Hearing after the 'Examiner's Determination' pursuant to 37 C.F.R. § 41.77(d)," filed February 16, 2012 (present petition). In the present petition, requester requests an oral hearing in light of the patent owner's decision to re-open prosecution as set forth in 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments, and the subsequent Examiner's Determination pursuant to § 41.77(d). The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) and the fee for the request for oral

hearing pursuant to § 41.20(b)(3) were charged to requester's deposit account on February 17, 2012,.

FINDINGS

1. On March 9, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,428,542, which was assigned Control No. 95/000,446.

2. On June 30, 2009, reexamination was ordered and a non-final action was mailed.

3. Prosecution was conducted on and September 29, 2010, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on October 29, 2010, and an appellant brief on December 29, 2010.

5. Patent owner filed a respondent brief on January 31, 2011.

6. On March 11, 2011, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on April 11, 2011.

8. On May 19, 2011, an Appeal Docketing Notice was mailed.

9. On August 5, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision affirming the examiner in-part, reversing the examiner in-part, and making a new ground of rejection under 37 C.F.R. § 41.77(b).

11. Patent owner filed a response pursuant to 37 C.F.R. § 41.77(b)(1) on September 6, 2011, requesting that prosecution be reopened, and including amendments.

12. Requester filed comments pursuant to 37 C.F.R. § 41.77(c) on October 6, 2011, proposing numerous new grounds of rejection.

13. On December 16, 2011, an Examiner's Determination pursuant to 37 C.F.R. § 41.77(d) was mailed, which adopted the majority of the proposed rejections, did not consider several improper proposed rejections, and refused to adopt several proposed rejections.

14. Requester filed comments in accordance with 37 C.F.R. § 41.77(e) on January 17, 2012.

15. Patent owner filed comments pursuant to 37 C.F.R. § 41.77(e) on January 17, 2012, accompanied by several petitions requesting that declarations be entered, further amendments be entered, and a second examiner's determination be provided prior to further consideration by the BPAI.

16. Requester filed a request for oral hearing on February 16, 2012, accompanied by the present petition.

17. Requester filed a reply to patent owner's comments on February 17, 2012, accompanied by oppositions to patent owner's petitions.

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. § 41.73 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

Requester's petition under 37 C.F.R. § 1.182 to request an Oral Hearing after the "Examiner's Determination" pursuant to 37 C.F.R. § 41.77(d) has been fully considered. Requester requests an oral hearing in light of the patent owner's decision to re-open prosecution under 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments and the subsequent Examiner's Determination pursuant to 37 C.F.R. § 41.77(d). A review of the record of *inter partes* reexamination 95/000,446 reveals that it is not yet docketed at the BPAI pursuant to 37 C.F.R. § 41.77(f).

Pursuant to 37 C.F.R. § 41.73(b),

> [i]f 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.

While there is no specific provision in the rules for requesting another oral hearing after an Examiner's Determination pursuant to 37 C.F.R.

§ 41.77(d), given the numerous new issues that will be presented for consideration to the BPAI, petitioner has shown sufficient cause in the instant petition under 37 C.F.R. § 1.182 to permit the request for oral hearing. The Examiner's Determination was mailed on December 16, 2011, and the instant request for oral hearing was filed via the Office's electronic filing system (eFS) on February 16, 2012. Therefore, the request for oral hearing is timely filed.

The request for an oral hearing is **granted**.

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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Hartville, OH 44632

Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,448	05/18/2009	6969390	101.0056-13REX	9508

22882 7590 05/04/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2011

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FISH & RICHARDSON PC
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MINNEAPOLIS, MN 55440-1022

Date:
MAILED
MAY 04 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000448
PATENT NO. : 6969390
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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Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Requester)

MAILED

MAY 04 2011

CENTRAL REEXAMINATION UNIT

In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,448
Filed: May 18, 2009
For: U.S. Patent No. 6,969,390

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

This is a decision on requester's petition entitled "Petition under 37 C.F.R. § 1.183 to Waive the 50-Page Limit Set Forth in 37 C.F.R. § 1.943, and Petition under 37 C.F.R. § 1.182 to Waive Any Requirement that the 1.5 Line Spacing Requirement Be Applied to Claim Charts" (the February 2, 2011 patent owner petition). The petition is taken as a petition under 37 CFR 1.182 as to the line spacing, since it requests waiver of a requirement, rather than waiver of a rule. The petition is also taken as a petition under 37 CFR 1.183 as to the page limit, since it requests waiver of a rule.

The February 2, 2011 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.

The February 2, 2011 combined petition, including the petition under 37 CFR 1.183 and the petition under 37 CFR 1.82, is **granted**.

DECISION

The February 2, 2011 Petition under 37 CFR 1.183 to Waive the Page Length Requirements of 37 CFR 1.943(b)

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b), and has submitted, concurrently with the present petition, a submission that is in excess of 50 pages.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a comments submission in compliance with the 50-page limit,

and the filing of a resulting comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the comments submission. Such a submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed submission: (1) for justification that more pages are needed to complete the submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the submission.

In support of its request for waiver of 37 CFR 1.943(b), the requester points to the January 18, 2011 notice by the primary examiner that the December 22, 2010 requester comments are not in compliance with Office rules and procedures, such as, for example, the procedures set forth in MPEP 2666.05 and 2617, which require that the proposed rejections be separately and clearly explained, i.e., the requester may not "lump together" proposed rejections. In addition, the requester points to patent owner's November 22, 2010 amendment, which added new features to the independent claims. The requester argues that the page length of its concurrently filed comments submission is necessary to address the examiner's January 18, 2011 notice and patent owner's November 22, 2011 amendment. Further, the requester has made a showing in support of its request for waiver of the 50-page limit by attempting to draft a corrected comments submission in compliance with the 50-page limit and in compliance with the January 18, 2011 notice by the primary examiner, and by submitting the resulting corrected comments submission, which is in excess of 50 pages.

Based on the individual facts and circumstances of this case including, for example, the January 18, 2011 notice by the primary examiner and the addition by the patent owner of new features to the independent claims, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's concurrently filed comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent of the page length of requester's February 2, 2011 comments submission. Accordingly, requester's petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of the page length of requester's February 2, 2011 comments submission. **This waiver makes requester's February 2, 2011 comments submission page-length compliant.**

The February 2, 2011 Petition under 37 CFR 1.182 to Waive Any Requirement that the 1.5 Line Spacing Requirement Be Applied to Claim Charts

The requester argues that while the January 18, 2011 notice by the primary examiner requires that any corrected comments filed in response to the notice be double or one-and-a-half spaced, the notice does not specify whether this requirement applies to claim charts. Claim charts, in general, are typically not subject to a line spacing requirement that is greater than single-spacing. Thus, to whatever extent the January 18, 2011 notice required claim charts to be double or one-and-a-half spaced, this requirement is hereby **waived**. Accordingly, requester's petition under 37 CFR 1.182 is **granted**.

CONCLUSION

- The February 2, 2011 petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is **waived to the extent** of the page length of requester's February 2, 2011 comments submission. **This waiver makes requester's February 2, 2011 comments submission page-length compliant.**

- The February 2, 2011 petition under 37 CFR 1.182 is **granted**.

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

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

5/02/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,448	05/18/2009	6969390	101.0056-13REX	9508

22882 7590 06/24/2011

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HARTVILLE, OH 44632

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 NuVasive, Inc.
Requester
v.
Warsaw Orthopedic, Inc.
Patent Owner

Reexamination Control No. 95/000,448
Patent 6,969,390
Technology Center 3900

DECISION ON PETITION

This is a decision on requester's "Petition under 37 C.F.R. § 1.182 to Oral Hearing after the 'Examiner's Determination' pursuant to 37 C.F.R. § 41.77(d)," filed May 13, 2011 ("Present Petition "). In the petition, requester requests an oral hearing in light of the patent owner's decision to re-open prosecution as set forth in 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments, and the subsequent Examiner's Determination pursuant to § 41.77(d). The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to requester's deposit

account on May 13, 2011, as well as the request for oral hearing fee pursuant to § 41.20(b)(3).

FINDINGS

1. On May 18, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,969,390, which was assigned Control No. 95/000,448.

2. On June 18, 2009, reexamination was ordered and an Action Closing Prosecution (ACP) was mailed.

3. On August 13, 2009, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on September 11, 2009, and an appellant brief on November 12, 2009.

5. Patent owner filed a respondent brief on December 14, 2009.

6. On February 16, 2010, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on March 16, 2010, and a request for oral hearing on April 16, 2010.

8. On May 11, 2010, an Appeal Docketing Notice was mailed.

9. The oral hearing was conducted on October 6, 2010.

10. On October 21, 2010, the Board of Patent Appeals and Interferences (BPAI) mailed a decision affirming the examiner in-part, and making a new ground of rejection under37 C.F.R. § 41.77(b).

11. Patent owner filed a response on November 22, 2010, requesting that prosecution be reopened, and including an amendment cancelling claims 1, 11-12, 23, 25, 27-28,; amending claims 2, 4-10, 13-17, 22, 24, 26 and 29-37; and adding new independent claims 46 and 47.

12. Requester filed corrected comments on February 2, 2011, proposing 14 new grounds of rejection.

13. On March 10, 2011, an Examiner's Determination pursuant to § 41.77(d) was mailed, which refused to adopt all 14 proposed rejections.

14. Requester filed Comments in accordance with § 41.77(c) on April 11, 2011.

15. Requester filed a request for oral hearing on May 13, 2011, 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. § 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

Requester's petition under 37 C.F.R. § 1.182 to request an Oral Hearing after the "Examiner's Determination" pursuant to 37 C.F.R. § 41.77(d), has been fully considered. Requester requests an oral hearing in light of the patent owner's decision to re-open prosecution as set forth in 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments, and the subsequent Examiner's Determination pursuant to § 41.77(d). A review of the record of *inter partes* reexamination 95/000,448, reveals that it is not yet docketed at the Board of Patent Appeals and Interferences (BPAI) for a decision pursuant to 37 C.F.R. § 41.77(f).

Pursuant to 37 C.F.R. § 41.73(b),"[i]f 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." Because the instant situation is provided for expressly in the regulations, relief under 37 C.F.R. § 1.182 is inapplicable.

The Examiner's Determination was mailed on March 10, 2011, and the instant request for oral hearing was filed via the Office's electronic filing system (eFS) on May 13, 2011. Therefore, the request for oral hearing is three days late. The request for oral hearing is **denied**.

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,449	03/12/2009	6936051	101.0056-14REX	9875

22882 7590 06/27/2011

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HARTVILLE, OH 44632

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Date: MAILED
JUN 27 2007
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000449
PATENT NO. : 6936051
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

JUN 27 2011

CENTRAL REEXAMINATION UNIT

Fish & Richardson PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Requester)

In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,449
Filed: March 12, 2009
For: U.S. Patent No. 6,936,051

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

This is a decision on requester's petition entitled "Petition under 37 C.F.R. § 1.183 to Waive the 50-Page Limit Set Forth in 37 C.F.R. § 1.943" (the May 11, 2011 requester petition).

The May 11, 2011 requester petition, and the record as a whole, are before the Office of Patent Legal Administration.

DECISION

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b) for its comments submission, also filed on May 11, 2011.

On June 17, 2011, the Office mailed a communication informing the requester that its comments submission of May 11, 2011 is improper, and is being expunged from the file of this proceeding. The June 17, 2011 Office communication set a time period of fifteen (15) days from the mail date of the June 17, 2011 communication to file a corrected comments submission. Accordingly, requester's May 11, 2011 petition requesting waiver of 37 CFR 1.943(b) for its May 11, 2011 comments submission is **dismissed as moot**.

CONCLUSION

- Requester's May 11, 2011 petition under 37 CFR 1.183 is **dismissed as moot**.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

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

5/02/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,449	03/12/2009	6936051	101.0056-14REX	9875

22882 7590 07/19/2011

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/19/2011

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Date: JUL 19 2011

CENTRAL REEXAMINATION UNIT

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

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000449
PATENT NO. : 6936051
TECHNOLOGY CENTER : 3999
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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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(For Patent Owner)

MAILED

JUL 19 2011

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,449
Filed: March 12, 2009
For: U.S. Patent No. 6,936,051

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

This is a decision on requester's July 5, 2011 petition entitled "Petition under 37 C.F.R. § 1.183 to Waive the 50-Page Limit Set Forth in 37 C.F.R. § 1.943" (the July 5, 2011 requester petition).

The July 5, 2011 requester petition, and the record as a whole, are before the Office of Patent Legal Administration.

DECISION

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b) for its comments submission, also filed on July 5, 2011.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response 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 response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b). Specifically, the requester argues that the requester must present proposed rejections of a total of nine newly added claims, two of which are independent and seven of which are dependent claims, and must present a detailed discussion of each proposed rejection of the newly added claims.

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(b), the requester has submitted a comments submission that is in excess of 50 pages. Upon brief review, the July 5, 2011 comments submission includes 53 pages of comments (excluding the table of contents) and a 11-page declaration under 37 CFR 1.132 of Dr. Gary L. Lowery. The 53 pages of comments are included in the page count. The declaration under 37 CFR 1.132 of Dr. Gary L. Lowery is replete with arguments that are deemed to be an extension of the arguments of counsel, i.e., arguments that the teachings of the reference meet the claim limitations of the '051 patent, that the claims of the '051 patent are obvious, or that one of ordinary skill would have been motivated to combine the teachings of the prior art (see, e.g., paragraphs 4, 5, 6, 9, 11, 16, 17, 20, 21, and 22 of the Lowery declaration), causing the entirety of the declaration to be subject to the page count. Thus, the 53 pages of comments and the 11-page Lowery declaration, resulting in a total of 64 pages, are included in the page count.

Based on the individual facts and circumstances of this case including, for example, the nine claims newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's July 5, 2011 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b). Accordingly, requester's 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 requester's comments submission to exceed the page limit by up to 14 pages. This waiver makes requester's July 5, 2011 comments submission page-length compliant.

CONCLUSION

- Requester's July 5, 2011 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 requester's July 5, 2011 comments

submission to exceed the page limit by up to 14 pages. This waiver makes requester's August 25, 2010 comments submission page-length compliant.

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

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

7/18/11

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.
95/000,449	03/12/2009	6936051	101.0056-14REX	9875

22882 7590 11/18/2011

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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 Nuvasive Inc.
v.
Zimmer Spine Inc.

Reexamination Control No. 95/000,449
Patent 6,936,051
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition Under 37 C.F.R. § 1.182 to Expunge and/or Strike Third Party Requester's Request for Oral Hearing," filed November 9, 2011 (Petition). Petitioner requests that the Office strike and/or expunge the request for oral hearing filed by requester on October 10, 2011. Petition 1. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on November 10, 2011, as authorized on the last page of the petition.

FINDINGS

1. On March 12, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,936,051, which was assigned Control No. 95/000,449.

2. On April 30, 2009, reexamination was ordered and on June 18, 2009, a non-final action was mailed.

3. Prosecution was conducted and on March 24, 2010, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on April 23, 2010.

5. Requester filed an appellant brief on June 23, 2010.

6. Patent owner filed a respondent brief on July 23, 2010.

7. On August 23, 2010, an examiner's answer was mailed.

8. Requester filed a rebuttal brief on September 23, 2010.

9. Requester filed a request for oral hearing on October 25, 2010.

10. On November 3, 2010, an appeal docketing notice was mailed.

11 An oral hearing was conducted on January 5, 2011.

12. On March 9, 2011, the Board of Appeals and Interferences (BPAI) mailed a decision on the appeal, including a new grounds of rejection pursuant to 37 C.F.R. § 41.77(b).

13. Patent owner filed a request to reopen prosecution pursuant to 37 C.F.R. § 41.77(b)(1) on April 11, 2011, and requester filed comments pursuant to 37 C.F.R. § 41.77(c) on July 5, 2011.

14. On August 11, 2011, the examiner mailed a determination pursuant to 37 C.F.R. § 41.77(d).

15. Patent owner filed a response pursuant to 37 C.F.R. § 41.77(e) on September 12, 2011, accompanied by a petition under 37 C.F.R. § 1.182

requesting entry of an amendment cancelling some claims rejected in the examiner's determination pursuant to 37 C.F.R. § 41.77(d).

16. Requester filed a request for oral hearing on October 10, 2011.

17. Requester filed comments on October 12, 2011, pursuant to 37 C.F.R. § 41.77(e).

18. Patent owner filed the instant petition on November 9, 2011.

DISCUSSION

Petitioner requests that the Office expunge and/or strike the request for oral hearing filed by requester. Petition 1. Petitioner asserts that prosecution of the present *inter partes* reexamination is governed by 37 C.F.R. § 41.77, which does not provide for an oral hearing after a decision has been rendered by the BPAI. *Id.* Petitioner points out that the requester did not file a petition under 37 C.F.R. § 1.182 requesting entry of the request for oral hearing of October 10, 2011. *Id.* at 2. Petitioner urges that the filing of the request for oral hearing is improper. *Id.*

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. § 41.73 provides in pertinent part:

> (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.
>
> . . .

ANALYSIS

Patent owner's petition under 37 C.F.R. § 1.182 has been considered fully. A request to expunge or strike another party's submission is appropriate only if the submission is improper. Petitioner requests that the Office expunge and/or strike the requester's request for oral hearing. A review of the record reveals that the instant *inter partes* reexamination includes a patent owner response accompanied by a petition under 37 C.F.R. § 1.182, and third party requester comments. Jurisdiction of the instant *inter partes* reexamination is currently before the Central Reexamination Unit for consideration of the petition and submissions pursuant to 37 C.F.R. § 41.77(e). The reexamination has not yet been forwarded to the Board of

Patent Appeals and Interferences (BPAI) for a decision pursuant to 37 C.F.R. § 41.77(f).

As stated in 37 C.F.R. § 41.73(b):

> [i]f 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 examiner's answer was mailed on August 23, 2010, and the requester filed a request for oral hearing on October 25, 2010. An oral hearing was conducted on January 5, 2011.

The request for another oral hearing filed by requester on October 10, 2011, subsequent to a BPAI decision pursuant to 37 C.F.R. § 41.77(b), is not provided for in 37 C.F.R. § 41.73(b). A grantable petition requesting another oral hearing was not filed with the request for a second oral hearing subsequent to a BPAI decision pursuant to 37 C.F.R. § 41.77(b). Therefore, the request for oral hearing of October 10, 2011, is **not entered**.

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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CENTRAL REEXAMINATION UNIT

In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,449
Filed: March 12, 2009
For: U.S. Patent No. 6,936,051

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

This is a decision on patent owners' September 12, 2011 petition entitled "Petition Under 37 C.F.R. § 1.182 for Entry of Amendment After Appeal" (the September 12, 2011 patent owner petition).

The September 12, 2011 patent owner petition, and the record as a whole, are before the Office of Patent Legal Administration.

DECISION

The patent owner requests entry of an amendment also submitted on September 12, 2011, which is limited to the cancellation of pending claims 2-4, 6, 7, 11, 14-17, and 40-48. The patent owner points to 37 CFR 41.63(a), which provides:

> 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.

The September 12, 2011 amendment is "filed after the date of filing an appeal pursuant to [37 CFR] 41.61", and is limited to the cancellation of claims. The cancellation is determined to "not affect the scope of any other pending claim in the proceeding". For this reason, the September 12, 2011 amendment is determined to have an entry right pursuant to 37 CFR 41.63(a).

Accordingly, the present petition is **dismissed as moot**.

CONCLUSION

- Patent owner's September 12, 2011 petition is **dismissed as moot**.
- This proceeding is being forwarded to the Central Reexamination Unit for entry of the September 12, 2011 amendment.

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

Brian E. Hanlon
Director
Office of Patent Legal Administration

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.
95/000,451	03/12/2009	6,936,050 B2	101.0056-10REX	5200

22882 7590 03/09/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/09/2011

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

Zimmer Spine, Inc.
Patent Owner
v.
NuVasive, Inc.
Third Party Requester

Inter partes Reexamination Control 95/000,451

Patent 6,936,050

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)" for Patent Owner's Respondent Brief filed August 30, 2010 ("present petition"). In the petition, patent owner requests that "the Director waive the 7000 word limit of 37 C.F.R. §1.943(c) to permit 2,780 additional words in the Respondent's Brief." The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on August 30, 2010, along with the respondent brief fee.

FINDINGS

1. U.S. Patent No. 6,936,050 issued on August 30, 2005. The '050 patent is assigned to patent owner Zimmer Spine, Inc. ("Zimmer").

2. On March 12, 2009, third party requester NuVasive, Inc. ("NuVasive"), filed a request for *inter partes* reexamination of U.S. Patent No. 6,936,050, which was assigned control no. 95/000,451.

3. On April 29, 2009, reexamination was ordered in the *inter partes* reexamination proceeding 95/000,451.

4. A non-final Office action was mailed on June 17, 2009.

5. Patent owner filed a response to the Office action on August 15, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On October 30, 2009, requester filed comments in reply to the Office action and patent owner's response, accompanied by a petition requesting that the page limit pursuant to 37 C.F.R. § 1.943(b) be waived.

7. A decision granting the requester's petition was mailed on January 8, 2010.

8. On February 16, 2010, an Action Closing Prosecution (ACP) was mailed.

9. On March 16, 2010, patent owner filed a response to the ACP, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

10. A Right of Appeal Notice (RAN) was mailed on April 28, 2010.

11. Requester filed a Notice of Appeal on May 28, 2010, and an appellant brief on July 28, 2010.

12. Patent owner filed a respondent brief on August 30, 2010, which was accompanied by the present petition.

13. On September 9, 2010, an "*Inter Partes Reexamination Notification re Brief*" was mailed.

14. Requester filed a corrected appellant brief on September 27, 2010.

DISCUSSION

In the present petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's respondent brief to fifteen pages or 7,000 words in length. The patent owner's respondent brief is stated to be 2,780 words over the limit.

Waiver is requested for the following reasons as stated by petitioner:

(1) Requester submitted a 30 page appellant brief which fails to include in the summary of the claimed subject matter all of the limitations of independent claims 1 and 20; fails to refer to the specification by column and line number; and inaccurately references the element numbers from the specification and drawings.

(2) 37 C.F.R. § 41.68(b)(1)(v) requires a respondent's brief to provide a "statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal" and that if "appellant's summary of the subject matter is disputed, the errors in the appellant's summary must be specified."

(3) Patent owner submits a 9,780 word respondent brief because patent owner is disputing requester's summary of the claimed subject matter, and therefore has used 2,910 words to provide a summary of the claimed subject

matter that includes all the limitations, refers to the specification by column and line number, and accurately references the element numbers from the specification and drawings.

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.

37 C.F.R. § 41.67(c)(v) provides:

(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.

37 C.F.R. § 41.68(b)(v) provides:

(v) *Summary of claimed subject matter.* A statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal. If appellant's summary of the subject matter is disputed, the errors in appellant's summary must be specified.

ANALYSIS

With regard to the present petition, 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 this appeal have been within the respective page limit requirements for responses. One exception is the third party comments submission of October 30, 2009, which exceeded the page limit by 6 pages, but was accepted by the petition decision of January 8, 2010. The rules require that the respondent brief be more limited than pre-appeal responses. Patent owner's respondent brief is numbered pages 1-25 and is stated to contain 9,780 words, which is in excess of the limit of 15 pages and 7,000 words.

Petitioner's reasons provided in support of waiving the page/word limits are based on the respondent's concern that the appellant brief does not sufficiently present the summary of the claimed invention. Petitioner asserts that if the summary of the claimed invention was sufficient in the appellant brief, then it would not be necessary for the patent owner to dispute the summary in the respondent brief. Petitioner points out that the 2,910 words used by the patent owner for the summary of the claimed subject matter included in the respondent brief would have been unnecessary. Petitioner indicates that without the summary of the claimed subject matter, the respondent brief would be less than 7,000 words, and therefore in compliance with 37 C.F.R. §1.943(c).

While these facts are all true, the appellant brief of July 28, 2010, was found to be non-compliant, and an "*Inter Partes Reexamination Notification re*

Brief" was mailed on September 9, 2010, due to improper status of claims section. This means that the respondent brief of August 30, 2010, did not have an entry right because an appellant brief had not been properly filed. On September 27, 2010, a corrected appellant brief was filed by requester. Patent owner had one month from the certificate of service date of the corrected appellant brief to file a respondent brief. This does not appear to have occurred. Note that the mere filing of a petition does not toll the time period for a response. However, a review of both appellant briefs reveals that the appellant's brief of September 27, 2010, contains the same summary of claimed subject matter as the previous appellant brief of July 28, 2010. Therefore, it stands to reason that the third party requester would file the same respondent brief, accompanied by the present petition in reply to the appellant brief of September 27, 2010.

In balancing the Office's need for special dispatch, avoiding unnecessary re-work, and in the interest of preserving equities, the present petition is **granted**. The patent owner's respondent brief of August 30, 2010, is entered and accepted as being in reply to the corrected appellant's brief of September 27, 2010.

DECISION

In view of the forgoing, the Petition is GRANTED.

Jurisdiction of the instant *inter partes* reexamination proceeding is returned to the Central Reexam Unit (CRU) for preparation of the next appropriate Office action.

James T. Moore
Acting Chief Administrative Patent Judge

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CENTRAL REEXAMINATION UNIT

In re Michelson
Inter Partes Reexamination Proceeding
Control No. 95/000,451
Filed: March 12, 2009
For: U.S. Patent No. 6,936,050

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

This is a decision on the third party requester's paper entitled "PETITION UNDER 37 C.F.R. §1.183 TO WAIVE THE 50-PAGE LIMIT SET FORTH IN 37 C.F.R. § 1.943" (the petition under 37 CFR 1.183), filed October 06, 2011.

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

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

BACKGROUND

1. On August 30, 2005, U.S. Patent Number 6,936,050 (the '050 patent) issued to Gary K. Michelson.

2. On March 12, 2009, a request for *inter partes* reexamination of the '050 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,451 (the '451 proceeding).

3. On April 29, 2009, the Office issued an order granting *inter partes* reexamination of the '050 patent in the '451 proceeding.

4. Prosecution of the '451 proceeding progressed to the point where, on April 28, 2010, the Office issued a Right of Appeal Notice.

5. On May 28, 2010, third party requester filed a notice of appeal.

6. The appeal in the '451 proceeding progressed to the point where, on August 05, 2011 the Board of Patent Appeals and Interferences (the Board) issued a decision affirming-in-part and reversing-in-part the examiner's non-adoption of proposed rejections of the pending claims of the '050 patent in the '451 proceeding.

7. On September 06, 2011, patent owner filed a REQUEST TO REOPEN PROSECUTION BEFORE THE EXAMINER UNDER 37 CFR § 41.77(b)(1)," concurrently with an amendment, amending pending claims and presenting 22 new claims.

8. On October 06, 2011, requester filed a comments submission, including a declaration under 37 CFR 1.132 by Dr. Gary L. Lowery, M.D., Ph.D., concurrently with the instant petition under 37 CFR 1.183.

DECISION

I. 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.

II. Third Party Requester October 06, 2011 Petition under 37 CFR 1.183

On October 06, 2011 third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of a comments submission of up to 72 pages.[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 50-page limit of 37 CFR 1.943(b) can be an

[1] Third party requester petition under 37 CFR 1.183 at page 1, stating: "Although Third Party Comments total 61 pages, the Requester is also providing an accompanying Declaration of Dr. Gary L. Lowery, M.D., Ph.D., under 37 C.F.R. § [1.132]. Thus the total combined page count ... is 72 pages."

attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In support of waiver of the rule, requester asserts that "waiver of the 50-page limit for third party comments is justified in view of the numerous amendments and new claims injected into the proceedings as a result of the Patent Owner's amendment filed on September 6, 2011, following the decision of the Board of Appeals and Patent Interferences."[2] In particular, requester asserts that, in the amendment, patent owner presents two new independent claims, each adding multiple features never previously considered during reexamination and reciting claim elements that extend several pages in length, in addition to multiple new dependent claims.[3] Additionally, requester states that "[t]hese new independent claims necessitated new grounds for rejection and accompanying claim charts...."[4] Requester further asserts that, "beyond adding the new claims, the Patent Owner made substantial amendments to the previously reexamined claims--increasing the total number of independent claims from two to eight."[5]

Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, and accompanying declaration and claim charts, which in total exceed 50 pages. Requester asserts that "[i]n a good faith effort to reduce the length of the accompanying Third Party Comments, the Requester elected to no longer contest many of these amended claims" but "[n]evertheless, the enormity of the contested claims (both in quantity and in individual length) and the relevant facts provided by the Lowery Declaration resulted in the accompanying Third Party Comments being greater than fifty pages."[6] However, requester asserts that it "has made a good faith effort to remove any redundant textual arguments from the Third Party Comments while still addressing the new issues raised by the Patent Owner's amendment."[7]

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, 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. Each determination of 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 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.*,

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[2] Id.
[3] See id.
[4] Id. at pages 2 and 4.
[5] Id. at page 2.
[6] Id.
[7] Id. at page 5.

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 this instance, the October 06, 2011 comments submission includes 61 pages of remarks and claim charts (excluding the title page and table of contents). Additionally, the comments submission includes an 11-page declaration by Dr. Gary L. Lowery (the Lowery declaration). Based on the guidance set forth above, the Lowery declaration is deemed to include legal argument (*e.g.*, as to the obviousness of the claims) and is subject to the regulatory page limit count. The claim charts are also subject to the regulatory page limit count. Based on the individual facts and circumstances of this case such as, for example, the 22 new claims added by patent owner, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester's October 06, 2011, comments submission exceeds the regulatory page limit by up to 22 pages.

Accordingly, requester's October 06, 2011 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 third party requester's October 06, 2011 comments submission to exceed the regulatory page limit by up to 22 pages. This waiver makes third party requester's October 06, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's October 06, 2011 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 requester's October 06, 2011 comments submission to exceed the page limit by up to 22 pages. **This waiver makes requester's October 06, 2011 comments submission page-length compliant**.

2. 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

12-15-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,451	03/12/2009	6,936,050 B2	101.0056-10REX	5200

22882 7590 03/02/2012

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

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 NuVasive, Inc.
Requester
v.
Warsaw Orthopedic, Inc.
Patent Owner

Reexamination Control No. 95/000,451
Patent 6,936,050
Technology Center 3900

DECISION ON PETITION

This is a decision on requester's "Petition under 37 C.F.R. § 1.182 to Oral Hearing after the 'Examiner's Determination' pursuant to 37 C.F.R. § 41.77(d)," filed February 16, 2012 (present petition). In the present petition, requester requests an oral hearing in light of the patent owner's decision to re-open prosecution as set forth in 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments, and the subsequent Examiner's Determination pursuant to § 41.77(d). The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) and the fee for the request for oral

hearing pursuant to § 41.20(b)(3)were charged to requester's deposit account on February 17, 2012.

FINDINGS

1. On March 12, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,936,050, which was assigned Control No. 95/000,451.

2. On April 29, 2009, reexamination was ordered and on June 17, 2009, a non-final action was mailed.

3. Prosecution was conducted on and April 28, 2010, a Right of Appeal Notice was mailed.

4. Requester filed a Notice of Appeal on May 28, 2010, and an appellant brief on September 27, 2010.

5. Patent owner filed a respondent brief on August 30, 2010.

6. On March 23, 2011, an examiner's answer was mailed.

7. Requester filed a rebuttal brief on April 27, 2011.

8. On May 31, 2011, an Appeal Docketing Notice was mailed.

9. On August 5, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision affirming the examiner in-part, reversing the examiner in-part, and making a new ground of rejection under 37 C.F.R. § 41.77(b).

11. Patent owner filed a response pursuant to 37 C.F.R. § 41.77(b)(1) on September 6, 2011, requesting that prosecution be reopened, and including amendments.

12. Requester filed comments pursuant to 37 C.F.R. § 41.77(c) on October 6, 2011, proposing numerous new grounds of rejection.

13. On December 16, 2011, an Examiner's Determination pursuant to 37 C.F.R. § 41.77(d) was mailed, which adopted the majority of the proposed rejections, did not consider several improper proposed rejections, and refused to adopt several proposed rejections.

14. Patent owner filed comments pursuant to 37 C.F.R. § 41.77(e) on January 16, 2012, accompanied by several petitions requesting that declarations be entered, further amendments be entered, and a second examiner's determination be provided prior to further consideration by the BPAI.

15. Requester filed comments in accordance with 37 C.F.R. § 41.77(e) on January 17, 2012.

16. Requester filed a request for oral hearing on February 16, 2012, accompanied by the present petition.

17. Requester filed a reply to patent owner's comments on February 16, 2012, accompanied by oppositions to patent owner's petitions.

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. § 41.73 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

Requester's petition under 37 C.F.R. § 1.182 to request an Oral Hearing after the "Examiner's Determination" pursuant to 37 C.F.R. § 41.77(d) has been fully considered. Requester requests an oral hearing in light of the patent owner's decision to re-open prosecution under 37 C.F.R. § 41.77(b), thereby raising new issues due to claim amendments and the subsequent Examiner's Determination pursuant to 37 C.F.R. § 41.77(d). A review of the record of *inter partes* reexamination 95/000,451, reveals that it is not yet docketed at the BPAI for a decision pursuant to 37 C.F.R. § 41.77(f).

Pursuant to 37 C.F.R. § 41.73(b),

> [i]f 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.

While there is no specific provision in the rules for requesting an oral hearing after an Examiner's Determination pursuant to 37 C.F.R. § 41.77(d), given the numerous new issues that will be presented for consideration to the BPAI, petitioner has shown sufficient cause in the instant petition under 37 C.F.R. § 1.182 to permit the request for oral hearing. The Examiner's Determination was mailed on December 16, 2011, and the instant request for oral hearing was filed via the Office's electronic filing system (eFS) on February 16, 2012, therefore, the request for oral hearing is timely filed.

The petition for an oral hearing is **granted**.

DECISION

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

James Donald Smith
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.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

20457 7590 09/29/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,457	05/07/09	6549970	

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

COOLEY GODWARD KRONISH LLP
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DATE MAILED

SEP 29 2010

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WASHINGTON, DC 20001

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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ART UNIT	PAPER
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DATE MAILED:
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SEP 29 2010

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SEP 29 2010

DECHERT LLP (Courtesy Copy)
PO Box 390460
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CENTRAL REEXAMINATION UNIT

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the June 28, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations"(the June 28, 2010 requester petition).

This decision also addresses the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The June 28, 2010 requester petition under 37 CFR 1.182, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**. The original declaration under 37 CFR 1.132 by Jake Richter and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The patent owner's October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address are **ineffective**.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 4, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 3, 2010, the requester filed its comments submission.

Also on February 3, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

Also on February 3, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 4, 2010 patent owner response submission **(the original Richter rebuttal declaration)**.

Patent owner's January 4, 2010 response submission, and requester's February 3, 2010 comments submission, including the corrected Richter and Ryan declarations, and the original Richter rebuttal declaration, were expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 3, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On April 15, 2003, the Office issued U.S. Patent No. 6,549,970 (the '970 patent) to Arai *et al.*

- On May 7, 2009, a request for *inter partes* reexamination of the '970 patent was filed. The request was assigned Control No. 95/000,457 (the '457 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 21, 2009, *inter partes* reexamination was ordered.

- On September 21, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 21, 2009 requester petition).

- On October 2, 2009, the Office mailed a non-final Office action.

- On October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition).[1]

[1] The September 21, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by a February 22, 2010 Office decision. The subject matter of the September 21, 2009 and October 9, 2009 petitions, and the February 22, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On February 22, 2010, the Office mailed a decision granting-in-part the October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 17, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

- On January 4, 2010, the patent owner timely filed a response submission to the October 2, 2009 Office action (the January 4, 2010 patent owner response submission).[2]

- On February 3, 2010, the requester filed a comments submission after patent owner's January 4, 2010 response submission (the February 3, 2010 requester comments submission). The February 3, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration) and a declaration by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January, 4, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 3, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- Also on February 3, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the February 3, 2010 requester comments submission (the February 3, 2010 requester petition).

- On February 24, 2010, the requester filed a petition entitled, "Petition Under 37 CFR § 1.182 for Replacement of Papers Previously Submitted" (the February 24, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 3, 2010 and February 24, 2010 requester petitions; 2) expunging, as improper, the January 4, 2010 patent owner response submission and the February 3, 2010 requester comments submission; and 3) determining that the October 9, 2009 power of

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considered with respect to the September 21, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 21, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

[2] January 2, 2010 was a Saturday.

attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

- On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 3, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[3] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 3, 2010 comments submission, of the Tols declaration and the original Richter rebuttal declaration.

- Also on July 19, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the July 19, 2010 corrected requester comments submission (the July 19, 2010 requester petition). The July 19, 2010 requester petition is addressed by a companion decision being mailed on even date.

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the page length requirements of 37 CFR 1.943(b), as a supplement to the July 19, 2010 requester petition, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration). The September 3, 2010 requester petition alternatively requests waiver of 37 CFR 1.947 to permit the entry of the revised Richter rebuttal declaration as a replacement for the original Richter rebuttal declaration. The September 3, 2010 requester petition is addressed by a companion decision being mailed on even date.

[3] July 18, 2010 was a Sunday.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

DECISION

The June 28, 2010 Requester Petition Under 37 CFR 1.182 Is Dismissed

The examiner, in the October 2, 2009 non-final Office action, determined that two declarations filed together with the request for reexamination, i.e., the declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and the declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration), failed to comply with the formal requirements of 37 CFR 1.68.[4]

On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the present June 28, 2010 requester petition). Concurrently, the requester filed copies of two corrected declarations under 37 CFR 1.132, which were originally included with the February 3, 2010 requester comments submission,[5] i.e., the corrected Richter declaration and the corrected Ryan declaration. The corrected declarations, re-executed by the declarants, contain language that tracks the formal requirements of 37 CFR 1.68. The requester, in the instant petition, requests that the concurrently-filed corrected declarations be accepted as replacement copies for the original Richter and Ryan declarations. The petition further requests that the original Richter and Ryan declarations be expunged from the record.

There is no vehicle, however, that will permit the Office to expunge the original Richter and Ryan declarations from the record. The original Richter and Ryan declarations, while defective, were not improperly filed; i.e., they had an entry right. When a paper is defective, such as an unsigned paper, or where, as here, a declaration fails to comply with the requirements of 37 CFR 1.68, the party filing the paper is informed of the defect, and the paper is not considered on the merits, but remains in the file, and is not returned. For this reason, the original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

Furthermore, 35 U.S.C. 314(b)(2) expressly states that "requester shall have **one** opportunity to file written comments **addressing issues raised by the action of the Office** or the patent owner's response thereto" (emphasis added). 37 CFR 1.947

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[4] See the October 2, 2009, Office action at page 5. Specifically the declarations were determined to not clearly and accurately warn declarants that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

[5] The February 3, 2010 requester comments submission was determined to be improper and was expunged by the June 4, 2010 decision.

states that the requester "may **once** file written comments . . . These comments shall be limited to issues raised by the Office action or the patent owner's response." (emphasis added). As admitted by requester, the corrected declarations are being submitted to address an issue raised by the examiner in the October 2, 2009 non-final Office action, i.e., to address the examiner's determination that the original declarations were defective. The separate submission of the declarations, in order to address such an issue raised by the examiner in a non-final Office action, renders the record unclear as to whether or not requester is exercising its comment right pursuant to 35 U.S.C. 314(b)(2). If the declarations are to be taken as requester's written comments pursuant 35 U.S.C. § 314(b)(2), then no petition is necessary for their entry.[6] **The requester's statutory right to comment, however, would be exhausted, as no supplemental comments are permissible under the statute.**[7] However, on July 19, 2010, the requester filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" (the July 19, 2010 corrected requester comments submission). Accordingly, the Office presumes that the requester intended to exercise its comment right under 35 U.S.C. 314(b)(2) by filing the July 19, 2010 corrected requester comments submission, and not by the filing of the instant petition and its accompanying declarations.[8] If this is the case, then the only manner by which the corrected declarations may be entered would be by filing the corrected declarations as part of a requester's comment submission pursuant to 35 U.S.C. 314(b)(2), because the sole reason for the filing of the corrected declarations is to directly respond to the examiner's determination, in the non-final Office action, that the declarations were formally defective. There is no other rule or Office procedure that will permit the Office to enter the corrected declarations. Since the requester has separately and timely filed a corrected comments submission, the filing of the corrected declarations with the present petition is an attempt to file a supplemental comments submission, contrary to 35 U.S.C. 314(b)(2), and is **improper**.[9] See MPEP 2667, subsection I B 3.

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[6] No petition is necessary where evidence, such as a declaration, is **timely** filed in response to an issue raised in a **non-final** Office action. However, if an affidavit or evidence is filed, for example, after a right of appeal notice (RAN) (which is not the case here), the timely filing of a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.116(f) would be required for entry of the affidavit or other evidence.

[7] See also MPEP 2667, subsection I B 3, which provides, in pertinent part:

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

[8] If this is not the case, the requester is required to so inform the Office, and the Office will enter the June 28, 2010 corrected Richter and Ryan declarations as a requester comments submission pursuant to 35 U.S.C. 314(b)(2), and will expunge the July 19, 2010 requester comments submission as improper, since no supplemental comments are permissible as explained in detail above. In the present case, however, the July 19, 2010 requester comments submission is being *sua sponte* expunged, for other reasons, by a companion decision mailed on even date.

[9] Note that the July 19, 2010 corrected requester comments submission was filed in response to patent owner's completion of a proper response, pursuant to MPEP 2667, subsection I B 3 (see footnote 7). The

Accordingly, the June 28, 2010 requester petition is **dismissed**. The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

In addition, the July 19, 2010 corrected requester comments submission incorporates the corrected Richter and Ryan declarations, filed on June 28, 2010 (see page 3 of the comments submission). As discussed in the companion Office decision of even date, dismissing requester's July 19, 2010 petition, and as also discussed in the June 4, 2010 Office decision, the 37-page corrected Richter declaration is replete with legal argument, and is subject to the 50-page limit set forth in 37 CFR 1.943(b).[10] The 37-page corrected Richter declaration, in addition to the 37-page remarks section, the 38 pages of claim charts, and the at least 15 pages of the original Richter rebuttal declaration (if the original Richter rebuttal declaration were double-spaced, as discussed in the companion Office decision of even date) cause the length of the July 19, 2010 corrected requester comments submission to exceed 50 pages, and is expunged for the reasons given in the companion Office decision.

The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

As expressly discussed on page 12 of the June 4, 2010 Office decision, the patent owner's October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address are **ineffective**, because they do not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission. Specifically, in the present case, the Office dismissed as moot requester's earlier February 3, 2010 petition under 37 CFR 1.183 to waive 37 CFR 1.943(b) and enter requester's earlier February 3, 2010 comments submission, because patent owner's response was also determined to be improper, as failing to comply with 37 CFR 1.943(b). See the June 4, 2010 decision. This decision also informed the requester that even if the patent owner's response had been proper, the February 3, 2010 requester petition would not have been granted, and that the February 3, 2010 requester comments submission was expunged as improper, for failing to comply with 37 CFR 1.943(b). The June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response". The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission.

[10] The corrected Ryan decision is determined to be free of legal argument.

In addition, 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. 09/732, 291. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

Once again, a courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for 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., 09/732,291, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.**

CONCLUSION

- The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**.

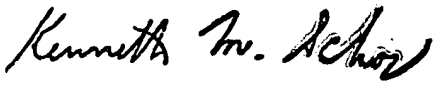
- The original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

- The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,291, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

20457 7590 09/29/2010

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,457	05/07/09	6549970	

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

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SEP 29 2010

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INTER PARTES REEXAMINATION COMMUNICATION

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

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LEE, CHRISTOPHER	
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Washington, DC 20001

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SEP 29 2010

CENTRAL REEXAMINATION UNIT

DECHERT LLP (Courtesy Copy)
PO Box 390460
Mountain View, CA 94039-0460

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the September 3, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule", requesting a supplemental waiver of the page length requirements of 37 CFR 1.943(b) or, in the alternative, waiver of the provisions of 37 CFR 1.947 to permit the late entry of a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition (the September 3, 2010 requester petition).

The September 3, 2010 requester petition and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The September 3, 2010 requester petition is **dismissed**.

The revised Richter 37 CFR 1.132 rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 4, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 3, 2010, the requester filed its comments submission.

Also on February 3, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

Also on February 3, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 4, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 4, 2010 response submission, and requester's February 3, 2010 comments submission, including the corrected Richter and Ryan declarations, and the original Richter rebuttal declaration, were expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with a petition under 37 CFR 1.182 (addressed in a companion decision on even date), a fourth proffered declaration by Jake Richter and a

third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 3, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

DECISION

The September 3, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

The requester requests entry and consideration of a supplement to requester's July 19, 2010 comments submission, i.e., a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition. The requester requests a supplemental waiver of the page length requirements of 37 CFR 1.943(b) or, in the alternative, a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission[1].

However, the filing of the declaration under 37 CFR 1.132 by Jake Richter, deposited on September 3, 2010 (the revised Richter rebuttal declaration) is improper. The requester timely filed a corrected comments submission on July 19, 2010, in response to the June 18, 2010 corrected patent owner response submission. The date of service of the June 18, 2010 corrected patent owner response submission is also June 18, 2010.

35 U.S.C. 314(b)(2) provides (emphasis added):

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

By statute, therefore, the requester is permitted only **one opportunity** to file written comments addressing issues raised by the Office action or by patent owner's response thereto. The **30-day time period** to file requester's comments is also a statutory requirement. **Statutory requirements cannot be waived.** 37 CFR 1.947 tracks the language of the statute and provides, in pertinent part (emphasis added):

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[1] There is also a corrected declaration under 37 CFR 1.132 by Jake Richter filed on June 28, 2010 which is addressed by a companion decision being mailed on even date.

> . . . may **once** file written comments **within a period of 30 days from the date of service of the patent owner's response**. These comments shall be limited to issues raised by the Office action or the patent owner's response."

The statute does not permit the filing of a supplemental requester comments submission, because the requester is statutorily given only "one" opportunity to file a written comments submission that is a proper paper, after each patent owner response. See also MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> **Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed.** Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

In the present case, the June 4, 2010 decision determined that the January 4, 2010 patent owner response was improper. The January 4, 2010 patent owner response was expunged, the February 3, 2010 requester petition under 37 CFR 1.183 to waive the page length requirements of 37 CFR 1.943(b) for requester's February 3, 2010 comments submission was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 3, 2010 requester comments submission was also improper and was expunged. In response to the June 4, 2010 decision, the patent owner filed the June 18, 2010 corrected patent owner response submission. The July 19, 2010 corrected requester comments submission was filed after patent owner's June 18, 2010 corrected response submission, which is a "completion of a proper response", as permitted by MPEP 2667. Thus, the revised Richter declaration deposited on September 3, 2010, in addition to being untimely filed (outside the statutory 30 day period), is clearly a submission which is supplemental to the July 19, 2010 corrected requester comments submission, and is **improper**.

Accordingly, the September 3, 2010 requester petition is **dismissed**. The revised Richter rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

Additional Comment

As expressly discussed on page 12 of the June 4, 2010 decision and in the companion decision mailed on even date, the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective** for the reasons given in those decisions. A courtesy copy of this decision will be mailed to

the address provided in the ineffective October 9, 2009 change of correspondence address.

CONCLUSION

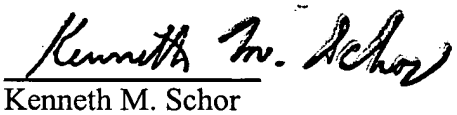
- The September 3, 2010 requester petition is **dismissed**.

- The revised Richter rebuttal declaration, deposited on September 3, 2010, is **improper**, will not be considered, and **is being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,291, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.



Kenneth M. Schor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

20457 7590 09/29/2010

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,457	05/07/09	6549970	

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039

DATE MAILED:
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SEP 29 2010
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COOLEY GODWARD KRONISH LLP
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777 6th STREET, NW
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WASHINGTON, DC 20001

DATE MAILED:
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DECHERT LLP (Courtesy Copy)
PO Box 390460
Mountain View, CA 94039-0460

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the July 19, 2010 "Petition under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the page length requirements of 37 CFR 1.943(b) (the July 19, 2010 requester petition).

This decision also addresses the July 19, 2010 corrected comments submission filed by the requester (the July 19, 2010 corrected requester comments submission).

The July 19, 2010 requester petition under 37 CFR 1.182, the July 19, 2010 corrected requester comments submission, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The July 19, 2010 requester petition under 37 CFR 1.183 is **dismissed**.

The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 4, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 3, 2010, the requester filed its comments submission.

Also on February 3, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

Also on February 3, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 4, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 4, 2010 response submission, and requester's February 3, 2010 comments submission, including the corrected Richter and Ryan declarations, and the original Richter rebuttal declaration, were expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with a petition under 37 CFR 1.182 (addressed in a companion decision on even date), a fourth proffered declaration by Jake Richter and a

third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 3, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On April 15, 2003, the Office issued U.S. Patent No. 6,549,970 (the '970 patent) to Arai *et al.*

- On May 7, 2009, a request for *inter partes* reexamination of the '970 patent was filed. The request was assigned Control No. 95/000,457 (the '457 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 21, 2009, *inter partes* reexamination was ordered.

- On September 21, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 21, 2009 requester petition).

- On October 2, 2009, the Office mailed a non-final Office action.

- On October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition). [1]

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

[1] The September 21, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by a February 22, 2010 Office decision. The subject matter of the September 21, 2009 and October 9, 2009 petitions, and the February 22, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On February 22, 2010, the Office mailed a decision granting-in-part the October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was considered with respect to the September 21, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 21, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 17, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

- On January 4, 2010, the patent owner timely filed a response submission to the October 2, 2009 Office action (the January 4, 2010 patent owner response submission).[2]

- On February 3, 2010, the requester filed a comments submission after patent owner's January 4, 2010 response submission (the February 3, 2010 requester comments submission). The February 3, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration) and a declaration by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January, 4, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 3, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- Also on February 3, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the February 3, 2010 requester comments submission (the February 3, 2010 requester petition).

- On February 24, 2010, the requester filed a petition entitled, "Petition Under 37 CFR § 1.182 for Replacement of Papers Previously Submitted" (the February 24, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 3, 2010 and February 24, 2010 requester petitions; 2) expunging, as improper, the January 4, 2010 patent owner response submission and the February 3, 2010 requester comments submission; and 3) determining that the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

---

[2] January 2, 2010 was a Saturday.

- On June 28, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 3, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration. The June 28, 2010 decision is addressed by a companion decision of even date.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[3] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 3, 2010 comments submission, of the Tols declaration and the original Richter rebuttal declaration.

- Also on July 19, 2010, the requester filed the instant petition entitled "Petition Under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the July 19, 2010 corrected requester comments submission (the July 19, 2010 requester petition).

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the page length requirements of 37 CFR 1.943(b), as a supplement to the July 19, 2010 requester petition, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration). The September 3, 2010 requester petition alternatively requests waiver of 37 CFR 1.947 to permit the entry of the revised Richter rebuttal declaration as a replacement for the original Richter rebuttal declaration. The September 3, 2010 requester petition is addressed by a companion decision being mailed on even date.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

[3] July 18, 2010 was a Sunday.

DECISION

The July 19, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

Requester's July 19, 2010 petition under 37 CFR 1.183 requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed comments submission, including claim charts and two declarations under 37 CFR 1.132.

The July 19, 2010 corrected requester comments submission includes a 37-page remarks paper, 38 pages of claim charts (Appendix I – III), a 2-page single-spaced declaration under 37 CFR 1.132 by Frans Tol (the Tol declaration), a 10-page single-spaced declaration under 37 CFR 1.132 by Jake Richter (the Richter rebuttal declaration), and a three-page double-spaced declaration under 37 CFR 1.132 by Wim van Maasakkers (the van Maasakkers declaration). Furthermore, the July 19, 2010 corrected requester comments submission incorporates the double-spaced corrected Richter and Ryan declarations filed on June 28, 2010 (see page 3 of the July 19, 2010 comments submission).

The Tol, van Maasakkers, and corrected Ryan declarations are determined to be free of legal argument.

The 37-page remarks section contains legal argument. Furthermore, the 38 pages of claim charts are replete with legal argument. See, e.g., App. I-1 ("Dependent Claims 30-35, and 37-42 (and Independent Claims 20 and 23) are Obvious"); see also App. I-7, I-11, II-1, II-4, II-8, III-1, III-4, III-9; see also obviousness arguments and analysis on page App. I-2, II-1, II-2, II-4, II-5, II-6, II-8, II-9, II-10, III-1, III-6, III-7, III-9, III-11, III-12; see also, e.g. App. I-14 ". . . this claim limitation is disclosed by Webb in view of VDDP Proposal, Draft 5.05, or Knowledge of Persons Having Ordinary Skill in the Art, as evidenced by VDDP, Draft 5.05" (this statement, and similar statements, are found through the claim charts).

The original Richter rebuttal declaration is a duplicate of the original Richter rebuttal declaration filed with the February 3, 2010 original requester comments submission, and is replete with legal argument for the same reasons given in the June 4, 2010 decision. If the 10-page single-spaced declaration were **double-spaced, as required on pages 11-12 of the June 4, 2010 decision**, the declaration would be at least 15 pages long.

Furthermore, the 37-page corrected Richter declaration filed on June 28, 2010, which is incorporated on page 3 of the corrected comments submission, and which is replete with legal argument for the same reasons set forth in the June 4, 2010 decision, is also included in the page count.

Accordingly, the 37-page remarks section, the 38 pages of claim charts, and the at least 15 pages of the Richter rebuttal declaration, and the 37-page corrected Richter declaration, totaling at least **127** pages, are subject to the 50-page limit.

The requester, however, has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). The requester states that it has made every effort to make the comments as brief as possible. The requester, however, only asserts that because the patent owner has added fourteen new dependent claims (claims 30-43), the filing of a corrected requester comments submission which exceeds the fifty (50) page regulatory limit is justified. Newly-added dependent claims 30-43 claims, however, only cover slightly more than one page. The need for **77** additional pages cannot be justified solely by patent owner's addition of this limited amount of new claim limitations.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. The requester only states that the newly added claims caused requester to exceed the fifty (50) page limit of 37 CFR 1.943(b). The newly added claims consist only of slightly more than one page. Requester provides no other facts to establish an extraordinary situation where justice requires suspension of the rule to such an extreme degree of an additional 77 pages. The failure of requester to comply with the rules, in the form of submitting an economized set of comments in accordance with 37 CFR 1.943(b), does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

Furthermore, the Tol and original Richter rebuttal declarations are single-spaced, contrary to the June 4, 2010 decision, which expressly stated on pages 11-12, in bold print:

> **To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:**
>
> **1) is double-spaced;**
> **2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);**
> **3) has a font size no smaller than 12-point;**
> **4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and**
> **5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).**
>
> **See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.**

In addition, the June 4, 2010 decision expressly stated, on page 13:

> Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. . See MPEP 2609 which 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.

Upon reconsideration, however, the requester is given one opportunity to correct the above-discussed defects. The June 4, 2010 decision determined that the January 4, 2010 patent owner response was improper. The January 4, 2010 patent owner response was expunged, the February 3, 2010 requester petition was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 3, 2010 requester comments submission was also improper and was expunged. Had the January 4, 2010 patent owner response been properly filed, and had the February 3, 2010 requester petition been directly dismissed for the reasons provided to the requester by the Office in an advisory capacity in the June 4, 2010 decision, the Office would not have been permitted to allow the requester another opportunity for resubmission. However, the June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response", as set forth in MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. **However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response.** Supplemental third party comments are also permitted in response to a supplemental patent owner response.

Accordingly, the July 19, 2010 requester petition is **dismissed**. The July 19, 2010 requester comments submission is **improper**, will not be considered, and **will be *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The requester is given **15 days from the mail date of this decision** to file a

corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

Additional Comment

As expressly discussed on page 12 of the June 4, 2010 decision and in the companion decision mailed on even date, the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective** for the reasons given in those decisions. A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

THIS DECISION HAS NOT TREATED THE JULY 19, 2010 CORRECTED REQUESTER COMMENTS SUBMISSION WITH REGARD TO ANY OTHER ISSUES, SUCH AS COMPLIANCE WITH 37 CFR 1.48.

CONCLUSION

- The July 19, 2010 requester petition under 37 CFR 1.183 is **dismissed**.

- The July 19, 2010 requester comments submission is **improper**, will not be considered, and **will be *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,291, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence

address of record for the patent owner, i.e., the address of Antonelli, Terry, Stout, & Kraus, LLP, 1300 North Seventeenth Street, Suite 1800, Arlington, VA 22209-3873.

- 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

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/26/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

37509 7590 09/01/2011

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EXAMINER

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Date:

MAILED

SEP 01 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000457
PATENT NO. : 6549970
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 01 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

COOLEY GODWARD KRONISH, LLP
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(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

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

This is a decision on Requester's petition, filed on September 21, 2009, which seeks relief to resolve allegedly contradictory findings of fact in copending, related reexamination proceedings. The petition is being treated as a petition under 37 CFR 1.181, requesting supervisory review of the July 21, 2009 order granting reexamination. The Requester's petition was entered into the proceeding record by the February 22, 2010 Office decision, which addressed other petitions and waived 37 CFR 1.939 to the extent that the September 21, 2009 petition is considered an authorized paper.

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

The instant petition filed by the Requester on September 21, 2009 is dismissed as moot.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,549,970 (the '970 patent) issued on April 15, 2003.

2. A completed request for *inter partes* reexamination of the '970 patent was filed on May 7, 2009. The request was assigned Control No. 95/000,457 (the '457 proceeding).

3. On July 21, 2009, the Office ordered that the '970 patent be reexamined. The order found that the VDDP document was not considered prior art. See page 10 of the order.

4. On September 21, 2009, the third party Requester filed the instant petition.

5. On October 2, 2009, the Office issued a non-final Office action, which upon reconsideration, found that the VDDP document was prior art that raises a substantial new question of patentability.

6. On October 9, 2009, the patent owner filed a petition requesting the Office to strike Requester's September 21, 2009 petition as an improper paper.

7. On January 4, 2010, the Patent Owner filed a response to the Office action.

8. On February 3, 2010, the Requester submitted comments.

9. On February 22, 2010, the Office, in a decision addressing Patent Owner's October 9, 2009 petition, waived 37 CFR 1.939 to the extent that the September 21, 2009 petition is considered an authorized paper. The decision also remanded the proceedings to the Central Reexamination Unit for consideration of the September 21, 2009 petition.

DECISION

As pointed out, the Requester filed a September 21, 2009 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to review the July 21, 2009 order. The petition was disputing the examiner's finding in the July 21, 2009 order that the VDDP document was not prior art. On October 2, 2009, Office mailed an action that reconsidered the initial determination in the order that the VDDP document was not prior art. The Office action found that the VDDP document was prior art and that it did raise a substantial new question of patentability. See page 6 of the Office action. Accordingly, the relief requested by the September 21, 2009 Requester petition has already been granted. Thus, the Requester's September 21, 2009 petition is moot, and thereby dismissed.

CONCLUSION

1. The September 21, 2009 Requester petition is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

37509 7590 09/01/2011

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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777-6th STREET NW, SUITE 1100
WASHINGTON, DC 20001

Date:
MAILED
SEP 01 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000457
PATENT NO. : 6549970
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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DECHERT LLP
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(For Patent Owner)

COOLEY GODWARD KRONISH, LLP
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WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on August 13, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on July 19, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.943, 1.947, and 1.948; and (2) Requester's opposition petition, filed on September 10, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on August 13, 2010. The petition and the opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on August 13, 2010 is dismissed as moot.

The opposition petition filed by the Requester on September 10, 2010 is dismissed as untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,549,970 (the '970 patent) issued on April 15, 2003.

2. A completed request for *inter partes* reexamination of the '970 patent was filed on May 7, 2009. The request was assigned Control No. 95/000,457 (the '457 proceeding).

3. On July 21, 2009, the Office ordered that the '970 patent be reexamined.

4. On October 2, 2009, the Office issued a non-final Office action.

5. On January 4, 2010, the Patent Owner filed a response to the Office action.

6. On February 3, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 3, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 2, 2009.

10. On August 13, 2010, the Patent Owner filed the instant petition, which is treated as under 37 CFR 1.181 requesting supervisory review as to whether Requester's comments filed on July 19, 2010 fail to comply with 35 U.S.C. § 314(b)(2) and 37 CFR 1.943(b), 1.947 and 1.948.

11. On September 10, 2010, the Requester filed a petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement of August 13, 2010.

12. On September 29, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements of 37 CFR 1.943(b). The Office gave the Requester 15 days to submit corrected comments.

DECISION

As pointed out, the Patent Owner filed an August 13, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the July 19, 2010 comments. On September 29, 2010, Office mailed a decision, which addressed other petitions and found the July 19, 2010 comments to be improper papers. The decision expunged the July 19, 2010 comments from the proceeding record. Accordingly, the relief requested by the August

13, 2010 Patent Owner petition has already been granted. Thus, the Patent Owner's August 13, 2010 petition is moot, and thereby dismissed.

The third party Requester's September 10, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the September 10, 2010 opposition was filed more than two weeks from August 13, 2010, the date of service for the original petition.

CONCLUSION

1. The August 13, 2010 Patent Owner petition is **dismissed as moot**.

2. The September 10, 2010 Requester opposition petition is **dismissed as untimely**.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,457	05/07/2009	6549970	379922-457RX (105402)	1192

37509 7590 09/01/2011

DECHERT LLP
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ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000457
PATENT NO. : 6549970
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 Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,457
Filed: May 7, 2009
For: U.S. Patent No. 6,549,970

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on November 23, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on October 14, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.947; and (2) Requester's opposition petition, filed on December 30, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on November 23, 2010. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on November 23, 2010 is dismissed as premature.

The opposition petition filed by the Requester on December 30, 2010 is dismissed as premature and untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,549,970 (the '970 patent) issued on April 15, 2003.

2. A completed request for *inter partes* reexamination of the '970 patent was filed on May 7, 2009. The request was assigned Control No. 95/000,457 (the '457 proceeding).

3. On July 21, 2009, the Office ordered that the '970 patent be reexamined.

4. On October 2, 2009, the Office issued a non-final Office action.

5. On January 4, 2010, the Patent Owner filed a response to the Office action.

6. On February 3, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 3, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 2, 2009.

10. On September 29, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements in 37 CFR 1.943(b). The Office gave the Requester 15 days to submit replacement comments.

13. On October 14, 2010, Requester submitted replacement comments, which included declarations and exhibits.

14. On November 23, 2010, the Patent Owner filed the instant petition, which is treated as a petition under 37 CFR 1.181 requesting supervisory review as to whether the Requester's comments filed on October 14, 2010 fail to comply with 35 USC 314(b)(2) and 37 CFR 1.947.

15. On December 30, 2010, the Requester filed the instant petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement, filed on November 23, 2010.

DECISION

As pointed out, the Patent Owner filed a November 23, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the October 14, 2010 replacement comments. On December 30, 2010, Requester filed an opposition to Patent Owner's November 23, 2010 petition. However, there has been no decision by the examiner if the Requester's October 14, 2010 replacement comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the October 14, 2010 replacement comments because the examiner has not made his or her decision. Thus, the Patent Owner's November 23, 2010 petition and third party Requester's December 30, 2010 opposition are premature, and they are dismissed.

In addition, the December 30, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the December 30, 2010 opposition was filed more than two weeks from November 23, 2010, the date of service for the original petition.

CONCLUSION

1. The November 23, 2010 Patent Owner petition is **dismissed as premature**.

2. The December 30, 2010 Requester opposition petition is **dismissed as premature and untimely**.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,458	05/07/2009	7089342	INNL-008/00US	5472

37509 7590 09/01/2011

DECHERT LLP
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MOUNTAIN VIEW, CA 94039-0460

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ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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Date:
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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000458
PATENT NO. : 7089242
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

COOLEY GODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6th STREET, NW
SUITE 1100
WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,458
Filed: May 7, 2009
For: U.S. Patent No. 7,089,342

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on August 18, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on June 18, 2010 for failure to comply with 37 CFR 1.948; and (2) Requester's opposition petition, filed on September 10, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on August 18, 2010. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on August 18, 2010 is dismissed as premature.

The opposition petition filed by the Requester on September 10, 2010 is dismissed as premature and untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,089,342 (the '342 patent) issued on August 8, 2006.

2. A completed request for *inter partes* reexamination of the '342 patent was filed on May 7, 2009. The request was assigned Control No. 95/000,458 (the '458 proceeding).

3. On August 5, 2009, the Office ordered that the '342 patent be reexamined.

4. On March 19, 2010, the Office issued a non-final Office action.

5. On May 19, 2010, Patent Owner filed a paper responsive to the March 19, 2010 non-final office action.

6. On June 18, 2010, Requester filed written comments to Patent Owner's Response and the Office action.

7. On August 18, 2010, Patent Owner filed the instant petition titled "PETITION UNDER 37 CFR §§ 1.182 AND 1.183 TO EXPUNGE INNOLUX'S IMPROPER COMMENTS SUBMISSION."

8. On September 10, 2010, Requester filed the instant opposing petition titled "PETITION UNDER 37 C.F.R. § 1.181 TO OPPOSE PETITION FILED BY PATENT OWNERS FOR EXPUNGEMENT OF THIRD PARTY COMMENTS".

DECISION

As pointed out, the Patent Owner filed an August 18, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the June 18, 2010 comments. On September 10, 2010, Requester filed an opposition to Patent Owner's August 18, 2010 petition. However, there has been no decision by the examiner if the Requester's June 18, 2010 comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the June 18, 2010 comments because the examiner has not made his or her decision. Thus, the Patent Owner's August 18, 2010 petition and third party Requester's September 10, 2010 opposition are premature, and they are dismissed.

In addition, the September 10, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the September 10, 2010 opposition was filed more than two weeks from August 18, 2010, the date of service for the original petition.

CONCLUSION

1. The August 18, 2010 Patent Owner petition is **dismissed as premature**.

2. The September 10, 2010 Requester opposition petition is **dismissed as premature and untimely**.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 09/29/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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WASHINGTON, D.C. 20001

Date: MAILED
SEP 29 2010
CENTRAL REEXAMINATION UNI

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
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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ANTONELLI, TERRY, STOUT & KRAUS, LLP (For Patent Owner)
1300 NORTH SEVENTEENTH STREET
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ARLINGTON VA 22209-3873

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SEP 2 9 2010

COOLEY GODWARD KRONISH LLP (For *Inter Partes* Requester)
ATTN: PATENT GROUP
777 6th Street, NW
Suite 1100
Washington, DC 20001

CENTRAL REEXAMINATION UNIT

DECHERT LLP (Courtesy Copy)
PO Box 390460
Mountain View, CA 94039-0460

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,459
Filed: May15, 2009
For: U.S. Patent No. 6,513,088

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the June 28, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations"(the June 28, 2010 requester petition).

This decision also addresses the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The June 28, 2010 requester petition under 37 CFR 1.182, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**. The original declaration under 37 CFR 1.132 by Jake Richter and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The patent owner's October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address are **ineffective**.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 6, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 5, 2010, the requester filed its comments submission.

Also on February 5, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 6, 2010 response submission, and requester's February 5, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On January 28, 2003, the Office issued U.S. Patent No. 6,513,088 (the '088 patent) to Arai *et al.*

- On May 15, 2009, a request for *inter partes* reexamination of the '088 patent was filed. The request was assigned Control No. 95/000,459 (the '459 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 21, 2009, *inter partes* reexamination was ordered.

- On September 21, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 21, 2009 requester petition).

- On October 6, 2009, the Office mailed a non-final Office action.

- On October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition). [1]

[1] The September 21, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by a February 22, 2010 Office decision. The subject matter of the September 21, 2009 and October 9, 2009 petitions, and the February 22, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On February 22, 2010, the Office mailed a decision

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 19, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

- On January 6, 2010, the patent owner timely filed a response submission to the October 6, 2009 Office action (the January 6, 2010 patent owner response submission).

- On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- On February 5, 2010, the requester filed a comments submission after patent owner's January 4, 2010 response submission (the February 5, 2010 requester comments submission). The February 5, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration) and a declaration by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 5, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the February 5, 2010 requester comments submission (the February 5, 2010 requester petition).

- On February 24, 2010, the requester filed a petition entitled, "Petition Under 37 CFR § 1.182 for Replacement of Papers Previously Submitted" (the February 24, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 5, 2010 and February 24, 2010 requester petitions; 2) expunging, as improper, the January 6, 2010 patent owner response submission and the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter

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granting-in-part the October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was considered with respect to the September 21, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 21, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

and Ryan declarations; and 3) determining that the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

- On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 4, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[2] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 5, 2010 comments submission, of the Tols declaration and the original Richter rebuttal declaration.

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration) as a replacement for the original Richter rebuttal declaration. The September 3, 2010 requester petition is addressed by a companion decision being mailed on even date.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

[2] July 18, 2010 was a Sunday.

DECISION

The June 28, 2010 Requester Petition Under 37 CFR 1.182 Is Dismissed

The examiner, in the October 6, 2009 non-final Office action, determined that two declarations filed together with the request for reexamination, i.e., the declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and the declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration), failed to comply with the formal requirements of 37 CFR 1.68.[3]

On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the present June 28, 2010 requester petition). Concurrently, the requester filed copies of two corrected declarations under 37 CFR 1.132, which were originally filed on February 4, 2010 and incorporated in the February 5, 2010 requester comments submission,[4] i.e., the corrected Richter declaration and the corrected Ryan declaration. The corrected declarations, re-executed by the declarants, contain language that tracks the formal requirements of 37 CFR 1.68. The requester, in the instant petition, requests that the concurrently-filed corrected declarations be accepted as replacement copies for the original Richter and Ryan declarations. The petition further requests that the original Richter and Ryan declarations be expunged from the record.

There is no vehicle, however, that will permit the Office to expunge the original Richter and Ryan declarations from the record. The original Richter and Ryan declarations, while defective, were not improperly filed; i.e., they had an entry right. When a paper is defective, such as an unsigned paper, or where, as here, a declaration fails to comply with the requirements of 37 CFR 1.68, the party filing the paper is informed of the defect, and the paper is not considered on the merits, but remains in the file, and is not returned. For this reason, the original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

Furthermore, 35 U.S.C. 314(b)(2) expressly states that "requester shall have **one** opportunity to file written comments **addressing issues raised by the action of the Office** or the patent owner's response thereto" (emphasis added). 37 CFR 1.947 states that the requester "may **once** file written comments . . . These comments shall be limited to issues raised by the Office action or the patent owner's response." (emphasis added). As admitted by requester, the corrected declarations are being submitted to address an issue raised by the examiner in the October 6, 2009 non-final

[3] See the October 6, 2009, Office action at page 5. Specifically the declarations were determined to not clearly and accurately warn declarants that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

[4] The February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was determined to be improper and was expunged by the June 4, 2010 decision.

Office action, i.e., to address the examiner's determination that the original declarations were defective. The separate submission of the declarations, in order to address such an issue raised by the examiner in a non-final Office action, renders the record unclear as to whether or not requester is exercising its comment right pursuant to 35 U.S.C. 314(b)(2). If the declarations are to be taken as requester's written comments pursuant 35 U.S.C. § 314(b)(2), then no petition is necessary for their entry.[5] **The requester's statutory right to comment, however, would be exhausted, as no supplemental comments are permissible under the statute.**[6] However, on July 19, 2010, the requester filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" (the July 19, 2010 corrected requester comments submission). Accordingly, the Office presumes that the requester intended to exercise its comment right under 35 U.S.C. 314(b)(2) by filing the July 19, 2010 corrected requester comments submission, and not by the filing of the instant petition and its accompanying declarations.[7] If this is the case, then the only manner by which the corrected declarations may be entered would be by filing the corrected declarations as part of a requester's comment submission pursuant to 35 U.S.C. 314(b)(2), because the sole reason for the filing of the corrected declarations is to directly respond to the examiner's determination, in the non-final Office action, that the declarations were formally defective. There is no other rule or Office procedure that will permit the Office to enter the corrected declarations. Since the requester has separately and timely filed a corrected comments submission, the filing of the corrected declarations with the present petition is an attempt to file a supplemental comments submission, contrary to 35 U.S.C. 314(b)(2), and is **improper**.[8] See MPEP 2667, subsection I B 3.

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[5] No petition is necessary where evidence, such as a declaration, is **timely** filed in response to an issue raised in a **non-final** Office action. However, if an affidavit or evidence is filed, for example, after a right of appeal notice (RAN) (which is not the case here), the timely filing of a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.116(f) would be required for entry of the affidavit or other evidence.

[6] See also MPEP 2667, subsection I B 3, which provides, in pertinent part:

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

[7] If this is not the case, the requester is required to so inform the Office, and the Office will enter the June 28, 2010 corrected Richter and Ryan declarations as a requester comments submission pursuant to 35 U.S.C. 314(b)(2), and will expunge the July 19, 2010 requester comments submission as improper, since no supplemental comments are permissible as explained in detail above.

[8] Note that the July 19, 2010 corrected requester comments submission was filed in response to patent owner's completion of a proper response, pursuant to MPEP 2667, subsection I B 3 (see footnote 7). The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission. Specifically, in the present case, the Office dismissed as moot requester's earlier February 5, 2010 petition under 37 CFR 1.183 to waive 37 CFR 1.943(b) and enter requester's earlier February 5, 2010 comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, because patent owner's response was also determined to be improper, as failing to comply with 37 CFR 1.943(b). See the June 4, 2010 decision. This decision also informed the requester

Accordingly, the June 28, 2010 requester petition is **dismissed**. The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The July 19, 2010 Corrected Requester Comments Submission Fails to Comply with 37 CFR 1.943(b)

In addition, the July 19, 2010 corrected requester comments submission incorporates the corrected Richter and Ryan declarations, filed on June 28, 2010 (see page 3 of the comments submission). As discussed in the June 4, 2010 Office decision, the 37-page corrected Richter declaration is replete with legal argument, and is subject to the 50-page limit set forth in 37 CFR 1.943(b).[9] The 37-page corrected Richter declaration, at least in addition to the 24-page remarks section, and the at least 15 pages of the original Richter rebuttal declaration (if the original Richter rebuttal declaration were double-spaced, as discussed in the June 4, 2010 decision) cause the length of the July 19, 2010 corrected requester comments submission to exceed 50 pages.[10] To date, the Office has not received a petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission.

The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

As expressly discussed on page 12 of the June 4, 2010 Office decision, the patent owner's October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address are **ineffective**, because they do not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

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that even if the patent owner's response had been proper, the February 5, 2010 requester petition would not have been granted, and that the February 5, 2010 requester comments submission, incorporating the February 4, 2010 corrected Richter and Ryan declarations, was expunged as improper, for failing to comply with 37 CFR 1.943(b). The June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response". The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission.

[9] The corrected Ryan decision is determined to be free of legal argument.

[10] This decision has not conducted a full analysis of the documents, filed with the July 19, 2010 corrected requester comments submission, that are subject to the 50 page regulatory limit.

In addition, 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. 09/732, 292. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

Once again, a courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for 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., 09/732,292, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.**

THIS DECISION HAS NOT TREATED THE JULY 19, 2010 CORRECTED REQUESTER COMMENTS SUBMISSION WITH REGARD TO ANY OTHER ISSUES, SUCH AS COMPLIANCE WITH 37 CFR 1.48.

CONCLUSION

- The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**.

- The original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

- The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,292, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence

address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 09/29/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATT: PATENT GROUP
777 6TH STREET N.W. SUITE 1100
WASHINGTON, D.C. 20001

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
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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ANTONELLI, TERRY, STOUT & KRAUS, LLP
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(For Patent Owner)

MAILED
SEP 29 2010
CENTRAL REEXAMINATION UNIT

COOLEY GODWARD KRONISH LLP
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777 6th Street, NW
Suite 1100
Washington, DC 20001

(For *Inter Partes* Requester)

DECHERT LLP
PO Box 390460
Mountain View, CA 94039-0460

(Courtesy Copy)

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,459
Filed: May15, 2009
For: U.S. Patent No. 6,513,088

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the September 3, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the provisions of 37 CFR 1.947 to permit the late entry of a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition (the September 3, 2010 requester petition).

The September 3, 2010 requester petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The September 3, 2010 requester petition is **dismissed**.

The revised Richter 37 CFR 1.132 rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 6, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 5, 2010, the requester filed its comments submission.

Also on February 5, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 6, 2010 response submission, and requester's February 5, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

DECISION

The September 3, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

The requester requests entry and consideration of a supplement to requester's July 19, 2010 comments submission, i.e., a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition. The requester requests a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission.

However, the filing of the declaration under 37 CFR 1.132 by Jake Richter, deposited on September 3, 2010 (the revised Richter rebuttal declaration) is improper. The requester timely filed a corrected comments submission on July 19, 2010, in response to the June 18, 2010 corrected patent owner response submission. The date of service of the June 18, 2010 corrected patent owner response submission is also June 18, 2010.

35 U.S.C. 314(b)(2) provides (emphasis added):

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

By statute, therefore, the requester is permitted only **one opportunity** to file written comments addressing issues raised by the Office action or by patent owner's response thereto. The **30-day time period** to file requester's comments is also a statutory requirement. **Statutory requirements cannot be waived.** 37 CFR 1.947 tracks the language of the statute and provides, in pertinent part (emphasis added):

> . . . may **once** file written comments **within a period of 30 days from the date of service of the patent owner's response**. These comments shall be limited to issues raised by the Office action or the patent owner's response."

The statute does not permit the filing of a supplemental requester comments submission, because the requester is statutorily given only "one" opportunity to file a written comments submission that is a proper paper, after each patent owner response. See also MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> **Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed.** Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

In the present case, the June 4, 2010 decision determined that the January 6, 2010 patent owner response was improper. The January 6, 2010 patent owner response was expunged, the February 5, 2010 requester petition under 37 CFR 1.183 to waive the page length requirements of 37 CFR 1.943(b) for requester's February 5, 2010 comments submission, which incorporated the Februrary 4, 2010 corrected Richter and Ryan declarations, was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was also improper and was expunged. In response to the June 4, 2010 decision, the patent owner filed the June 18, 2010 corrected patent owner response submission. The July 19, 2010 corrected requester comments submission was filed after patent owner's June 18, 2010 corrected response submission, which is a "completion of a proper response", as permitted by MPEP 2667. Thus, the revised Richter declaration deposited on September 3, 2010, in addition to being untimely filed (outside the statutory 30 day period), is clearly a submission which is supplemental to the July 19, 2010 corrected requester comments submission, and is **improper**.

Accordingly, the September 3, 2010 requester petition is **dismissed**. The revised Richter rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

The July 19, 2010 Corrected Requester Comments Submission Fails to Comply with 37 CFR 1.943(b)

In addition, the July 19, 2010 corrected requester comments submission incorporates

the corrected Richter and Ryan declarations, filed on June 28, 2010 (see page 3 of the comments submission). As discussed in the June 4, 2010 Office decision, the 37-page corrected Richter declaration is replete with legal argument, and is subject to the 50-page limit set forth in 37 CFR 1.943(b).[1] The 37-page corrected Richter declaration, at least in addition to the 24-page remarks section, and the at least 15 pages of the original Richter rebuttal declaration (if the original Richter rebuttal declaration were double-spaced, as discussed in the June 4, 2010 decision) cause the length of the July 19, 2010 corrected requester comments submission to exceed 50 pages.[2] To date, the Office has not received a petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission.

Additional Comment

As expressly discussed on page 12 of the June 4, 2010 decision and in the companion decision mailed on even date, the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective** for the reasons given in those decisions. A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

CONCLUSION

- The September 3, 2010 requester petition is **dismissed**.

- The revised Richter rebuttal declaration, deposited on September 3, 2010, is **improper**, will not be considered, and **is being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 09/732,292, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

---

[1] The corrected Ryan decision is determined to be free of legal argument.

[2] This decision has not conducted a full analysis of the documents, filed with the July 19, 2010 corrected requester comments submission, that are subject to the 50 page regulatory limit.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 01/28/2011

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2011

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Date: JAN 28 2011

CENTRAL REEXAMINATION UN

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATT: PATENT GROUP
777 6TH STREET N.W. SUITE 1100
WASHINGTON, D.C. 20001

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
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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PO Box 390460
Mountain View, CA 94039-0460

(For Patent Owner)

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JAN 28 2011

CENTRAL REEXAMINATION UNIT

COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP
777 6th Street, NW
Suite 1100
Washington, DC 20001

(For *Inter Partes* Requester)

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,459
Filed: May15, 2009
For: U.S. Patent No. 6,513,088

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the October 15, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the October 15, 2010 requester petition).

The October 15, 2010 requester petition under 37 CFR 1.183, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The October 15, 2010 requester petition under 37 CFR 1.183 is **dismissed**.

The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 6, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 5, 2010, the requester filed its comments submission.

Also on February 5, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 6, 2010 response submission, and requester's February 5, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with a petition under 37 CFR 1.182, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183, a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On January 28, 2003, the Office issued U.S. Patent No. 6,513,088 (the '088 patent) to Arai *et al.*

- On May 15, 2009, a request for *inter partes* reexamination of the '088 patent was filed. The request was assigned Control No. 95/000,459 (the '459 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 21, 2009, *inter partes* reexamination was ordered.

- On September 21, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 21, 2009 requester petition).

- On October 6, 2009, the Office mailed a non-final Office action.

- On October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition). [1]

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 19, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

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[1] The September 21, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by a February 22, 2010 Office decision. The subject matter of the September 21, 2009 and October 9, 2009 petitions, and the February 22, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On February 22, 2010, the Office mailed a decision granting-in-part the October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was considered with respect to the September 21, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 21, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

- On January 6, 2010, the patent owner timely filed a response submission to the October 6, 2009 Office action (the January 6, 2010 patent owner response submission).

- On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- On February 5, 2010, the requester filed a comments submission after patent owner's January 4, 2010 response submission (the February 5, 2010 requester comments submission). The February 5, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration) and a declaration by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 5, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183", requesting waiver of the page length requirements of 37 CFR 1.943(b) for the February 5, 2010 requester comments submission (the February 5, 2010 requester petition).

- On February 24, 2010, the requester filed a petition entitled, "Petition Under 37 CFR § 1.182 for Replacement of Papers Previously Submitted" (the February 24, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 5, 2010 and February 24, 2010 requester petitions; 2) expunging, as improper, the January 6, 2010 patent owner response submission and the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations; and 3) determining that the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

- On June 28, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 4, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes*

Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[2] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 5, 2010 comments submission, of the Tols declaration and the original Richter rebuttal declaration.

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration) as a replacement for the original Richter rebuttal declaration.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

- On September 29, 2010, the Office mailed a decision dismissing the June 28, 2010 requester petition and *sua sponte* expunging the corrected Richter and Ryan declarations filed on June 28, 2010.

- Also on September 29, 2010, the Office mailed a decision dismissing the September 3, 2010 requester petition, and *sua sponte* expunging the revised Richter rebuttal declaration filed on September 3, 2010.

- On October 15, 2010, the requester filed the instant petition, entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the October 15, 2010 requester petition).

DECISION

The October 15, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

Requester's October 15, 2010 petition under 37 CFR 1.183 requests waiver of the 50-page limit of 37 CFR 1.943(b) for the July 19, 2010 corrected requester comments submission.

The July 19, 2010 corrected requester comments submission, however, incorporated the double-spaced corrected Richter and Ryan declarations, filed on June 28, 2010 (see page 3 of the comments submission). As discussed in the June 4, 2010 Office decision, the 37-page double-spaced corrected Richter declaration is replete with

[2] July 18, 2010 was a Sunday.

legal argument, and is subject to the 50-page limit set forth in 37 CFR 1.943(b).[3] The 37-page double-spaced corrected Richter declaration, at least in addition to the double-spaced 24-page remarks section, and the at least 15 pages of the original single-spaced Richter rebuttal declaration (if the original Richter rebuttal declaration were double-spaced, as discussed in the June 4, 2010 decision)[4] caused the length of the July 19, 2010 corrected requester comments submission to exceed 50 pages.[5]

Accordingly, the 24-page remarks section, the at least 15 pages of the Richter rebuttal declaration, and the 37-page corrected Richter declaration, totaling at least 76 pages, are subject to the 50-page limit.

The requester, however, has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). The requester states that it has made every effort to make the comments as brief as possible. The requester, however, provides no explanation for the need for 26 additional pages.

Waiver of the rules under 37 CFR 1.183 may be suspended in an *extraordinary situation when justice requires*. The requester provides no facts to establish an extraordinary situation where justice requires suspension of the rule to permit the filing of an additional 26 pages. The failure of requester to comply with the rules does not rise to an *extraordinary situation* under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

Furthermore, the Tol and original Richter rebuttal declarations are single-spaced, contrary to the June 4, 2010 decision, which expressly stated on page 14, in bold print:

> **To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:**
>
> **1) is double-spaced;**
> **2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);**

---

[3] The corrected Ryan declaration is determined to be free of legal argument.

[4] The original Richter rebuttal declaration is a duplicate of the original Richter rebuttal declaration filed with the February 5, 2010 original requester comments submission, and is replete with legal argument for the same reasons given in the June 4, 2010 decision. If the 10-page single-spaced declaration were **double-spaced, as required on pages 11-12 of the June 4, 2010 decision**, the declaration would be at least 15 pages long

[5] The July 19, 2010 corrected requester comments submission also includes a 2-page single-spaced declaration under 37 CFR 1.132 by Frans Tol (the Tol declaration), a 3-page double-spaced declaration under 37 CFR 1.132 by Wim van Maasakkers (the van Maasakkers declaration). The Tol, van Maasakkers, and corrected Ryan declarations are determined to be free of legal argument, and are not subject to the 50-page regulatory limit.

3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

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

In addition, the June 4, 2010 decision expressly stated, on page 16:

> Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. . See MPEP 2609 which 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.

Upon reconsideration, however, the requester is given one opportunity to correct the above-discussed defects. The June 4, 2010 decision determined that the January 6, 2010 patent owner response was improper. The January 6, 2010 patent owner response was expunged, the February 5, 2010 requester petition was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 4, 2010 and February 5, 2010 requester comments submission was also improper and was expunged. Had the January 6, 2010 patent owner response been properly filed, and had the February 5, 2010 requester petition been directly dismissed for the reasons provided to the requester by the Office in an advisory capacity in the June 4, 2010 decision, the Office would not have been permitted to allow the requester another opportunity for resubmission. However, the June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response", as set forth in MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. **However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments**

were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

Accordingly, the October 15, 2010 requester petition is **dismissed**. The July 19, 2010 requester comments submission is **improper**, will not be considered, and **will be *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

CONCLUSION

- The October 15, 2010 requester petition under 37 CFR 1.183 is **dismissed**.

- The July 19, 2010 requester comments submission is **improper**, will not be considered, and **will be *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

- 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
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Alexandria, VA 22313-1450

By Fax: (571) 273-9900

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

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

01/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,459	05/15/2009	6513088	379922-459RX (105402)	3741

37509 7590 10/25/2011

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

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ART UNIT	PAPER NUMBER

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Date:

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OCT 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000459
PATENT NO. : 6513088
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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(For Requester)

COOLEY LLP
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SUITE 1100
777 - 6TH STREET, NW
WASHINGTON, DC 20001

In re Arai *et alia*
Reexamination Proceeding
Control No. 95/000,459
For: U.S. Patent No. 6,513,088

: DECISION
: DISMISSING
: PLURAL PETITIONS

The *inter partes* reexamination is before the Central Reexamination Unit to address papers filed September 21, 2009, August 13, 2010, April 11, 2011, and May 11, 2011.

The petitions are **dismissed** for the reasons set forth below.

As to the September 21, 2009, which seeks relief to resolve allegedly contradictory findings of fact in copending, related reexamination proceeding, the petition is being treated as a petition under 37 CFR 1.181, requesting supervisory review of the July 21, 2009 order granting reexamination.

The petition was disputing the examiner's finding in the July 21, 2009 order that the VDDP document was not prior art. On October 6, 2009, Office mailed an action that reconsidered the initial determination in the order that the VDDP document was not prior art. The Office action found that the VDDP document was prior art and that it did raise a substantial new question of patentability. See pages 4-5 of the Office action. Accordingly, the relief requested by the September 21, 2009 Requester petition has already been granted. Thus, the Requester's September 21, 2009 petition is moot and thereby **dismissed**.

The August 13, 2010 and April 11, 2011 petitions request the Office find non-compliant and/or expunge various papers. However, there has been no decision by the examiner if the papers are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the comments because the examiner has not yet made his or her decision. Thus the petitions (including the opposition petition) are premature, and they are **dismissed**.

CONCLUSION

1. The petitions of September 21, 2009, August 13, 2010, April 11, 2011, and May 11, 2011 are **dismissed**.

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

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

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,460	05/04/2009	6304236	INNL-002/00US	7144

37509 7590 09/28/2010

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Date:

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SEP 2 8 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000460
PATENT NO. : 6304236
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

(For Patent Owner)

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(For Third Party Requester)

In re Arai
Reexamination Proceeding
Control No. 95/000,460
Correct Request Deposited: May 4, 2009
For: U.S. Patent No. 6,304,236

DECISION
DISMISSING PETITIONS

This is a decision on the April 1, 2010 paper entitled "PETITION UNDER 37 C.F.R. § 1.181". This decision also addresses the April 8, 2010 paper entitled "PETITION UNDER 37 CFR §§1.182 AND 1.183 OPPOSING INNOLUX'S PETITION FILED APRIL 1, 2010 TO REPOPEN PROSECUTION AND REQUESTING THAT INNOLUX'S CLAIM CHARTS BE EXPUNGED FROM THE RECORD" and the April. 29, 2010 paper entitled "SUPPLEMENTAL PETITION UNDER 37 CFR §§ 1.182 AND 1.183".

The papers are before the Director of the Central Reexamination Unit for consideration.

The request to reopen prosecution is **dismissed** for the reasons set forth below.

BACKGROUND AND DECISION

On July 31, 2009, the office mailed an Action Closing Prosecution (ACP).

On December 22, 2009, the office mailed a Right of Appeal Notice (RAN).

On January 12, 2010, Third-Party Requester (3PR) filed a Notice of Appeal.

On April 1, 2010, 3PR filed the present petition.

On April 9, 2010, Patent Owner filed an opposition petition.

On April 29, 2010, Patent Owner filed a supplemental 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 no filed within two months of the mailing date of the action or notice form 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 April 1, 2010 requesting relief from an action mailed on December 22, 2009. Therefore, the request is **dismissed as untimely**.

In addition, PO has a filed petition on April 9, 2010 and April 29, 2010 opposing reopening prosecution and requesting the office expunge the claim charts submitted with 3PR's April 1, 2010 petition, which 3PR petitioned to be considered upon reopening prosecution.

Since 3PR's petition filed April 1, 2010 is dismissed as untimely, PO's opposition to reopening prosecution in the papers filed April 9, 2010 and April 29, 2010 are **dismissed as moot**.

CONCLUSION

1. 3PR's request to reopen after RAN is **dismissed as untimely**.

2. PO's petitions opposing reopening prosecution are **dismissed as moot**.

3. **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

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

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html.

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

5. 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.
95/000,463	04/27/2009	6542673	14770-1	3503

20786 7590 02/03/2011

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1180 PEACHTREE STREET , NE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/03/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
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WASHINGTON, DC 20005

Date:

MAILED

FEB 03 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000463
PATENT NO. : 6542673
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

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

Kenyon & Kenyon
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Washington, DC 20005

(For Third Party Requester)

In re Holter *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,463
Filed: April 27, 2009
For: U.S. Patent No. 6,542,673 B1

: **DECISION DISMISSING**
: **REQUESTS FOR**
: **RECONSIDERATION**

This is a decision on the December 7, 2010 third party requester petitions entitled "RENEWED PETITION UNDER 37 CFR § 1.183" and "RENEWED PETITION UNDER 37 CFR § 1.182."

The third party requester petitions are before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.182 to request for rule waiver and an extension of time is **granted** to the extent that the prior decision has been fully reconsidered but **dismissed** as to the underlying relief requested.

The petition under 37 C.F.R. § 1.183 to request for rule waiver and an extension of time is **granted** to the extent that the prior decision has been fully reconsidered but **dismissed** as to the underlying relief requested. Third party requester is invited to supply additional evidence, as detailed below.

BACKGROUND

1. On April 27, 2009, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,463 ("the '463 proceeding").

2. On July 23, 2009, the Office issued an order granting the April 27, 2009 request for *inter partes* reexamination and also issued an Office action on the merits of the '463 proceeding.

3. Prosecution progressed until, on July 22, 2010, third party requester filed a Notice of Appeal.

4. On October 6, 2010, third party requester filed an appellant's brief.

5. On November 2, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate ("NIRC"), in which the October 6, 2010 appellant's brief was stated to be untimely filed.

6. On November 8, 2010, third party requester filed petitions entitled "PETITION UNDER 37 CFR § 1.183" and "PETITION UNDER 37 CFR § 1.182."

7. On November 23, 2010, the Office issued a decision dismissing both third party requester petitions filed on November 8, 2010.

8. On December 7, 2010, third party requester filed the instant petitions entitled "RENEWED PETITION UNDER 37 CFR § 1.183" and "RENEWED PETITION UNDER 37 CFR § 1.182."

9. On December 30, 2010, third party requester filed a petition under § 1.181 seeking that the November 2, 1010 NIRC be vacated.

10. On January 11, 2011, the Office issued a Supplemental Notice of Intent to Issue a Reexamination Certificate (" supplemental NIRC").

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

> [R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

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.

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. § 1.182 states:

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

37 C.F.R. § 1.957(a) states:

> **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.** [emphasis added].

37 C.F.R. § 1.958(b) states, 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). [emphasis added]

37 C.F.R. § 1.137(b) 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 [emphasis added]

37 C.F.R. § 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.

37 C.F.R. § 41.67(b) provides:

> (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).

DECISION

The present third party requester petitions were filed on December 7, 2010, seeking reconsideration of the November 23, 2010 Office decision dismissing the third party requester's November 8, 2010 petitions. On November 28, 2010, third party requester filed a petition under § 1.183 for waiver of the provisions of § 41.66 and § 41.67 to accept the October 6, 2010 appellant's brief as being timely filed, as well as a petition seeking the same relief under § 1.182.

Petitioner third party requester argues that the delay was "unavoidable" and that additional factors, *presented for the first time in the reconsideration petition*, must be considered in the determination of "how justice is best served and the goals of the patent statutes are best achieved." Based upon these arguments, petitioner seeks reconsideration of the dismissal of the November 8, 2010 petitions.

1. Whether An Extraordinary Situation Exists to Justify Rule Waiver Under § 1.183

I. The Proper Standard For Entry of Untimely Third Party Requester Papers

Petitioner presents the instant petition seeking rule waiver under § 1.183, which requires the existence of an "extraordinary situation" such that "justice requires" relief from the rule. The petition emphasizes that § 1.183 is an "inherently flexible standard" requiring consideration of all accompanying facts and circumstances.[1]

Petitioner further alleges that relief under § 1.183 has been found previously where the cause of a delay is unavoidable, unintentional, or even intentional. Petitioner reasons that showing the cause of the delay was both unintentional and unavoidable would be a strong factor in favour of relief under § 1.183. However, neither past nor current practices reveal that the unintentional and/or unavoidability standards, which apply to relief in the context of revival of proceedings, are controlling as to relief under § 1.183.

Following the enactment of *ex parte* reexamination in 1980, entry of late papers in *ex parte* reexamination proceedings were requested via patent owner petition under § 1.183. Such

[1] Section 1.183 petition at 1-2.

petitions were grantable "if the situation is 'extraordinary' and if 'justice requires' the waiver [in cases where] rights may be lost by the failure to timely respond."[2] In 1988, in reaction to *In re Katrapat*, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988),[3]), Office policy changed to permit entry of a late paper by a patent owner where the delay in submitting the paper could be shown to be "unavoidable in the sense of § 133." The MPEP was accordingly updated in July 1989 to substitute 35 U.S.C. § 133 (and a petition under 37 CFR § 1.137(a) based on the "unavoidable" standard for accepting late papers) in place of 37 C.F.R § 1.183 as the basis for seeking entry of late papers in reexamination, which at that time existed in *ex parte* form only.[4]

In the American Inventors Protection Act of 1999 enactment of optional *inter partes* reexamination, Congress specifically authorized entry of late papers to patent owners based on either unavoidable or unintentional delay through amendment of 35 U.S.C. § 41 (a)(7).[5] Congress, however, did not extend such relief to third party requesters in that Act.

Accordingly, the Office promulgated 37 C.F.R. § 1.958, which set forth the procedure for a petition to accept late papers and revive a terminated *inter partes* reexamination or claims terminated for lack of patent owner response.[6] Further, the text of the rule concerning acceptance of late papers in reexamination prosecution, 37 C.F.R. § 1.137, is limited to "delay in reply by applicant or patent owner," whether unavoidable or unintentional. However, untimely third party requester papers, including appellant's briefs, are to be "refused consideration" per 37 C.F.R. 1.957(a).[7]

A further example of this is the discussion of these topics in the Report from the Committee on the Judiciary accompanying the proposed Act:

> A patent owner must pay a fee of $1,210 for each petition in connection with an unintentionally delayed response by the patent owner during a reexamination.
>
> A patent applicant, any of whose claims has been twice rejected; a patent owner in a reexamination proceeding; and a third-party requester may all appeal final adverse decisions from a primary examiner to the Board of Patent Appeals and Interferences. (emphasis added).[8]

Therefore, while patent owner and *inter partes* requester appeal rights stand on an equal footing,

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[2] MPEP 2268, 5th edition, August 1983.

[3] See *In re Katrapat*, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988) (finding that § 305 intends that the "unavoidable delay" provision of § 133 applies to patent owners in reexaminations as well as applicants in patent application proceedings).

[4] MPEP 2268, 5th edition, revision 12, July 1989.

[5] 106 P.L. 113, Title IV "American Inventors Protection Act of 1999," Subtitle F "Optional Inter Partes Reexamination Procedure," § 4605. 35 U.S.C. § 41 (a)(7) states that upon filing "for an unintentionally delayed response by the patent owner in any reexamination proceeding, [the fee is] $1,210, unless the petition is filed under section 133 or 151 of this title [unavoidable delay], in which case the fee shall be $110."

[6] 65 Fed. Reg. 76765, 76781 (Dec. 7, 2000).

[7] *Id.*

[8] Remarks of Mr. Coble, Report from the Committee on the Judiciary, 106 H. Rpt 287 (August 3, 1999). Note that both parties also (by virtue of legislation enacted November 2, 2002) stand on an equal footing for appeals to the Federal Circuit.

patent owner and *inter partes* requester rights of entry of a late paper do not. The unavoidable and unintentional delay standards in *inter partes* reexamination are uniquely associated with action by the applicant or patent owner by 35 U.S.C. § 41(a)(7), 35 U.S.C. § 133 and 37 C.F.R. § 1.137. Therefore, the standard for "unavoidable" delay, is not the standard by which this question is to be decided. However, in view of the pertinence of the concerns underlying the "unavoidable" standard to situations involving untimely response by a third party requester, a showing analogous to that required by § 1.137(a) is required in conjunction with requiring a showing of extraordinary circumstances, for acceptance of a late requester brief.

II. Factors Determining "Extraordinary Circumstances . . . Such That Justice Requires" Relief

The question of whether extraordinary circumstances exist such that justice requires waiver of a rule is necessarily specific to the facts and circumstances of the particular case. However, past practice and court precedent provide some guidance into this inquiry.

A. Past and Current Office Procedure:

Currently, the MPEP does not specifically address the circumstance in which a third party requester may seek entry of untimely papers, which are refused consideration under § 1.957(a). However, prior to the establishment of procedures for revival of a proceeding to enter an untimely paper submitted by the patent owner, the August 1983 5th edition of the MPEP provided guidance for seeking waiver of the rules to enter an untimely paper. In that edition, MPEP 2268 stated that "substantial property rights are involved in patents undergoing reexamination, the Office will consider, in appropriate circumstances, petitions to waive the rules pursuant to 37 CFR 1.183."[9] Decisions on such petitions applied the "extraordinary circumstances" test, and weighed such factors as the potential loss of appeal rights, acts of counsel to prudently ensure timely filing, and/or unawareness of or failure to properly interpret applicable due date regulations.[10] Such considerations have also been found appropriate in other situations, such as interference proceedings, in which an "extraordinary circumstances" test is applicable.[11]

Such petitions were noted to be appropriate where "rights may be lost by the failure to timely respond."[12] Since Congress has given the *inter partes* reexamination third party requester the

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[9] See MPEP 2268, 5th edition, August 1983.

[10] *See, e.g., In re Sivertz*, 227 USPQ 255 (Commr. Pat. July 23, 1985) (finding that counsel's apparent unawareness of the proper due date provisions did not show that justice required waiver of any time period set forth in USPTO regulations for appeal to the Federal Circuit); *In re Bachler*, 229 USPQ 553 (Commr. Pat. March 13, 1986) (stating that "the evidence does establish that counsel took detailed steps to ensure that timely filing took place, and these, coupled with the fact that the denial of the request to have the reply brief considered and of an opportunity for an oral hearing may prejudice the patent owner, established an extraordinary situation"); *In re Reck*, 227 USPQ 488 (Commr. Pat. August 28, 1985) (stating "[c]ounsel's apparent oversight . . . and unawareness with respect to [the appropriate timeliness regulations] does not make this an extraordinary situation for a grant of the relief sought").

[11] *See, e.g., B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d 1906 (Commr. Pat. April 27, 1988) (finding that "the mistake was the result of counsel's failure to review the rule" where counsel placed the burden of rule interpretation on a non-attorney staff member, resulting in an improper interpretation of a rule, resulting in untimeliness of a filing).

[12] MPEP 2268, 5th edition, August 1983.

same rights of appeal as given to the patent owner, waiver of the rules to permit entry of untimely papers should be applied to both parties, in appropriate situations, in the absence of a right to revive the proceeding.

The Office has previously entertained at least one petition for identical relief to that sought in the instant petition. In *inter partes* reexamination 95/000,209, third party requester sought relief from an untimely filed appellant's brief based solely upon a miscalculation of the due date for that brief. The decision on that petition was based on a determination of whether the facts and circumstances gave rise to an "extraordinary circumstance." In that decision, such miscalculation, stemming from a confusion over the proper date of filing of patent owner's appellant's brief, was noted to be "unfortunately, something that is not a rare occurrence, and is hardly an unusual or extraordinary circumstance."[13] Thus, it is seen that the Office has treated petitions to enter untimely appellant's brief under the "extraordinary circumstances" standard through review of the circumstances associated with the late filing.

B. Prior Court Precedent:

The essence of the "extraordinary circumstances" requirement was expressed by the CCPA in *Myers v. Feigelman*, 455 F.2d 586, 172 USPQ 580 (CCPA 1972).:

> [T]he rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules.[14]

Certain circumstances have been considered by the court as strong factors weighing against a finding of extraordinary circumstances. For example, numerous courts have found that lack of awareness of the provisions of a rule by an attorney is not a basis for waiver of that rule.[15] Additionally, permitting a requester to cure any such mere mistake through § 1.183 would place requester, contrary to the action of Congress, at an advantage to patent owner, which is by statute accorded such a right at a fee substantially greater than that for § 1.183.[16]

Certain other circumstances have been correlated by the courts with a finding of extraordinary circumstances. For example, where an unforeseeable intervening act in the submission of the document causes delay, such an act has been found to contribute to an "extraordinary"

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[13] "Decision Granting Petition," November 18, 2008, *inter partes* reexamination 95/000,209, at 7-8.

[14] See *Myers v. Feigelman*, 455 F.2d at 601, 172 USPQ at 584.

[15] *See, e.g., Nugent v. Yellow Cab Co.*, 295 F.2d 794 (7th Cir. 1961) cert denied, 369 U.S. 828 (1962)(stating "counsel's mistake in overlooking and not being aware of rule [is] not [a] basis for waiving [a] rule"); *In re Jones*, 542 F.2d 65, 68, 191 USPQ 249, 252 (CCPA 1976)(stating "attorneys appearing before Court are presumed to have knowledge of the provisions of the current rules").

[16] At the time of this decision, a petition to revive an unintentionally abandoned proceeding is set at $1,620; a petition to waive a rule under § 1.183 is set at $400. *See* http://www.uspto.gov/web/offices/ac/qs/ope/fee2009september15.htm

situation.[17] Where certain aspects of the Office's behavior are implicated in a party's untimely submission, courts are apt to find that such behavior contributes to an "extraordinary" situation.[18] Additionally, courts have stated a preference for mitigating "inevitable mistakes,"[19] and courts have been noted to be "loathe to extinguish a litigant's claim based solely on the innocent mistakes of his lawyer,"[20]

In each situation, the court or deciding official weighs the entirety of the facts presented by the party seeking waiver to determine whether "extraordinary circumstances" which would justify rule waiver are found to exist. No one circumstance is solely determinative.

II. The Entirety of Facts Does Not Yet Show Extraordinary Circumstances Such That Justice Requires Relief

The petition presents numerous additional facts and lines of reasoning in support of establishing the existence of extraordinary circumstances in the petitioner's present situation. Each of these has been carefully reviewed, and the totality of circumstances has been weighed in light of all of the facts and reasoning presented by the petitioner.

Weighing against an "extraordinary" finding is the extent to which the lack of timeliness was due to a mistake in applying the regulations by the registered practitioner, who admits to improperly applying the timeliness regulations §§ 41.61 and 41.66 to the facts, resulting in calculation of a late due date.[21]

Weighing towards an "extraordinary" finding is the extent to which the rights of the real parties in interest are affected by the mistake of counsel. Failure to cure the lack of timeliness of the appellant's brief would lead to dismissal of the requester's appeal, which would not further Congressional intent in providing appeal rights to the requesters, and could potentially be an important factor in the establishment of statutory estoppel under 35 U.S.C. 315(c) and 35 U.S.C. 317(b). Further, the rights of the real parties in interest would be affected by the preclusive effect of *inter partes* reexamination on the copending litigation.[22] It must be noted, however, that the Office has promulgated § 41.67(b), dismissing requester appeals upon failure to timely

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[17] *See Howard Florey Institute v. Dudas*, 87 U.S.P.Q.2d 1913 (E.D.VA 2008) (finding an acute panic attack by a courier of the paper to be filed at the USPTO to be an "extraordinary" situation).

[18] *See Commonwealth of Australia v. Radio Corporation of America*, 399 F.2d 807, 810 (2nd Cir. 1968)(finding that "the lengthy deliberation of the Board of Patent Interferences upon the petition for reconsideration and appended motion was a major factor" with respect to 37 C.F.R. § 2.148).

[19] *Helfgott & Karas v. Dickenson*, 209 F.3d 1328, 1330 (Fed. Cir) (stating "[m]istakes are inevitable, much as all those involved try to minimize their possibility. Even if total elimination of mistakes is an illusory goal, their reasonable mitigation should not be. Sound judgment, flexibility, and the careful following of considered processes are critical to ensuring that small mistakes do not become large ones, and that mistakes of form do not overwhelm the correctness of substance. Unfortunately, in this case, at least some of these elements were lacking from both parties to this dispute, leaving it to us to ascertain error, and assign responsibility for it").

[20] *Theodor Groz v. Quigg*, 10 U.S.P.Q.2d 1787 (reversing a refusal of the USPTO to find "unavoidable" a delay by patent owner in filing an appeal brief in a reexamination).

[21] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Richard W. Ward, point 4, at 2. The practitioner, Mr. Ward, does not allege that the rules were unclear in any manner as to the calculation of the proper date.

[22] § 1.183 petition for reconsideration, December 8, 2010, point 11, at 25.

file a brief, in the knowledge that such consequences would inherently flow therefrom.

Additionally weighing towards an "extraordinary" finding is the fact that a district court has stayed litigation (involving the patent being reexamined) for the benefit of the Office's expertise.[23] Furthermore, the public interest in the validity of the pending claims is affected where, as in this case, amended claims are presented and would become part of the 6,542,673 patent without consideration of requester's comments directed to the examiner's basis for allowability of those claims.

However, the factor which petitioner relies upon to the greatest extent is that this is an exceptional situation caused by an unexpected failure of a normally reliable routine. For such argument to be persuasive, evidence must show that a relevant routine is in place and is reliable, and that the unexpected failure actually caused the lack of timeliness of the submission.

Here, petitioner relies upon the fact that fault lay only in the failure of party A to consult her supervisor, party B, in accordance with Kenyon Docket Department practice.[24] The sworn affidavits allege that if party A had consulted party B, party B would have acted such as to apply the rule properly and assign the proper due date, thus preventing the lack of timeliness of the response.[25] The registered practitioner associated with the case further alleges that it was reasonable to rely upon party A to have performed her task properly, without his direct involvement, due to her history of excellent performance over the course of her employment.[26]

These allegations are supported by the information presented, in the sworn statements of Mr. Ward and Ms. McArdle, as to the reliability of the docketing system, which include a description of proper training of, and performance by, the Kenyon docketing employees. Particularly persuasive is the 20 year supervisory track record of Ms. McArdle, who states that she is "unaware of any other instance at Kenyon in which an appeal brief in any other reexamination (including *ex parte* reexaminations) was deemed to have been filed in an untimely fashion."[27] Ms. McArdle states that if she had been consulted, she "would have independently calculated the due date, which in [her] view [she] would have calculated to be October 5, 2010."[28]

However, the submission also notes that entry of a due date for a third party requester appellant's brief in an *inter partes* reexamination is not part of the normal docketing procedure. For instance, the docketing software, while reliable in most situations, simply cannot calculate the

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[23] § 1.183 petition for reconsideration, December 8, 2010, point 7, at 23.

[24] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Lorrie McArdle, point 15, at 4. Kenyon Docket Department policy was to consult a supervisor where there is uncertainty in a due date (McArdle, point 6, at 2); in this case the evidence supports a finding that the employee was, in fact, uncertain about the correct due date (Declaration of Judith Russo, point 6, at 2).

[25] *Id.*

[26] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Richard W. Ward, at 3. *See also* Declaration of Lorrie McArdle, point 17, at 4.

[27] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Lorrie McArdle, point 16, at 4.

[28] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Lorrie McArdle, point 15, at 4.

proper date for third party appellant's briefs in *inter partes* reexamination proceedings.[29] The petition submission fails to specifically aver and describe any Kenyon docketing procedure in place (at the time of the mistake) and the nature and extent of training system as to properly recording due dates for *inter partes* third party requester appellant's briefs, such that it would be reasonable for Mr. Ward to rely entirely on the docketing system in the face of his knowledge of a potential due date problem. Furthermore, the petition submission fails to provide any evidence supporting Ms. McArdle's contention that, if consulted, she would have calculated the correct due date. Finally, there is no discussion as to whether any *inter partes* third party requester appellant's briefs have been docketed in the past, and if so, copies of correctly entered due dates for the briefs.

The petition is grounded in the contention that the lack of timeliness resulted from an unforeseeable error in a clerical function that (1) was the actual cause of the delay; (2) occurred despite a reasonably reliable business routine; and (3) involved reliance upon an employee who was trained and experienced with regard to the routine that suffered from the error. However, the petition and supporting declarations provide minimal information on the Kenyon Docketing Department experience and routine for assigning due dates to third party appellant's briefs in *inter partes* reexaminations. While appeal briefs in *ex parte* reexaminations are averred to be correctly addressed by Kenyon Docket Department experience and routine, the procedures are very different for *inter partes* reexaminations. Manual entry of an appeal brief date is not required for *ex parte* reexaminations; as such, establishment of reliable procedures and training for appeal brief docketing in *ex parte* reexamination is not sufficient establishment of reliable procedures and training for brief docketing in *inter partes* reexamination. Absent such information, it is unclear whether the proper due date would have been set even if the employee had consulted her supervisor Ms. McArdle.

Therefore it is unclear, under the facts provided by petitioner, whether the lack of timeliness was in actuality caused by the failure of Kenyon's standard docketing procedures in place at the critical time, and whether such procedures are in actuality reasonably reliable to properly assign due dates to appellate brief filings in *inter partes* reexaminations. This is a matter that would need to be addressed even for a petition to revive under § 1.137(a) based on the "unavoidable" delay standard.

Since such facts are critical to petitioner's arguments, and as a successful showing would excuse the registered practitioner's mistake in applying the regulations by demonstrating that it was reasonable to rely on the date supplied by Kenyon's docketing department, the petitioner may file a renewed petition to supply the missing facts identified above.

Such evidence should address whether Kenyon's docket system can reasonably be relied upon in calculating *inter partes* appellant's brief due dates. The declaration of Ms. McArdle has already provided supporting evidence in that she "cannot recall a single other instance in my nearly 20 years of supervising the Docket Department in which a manually entered due date had been entered incorrectly, leading to a belated filing." However, the statement fails to aver that the

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[29] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Lorrie McArdle, point 18, at 5; *see* petition at 9 (stating that neither that system "nor any other docketing software could be programmed accurately to compute a deadline" for an appellant's brief in an *inter partes* reexamination) .

Docket Department has ever correctly calculated an *inter partes* appellant's brief, if there was one. Evidence may be submitted to show the standard procedures in place, as well as the procedures trained in and the nature of such training, for docketing appellant's briefs in *inter partes* reexamination.

2. Relief is Unavailable Under § 1.182

37 C.F.R. § 1.182 is available for relief for "situations not specifically provided for in the regulations of this part. However, § 1.957(a) states that if the third party requester files an untimely or inappropriate brief in an *inter partes* reexamination, the paper will be refused consideration. Since 37 C.F.R. § 41.66(a) provides a time deadline for filing an appellant's brief and § 1.957(a) provides for situations in which a third party requester files an untimely brief, the vehicle provided for relief is rule waiver under § 1.183; this is not a situation that is "not provided for" under the rules of practice. For the abovementioned reasons, relief is unavailable under § 1.182 for the instant situation. In such circumstances the avenue for relief is by petition under § 1.183 to waive the relevant rule.

Third party requester, in the instant petition, argues for reconsideration on the ground that the copy of third party requester's appellant's brief submitted with third party requester's November 8, 2010 petition was a "newly-filed" appeal brief, and thereby not covered by the provisions of § 1.957(a). However, even if the November 8th copy is considered to be a "newly-filed" copy, it is still an "untimely . . . brief in an *inter partes* reexamination," which, under § 1.957(a), " will be refused consideration."

Third party requester presents alleged "analogous situations" in which § 1.182 may be available to accept an untimely appeal brief in a patent application or to provide a mechanism for a patent owner to obtain entry of an amendment after an action closing prosecution in an *inter partes* reexamination proceeding. However, neither situation involves a third party requester submission.

The first situation, reinstatement of an appeal that was dismissed due to lack of a timely filed appeal brief where at least one claim stands allowed, exists in recognition of the fact that an applicant may request continued examination in an application, even where claims have been cancelled due to the dismissal of an appeal incident to a late-filed appeal brief. In such a situation, the procedure under § 1.182 merely simplifies an applicant's appeal of claims, eliminating Office effort in, e.g., issuing a paper which should not be needed. It must be noted that the use of § 1.182 does not, in that situation, create any new right that does not exist in the current regulations, but instead creates a simplified procedure for exercising that right.

The second situation, involving a request for continued reexamination (RCR), exists in recognition of the fact that patent owner is "prevented from obtaining entry or an amendment or evidence not entered" after the close of prosecution in an *inter partes* reexamination proceeding by filing a subsequent request for reexamination based on the same substantial question of

patentability.[30] However, an RCR is not used to cure a late-filed paper, nor is it available to a third party requester. Therefore, third party requester's invocation of the petition procedure under § 1.182 to seek RCR-type relief is not found analogous to illuminate the instant situation.

For the above reasons, § 1.182 remains unavailable to provide relief.

3. Further discussion:

Certain facts cited by petitioner in the instant petition, and accompanying declarations filed December 8, 2010, reflect apparent misunderstanding of what would be considered to be prudent care by an attorney registered to practice before the Office.

First, while it is true that an attorney may rely upon a competently trained staff to perform docketing functions, the attorney's signature on a submission is a certification that the submission is warranted by existing law.[31] This includes the timeliness requirements set forth in the applicable regulations. Regardless of any clerical docketing errors, a registered practitioner is expected to understand the appropriate due dates, when set by regulation, and conform to such rules when submitting a paper. This clearly did not occur, as the Appellant's brief signed by Mr. Ward on October 6, 2010, stated that the brief was "filed 'no later than two months from the expiration of the time for filing [the Patent Owner's] cross appeal' in accordance with 37 CFR 41.66(a) and 37 CFR 41.61(b)(1)."[32] (emphasis added). While Mr. Ward has stated that he has no supervisory authority over the docketing department, neither does he have any cause to rely upon that department for legal conclusions set forth in papers to the Office. Apparently, Mr. Ward failed to independently verify that his submission would meet the timeliness requirement set forth in the regulations such that his submission would be warranted by existing regulations.

Second, both Mr. Ward's and Ms. McArdle's declarations state that it is standard practice for clerical employees to contact the Office for rule interpretations as part of their "adequate training;"[33] indeed, Mr. Ward stated that he suggested that such be done in this particular case. Apparently, Kenyon and Kenyon suffer from the mistaken belief that the Office is part of Kenyon's Docket Department System. Reliance on oral advice from Office employees is not a substitute for proper legal analysis by one registered to practice in front of the Office and 37 CFR § 1.2 states that "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt." Note that such reliance has previously been found insufficient to support a finding of "unavoidable" delay.[34]

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[30] "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," *Official Gazette*, 1 March 2005.
[31] *See* 37 C.F.R. § 11.18(b)(2)(i).
[32] "Appeal Brief" filed October 6, 2010.
[33] § 1.183 petition for reconsideration, December 8, 2010, Declaration of Lorrie McArdle, point 6, at 2; Declaration of Richard Ward, point 5, at 2-3.
[34] MPEP 711.03(c)(II)(C)(2) (citing *In re Sivertz*, 227 USPQ at 256).

CONCLUSION

1. The December 7, 2010 third party requester petitions to reconsider the Office's November 23, 2010 petition decision and accept the October 6, 2010 appellant's brief as being timely filed are **dismissed**.

2. Third party requester may file a renewed petition to address the deficiencies noted above, and is given a **time period of the better of 30 days or 1 month is set for the filing of such a petition**.

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

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

4. It is strongly suggested that the filing of any renewed petition be made as soon as possible and be accompanied by a telephone call to Michael Cygan, Legal Advisor, at (571) 272-7700, alerting the Office of the filing.

5. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700 or in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

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

February 2, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,463	04/27/2009	6542673	14770-1	3503

20786 7590 02/28/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
1500 K STREET, N.W.
SUITE 700
WASHINGTON, DC 20005

Date:

MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000463
PATENT NO. : 6542673
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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MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

King & Spalding
1180 Peachtree Street, NE
Atlanta, GA 30309-3521

(For Patent Owner)

Kenyon & Kenyon
1500 K Street, N.W.
Suite 700
Washington, DC 20005

(For Third Party Requester)

In re Holter *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,463
Filed: April 27, 2009
For: U.S. Patent No. 6,542,673 B1

: **DECISION GRANTING**
: **PETITION UNDER**
: **37 C.F.R. § 1.183**

This is a decision on the February 16, 2011 third party requester petition entitled "SECOND RENEWED PETITION UNDER 37 CFR § 1.183."

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

The petition under 37 C.F.R. § 1.183 to request for rule waiver is **granted**, and the October 6, 2010 third party requester's Appellant's Brief will be considered in due course.

In view of the grant, the January 11, 2011 Supplemental Notice of Intent to Issue a Reexamination Certificate is withdrawn; thus a Respondent's Brief under 37 C.F.R. § 41.68 may be filed by the patent owner. Any Respondent's Brief under 37 C.F.R. § 41.68 must be filed by patent owner **within one month of the mailing date of this decision**. Following submission of any such Respondent's Brief, or the expiration of the time for filing such, the appeal will proceed in due course.

BACKGROUND

1. On April 27, 2009, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,463 ("the '463 proceeding").

2. On July 23, 2009, the Office issued an order granting the April 27, 2009 request for *inter partes* reexamination and also issued an Office action on the merits of the '463 proceeding.

3. Prosecution progressed until, on July 22, 2010, third party requester filed a Notice of Appeal.

4. On October 6, 2010, third party requester filed an appellant's brief.

5. On November 2, 2010, the Office issued a Notice of Intent to Issue a Reexamination Certificate ("NIRC"), in which the October 6, 2010 appellant's brief was stated to be untimely filed.

6. On November 8, 2010, third party requester filed petitions entitled "PETITION UNDER 37 CFR § 1.183" and "PETITION UNDER 37 CFR § 1.182" to accept as timely the appellant's brief that was filed by the third party requester on October 6, 2010.

7. On November 23, 2010, the Office issued a decision dismissing both third party requester petitions filed on November 8, 2010.

8. On December 7, 2010, third party requester filed petitions, entitled "RENEWED PETITION UNDER 37 CFR § 1.183" and "RENEWED PETITION UNDER 37 CFR § 1.182," seeking reconsideration of the November 23, 2010 Office decision.

9. On December 30, 2010, third party requester filed a petition under § 1.181 seeking that the November 2, 1010 NIRC be vacated.

10. On January 11, 2011, the Office issued a Supplemental Notice of Intent to Issue a Reexamination Certificate (" supplemental NIRC").

11. On February 3, 2011, the Office issued a decision dismissing the December 7, 2010 petitions.

12. On February 16, 2011, the instant petition entitled "SECOND RENEWED PETITION UNDER 37 CFR § 1.183" was filed by third party requester.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

> [R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

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.

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. § 1.182 states:

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

37 C.F.R. § 1.957(a) states:

> **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.** [emphasis added].

37 C.F.R. § 1.958(b) states, 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). [emphasis added]

37 C.F.R. § 1.137(b) 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 [emphasis added]

37 C.F.R. § 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.

37 C.F.R. § 41.67(b) provides:

> (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).

DECISION

The present third party requester petition was filed on February 16, 2011, seeking relief under § 1.183 for waiver of the provisions of § 41.66 and § 41.67 to accept the October 6, 2010 requester appellant's brief as being timely filed.

Petitioner third party requester files the instant petition to supply information requested by the Office in its previous dismissal decision, namely:

> [W]hether the lack of timeliness was in actuality caused by the failure of Kenyon's standard docketing procedures in place at the critical time, and whether such procedures are in actuality reasonably reliable to properly assign due dates to appellate brief filings in *inter partes* reexaminations.

1. Evidence Presented as to Kenyon's Standard Docketing Procedures for Appellate Brief Filings in *Inter Partes* Reexaminations:

According to Kenyon's evidence, Kenyon's Docketing Department had, prior to the instant proceeding, encountered appeal docketing in only two *inter partes* proceedings. In the first proceeding, 95/000,125, Kenyon only docketed a date for filing a notice of appeal. In the second proceeding, 95/001.030, Kenyon docketed dates for notice of appeal, and multiple brief filings.

From the data presented, Kenyon's Docketing Department is found to have been capable of properly docketing due dates in response to a paper mailed by the Office. In each of the four situations in which the Office mailed a paper in an *inter partes* reexamination under appeal, the

response date was properly docketed.[1]

The Docketing Department's record of docketing due dates in response to a paper mailed by the patent owner was less clear. Of the three instances in which this occurred, one was docketed on the correct date while two others were docketed a day early. In one instance, there was no explanation given for the early docketing date.[2] In the other instance, the Docketing Department does not appear to realize that it failed to note that a patent owner filing was not proper until resubmission with the proper fee, after an earlier patent owner filing.[3]

Additionally, Kenyon admits that it dockets due dates from the certificate of USPS mailing date rather than from the actual receipt date, unless an update to the actual receipt date is requested.[4] As Kenyon admits, the date of filing is triggered by the actual receipt date rather than a certificate of USPS mailing date.[5] Although in error, this is deemed harmless in the circumstances presented, since, in each case, the docketed due date would be earlier than the actual due date, and not lead to an unexpectedly late filing of a responsive paper.

The instance in which the date was properly docketed is of special note because of the personal involvement of Ms. McArdle in properly docketing a third party requester's respondent's brief.[6] The instant petition states that the error in docketing in the instant '463 proceeding occurred because Ms. McArdle was not consulted, despite an existing practice in place to consult her.[7] It does appear, therefore, that if Ms. McArdle had been consulted, she would have ensured that the proper due date for the respondent's brief in the instant '463 proceeding was docketed. Therefore, petitioner's argument that the error in docketing was due to failure to consult Ms. McArdle in a situation which there existed uncertainty as to a proper due date is well grounded in fact. Such an error was therefore committed by a docketing department which could reasonably have been relied upon to docket due dates for a timely filing (at least not later than the actual due date).

2. Discussion of Extraordinary Circumstances:

Following the enactment of *ex parte* reexamination in 1980, entry of late papers in *ex parte* reexamination proceedings were requested via patent owner petition under § 1.183. Such petitions were grantable "if the situation is 'extraordinary' and if 'justice requires' the waiver [in cases where] rights may be lost by the failure to timely respond."[8] In 1988, in reaction to *In re*

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[1] *See* McArdle declaration, paragraphs 10, 11, 12, 15, and 18.
[2] *See* McArdle declaration, paragraphs 16 and 17.
[3] *See* McArdle declaration, paragraph 13. The due date for a patent owner's brief filing was computed from the date of an incomplete patent owner's notice of appeal on July 15, 2009; the computation should have been computed from the resubmission, with the proper fee, on July 16, 2009.
[4] *See* McArdle declaration, page 4 at fn 1.
[5] *Id.*
[6] *See* McArdle declaration, paragraph 14.
[7] *See* the discussion of this reasoning at page 10 of the February 3, 2011 Office decision.
[8] MPEP 2268, 5th edition, August 1983.

Katrapat, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988),[9] Office policy changed to permit entry of a late paper by a patent owner where the delay in submitting the paper could be shown to be "unavoidable in the sense of § 133." The MPEP was accordingly updated in July 1989 to substitute 35 U.S.C. § 133 (and a petition under 37 C.F.R. § 1.137(a) based on the "unavoidable" standard for accepting late papers) in place of 37 C.F.R § 1.183 as the basis for seeking entry of late papers in reexamination, which at that time existed in *ex parte* form only.[10]

In the American Inventors Protection Act of 1999 enactment of optional *inter partes* reexamination, Congress specifically authorized entry of late papers to a patent owner, in a reexamination, based on unintentional delay through amendment of 35 U.S.C. § 41 (a)(7).[11] Congress, however, omitted extension of such relief to third party requester appeals in that Act. Nor did Congress provide the third party requester with late-paper relief based on unavoidable delay.

In view of the above, the Office promulgated 37 C.F.R. § 1.958, which set forth the procedure for a petition under 37 C.F.R. § 1.137 to accept late papers filed by a patent owner, including appeal briefs.[12] However, untimely third party requester papers, including appellant's briefs, are "refused consideration" per 37 C.F.R. § 1.957(a).[13]

Since the statutory "unavoidable" and "unintentional" relief is not available to a third party requester appellant, the pre-1988 entry of late papers in reexamination proceedings via petition under § 1.183 is the only vehicle available for such entry. Such petitions were, and are, grantable "if the situation is 'extraordinary' and if 'justice requires' the waiver [in cases where] rights may be lost by the failure to timely respond."

Weighing towards an "extraordinary" finding, in this instance, is the extent to which the rights of the real parties in interest are affected by the mistake of counsel. Failure to cure the lack of timeliness of the appellant's brief would lead to dismissal of the requester's appeal, which would not further Congressional intent in providing appeal rights to the requesters, and could potentially be an important factor in the establishment of statutory estoppel under 35 U.S.C. 315(c) and 35 U.S.C. 317(b). Further, the rights of the real parties in interest would be affected by the preclusive effect of *inter partes* reexamination on the copending litigation.[14]

Additionally weighing towards an "extraordinary" finding is the fact that a district court has stayed litigation (involving the patent being reexamined) for the benefit of the Office's

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[9] See *In re Katrapat*, 6 U.S.P.Q.2D 1863 (Comm'r Patents 1988) (finding that § 305 intends that the "unavoidable delay" provision of § 133 applies to patent owners in reexaminations as well as applicants in patent application proceedings).

[10] MPEP 2268, 5th edition, revision 12, July 1989.

[11] 106 P.L. 113, Title IV "American Inventors Protection Act of 1999," Subtitle F "Optional Inter Partes Reexamination Procedure," § 4605. 35 U.S.C. § 41 (a)(7) states that upon filing "for an unintentionally delayed response by the patent owner in any reexamination proceeding, [the fee is] $1,210, unless the petition is filed under section 133 or 151 of this title [unavoidable delay], in which case the fee shall be $110."

[12] 65 Fed. Reg. 76765, 76781 (Dec. 7, 2000).

[13] *Id.*

[14] § 1.183 petition for reconsideration, December 8, 2010, point 11, at 25.

expertise.[15] Furthermore, the public interest in the validity of the pending claims is affected where, as in this case, amended claims are presented and would become part of the 6,542,673 patent without consideration of requester's comments directed to the examiner's basis for allowability of those claims.

Finally, in view of the pertinence of the concerns underlying the "unavoidable" standard to situations involving untimely response by a third party requester, a showing analogous to that required by § 1.137(a) is required in conjunction with requiring a showing of extraordinary circumstances, for acceptance of a late requester brief. Such a showing has been presented to the Office based on the discussion in part 1 above.

Therefore, the petition is **granted**, and the appropriate rules are waived under the authority of 37 C.F.R. § 1.183 such that third party requester's Appellant's Brief of October 6, 2010 is considered timely and is entered.

3. Additional Discussion:

While the instant situation has been determined to have involved extraordinary circumstances, certain facts cited by petitioner in the instant petition, and in the accompanying declaration filed on February 16, 2011, reflect an apparent misunderstanding of what would be considered to be prudent care by an attorney registered to practice before the Office.

One of the petitioner's arguments for a finding of "extraordinary circumstances" was grounded on the fact that whether the date was calculated properly or improperly would not matter except in an "exceedingly rare" set of circumstances. Such a relaxed attitude towards docketing proper due dates is also reflected in the fact that certain due dates in *inter partes* appellate practice at Kenyon are set early either based upon a certificate of mailing date rather than the proper filing date, or based upon a request for an early date or for some undocumented reason. Should such an attitude in the future result in a late filing of a paper, even if only by one day, Kenyon cannot expect the Office to provide a remedy.

Additionally, it is apparent from the facts provided in the instant petition that Kenyon's proper docketing of due dates in *inter partes* appellate practice, where in response to a filing by another party, requires the personal supervision of Ms. McArdle. Should such a practice in the future result in a late filing of a paper, e.g. by another docketing staff member, Kenyon should not expect the Office to provide a remedy. Kenyon has not discussed the training given to other members of the Docketing Department on *inter partes* appellate practice; however, it is again noted that any reliance on the Office to provide training on a person-by-person basis to Kenyon's staff is no substitute for adequate training of all personnel who are expected to handle such cases.

Finally, the petition states that the docketing error of only a single day "would not immediately jump out to most practitioners that an error had been made." However, previous petitions have stated that neither Kenyon's electronic docketing system "nor any other docketing software could be programmed accurately to compute a deadline" for an appellant's brief in an *inter*

[15] § 1.183 petition for reconsideration, December 8, 2010, point 7, at 23.

partes reexamination.[16] As shown above, Kenyon's manual entry system does not show a proven record of manual entry in *inter partes* appellate practice, in part due to lack of experience with such situations. It would be prudent, therefore, for any registered practitioner to ensure the propriety of due dates in *inter partes* appellate practice. This is particularly true where the practitioner is signing a paper to the Office which avers that the paper is being timely filed, and where multiple real parties in interest may be "significant prejudiced" by an inability to appeal to the BPAI and the preclusive effect of an *inter partes* reexamination.[17]

CONCLUSION

1. The February 16, 2011 third party requester petition to reconsider the Office's November 23, 2010 petition decision and accept the October 6, 2010 appellant's brief as being timely filed is **granted**.

2. The October 6, 2010 third party requester's Appellant's Brief is entered in the file to the effect that it will be considered in due course. Any processing needed with respect to this entry will be carried out by the Central Reexamination Unit.

3. The January 11, 2011 Supplemental Notice of Intent to Issue a Reexamination Certificate is withdrawn; thus a Respondent's Brief under 37 C.F.R. § 41.68 may be filed by the patent owner. Any Respondent's Brief under 37 C.F.R. § 41.68 must be filed by patent owner **within one month of the mailing date of this decision**. Following submission of any such Respondent's Brief, or the expiration of the time for filing such, the appeal will proceed in due course.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700 or in his absence to the undersigned, at (571) 272-7710.

/Kenneth M. Schor/

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

February 24, 2011

[16] *See* December 7, 2010 petition at 9.
[17] *See, e.g.*, December 7, 2010 petition at 25.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,463	04/27/2009	6542673	14770-1	3503

20786 7590 03/25/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
1500 K STREET, N.W.
SUITE 700
WASHINGTON, DC 20005

Date:
MAILED
MAR 25 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000463
PATENT NO. : 6542673
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

MAR 25 2011

CENTRAL REEXAMINATION UNIT

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

(For Requester)

KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

In re: Holter *et alia*
Reexamination Proceeding
Control No. 95/000,463
Request Deposited: May 11, 2010
For: U.S. Patent No. 5,960,074

This is a decision on the December 30, 2010 paper entitled "PETITION UNDER 37 CFR §1.181" requesting the NIRC of November 2, 2010 be vacated.

In view of the supplemental NIRC mailed January 7, 2011 and the decision, mailed February 28, 2011, accepting the appellant brief as timely, the petition is **dismissed as moot**.

CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611

Eric Keasel
SPE, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,463	04/27/2009	6542673	14770-1	3503

20786 7590 05/19/2011

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1180 PEACHTREE STREET , NE
ATLANTA, GA 30309-3521

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Ciena Corp., JDS Uniphase Corp., Newport Corp., and Palomar Technologies, Inc. v. Cirrex Systems LLC

Reexamination Control No. 95/000,463
Patent 6,542,673
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 the Respondent Brief as Non-Compliant with 37 C.F.R. § 41.68" filed April 29, 2011 ("present petition"). Petitioner requests that the patent owner's respondent brief of March 22, 2011, be stricken for not being "limited to issues raised in the appellant brief," as required by 37 C.F.R. § 41.68(a)(3). The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's credit card on April 29, 2011.

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

FINDINGS

1. On April 27, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,542,673, which was assigned control no. 95/000,463.

2. On July 23, 2009, reexamination was ordered, and a non-final Office action was mailed.

3. Prosecution was conducted, and on June 22, 2010, a Right of Appeal Notice (RAN) was mailed.

4. Requester filed a Notice of Appeal on July 22, 2010.

5. Requester filed an appellant brief on October 6, 2010.

6. Patent owner filed a respondent brief on March 22, 2010.

7. On April 1, 2010, an examiner's answer was mailed.

8. Requester filed a rebuttal brief on April 29, 2010, accompanied by the present petition.

9. On May 6, 2011, the rebuttal brief was noted by the examiner.

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 provides in pertinent part:

(a)(3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

. . .

(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.

. . .

(vi) Issues to be reviewed on appeal. A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) Argument. A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

. . .

(2) A respondent 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 filed after the date of filing the appeal.
. . .

ANALYSIS

Petitioner requests that the respondent brief be held non-compliant for not being "limited to issues raised in the appellant brief," as required by 37 C.F.R. § 41.68(a)(3). Petitioner asserts that the respondent brief includes arguments directed to the prior art status of the Lowry and Lu references. Petitioner argues that these issues were not raised in the appellant brief and that the Lowry and Lu references were found by the examiner to qualify as prior art printed publications. Petitioner contends that the patent owner's inclusion of these arguments for the first time in the respondent brief is prejudicial to petitioner. Petitioner asserts that if patent owner had raised these arguments during prosecution before the examiner, then the requester would have had the opportunity to submit additional evidence directed to the issue. Petitioner correctly points out that 37 C.F.R. § 41.71(c)(4) prohibits the submission of new evidence at this time.

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 March 22, 2011, and an examiner's answer was mailed on April 1, 2011. The requester filed a rebuttal brief on April 29, 2011, which was noted by the examiner on May 6, 2011. The issues on appeal pertinent to the present petition are:

VIII. Whether claims 24, 68-71, 91-93, and 101-102 are anticipated by "Low-Cost Packaging of High-Performance Optoelectronic Components" ("Lowry");

IX. Whether claims 24, 68-69, 71, and 91-93 are anticipated by "Flexible Manufacturing for Photonics Device Assembly" ("Lu").

Patent owner has presented new arguments concerning the prior art status of the Lu and Lowry references in responding to the above issues on appeal. Note that 37 C.F.R. § 41.68 does not preclude the presentation of new arguments in a respondent brief. Petitioner points out that the Lowry and Lu references were found by the examiner to qualify as prior art printed publications. The rebuttal brief addresses patent owner's arguments regarding the prior art status of the Lowry and Lu references on pages 22-23. Therefore, all briefing in this *inter partes* reexamination has been completed, and this case is ripe for a decision on appeal.

The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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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.
95/000,463	04/27/2009	6542673	14770-1	3503

20786 7590 04/13/2012

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
CIENA CORP.
v.
CIRRIX SYSTEMS LLC.

Reexamination Control No. 95/000,463
Patent 6,542,673 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition for One-Month Extension of Time Under 37 C.F.R. 1.956," filed April 6, 2012 (present petition). In the present petition, patent owner requests that the Office extend the time period for filing an amendment and/or evidence and reopening prosecution by one month. The petition fee of $200 in accordance with 37 C.F.R. § 1.17(g) was charged to petitioner's credit card on April 9, 2012.

FINDINGS

1. On March 16, 2012, the Board of Patent Appeals and Interferences ("Board") entered a Decision on Appeal in this *inter partes* reexamination proceeding, including new grounds of rejection. Decision, 8-21.

2. The Decision on Appeal, citing 37 C.F.R. 41.77(b), notes that patent owner has one month from the date of the Decision to file a response requesting reopening of prosecution before the examiner.

3. In the petition, it is stated that patent owner is attending to filing a response requesting reopening of prosecution before the examiner, including either an amendment of the rejected claims or new evidence relating to the rejected claims. Petitioner indicates that patent owner has been working diligently since receiving the Decision on Appeal and that a one month extension of time will allow the patent owner the best opportunity to provide amendments and/or new evidence in a response requiring reopening of prosecution before the examiner; to coordinate and fully pursue any new evidence that may be provided by the experts; and to consider and determine acceptable amendments, if any, to further advance this case in view of the litigation involving the '673 patent. Petition, 2.

RELEVANT AUTHORITY

37 C.F.R. § 41.77(g) provides:

> 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.

37 C.F.R. § 1.956 provides:

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

ANALYSIS

Patent owner's petition has been considered fully. While the desire for filing an amendment and/or evidence is appreciated, petitioner has neither explained what steps have been taken so far, nor the circumstances that have prevented the completion of such amendment preparation and/or collection of evidence from taking place. Note that *inter partes* reexaminations are required to proceed with special dispatch pursuant to 35 U.S.C. § 314(c):

> 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.

Petitioner has not established that sufficient cause exists for extending the due date for patent owner to request reopening of prosecution in response to the new grounds of rejection yet.

Accordingly, the present petition is **denied**.

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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1180 Peachtree Street, NE
Atlanta, GA 30309-3521

Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,464	06/15/2009	6624761	2855.002REX2	8229

26111 7590 01/25/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date:
MAILED
JAN 25 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000464
PATENT NO. : 6624761
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED

JAN 25 2011

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1100 New York Ave, N.W.
Washington, D.C. 20005-3934

CENTRAL REEXAMINATION UNIT

In re Fallon :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/000,464 : **DISMISSING**
Filing Date: June 15, 2009 : **PETITIONS**
For: U.S. Patent No.: 6,624,761 :

This is a decision on the following petitions, filed concurrently on August 25, 2010:

- The patent owner petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (the patent owner petition to terminate); and

- The patent owner petition under 37 C.F.R. 1.183, entitled "Petition Under 37 C.F.R. 1.183 to Transfer Jurisdiction of *Inter Partes* Reexamination" (the patent owner petition to transfer jurisdiction).

The August 25, 2010 patent owner petitions to terminate and to transfer jurisdiction, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

The $400 fee under 37 CFR 1.17(f) for each petition has been paid.

SUMMARY

The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

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 August 25, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

The patent owner argues that termination of the '464 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). 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 argues that, pursuant to the statute, a final decision has been entered against the requester/co-defendant in a civil action. The patent owner has provided a copy of a stipulated order of dismissal by the United States District Court for the Eastern District of Texas, Tyler Division (district court) on January 26, 2010, between the patent owner/plaintiff, Realtime Data, Inc., and requester/co-defendant Blue Coat Systems, 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 *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010), the district court ordered "that said stipulation is in all things granted", and that the action [before the district court] "including the amended complaint, answers and counterclaims, be dismissed with prejudice, pursuant to the Settlement and License Agreement dated January 12, 2010 executed by the parties". The district court further ordered that that "this Court shall retain continuing jurisdiction over the parties and the subject matter to enforce the aforesaid Settlement and License Agreement", 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 January 26, 2010 district court judgment is deemed 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

The patent owner further argues that, pursuant to the statute, "[t]he Order of Dismissal was a final decision that Blue Coat did not sustain its burden of proving the invalidity of any patent claim" in suit. Citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1473 (Fed. Cir. 1989), the patent owner states that "[a] stipulated judgment in a District Court litigation 'operates as an adverse adjudication on the merits of a claim'". The patent owner points out that the requester, who had the burden of proving invalidity, "stipulated by agreement to dismiss its invalidity defenses and counterclaims with prejudice". Thus, argues the patent owner, "the Order of Dismissal establishes that the Requester did not sustain its burden of proving invalidity in the District Court litigation".

In *Hartley*, however, the issue of validity was actually litigated in an earlier suit, when a court ruled on summary judgment that the patent was invalid under 35 U.S.C. 102(b). The parties then settled and a stipulated judgment was entered dismissing the plaintiff's (Hartley's) infringement claim. The judgment did not address the invalidity ruling already entered by the court. Hartley

[1] See Exhibit E, *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010). Exhibit E is attached to the present petition.

later sued a different defendant, Mentor, on the same patent, who defended on issue preclusion grounds, i.e., that the patent was already held invalid in the earlier litigation. Hartley argued that issue preclusion did not apply because the earlier suit had been finally resolved via a stipulated judgment, i.e., that any preclusive effects of the earlier invalidity judgment were erased when the earlier suit settled with a stipulated judgment. The Federal Circuit disagreed. "Where rulings made after a full and fair opportunity to litigate are firm and consistent with the subsequent settlement agreement by the parties and judgment actually entered into the case, issue preclusion has been applied as to those issues when raised in a subsequent suit." *Hartley v. Mentor Corp.*, 869 F.2d at 1472. The court further noted that "a stipulated final judgment may rest in part on a court's rulings during the course of a trial," and such a judgment "like a contract, must be construed to determine its effect in light of all the circumstances." *Id.* The issue preclusion in *Hartley* was created by the actual litigation and *summary judgment* of invalidity, and not by the dismissal.

Unlike *Hartley*, however, the issue of invalidity was never actually litigated in the present case. The present case solely involves a 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). Finally, while the Federal Circuit in *Hartley* suggested that a stipulated judgment should be construed like a contract to determine its effect, the patent owner in the present case points to no language in the court's dismissal or in the related Settlement and License Agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue. In fact, the Settlement and License Agreement expressly states that "the issues in the Action are disputed".[2] Thus, 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 action was 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, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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).

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 the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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.

---

[2] See Exhibit D, "Settlement and License Agreement between Realtime Data, LLC D/B/A, IXO and Blue Coat Systems, Inc.", page 2. Exhibit D is attached to the present petition.

Accordingly, the August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

II. The August 25, 2010 Patent Owner Petition under 37 CFR 1.183 to Transfer Jurisdiction to OPLA

The patent owner requests that jurisdiction of the present reexamination proceeding be transferred from the Central Reexamination Unit (CRU) to the Office of Patent Legal Administration (OPLA) until a decision on the petition to terminate (also filed on August 25, 2010) has been decided. The present petition under 37 CFR 1.183 is taken as a petition under 37 CFR 1.182.[3]

In essence, the patent owner requests that OPLA take control of the present proceeding to prevent the CRU from taking any further action until OPLA decides the petition to terminate *inter partes* reexamination. This is essentially a request to delay the prosecution in this proceeding. Such a petition is contrary to the statutory mandate that *inter partes* reexamination proceedings be conducted with special dispatch in the Office (35 U.S.C. § 314(c)). Accordingly, the petition is dismissed. [4]

In addition to the above, the patent owner's request, i.e., that OPLA take jurisdiction until a decision on the petition to terminate has been issued, is moot because a decision on the petition to terminate has now been rendered.

For all of the foregoing reasons, the petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182 to transfer jurisdiction, is **dismissed**.

CONCLUSION

- The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

- The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

---

[3] A petition under 37 CFR 1.183 requires waiver of the rules, and requires a showing of extraordinary circumstances, such that justice requires waiver of the rule. The requested relief, however, has not been shown to require waiver of a rule in the present instance. Furthermore, the patent owner fails to request a waiver of an identified rule. Since transfer of jurisdiction is not specifically provided for in the rules, the present petition is taken under 37 CFR 1.182.

[4] To the extent the patent owner may be relying on MPEP § 2686.04(III) as a basis for submitting the instant petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding, this reliance is misplaced as that section is directed to the situation where such petition is accompanied by a petition to suspend a reexamination proceeding, which must be supported by a showing of "good cause", which did not occur here.

- 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.
95/000,465	05/05/2009	7128744	SYNT-0711	1725

53443 7590 03/31/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

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

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

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

Patent 7,128,744

Technology Center 3900

DECISION ON PETITION

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

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

FINDINGS

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

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

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

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

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

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

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

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

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

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

RELEVANT AUTHORITY

37 C.F.R. § 1.182 states:

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

ANALYSIS

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

The petition is **granted**.

DECISION

In view of the forgoing, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

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

Counsel for Third Party Requester
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,465	05/05/2009	7128744	SYNT-0711	1725

53443 7590 07/13/2011

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

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

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

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

Patent 7,128,744

Technology Center 3900

DECISION ON PETITION

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

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

FINDINGS

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

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

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

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

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

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

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

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

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

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

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

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

RELEVANT AUTHORITY

37 C.F.R. § 1.182 states:

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

ANALYSIS

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

The petition is **granted**.

DECISION

In view of the forgoing, the Petition is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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2929 Arch Street
Philadelphia, PA 19104-2891

Counsel for Third Party Requester
Hunton and Williams, LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,465	05/05/2009	7128744	SYNT-0711	1725

53443 7590 11/18/2011

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Smith & Nephew, Inc.

v.

Synthes (U.S.A.)

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

DECISION ON PETITION

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

FINDINGS

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

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

RELEVANT LEGAL AUTHORITY

37 C.F.R. § 41.5(a) provides that:

While the Board has jurisdiction:

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

ANALYSIS

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

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

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

Counsel for Third Party Requester:
Robert A. King
Hunton & Williams LLP
Intellectual Property Department
2200 Pennsylvania Avenue, NW
Washington, DC 20037

United States Patent and Trademark Office

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JAN 26 2011

CENTRAL REEXAMINATION UNIT

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Robert Greene Sterne, Esq. (For Patent Owner)
Sterne, Kessler, Goldstein & Fox P.L.L.C.
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Washington, D.C. 20005-3934

In re Fallon :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/000,466 : **DISMISSING**
Filing Date: July 7, 2009 : **PETITION**
For: U.S. Patent No.: 6,604,158 :

This is a decision on the following petition, filed on August 25, 2010:

- The patent owner petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (the patent owner petition to terminate); and

The August 25, 2010 patent owner petition to terminate, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

The $400 fee under 37 CFR 1.17(f) for the August 25, 2010 petition has been paid.

SUMMARY

The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

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 August 25, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

The patent owner argues that termination of the '464 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). 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 argues that, pursuant to the statute, a final decision has been entered against the requester/co-defendant in a civil action. The patent owner has provided a copy of a stipulated order of dismissal by the United States District Court for the Eastern District of Texas, Tyler Division (district court) on January 26, 2010, between the patent owner/plaintiff, Realtime Data,

Inc., and requester/co-defendant Blue Coat Systems, 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 *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010), the district court ordered "that said stipulation is in all things granted", and that the action [before the district court] "including the amended complaint, answers and counterclaims, be dismissed with prejudice, pursuant to the Settlement and License Agreement dated January 12, 2010 executed by the parties". The district court further ordered that that "this Court shall retain continuing jurisdiction over the parties and the subject matter to enforce the aforesaid Settlement and License Agreement", 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 January 26, 2010 district court judgment is deemed 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

The patent owner further argues that, pursuant to the statute, "[t]he Order of Dismissal was a final decision that Blue Coat did not sustain its burden of proving the invalidity of any patent claim" in suit. Citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1473 (Fed. Cir. 1989), the patent owner states that "[a] stipulated judgment in a District Court litigation 'operates as an adverse adjudication on the merits of a claim'". The patent owner points out that the requester, who had the burden of proving invalidity, "stipulated by agreement to dismiss its invalidity defenses and counterclaims with prejudice". Thus, argues the patent owner, "the Order of Dismissal establishes that the Requester did not sustain its burden of proving invalidity in the District Court litigation".

In *Hartley*, however, the issue of validity was actually litigated in an earlier suit, when a court ruled on summary judgment that the patent was invalid under 35 U.S.C. 102(b). The parties then settled and a stipulated judgment was entered dismissing the plaintiff's (Hartley's) infringement claim. The judgment did not address the invalidity ruling already entered by the court. Hartley later sued a different defendant, Mentor, on the same patent, who defended on issue preclusion grounds, i.e., that the patent was already held invalid in the earlier litigation. Hartley argued that issue preclusion did not apply because the earlier suit had been finally resolved via a stipulated judgment, i.e., that any preclusive effects of the earlier invalidity judgment were erased when the earlier suit settled with a stipulated judgment. The Federal Circuit disagreed. "Where rulings made after a full and fair opportunity to litigate are firm and consistent with the subsequent settlement agreement by the parties and judgment actually entered into the case, issue preclusion has been applied as to those issues when raised in a subsequent suit." *Hartley v. Mentor Corp.*, 869 F.2d at 1472. The court further noted that "a stipulated final judgment may rest in part on a court's rulings during the course of a trial," and such a judgment "like a contract, must be construed to determine its effect in light of all the circumstances." *Id.* The issue preclusion in

[1] See Exhibit E, Order of Dismissal, *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010). Exhibit E is attached to the present petition.

Hartley was created by the actual litigation and *summary judgment* of invalidity, and not by the dismissal.

Unlike *Hartley*, however, the issue of invalidity was never actually litigated in the present case. The present case solely involves a 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). Finally, while the Federal Circuit in *Hartley* suggested that a stipulated judgment should be construed like a contract to determine its effect, the patent owner in the present case points to no language in the court's dismissal or in the related Settlement and License Agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue. In fact, the Settlement and License Agreement expressly states that "the issues in the Action are disputed".[2] Thus, 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 action was 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, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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).

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 the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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 August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

CONCLUSION

- The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

[2] See Exhibit D, "Settlement and License Agreement between Realtime Data, LLC D/B/A, IXO and Blue Coat Systems, Inc.", page 2. Exhibit D is attached to the present petition.

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

53443 7590 03/22/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/22/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date:

MAILED

MAR 22 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468
PATENT NO. : 6623486
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
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Alexandria, VA 22313-1450
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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

MAILED

MAR 22 2011

CENTRAL REEXAMINATION UNIT

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W., SUITE 1200
WASHINGTON, D.C. 20006-1109

(For Third Party Requester)

In re Weaver et al.
Reexamination Proceeding
Control No. : 95/000,468
Filed: May 8, 2009
Patent No. 6,623,486

: **DECISION**
: **ON**
: **PATENT OWNER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

This is a decision addressing Patent Owner's petition, filed February 10, 2011, under 37 CFR 1.181 requesting that prosecution be reopened. Although the petition contains statements that an alternative relief sought is a granting of a request for continued reexamination under 37 CFR 1.182, the petition is being decided solely under 37 CFR 1.181. Likewise, the request for an extension of time combined with a petition under 37 CFR 1.181 and 1.182 is improper. In other words, the Patent Owner's combined petition under 37 CFR 1.181, 1.182, and 1.956 is deemed improper because it combines three distinct petitions, which is not compliant with 37 CFR 1.4. Patent Owner must file a separate petition if Patent Owner wants consideration of the issues under 37 CFR 1.182. The request for an extension of time is moot in view of the filing of a Notice of Appeal on February 22, 2011. 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 petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is DENIED.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,623,486 (the '486 patent) issued on September 23, 2003.

2. A request for reexamination, assigned Control No. 95/000,468 (the '468 proceeding), was filed by a third party Requester on May 8, 2009.

3. Reexamination was ordered in the '468 reexamination proceeding on June 19, 2009.

4. On July 10, 2009, a decision that merged the '468 proceeding with *ex parte* reexamination proceeding 90/009,378 was mailed by the Office.

5. An Office action on the merits was mailed on November 30, 2009 in the merged proceedings. The Office action contained rejections of patent claims 1-18.

6. On March 22, 2010[1], Patent Owner filed a response (108 pages) to the Office action by the examiner and a petition to waive the page limits of 37 CFR 1.943, which was granted on May 26, 2010. The response was supported by three declarations under 37 CFR 1.132.

7. On June 25, 2010[2], the Requester filed comments on the Patent Owner's response, which supported the rejections set forth in the first Office action. The comments included declarations by Dr. Lawrence Marsh and Michael Donoghue to rebut the commercial success evidence of the Patent Owner.

8. On August 24, 2010, the Office mailed an Action Closing Prosecution (ACP). The ACP continued to reject patent claims 1-18.

9. On October 22, 2010, Patent Owner filed a response to the ACP. The response included a declaration by Dr. Clifford Turen to support the response.

10. On November 22, 2010, the Requester filed comments, which included another declaration by Dr. Marsh ("the second Marsh declaration").

11. On January 21, 2011, the Office mailed a Right of Appeal Notice (RAN). The RAN entered the Patent Owner's October 22, 2010 response and the Requester's November 22, 2010 comments, and maintained the rejection of claims 1-18.

12. On February 10, 2011, the Patent Owner filed the instant petition under 37 CFR 1.181 and 1.182, which also included a request for an extension of time.

13. On February 22, 2011, the Patent Owner filed a Notice of Appeal.

---

[1] Extensions of time were granted.

[2] The decision of May 26, 2010 gave Requester thirty days to file comments.

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 prosecution be reopened. Petitioner specifically requests that the director find that the issuance of a RAN, which had the effect of not permitting Patent Owner to file a rebuttal to the second Marsh Declaration, was unfair and prematurely ended prosecution. See, e.g., pages 3-4 of the petition.

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) 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 an ACP and a RAN, and did not categorically deprive the petitioner of its statutory rights to present arguments and evidence in reexamination proceedings.

Specifically, upon review of the record, it is noted that the November 30, 2009 Office action adopted all 93 proposed rejections. The ACP maintained most of the rejections (Grounds 1, 2, 6, 8, 9, 11-85 and 87-92) that were applied in the first Office action. The RAN maintained the position set forth in the ACP. See the stated facts above. Therefore, the grounds of rejections are set forth in the November 30, 2009 Office action, and the RAN either maintained or withdrew the rejections. As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. In the petition, patent owner states that the examiner's reference to the second Marsh declaration on page 37 of the RAN should have required the examiner to reopen prosecution in order to permit the Patent Owner an opportunity to respond. See pages 3-4 of the petition. However, the record clearly shows that the examiner set forth the *exact* same rejections as in the non-final Office action of November 30, 2009. The basis for which petitioner requests reopening of prosecution is merely the examiner's response to commercial success evidence in the patent owner's response filed October 22, 2010. To reiterate, in the RAN, the examiner was addressing arguments and evidence of the Patent Owner by referring to the arguments and evidence filed in the Requester's comments of November 22, 2010, and did not modify or alter the grounds of rejection. Therefore, no new grounds of rejection were made, and Office policies and procedures do not require reopening of prosecution. See MPEP 2673.01. Furthermore, it is noted that prosecution was already closed prior to the submission of second Marsh declaration by the issuance of the ACP, which is an Action Closing Prosecution. Therefore, petitioner's arguments that the RAN is unfair because it closed prosecution are not persuasive because prosecution was already closed prior to the RAN.

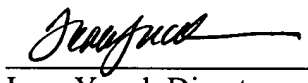
The record shows that the examiner appropriately followed the reexamination laws and procedures, e.g., as set forth in MPEP 2673 *et seq.*, in making the determination that the January 21, 2011 Office action should be designated as RAN in the interest of special dispatch. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to make the January 21, 2011 Office action a RAN.

In summary, the examiner appropriately followed the reexamination laws and procedures in deciding to issue the RAN in the interest of "special dispatch," in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided. Therefore, the Patent Owner's petition, as it relates to reopening prosecution of the instant reexamination proceeding because the examiner failed to follow the laws and procedures, is denied.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed February 10, 2011, is DENIED for the reasons discussed above.

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.
95/000,468	05/08/2009	6623486	SYNT-0712	2083

53443 7590 06/23/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW, SUITE 1200
WASHINGTON, DC 20006-1109

Date:

MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468
PATENT NO. : 6623486
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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JUN 23 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For *Inter Partes & Ex Parte* Requester)

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

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

DECISION ON PETITION

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

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

BACKGROUND

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

RELEVANT AUTORITY AND GUIDANCE

35 U.S.C. § 314 provides:

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

(b) RESPONSE.-

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

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

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

37 CFR 1.181(a) provides:

Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.951 provides:

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

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

37 CFR 1.953 provides:

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

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

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

MPEP 2673.01 provides (in pertinent part):

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

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

II. DISCRETIONARY REOPENING
In addition to the above situation which requires reopening of prosecution, the examiner should be liberal in reopening prosecution where the equities of the situation make such appropriate, because patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d), nor by filing a Request for Continued Examination under 37 CFR 1.114.

DECISION ON PETITION UNDER 37 CFR 1.181

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

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

For the Director to intervene, petitioner must show that the March 22, 2011 decision by the TC 1600 Director was made in clear error. A petition under 37 CFR § 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). A review of the record indicates that the TC 1600 Director had a reasonable basis to support her findings and conclusion. Therefore, petitioner has not provided a showing of clear error that would justify setting aside or otherwise disturbing the Technology Center Director's decision.

I. Discussion of Previous Petition and Decision

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

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

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

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

[4] Petition at page 12.

II. Findings and Analysis

A. The March 22, 2011 Decision

1. Mischaracterization of the March 22, 2011 Decision

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

2. MPEP 2673.01 Supports the March 22, 2011 Decision

MANDATORY REOPENING

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

DISCRETIONARY REOPENING

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

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

[5] Petition at page 10.

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

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

B. The January 21, 2011 RAN

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

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

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

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

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

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

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

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

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

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

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

C. Patent Owner's Procedural Due Process Rights

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

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

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

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

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

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

CONCLUSION

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

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

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

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

4. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759, or in his absence, to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.

Robert W. Bahr
Senior Patent Counsel
Acting Associate Commissioner
for Patent Examination Policy

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

53443 7590 06/24/2011

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, NW, SUITE 1200
WASHINGTON, DC 20006-1109

Date:

MAILED

JUN 24 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468
PATENT NO. : 6623486
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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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

(For Patent Owner)

MAILED

JUN 24 2011

CENTRAL REEXAMINATION UNIT

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

(For *Inter Partes & Ex Parte* Requester)

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

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

DECISION ON PETITION

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

The petition is before the Office of Patent Legal Administration.

The patent owner petition is DISMISSED.

DECISION

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

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

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

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

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

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

CONCLUSION

1. The patent owner petition is DISMISSED.

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

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

/Kenneth M. Schor/

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

6-24-11

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

53443 7590 06/29/2011

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2011

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WASHINGTON, DC 20006-1109

Date:
MAILED
JUN 29 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000468
PATENT NO. : 6623486
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

WOODCOCK WASHBURN LLP
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PHILADELPHIA PA 19104-2891

(For Patent Owner)

ROBERT A. KING
HUNTON & WILLIAMS LLP
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WASHINGTON, DC 20006-1109

(For *Inter Partes & Ex Parte* Requester)

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

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

DECISION ON PETITION

This is a decision on the renewed patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.183 REQUESTING WAIVER OF THE PROHIBITION OF AN EXTENSION OF TIME FOR FILING AN APPEAL BRIEF," filed on June 27, 2011.

The petition is before the Office of Patent Legal Administration.

The patent owner petition is granted to the extent that the due date for filing both the patent owner's and third party requester's briefs is July 21, 2011.

DECISION

Patent owner filed the present renewed petition under § 1.183 for an extension of time on June 27, 2011, subsequent to the Office's June 23, 2011 decision denying patent owner's March 28, 2011 § 1.181 petition, and June 24, 2011 decision dismissing patent owner's June 21, 2011 petition for a third extension of time. Both Office decisions reaffirmed the time to file appellant's briefs as July 7, 2011.

On February 22, 2011, patent owner filed a notice of appeal. On March 7, 2011, third party requester filed a notice of cross appeal. On April 14, 2011, and June 3, 2011, respectively, the Office granted, in response to patent owner petitions, two 30 day extensions of time, giving both the parties until July 7, 2011, to file their appellant's briefs.

Under the present facts and circumstances, 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 14 days from the currently set due date of July 7, 2011; *i.e.*, July 21, 2011. 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 14 days from the currently set due date of July 7, 2011; *i.e.*, July 21, 2011.

CONCLUSION

1. The patent owner petition is granted to the extent that the time period to submit both parties' appellant's briefs is extended to run 14 days from the currently set due date of July 7, 2011.

2. The due date for filing both the patent owner's and third party requester's briefs is July 21, 2011.

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

/Kenneth M. Schor/

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

6-28-11

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

53443 7590 08/18/2011

WOODCOCK WASHBURN LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes

Smith & Nephew, Inc.

v.

Synthes (U.S.A.).

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

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

Patent 6,623,486

Technology Center 3900

DECISION ON PETITION

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

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

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

FINDINGS

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

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

DISCUSSION

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

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

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

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

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

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

37 CFR § 1.943(c) provides:

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

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

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

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

ANALYSIS

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

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

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

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

DECISION

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

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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Cira Centre, 12th Floor
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Counsel for Third Party Requester
Hunton and Williams, LLP
Intellectual Property Department
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,378	01/08/2009	6623486	SYNT-0703	5757

53443 7590 09/29/2011

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

53443 7590 09/30/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

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

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

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

Patent 6,623,486

Technology Center 3900

DECISION ON PETITION

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

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

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

FINDINGS

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

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

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

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

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

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

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

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

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

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

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

RELEVANT AUTHORITY

37 C.F.R. § 1.182 states:

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

ANALYSIS

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

The petition is **dismissed as moot**.

DECISION

In view of the forgoing, the Petition is DISMISSED.

James Donald Smith
Chief Administrative Patent Judge

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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.
95/000,469	09/03/2009	7389243	535412800100	6472

23694 7590 09/22/2010

Law Office of J. Nicholas Gross, Prof. Corp.
PO BOX 9489
BERKELEY, CA 94709

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/22/2010

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Date: MAILED
SEP 22 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000469
PATENT NO. : 7389243
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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LAW OFFICE OF J. NICHOLAS GROSS, PROF. CORP.
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BERKELEY, CA 94704

(For Patent Owner)

MAILED

SEP 2 2 2010

CENTRAL REEXAMINATION UNIT

ROBERT A. SALTZBERG
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425 MARKET STREET
SAN FRANCISCO, CA 94105

(For Third Party Requester)

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,469 : **GRANTING**
Filed: September 3, 2009 : **PETITION**
For: U.S. Patent No. 7,389,243 :

This is a decision on requester's petition under 37 CFR 1.183 to waive the page limit requirement pursuant to 37 C.F.R. 1.943(b), filed on August 16, 2010 (the August 16, 2010 requester petition).

The August 16, 2010 requester petition is before the Office of Patent Legal Administration for consideration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was received.

The August 16, 2010 requester petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

BACKGROUND

- On June 17, 2008, United States Patent No. 7,389,243 (the '243 patent) issued to Gross.
- On September 3, 2009, a request for *inter partes* reexamination of the '243 patent was filed by a third party requester. The request was assigned reexamination control no. 95/000,469 (the '469 proceeding).
- On December 1, 2009, *inter partes* reexamination was ordered in the '469 proceeding.

- On February 3, 2010, a non-final Office action was mailed in the '469 proceeding.

- On April, 1, 2010, the patent owner filed a paper responsive to the February 3, 2010 non-final Office action, including a declaration under 37 CFR 1.132 of J. Nicholas Gross.

- On April 6, 2010, the patent owner filed a paper responsive to the February 3, 2010 non-final Office action.

- On April 28, 2010, the Office mailed a Notice Re Defective Paper in Inter Partes Reexamination, which determined that the April 1 and April 6, 2010 patent owner responses exceeded the page limit provisions of 37 CFR 1.943, and that the amendment accompanying the April 1 and April 6 patent owner responses failed to comply with 37 CFR 1.530(e).

- On May 13, 2010, the patent owner filed a replacement response submission, including a declaration under 37 CFR 1.132 of J. Nicholas Gross, in response to the April 28, 2010 notice.

- Also on May 13, 2010, the patent owner filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) (the May 13, 2010 patent owner petition).

- On July 16, 2010, the Office mailed a decision granting the May 13, 2010 patent owner petition, and *sua sponte* waiving the page limit requirement for any comments filed by requester in response to the May 13, 2010 patent owner response, to the extent that the requester comments not exceed 93 pages in length.

- On August 16, 2010, the requester filed comments in response to the patent owner's May 13, 2010 replacement response submission.

- Also on August 16, 2010, the requester filed the present petition under 37 CFR 1.183 to further waive the page limit requirement of requester's August 16, 2010 comments.

DECISION

Requester's August 16, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response 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 response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, requester requests that the page limit for requester's August 16, 2010 comments be waived to the extent needed to accommodate the number of pages of requester's concurrently-submitted response. In support of the waiver of 37 CFR 1.943(b), the requester argues that patent owner's addition of 98 new claims necessitated new proposed rejections based on each of the 14 issues included in the original request. The requester argues that its comments needed to address not only patent owner's addition of 98 new claims, but also the non-adoption in the Office action of multiple grounds of rejection presented in the request. The Office notes that at least nine grounds of rejection were not adopted by the examiner in the Office action. Finally, the requester argues that its comments needed to also address patent owner's arguments rebutting the rejections applied by the examiner in the Office action.

Further in support of its request for waiver of 37 CFR 1.943(b), the requester has submitted, on August 16, 2010, a comments submission that is in excess of 50 pages. The requester asserts that it has made an effort to minimize the length of the comments and supporting evidence.

Based on the individual facts and circumstances of this case including, for example, the addition of 98 new claims by the patent owner, and the need to address the examiner's non-adoption of at least nine grounds of rejection proposed in the request in addition to patent owner's 93 pages of arguments, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The number of pages of the August 16, 2010 requester comments submission that count toward the page limit is approximately 355 pages, including a 17-page declaration under 37 CFR 1.132 of Dorion Carroll,[1] a 27-page court document entitled "Claim Construction Order and Order Granting Defendents' Motions for Summary Judgment", and a 311-page document entitled "Third-Party Requester Comments after Patent Owner Response Pursuant to 37 C.F.R. § 1.947", all of which contain legal argument, which causes these documents to be subject to the page limit requirement of 37 CFR 1.943(b).

Thus, even though requester's August 16, 2010 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that requester's August 16, 2010 comments not exceed 355 pages. Accordingly, requester's 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 requester's August 16, 2010 comments submission to exceed

[1] In determining whether an affidavit or declaration under 37 CFR 1.132 is subject to the 50-page length requirement under 37 CFR 1.943(b), the Office analyzes whether the affidavit or declaration is providing factual evidence, i.e., evidence of *technological* facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes 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. Where the affidavit or declaration includes arguments containing legal argument, including legal analysis and legal conclusions, such as arguments that the claims are patentable or unpatentable, or are directed to how an outstanding or proposed rejection is overcome, or, in the case of a declaration filed by the requester, how an outstanding or proposed rejection is supported, the affidavit or declaration is subject to the 50-page length requirement.

the page limit by up to 305 pages. This waiver makes requester's August 16, 2010 comments submission page-length compliant.

CONCLUSION

- Requester's August 16, 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 requester's August 16, 2010 comments submission to exceed the page limit by up to 305 pages. This waiver makes requester's August 16, 2010 comments submission page-length compliant.

- Jurisdiction for the '469 reexamination proceeding is returned to the Central Reexamination Unit (CRU).

- Any questions 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,469	09/03/2009	7389243	535412800100	6472

23694 7590 08/31/2011

Law Office of J. Nicholas Gross, Prof. Corp.
PO BOX 9489
BERKELEY, CA 94709

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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425 MARKET STREET
SAN FRANCISCO, CA 94105-2482

Date: MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000469
PATENT NO. : 7389243
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)

Robert A. Saltzberg
MORRISON & FOERSTER LLP
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(For *Inter Partes* Requester)

In re John N. Gross
Inter partes Reexamination Proceeding
Control No. 95/000,469
Filed: September 3, 2009
For: U.S. Patent No. 7,389,243

: **DECISION DISMISSING**
: **PETITIONS AND**
: **RETURNING**
: **UNAUTHORIZED PAPERS**

This is a decision on (1) Patent Owner's petition, filed on October 25, 2010, requesting the Director expunge portions of the Requester's comments submitted on August 16, 2010 for failure to comply with reexamination regulations; and (2) Requester's opposition petition ("the first opposition"), filed on November 8, 2010, which requests that the Director dismiss Patent Owner's petition filed on October 25, 2010. The petition and first opposition are being treated as petitions under 37 CFR 1.181.

This decision is also addressing Patent Owner's petition filed on November 12, 2010 ("the second opposition") and Requester's petition filed on November 23, 2010 ("the third opposition").

The petition and oppositions are before the Director of the Central Reexamination Unit for decision.

The Patent Owner's petition, filed on October 25, 2010, and the Requester's first opposition, filed on November 8, 2010, are dismissed as premature.

The second opposition, filed on November 12, 2010, and the third opposition, filed on November 23, 2010, are hereby returned as unauthorized papers for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,389,243 B2 (the '243 patent) issued on June 17, 2008.

2. A completed request for reexamination of the '243 patent was filed on September 3, 2009. The request was assigned control No. 95/000,469 (the '469 reexamination proceeding).

3. On December 1, 2009, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-30 of '243 patent.

4. On February 3, 2010, the Office mailed an Office action, confirming claims 2, 4, 7, 11, 14, 16, 18, 24 and 27-30, and rejecting claims 1, 3, 5-6, 8-10, 12-13, 15, 17, 19-23 and 25-26.

5. On April 1, 2010, Patent Owner filed a paper responsive to the February 3, 2010 non-final Office action, including a declaration under 37 CFR 1.132 by J. Nicholas Gross.

6. On April 6, 2010, Patent Owner filed a revised amendments and response to the Office action to provide corrections to the April 1, 2010 response.

7. On April 28, 2010, the Office mailed a Notice Re Defective Paper in Inter Partes Reexamination, which determined that the April 1 and April 6, 2010 patent owner responses exceeded the page limit provisions of 37 CFR 1.943, and that the amendment accompanying the April 1 and April 6 patent owner responses failed to comply with requirements of 37 CFR 1.530(e).

8. On May 13, 2010, the patent owner filed a replacement response submission, including a declaration under 37 C.F.R. 1.132 of J. Nicholas Gross, in response to the April 28, 2010 notice. Concurrently, patent owner filed a petition under 37 CFR 1.183 to waive the page length provisions of 37 CFR 1.943(b).

9. On July 16, 2010, the Office mailed a decision granting Patent Owner's May 13, 2010 petition under 37 CFR 1.183. The decision set a time period of 30 days for the Requester to file comments on the Patent Owner's response and the February 3, 2010 Office action.

10. On August 16, 2010, Requester filed comments. Concurrently, the Requester filed a petition under 37 CFR 1.183 to waive the page length provisions of 37 CFR 1.943(b).

11. On September 22, 2010, the Office mailed a decision granting Requester's August 16, 2010 petition under 37 CFR 1.183.

12. On October 25, 2010, Patent Owner filed the instant petition entitled "PETITION TO STRIKE PORTIONS OF REQUESTER REPLY."

13. On November 8, 2010, Requester filed the instant first opposition entitled "OPPOSITION

PETITION TO PATENT OWNER'S PETITION TO STRIKE PORTIONS OF REQUESTER'S REPLY."

14. On November 12, 2010, Patent Owner filed the instant second opposition entitled "PETITION TO STRIKE REQUESTER OPPOSITION."

15. On November 23, 2010, Requester filed the instant third opposition entitled "OPPOSITION PETITION TO PATENT OWNER'S PETITION TO STRIKE REQUESTER OPPOSITION."

DECISION

October 25, 2010 Petition and November 8, 2010 Opposition

As pointed out, the Patent Owner filed an October 25, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the August 16, 2010 comments. On November 8, 2010, Requester filed an opposition to Patent Owner's October 25, 2010 petition. However, there has been no decision by the examiner if the Requester's August 16, 2010 comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the August 16, 2010 comments because the examiner has not made his or her decision. Thus, the Patent Owner's October 25, 2010 petition and third party Requester's November 8, 2010 opposition are premature, and they are dismissed.

November 12, 2010 Second Opposition and November 23, 2010 Third Opposition

Patent Owner's petition, filed on November 12, 2010, is a second opposition petition on the same issue as to whether Requester's August 16, 2010 comments comply with reexamination laws and policies. Similarly, Requester's petition, filed November 23, 2010, is a third opposition on the same issue. The filing of additional rounds of petitions on the same issue is not permitted. See MPEP 2667, subsection II.B.4., which states, in relevant part, that "... after an opposition to any patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not), any further paper in opposition/rebuttal/response to the third party opposition paper will not be considered and will be returned." Therefore, second opposition petition, and third opposition petition are unauthorized papers that do not have a right of entry. See MPEP 2609.

In view of the above, the second opposition, filed on November 12, 2010, and the third opposition, filed on November 23, 2010, will not be made of record in the '469 reexamination proceeding, and the papers are being returned to the parties *without consideration of the substance of the petition.* 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 paper nonpublic to expunge it

from the record. The present decision will, however, be made of record in the reexamination proceeding. See also MPEP 2667.

CONCLUSION

1. The Patent Owner's petition, filed October 25, 2010, is **dismissed as premature**.

2. The Requester's first opposition petition, filed November 8, 2010, is **dismissed as premature**.

3. Patent Owner's second opposition petition, filed November 12, 2010, is **returned** as not having a right of entry into the proceeding record. No copy of the petition papers, including any supporting documents, will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.

4. Requester's third opposition petition, filed November 23, 2010, is **returned** as not having a right of entry into the proceeding record. No copy of the petition papers, including any supporting documents, will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.

5. Telephone inquiries related to this decision should be directed Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470 90/010,540	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 09/02/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2010

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HOUSTON, TX 77002

Date:
MAILED

SEP 02 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470; 90/010,540
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED

SEP 02 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

DECISION
ON
PETITION

This is a decision on patent owner's May 13, 2010 petition entitled "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS." The third party requester, on June 14, 2010, filed an opposition to patent owner's May 13, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on May 13, 2010, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent owner's May 13, 2010 petition is dismissed.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of

the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

---

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

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

14. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".

15. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.

16. On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '470 *inter partes* reexamination proceeding.

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10540 *ex parte* reexamination proceeding.

19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

DECISION

As pointed out, on July 13, 2010, requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '470 and '10540 reexamination proceedings. Until the reconsideration of the June 22, 2010 decision is concluded, patent owner's May 13, 2010 petition to strike third party comments from previously merged proceedings is premature, and will only be necessary if the Office reverses its current position. The status of all papers made of record during the period when the proceedings were merged is subject to requester's merger challenge, until the petition for reconsideration of the issue of merger is decided. Should the merger be reinstated, then patent owner may renew the present petition, but under 37 CFR 1.181, as a petition challenging entry of the papers.

CONCLUSION

1. Patent owner's May 13, 2010 petition is dismissed.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 10/28/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED

OCT 28 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED

OCT 28 2010

CENTRAL REEXAMINATION UNIT

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

(For Patent Owner)

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

(For Third Party Requester)

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

: DECISION
: ON
: PETITION

This is a decision on third party requester's September 20, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION TO HALT PUBLICATION OF REEXAMINATION CERTIFICATE".

The fee set forth in 37 CFR 1.17(f) for the petition is $400, which was charged to requester's credit card on September 20, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

The petition is **dismissed**.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired after September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January

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

19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

14. On March 17, 2010, patent owner timely filed a response to the December 17, 2009 Office action.[2]

15. On April 16, 2010, third party requester timely filed responsive comments.

16. On June 22, 2010, the Office issued a decision dissolving the merger of the '470 and the '10540 proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '470 proceeding

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10540 proceeding.

19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 decision.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '470 proceeding.

21. On September 20, 2010, third party requester filed the present petition in the '470 proceeding requesting that publication of the '10540 proceeding's *ex parte* reexamination certificate be halted.

22. Also on September 20, 2010, third party requester concurrently filed a petition in the '10540 proceeding requesting that publication of the '10540 proceeding's *ex parte* reexamination certificate be halted.

23. Concurrently on September 20, 2010, third party requester filed a notice of appeal in the '470 proceeding.

24. On October 12, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7805th) for US Patent No. 6,564,281 C1.

25. On October 13, 2010, the Office issued a decision on the September 20, 2010 requester petition filed in the '10540 proceeding stating that it was an improper paper and had been returned/destroyed.

---

[2] On January 21, 2010, the Office granted patent owner a one month extension of time.

DECISION

Third party requester is petitioning in the present '470 proceeding that publication of the reexamination certificate in the in the '10540 proceeding be halted. The requested relief cannot be granted, as the '10540 reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7805th), US 6,564,281 C1. Upon issuance of the certificate, the Office was divested of jurisdiction over the '281 patent as to the relevant issues raised in the '10540 proceeding. Even if the petition had been addressed prior to issuance of the certificate, the requested relief could not be granted. Third party requester is petitioning in the present '470 proceeding for relief to be provided in a different proceeding - the '10540 proceeding. Accordingly, the petition is dismissed.

CONCLUSION

1. The petition is **dismissed**.

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

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

10-26-10
Kimpropa/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 01/06/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,540	05/14/2009	6564281	9278.002.RX0000	5404

86497 7590 01/06/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
JAN 0 6 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010540
PATENT NO. : 6564281
ART UNIT : 3992

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

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

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Date: MAILED

JAN 0 6 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Third Party Requester)

MAILED

JAN 06 2011

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,540
Filed: May 14, 2009
For: U.S. Patent No. 6,564,281

DECISION
ON
PETITION

This is a decision on third party requester's July 13, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is $400, which was charged to requester's credit card on July 14, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

SUMMARY

The petition is **dismissed**.

The Office *Sua Sponte* directs the examiner to reestablish the record with regard to the Rosen reference in accordance with this decision.

As discussed below, the requester was not precluded from filing another *inter partes*

reexamination request on the same day requester filed the '470 *inter partes* reexamination request (or even shortly thereafter). Further, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either a single *inter partes* request with all issues, or a second *inter partes* request raising the issues presented in the *ex parte* request, concurrently or before the '470 *inter partes* request was ordered. In short, requester has made the conscious choice to present the issues in the *ex parte* reexamination request in a manner that does not provide requester *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, so now has no basis to complain that *inter partes* rights are not being afforded.

The June 22, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as of the order date of the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

Finally, in order to address a point made in the third party requester petition, the present decision instructs the examiner of record to recreate the record by incorporating the appropriate issues from the previously vacated Office action of December 17, 2009 and mail an appropriate Office action presenting all issues of patentability, to include the issues of patentability regarding the Rosen reference. This recreation of the record is for the purpose of preserving all party appeal rights, to thereby address the requester petition.

REVIEW OF FACTS

1. On May 13, 2003, the Office issued U.S. Patent No. 6,564,281 (the '281 patent) to Farmwald *et al.*

2. On May 14, 2009, a request for *ex parte* reexamination of all the claims (claims 1-46) of the '281 patent was filed by a third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,540 (the '10540 proceeding).

3. Also on May 14, 2009, a request for *inter partes* reexamination of all the claims (claims 1-46) of the '281 patent was filed by the same requester (NVIDIA Corporation). This request was assigned Control No. 95/000,470 (the '470 proceeding).

4. The '281 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-46 against the requester in the litigation.

5. On July 6, 2009, the Office issued an order granting the '10540 request for *ex parte* reexamination and setting a two month time period for the filing of a Patent Owner's Statement. The order stated that all the claims of the '281 patent, i.e., claims 1-46, would be subject to reexamination.

6. Also on July 6, 2009, the Office issued an order granting the '470 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '281 patent, i.e., claims 1-46, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10540 *ex parte* reexamination proceeding expired September 6, 2009.[1]

8. On September 24, 2009, the Office, *sua sponte,* issued a decision merging the '470 *inter partes* reexamination proceeding with the '10540 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 24, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that would prevent consideration of the petition.

10. On December 16, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

11. On December 17, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 24, 2009 decision to merge the '470 *inter partes* and '10540 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision.

---

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

14. On March 17, 2010, patent owner timely filed a response to the December 17, 2009 Office action.[2]

15. On April 16, 2010, third party requester timely filed comments after the response.

16. On June 22, 2010, the Office issued a decision dissolving the merger of the '470 and the '10540 proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '470 proceeding confirming all the claims in light of the prior art of record to include a US patent to Rosen ("the Rosen reference").

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10540 proceeding, neither citing nor discussing the Rosen reference.

19. On July 13, 2010, third party requester filed the present petition, requesting reconsideration of the June 22, 2010 decision.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '470 proceeding.

21. On September 20, 2010, third party requester filed a notice of appeal in the '470 proceeding.

22. On October 12, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7805th) for US Patent No. 6,564,281 C1 the '10540 proceeding. The certificate stated that the '470 proceeding was still pending with respect to the '281 patent.

DECISION

I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 22, 2010 decision is: (1) Arbitrary, Capricious and an Abuse of Discretion; (2) A violation of Third Party Requester's Appeal Rights; (3) Impermissible Substantive Rule Making; (4) Contrary to Public and Office policy; and (5) Contrary to Special Dispatch.

Third party requester requests the relief of vacatur of the June 22, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding.

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[2] On January 21, 2010, the Office granted patent owner a one month extension of time.

If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

II. Discussion of Previous Petitions and Decisions

a. The October 13, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision on December 16, 2009, dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's concurrently filed requests for reexamination were filed with an "intent to harass" and that the finding of a substantial new question of patentability in each request precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives for handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

b. The January 19, 2010 Patent Owner Petition, January 29, 2010 Requester Opposition, and June 22, 2010 Office Decision

On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 19, 2010 petition: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination

proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision. The requester argued (1) Merger of the reexamination proceedings was proper and in accordance with statute and policy; (2) An *ex parte* requester that is also an *inter partes* requester in a merged proceeding is subject to the estoppel provisions of 35 U.S.C. 315(c) as to the *ex parte* issues; (3) Waiver of 37 CFR 1.989(b) should not be granted as no interview right exists; and (4) No intent to harass exists.

On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

III. Findings and Analysis

a. The June 22, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester, citing Office's Federal Register rulemaking commentary,[3] argues that the June 22, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

The June 22, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy commentary is based upon.[4] The present circumstance involves the same third party requester concurrently filing, on the same day, both an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding on the same patent. The cited comment by requester in the July 13, 2010 petition addressed a circumstance where an *inter partes*

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

reexamination proceeding was already ordered and under active examination and a requester had discovered relevant information that could not be admitted via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. As pointed out, both reexamination requests under consideration *were filed on the same day*. Under such circumstances, the requester was not precluded from filing another *inter partes* reexamination request on the same day requester filed the '470 *inter partes* reexamination request (or even shortly thereafter). More significantly, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either: (1) A single *inter partes* request with all issues; or (2) A second *inter partes* request raising the issues presented in the *ex parte* request. Requester could have either concurrently filed two *inter partes* requests or filed the second request before the '470 *inter partes* request was ordered. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of two different types of proceedings as a vehicle to obtain *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),[5] 37 CFR 1.989(a),[6] MPEP 2686.01 I,[7] MPEP 2686.01 IV,[8] MPEP 2283,[9] and MPEP 2286.[10] See also "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

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[5] "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will **usually** be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

[6] "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[7] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[8] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[9] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[10] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

In summary, requester made the conscious choice to present the issues in the *ex parte* reexamination request, which does not provide a requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights beyond what an *ex parte* request would accord, and therefore now has no basis to complain.

Requester's citation to *inter partes* reexamination proceeding 95/000,050 (the '50 proceeding) in support of requester's position, fails to acknowledge the significant differences between the '50 proceeding and the present proceeding. In the '50 proceeding, the request for *inter partes* reexamination antedated the filing of the 90/007,885 *ex parte* request (the '7885 proceeding) by over a year. Thus the circumstances of the '50 proceeding in terms of date order, unlike the circumstances of the present proceeding, were in accord with Office policy and procedure commented upon with regard to 37 CFR 1.948. Furthermore, the '7885 proceeding was filed by the patent owner and not by the same third party requester (as in the present instance). Significant prosecution had taken place in the '50 proceeding and unlike a third party requester, a patent owner in an *inter partes* proceeding, was not bound by 37 CFR 1.948 in order to submit relevant prior art into the *inter partes* proceeding. The facts and circumstances of the '50 proceeding differ significantly from the facts and circumstances of the present proceeding. Therefore the '50 proceeding cannot serve as a basis to establish that the Office has acted in an arbitrary and capricious manner. If anything, the contrast of the present proceedings with the cited '50 proceeding illustrates how unforeseeable, disparate sets of circumstances can arise with regard to merger, thus bolstering the soundness of the policy of giving the Office sole discretion to merge, not-merge or demerge on a case-by-case basis.

b. The June 22, 2010 Office decision is not a violation of Requester's Appeal Rights

The requester asserts that the June 22, 2010 dissolution decision somehow alters requester's substantive appeal rights.

The dissolution decision does not alter the requester's appeal rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's appeal rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. Even after merger, the third party requester had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. As pointed out in MPEP 2674, "[a] notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested." Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN

that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi): "No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection."

In any event, if third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have filed a second *inter partes* request raising the issues presented, instead of filing an *ex parte* request. In this instance, the filing of a second *inter partes* request was clearly permissible under the statute. The *ex parte* proceeding request was filed prior to the issue of an order for reexamination in the *inter partes* reexamination; thus, a second *inter partes* request could have been filed instead of the *ex parte* request, and it should have been filed if requester desired *inter partes* reexamination treatment for the proposed rejections. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation.

CORRECTION OF THE PRESENT RECORD:

Requester has actually identified the problem of accounting for issues of patentability raised by the Office when the proceedings were merged, which were not based upon the submitted requests, *e.g.* the Rosen reference based issues of patentability. As a preliminary matter, the Office possesses statutory authority to add a reference in reexamination. Pursuant to 35 U.S.C. § 314(a), " [e]xcept as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." 35 U.S.C. § 305 provides analogous language. Under 35 U.S.C. § 132, the Office is entitled to introduce any art it deems relevant. Also, the Office possesses statutory authority, pursuant to 35 U.S.C. § 312, to consider information outside a request for reexamination.[11] The Rosen based issues of patentability were proposed by the examiner based upon the Office's statutory authority, and they must be accounted for to ensure that the record is clear with regard to the Rosen reference. In the December 17, 2009 Office action of the merged proceeding, the examiner exercised the Office's statutory authority, and in addition to considering the patentability issues raised in the requests, the examiner issued rejections based upon US 5,235,543 issued to Rosen. After the June 22, 2010 merger dissolution decision, the examiner issued a NIRC in the '10540 *ex parte* reexamination proceeding confirming all the claims and issued an ACP in the '470 *inter partes* reexamination proceeding, also confirming all the claims. In the '10540 *ex parte* proceeding's NIRC confirmation of the claims the examiner

[11] ". . .[T]he Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, **with or without consideration of other patents or printed publications.** The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." 35 U.S.C. § 312, emphasis added.

was silent with regard to the Rosen reference. In the '470 *inter partes* proceeding's ACP confirmation of the claims, the examiner discussed how the Rosen reference did not obviate patentability of the claims, and thus inadvertently omitted a patentability rejection that was raised by the Office action vacated in the June 22, 2010 merger dissolution decision. This took away the rights of the requester as to the use of the Rosen reference (the confirmation of the claims in the ACP of the *inter partes* proceeding does not constitute a rejection that the requester could appeal). Accordingly, the examiner of record is directed to recreate the record in the '470 proceeding and issue an appropriate Office action presenting all issues of patentability appropriate to this proceeding, to including the issues of patentability regarding the Rosen reference, to recreate the record and preserve all party participation rights.

c. The June 22, 2010 Office decision is not Substantive Rule Making

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. *Requester's counsel has explicitly recognized the Office's authority and discretion extending to demerge in accordance with special dispatch in previous proceedings.*[12] Additionally, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the administrative act of a consolidation of cases does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before the issuance of the merger and dissolution of the merger decisions.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would

[12] See e.g. Petition to Demerge 95/000283 and 90/008,170 filed August 16, 2008.

also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.[13]

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

d. The June 22, 2010 Office decision is not Contrary to Special Dispatch

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. The '10540 proceeding has advanced to issuance of a reexamination certificate and the '470 proceeding has advanced to the appeal stage. Issuance of a new ACP in the '470 proceeding, recreating the record therefore better serves special dispatch. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 22, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As the '470 proceeding has advanced to the appeal stage and a reexamination certificate has issued in the '10540 proceeding, special dispatch would not be served by remerging the proceedings and re-opening prosecution back to the point in prosecution just prior to the initial merger of the proceedings.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In

[13] It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Regarding previous Office decisions, to include the '50 *inter partes* reexamination proceeding cited by requester, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.[14] Furthermore, as noted in section III a. of this decision, the facts and circumstances of the '50 proceeding significantly differ from the facts and circumstances of the present proceeding. In the present instance, as noted in the June 22, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

e. The June 22, 2010 Office decision is not Contrary to Public and Office policy

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Policy considerations that requester asserts dictate that merger must occur when multiple, co-pending proceedings on the same patent exist.

In response, the June 22, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 22, 2010 dissolution decision is in accord with and not contrary to public policy, as the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings on the same day for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Requester asked for separate proceedings for separate issues of patentability on the same patent. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given

[14] See MPEP 2686.01 IV.

instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The June 22, 2010 dissolution decision, the MPEP, and Office practice and procedure provides a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.[15] As of October 12, 2010 a certificate has issued in the '10540 proceeding containing an appropriate notice regarding the existence of an outstanding reexamination proceeding.[16] The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 22, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.[17] As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the June 22, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to recreate the record by issuing an appropriate Office action presenting all issues of patentability appropriate for the '470 proceeding, including the issues of patentability regarding the Rosen reference rejection. The record is being recreated to preserve all party participation rights, to thereby address the requester petition.

CONCLUSION

1. The petition is **dismissed**.

---

[15] See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g. Ex Parte* Reexamination Certificate (7412th) No. 6188988 C1, right column notice under the abstract.
[16] *Ex Parte* Reexamination Certificate (7805th) No. 6564281 C1, right column notice under the abstract.
[17] See Petition at page 9, section C.

2. The examiner of record is directed to recreate the record by issuing an appropriate Office action in the '470 proceeding presenting all issues of patentability, which is to include the issues of patentability regarding the Rosen reference.

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

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

1-5-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 02/25/2011

Paul M. Anderson, PLLC
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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

RAMBUS, INC.
Patent Owner
v.
NVIDIA CORPORATION
Third Party Requester – *Inter partes* Reexamination Control No. 95/000,470

Inter partes Reexamination Control 95/000,470

Patent 6,564,281

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition to Expunge Portions of Third Party Requester's Appeal Brief" of November 30, 2010 ("Petition #1"). In Petition #1, Patent Owner requests "that the Office expunge portions of Third Party Requester's Appeal Brief Pursuant to 37 C.F.R. 41. 67" from the record because those portions purport to appeal issues that NVIDIA did not propose in its' *inter partes* reexamination request, including those concerning a primary reference that NVIDIA raised exclusively in an *ex parte* reexamination request. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account.

This is also a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed December 22, 2010 ("Petition #2"). In Petition #2, 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 . . . and accept its respondent appeal brief, which is 28 pages and 16,213 words in length." The petition fee was paid by check on December 22, 2010, along with the respondent brief fee.

FINDINGS

1. Patent 6,564,281 issued on May 13, 2003 with 46 claims. The '281 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. On May 14, 2009, third party requester NVIDIA, filed a request for *inter partes* reexamination of U.S. Patent No. 6,564,281, which was assigned control no. 95/000,470; and third party requester NVIDIA also filed a request for *ex parte* reexamination of U.S. Patent No. 6,564,281, which was assigned control no. 90/010,540.

3. On July 6, 2009, reexamination was ordered in the *inter partes* reexamination proceeding 95/000,470, and also in the *ex parte* reexamination proceeding 90/010,540.

4. A decision merging *inter partes* reexamination proceeding 95/000,470 and *ex parte* reexamination proceeding 90/010,540 was mailed on September 24, 2009.

5. On December 17, 2009, a non-final Office action was mailed in the merged reexamination proceeding.

6. Patent owner filed a response to the Office action on March 17, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on April 16, 2010.

7. Merger of *inter partes* reexamination proceeding 95/000,470 and *ex parte* reexamination proceeding 90/010,540 was dissolved in a petition decision mailed on June 22, 2010. The petition decision indicated that "the Office action issued and the responses/comments submitted by the parties during the merged proceeding are hereby vacated by the petition decision." The decision also indicated that "reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and party responses from the time of merger to the present will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public."

8. On July 2, 2010, an Action Closing Prosecution (ACP) was mailed; and on August 20, 2010, a Right of Appeal Notice (RAN) was mailed in *inter partes* reexamination proceeding 95/000,470.

9. Third party requester filed a petition on July 13, 2010, requesting reconsideration of the decision of June 22, 2010, dissolving the merger of the reexamination proceedings.

10. Third party requester filed a Notice of Appeal on September 20, 2010.

11. On November 22, 2010, Third Party Requester filed an appellant's brief.

12. Patent Owner filed Petition #1 on November 30, 2010.

13. On December 22, 2010, Patent Owner filed a respondent's brief, which was accompanied by Petition #2.

14. The Office of Patent Legal Administration mailed a petition decision on January 6, 2011, dismissing the requester's petition of July 13, 2010.

DISCUSSION

Merger of *inter partes* reexamination proceeding 95/000,470 and *ex parte* reexamination proceeding 90/010,540 was dissolved in a petition decision mailed on June 22, 2010. The petition decision indicated that the Office action issued and the responses/comments submitted by the parties during the merged proceeding were vacated by the petition decision. The decision also indicated that reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. The decision further indicated that all Office actions and party responses from the time of merger to the present will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public.

Requester NVIDIA filed a petition on July 13, 2010, for reconsideration to dissolve the merged proceedings. A decision dismissing this petition for reconsideration to dissolve the merged proceedings was mailed on January 6, 2011. The petition decision states on page 2 and on pages 13-14 that the examiner will recreate the record by incorporating the appropriate issues from the previously vacated Office action of December 17, 2009, and mail an appropriate Office action presenting all issues of patentability to include the issues of patentability regarding the Rosen reference. The petition decision indicates that this recreation of the record is for the purpose of preserving all party appeal rights to thereby address the requester petition of July 13, 2010.

In view of the petition decision of January 6, 2011, and the upcoming recreation of the record by the examiner, Petition #1 and Petition #2 are **dismissed as moot**.

DECISION

In view of the forgoing, the Petitions are 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.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED
APR 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

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APR 27 2011

CENTRAL REEXAMINATION UNIT

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P.O. Box 160006
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(For Requester)

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In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/000,470
Request Deposited: May 14, 2009
For: U.S. Patent No. 6,564,281

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

This is a decision on the October 28, 2010 paper entitled "PETITION TO EXPUNGE THIRD-PARTY REQUESTER'S NOTICE OF APPEAL THAT INCLUDES *EX PARTE* ISSUES".

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

Subsequent to the October 28, 2010 petition and consistent with the petition decision mailed January 6, 2011, the Office re-opened prosecution and issued a new non-final office action on February 22, 2011.

Therefore, the petition of October 28, 2010 is **dismissed as moot**.

CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611

Eric Keasel
SPE, Central Reexamination Unit

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ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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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 MAILED
JUL 21 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000470
PATENT NO. : 6564281
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED
JUL 21 2011
CENTRAL REEXAMINATION UNIT

Paul M. Anderson, PLLC (For Patent Owner)
P.O. Box 160006
Austin TX 78716

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

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,470
Filed: May 15, 2009
For: U.S. Patent No. 6,564,281

: DECISION
: DISMISSING
: PETITION

This is a decision on the April 22, 2011 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943(b) FOR PATENT OWNER'S RESPONSE TO OFFICE ACTION," which is being taken as a petition under 37 C.F.R. § 1.183.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended by 14 pages. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is dismissed.

DECISION

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on April 22, 2011 to address the February 22, 2011 non-final Office action, and requests that the page limit be extended by 14 pages.[1]

[1] Petition at 2.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of the resulting response paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response submission: (1) for justification that more pages are needed to complete the response submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response submission.

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's April 22, 2011 response includes 37 pages of remarks, which are subject to the 50 page limit.

The patent owner response includes a 27-page declaration by Robert Murphy under 37 CFR 1.132. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 27-page declaration by Murphy presents only objective and technical opinion evidence, and is free of legal argument. Therefore the Murphy declaration does not count against the regulatory page limit.

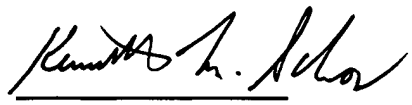
Further, patent owner's April 22, 2011 submissions have been reviewed by the Central Reexamination unit (CRU) and determined to be compliant with the 50-page limit requirement of 37 CFR 1.943(b).

For the reasons given above, waiver of 37 CFR 1.943(b) is not necessary for patent owner's April 22, 2011 submission. Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. Patent owner's April 22, 2011 petition is dismissed. Patent owner's response filed on April 22, 2011 is page-length compliant.

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



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

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,470	05/14/2009	6564281	9278.002.RXUS00	3302

86497 7590 12/16/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2011

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

RAMBUS, INC.
Patent Owner
v.
NVIDIA CORPORATION
Third Party Requester

Inter partes Reexamination Control 95/000,470
Patent 6,564,281 B2
Technology Center 3900

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 November 23, 2011 (present petition). Petitioner requests waiver of 37 C.F.R. §1.943(c) to permit requester to file an appellant brief up to 38 pages or 14,847 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on November 25, 2011, along with the appellant brief fee.

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

FINDINGS

1. Patent 6,564,281 B2 issued on May 13, 2003 with 46 claims. The '281 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. On May 14, 2009, third party requester NVIDIA filed a request for *inter partes* reexamination of the '281 patent, which was assigned control no. 95/000,470. Third party requester also filed a request for *ex parte* reexamination of the '281 patent, which was assigned control no. 90/010,540.
3. On July 6, 2009, reexamination was ordered in *inter partes* reexamination proceeding 95/000,470 and in *ex parte* reexamination proceeding 90/010,540.
4. A decision merging *inter partes* reexamination proceeding 95/000,470 and *ex parte* reexamination proceeding 90/010,540 was mailed on September 24, 2009.
5. Prosecution was conducted but on June 22, 2010, a petition decision was mailed indicating that the merger of *inter partes* reexamination proceeding 95/000,470 and *ex parte* reexamination proceeding 90/010,540 was dissolved. The petition decision stated: "[a]ny Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision." Petition Decision of Jun. 22, 2010, at 6. The decision also directed that "[r]eexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and

party responses from the time of merger to the present will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public." *Id.*

6. On July 2, 2010, an Action Closing Prosecution (ACP) was mailed; and on August 20, 2010, a Right of Appeal Notice (RAN) was mailed in *inter partes* reexamination proceeding 95/000,470.

7. Further prosecution was conducted, numerous petitions were filed, and on January 6, 2011, the Office of Patent Legal Administration mailed a petition decision stating:

> Accordingly, for all the reasons stated above requester's petition to reconsider the June 22, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to recreate the record by issuing an appropriate Office action presenting all issues of patentability appropriate for the '470 proceeding, including the issues of patentability regarding the Rosen reference rejection. The record is being recreated to preserve all party participation rights, to thereby address the requester petition.

Petition Decision of Jan. 6, 2011, at 13.

8. On February 25, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision dismissing the petitions of November 30, 2010, and December 22, 2010, as moot in view of the petition decision of January 6, 2011, and reopening of prosecution.

9. On February 22, 2011, a non-final Office action was mailed.

10. Prosecution was conducted and on August 26, 2011, a Right of Appeal Notice was mailed.

11. Requester filed a Notice of Appeal on September 23, 2011.

12. Requester filed an appellant brief on November 23, 2011, accompanied by the present petition.

DISCUSSION

Petitioner requests waiver of 37 C.F.R. § 1.943(c), which limits requester's appellant brief to thirty pages or 14,000 words in length. Petitioner is seeking permission to file an appellant brief of up to 38 pages or 14,847 words.

Petitioner states that throughout prosecution the parties responded and commented on 64 proposed rejections as presented in Issues 5-12, 17-24, 29-36, 41-64, including alternative proposed rejections based on the Rosen reference. Petition 1. Petitioner indicates that in the RAN, the Office did not adopt any of the issues and all claims 1-46 are confirmed. Petitioner asserts that:

> Justice requires waiver of the provision of 37 C.F.R. § 1.943 and granting NVIDIA an additional 847 words for its Appeal Brief so that NVIDIA may appeal all of the proposed rejections not adopted by the Office in the RAN. . . . Moreover, an extraordinary situation results should the Office deny NVIDIA the opportunity to properly appeal all issues as provided under 35 U.S.C. § 134 which provides a third party requester the right to appeal to the BPAI from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claims of a patent.

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

Requester'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, requester 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. Requester is seeking permission to file an appellant brief of up to 38 pages or 14,847 words, which exceeds the limit of 30 pages or 14,000 words.

Requester's reasons provided in support of waiving the page/word limits focus on the RAN and the 64 proposed rejections that were not adopted. However, the record reveals that requester chose to present numerous proposed rejections in the original request. It is not surprising that requester is now challenged by the page and word limit, given the number of proposed rejections set forth in the original request. Hence, the challenge presented is of the requester's own making.

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 present petition is **denied**. The appellant brief of November 23, 2011, is **not entered**.

DECISION

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

Requester 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 requester's appeal will be dismissed. If a compliant appellant brief is timely filed, then patent owner will have one month from the date of service to file a respondent brief.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

Counsel for Third Party Requester:
Tracy W. Druce
Novak Druce & Quigg, LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,471	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 09/02/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/02/2010

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

MAILED
SEP 02 2010
CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*	:
Inter partes Reexamination Proceeding	:
Control No.: 95/000,471	:
Filed: May 15, 2009	:
For: U.S. Patent No. 7,209,997	: DECISION
	: ON
In re Farmwald *et al.*	: PETITION
Ex Parte Reexamination Proceeding	:
Control No.: 90/010,542	:
Filed: May 15, 2009	:
For: U.S. Patent No. 7,209,997	:

This is a decision on patent owner's May 13, 2010 petition entitled "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS." The third party requester, on June 14, 2010, filed an opposition to patent owner's May 13, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is $400, which was charged to Patent Owner's credit card on May 13, 2010, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent owner's May 13, 2010 petition is dismissed.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of

the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

---

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

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

14. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".

15. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.

16. On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '471 *inter partes* reexamination proceeding.

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10542 *ex parte* reexamination proceeding.

19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '471 *inter partes* reexamination proceeding.

DECISION

As pointed out, on July 13, 2010, requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '471 and '10542 reexamination proceedings. Until the reconsideration of the June 22, 2010 decision is concluded, patent owner's May 13, 2010 petition to strike third party comments from previously merged proceedings is premature, and will only be necessary if the Office reverses its current position. The status of all papers made of record during the period when the proceedings were merged is subject to requester's merger challenge, until the petition for reconsideration of the issue of merger is

decided. Should the merger be reinstated, then patent owner may renew the present petition, but under 37 CFR 1.181, as a petition challenging entry of the papers.

CONCLUSION

1. Patent owner's May 13, 2010 petition is dismissed.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 28 2010

CENTRAL REEXAMINATION UNIT

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

: DECISION
: ON
: PETITION

This is a decision on third party requester's September 20, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION TO HALT PUBLICATION OF REEXAMINATION CERTIFICATE".

The fee set forth in 37 CFR 1.17(f) for the petition is $400, which was charged to requester's credit card on September 20, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

The petition is **dismissed.**

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

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5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

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7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired after September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

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19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

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19. On July 13, 2010, third party requester filed a petition requesting reconsideration of the June 22, 2010 Office decision dissolving the merger of the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '471 *inter partes* reexamination proceeding.

21. On September 20, 2010, third party requester filed the present petition in the '471 proceeding requesting that publication of the '10542 proceeding's *ex parte* reexamination certificate be halted.

22. Also on September 20, 2010, third party requester concurrently filed a petition in the '10542 proceeding requesting that publication of the '10542 proceeding's *ex parte* reexamination certificate be halted.

23. Concurrently on September 20, 2010, third party requester filed a notice of appeal in the '471 proceeding.

24. On October 12, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7809th) for US Patent No. US 7,209,997 C1.

25. On October 13, 2010, the Office issued a decision on the September 20, 2010 requester petition filed in the '10542 proceeding stating that it was an improper paper and had been returned/destroyed.

DECISION

Third party requester is petitioning in the present '471 proceeding that publication of the reexamination certificate in the in the '10542 proceeding be halted. The requested relief cannot be granted, as the '10542 reexamination proceeding concluded with the issuance of *Ex Parte* Reexamination Certificate (7809th), US 7,209,997 C1. Upon issuance of the certificate, the Office was divested of jurisdiction over the '997 patent as to the relevant issues raised in the '10542 proceeding. Even if the petition had been addressed prior to issuance of the certificate, the requested relief could not be granted. Third party requester is petitioning in the present '471 proceeding for relief to be provided in a different proceeding - the '10542 proceeding. Accordingly, the petition is dismissed.

CONCLUSION

1. The petition is **dismissed**.

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

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

10-26-10
Kimpropa/IP

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CENTRAL REEXAMINATION U

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In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

In re Farmwald *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/010,542
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

: DECISION
: ON
: PETITION

This is a decision on third party requester's July 13, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is $400, which was charged to requester's credit card on July 14, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

SUMMARY

The petition is **dismissed**.

The Office *Sua Sponte* directs the examiner to reestablish the record with regard to the Rosen reference in accordance with this decision.

As discussed below, the requester was not precluded from filing another *inter partes* reexamination request on the same day requester filed the '471 *inter partes* reexamination request (or even shortly thereafter). Further, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either a single *inter partes* request with all issues, or a second *inter partes* request raising the issues presented in the *ex parte* request, concurrently or before the '471 *inter partes* request was ordered. In short, requester has made the conscious choice to present the issues in the *ex parte* reexamination request in a manner that does not provide requester *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, so now has no basis to complain that *inter partes* rights are not being afforded.

The June 22, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as of the order date of the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

Finally, in order to address a point made in the third party requester petition, the present decision instructs the examiner of record to recreate the record by incorporating the appropriate issues from the previously vacated Office action of December 18, 2009 and mail an appropriate Office action presenting all issues of patentability, to include the issues of patentability regarding the Rosen reference. This recreation of the record is for the purpose of preserving all party appeal rights, to thereby address the requester petition.

REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,209,997 (the '997 patent) to Farmwald *et al.*

2. On May 15, 2009, a request for *ex parte* reexamination of all the claims (claims 1-38) of the '997 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,542 (the '10542 proceeding).

3. Also on May 15, 2009, a request for *inter partes* reexamination of all the claims (claims 1-38) of the '997 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 95/000,471 (the '471 proceeding).

4. The '997 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner appears to be enforcing at least one of claims 1-38 against the requester in the litigation.

5. On July 7, 2009, the Office issued an order granting the '10542 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '997 patent, claims 1-38, would be subject to reexamination.

6. Also on July 7, 2009, the Office issued an order granting the '471 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '997 patent, claims 1-40, would be subject to reexamination.

7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10542 *ex parte* reexamination proceeding expired September 7, 2009.[1]

8. On September 23, 2009, the Office, *sua sponte,* issued a decision merging the '471 *inter partes* reexamination proceeding with the '10542 *ex parte* reexamination proceeding (the merged proceeding).

9. On October 13, 2009, patent owner filed a petition requesting reconsideration of the September 23, 2009 merger decision, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition.

10. On December 17, 2009 the Office issued a decision dismissing patent owner's October 13, 2009 petition requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

11. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.

12. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision dismissing patent owner's October 13, 2009 petition

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

requesting reconsideration of the September 23, 2009 decision to merge the '471 *inter partes* and '10542 *ex parte* reexamination proceedings.

13. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 17, 2009 decision.

14. On March 18, 2010, patent owner timely filed a response to the December 18, 2009 Office action.[2]

15. On April 19, 2010, third party requester timely filed comments after the response.

16. On June 22, 2010, the Office issued a decision dissolving the merger of the '471 and the '10542 proceedings.

17. On July 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the '471 proceeding confirming all the claims in light of the prior art of record to include a US patent to Rosen (the Rosen reference).

18. On July 6, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10542 proceeding, neither citing nor discussing the Rosen reference.

19. On July 13, 2010, third party requester filed the present petition, requesting reconsideration of the June 22, 2010 decision.

20. On August 20, 2010, the Office issued a Right of Appeal Notice (RAN) in the '471 proceeding.

21. On September 20, 2010, third party requester filed a notice of appeal in the '471 proceeding.

22. On October 12, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7809th) for US Patent No. 7,209,997 C1 the '10542 proceeding. The certificate states that the '471 proceeding was still pending with respect to the '997 patent.

DECISION

I. Issues Raised and Relief Requested

[2] On January 21, 2010, the Office granted patent owner a one month extension of time.

Third party requester contends that the Office's June 22, 2010 decision is: (1) Arbitrary, Capricious and an Abuse of Discretion; (2) A violation of Third Party Requester's Appeal Rights; (3) Impermissible Substantive Rule Making; (4) Contrary to Public and Office policy; and (5) Contrary to Special Dispatch.

Third party requester requests the relief of vacatur of the June 22, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

II. Discussion of Previous Petitions and Decisions

a. The October 13, 2009 Patent Owner Petition and December 17, 2009 Office Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision on December 17, 2009, dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's concurrently filed requests for reexamination were filed with an "intent to harass" and that the finding of a substantial new question of patentability in each request precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives for handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

b. The January 19, 2010 Patent Owner Petition, January 29, 2010 Requester Opposition, and June 22, 2010 Office Decision

On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 19, 2010 petition: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, in a narrow time frame, constitutes a harassment of patent owner.

On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 16, 2009 decision. The requester argued (1) Merger of the reexamination proceedings was proper and in accordance with statute and policy; (2) An *ex parte* requester that is also an *inter partes* requester in a merged proceeding is subject to the estoppel provisions of 35 U.S.C. 315(c) as to the *ex parte* issues; (3) Waiver of 37 CFR 1.989(b) should not be granted as no interview right exists; and (4) No intent to harass exists.

On June 22, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

III. Findings and Analysis

a. The June 22, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester, citing Office's Federal Register rulemaking commentary,[3] argues that the June 22, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

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

The June 22, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy commentary is based upon.[4] The present circumstance involves the same third party requester concurrently filing, on the same day, both an *ex parte* reexamination proceeding and an *inter partes* reexamination proceeding on the same patent. The cited comment by requester in the July 13, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was already ordered and under active examination and a requester had discovered relevant information that could not be admitted via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. As pointed out, both reexamination requests under consideration *were filed on the same day.* Under such circumstances, the requester was not precluded from filing another *inter partes* reexamination request on the same day requester filed the '471 *inter partes* reexamination request (or even shortly thereafter). More significantly, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either: (1) A single *inter partes* request with all issues; or (2) A second *inter partes* request raising the issues presented in the *ex parte* request. Requester could have either concurrently filed two *inter partes* requests or filed the second request before the '471 *inter partes* request was ordered. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of two different types of proceedings as a vehicle to obtain *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),[5] 37 CFR 1.989(a),[6] MPEP 2686.01 I,[7] MPEP 2686.01 IV,[8] MPEP 2283,[9] and MPEP 2286.[10] See also "Revisions

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[4] Id.

[5] "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will **usually** be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

[6] "If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[7] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'"

[8] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[9] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[10] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the

and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

In summary, requester made the conscious choice to present the issues in the *ex parte* reexamination request, which does not provide a requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights beyond what an *ex parte* request would accord, and therefore now has no basis to complain.

Requester's citation to *inter partes* reexamination proceeding 95/000,050 (the '50 proceeding) in support of requester's position, fails to acknowledge the significant differences between the '50 proceeding and the present proceeding. In the '50 proceeding, the request for *inter partes* reexamination antedated the filing of the 90/007,885 *ex parte* request (the '7885 proceeding) by over a year. Thus the circumstances of the '50 proceeding in terms of date order, unlike the circumstances of the present proceeding, were in accord with Office policy and procedure commented upon with regard to 37 CFR 1.948. Furthermore, the '7885 proceeding was filed by the patent owner and not by the same third party requester (as in the present instance). Significant prosecution had taken place in the '50 proceeding and unlike a third party requester, a patent owner in an *inter partes* proceeding, was not bound by 37 CFR 1.948 in order to submit relevant prior art into the *inter partes* proceeding. The facts and circumstances of the '50 proceeding differ significantly from the facts and circumstances of the present proceeding. Therefore the '50 proceeding cannot serve as a basis to establish that the Office has acted in an arbitrary and capricious manner. If anything, the contrast of the present proceedings with the cited '50 proceeding illustrates how unforeseeable, disparate sets of circumstances can arise with regard to merger, thus bolstering the soundness of the policy of giving the Office sole discretion to merge, not-merge or demerge on a case-by-case basis.

b. The June 22, 2010 Office decision is not a violation of Requester's Appeal Rights

The requester asserts that the June 22, 2010 dissolution decision somehow alters requester's substantive appeal rights.

The dissolution decision does not alter the requester's appeal rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's appeal rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a

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

joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. Even after merger, the third party requester had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. As pointed out in MPEP 2674, "[a] notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested." Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi): "No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection."

In any event, if third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have filed a second *inter partes* request raising the issues presented, instead of filing an *ex parte* request. In this instance, the filing of a second *inter partes* request was clearly permissible under the statute. The *ex parte* proceeding request was filed prior to the issue of an order for reexamination in the *inter partes* reexamination; thus, a second *inter partes* request could have been filed instead of the *ex parte* request, and it should have been filed if requester desired *inter partes* reexamination treatment for the proposed rejections. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation.

CORRECTION OF THE PRESENT RECORD:

Requester has actually identified the problem of accounting for issues of patentability raised by the Office when the proceedings were merged, which were not based upon the submitted requests, *e.g.* the Rosen reference based issues of patentability. As a preliminary matter, the Office possesses statutory authority to add a reference in reexamination. Pursuant to 35 U.S.C. § 314(a), " [e]xcept as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." 35 U.S.C. § 305 provides analogous language. Under 35 U.S.C. § 132, the Office is entitled to introduce any art it deems relevant. Also, the Office possesses statutory authority, pursuant to 35 U.S.C. § 312, to consider information outside a request for reexamination.[11] The

[11] ". . .[T]he Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, **with or without consideration of other patents or printed publications**. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." 35 U.S.C. § 312, emphasis added.

Rosen based issues of patentability were proposed by the examiner based upon the Office's statutory authority, and they must be accounted for to ensure that the record is clear with regard to the Rosen reference. In the December 18, 2009 Office action of the merged proceeding, the examiner exercised the Office's statutory authority, and in addition to considering the patentability issues raised in the requests, the examiner issued rejections based upon US 5,235,543 issued to Rosen. After the June 22, 2010 merger dissolution decision, the examiner issued a NIRC in the '10542 *ex parte* reexamination proceeding confirming all the claims and issued an ACP in the '471 *inter partes* reexamination proceeding, also confirming all the claims. In the '10542 *ex parte* proceeding's NIRC confirmation of the claims the examiner was silent with regard to the Rosen reference. In the '471 *inter partes* proceeding's ACP confirmation of the claims, the examiner discussed how the Rosen reference did not obviate patentability of the claims, and thus inadvertently omitted a patentability rejection that was raised by the Office action vacated in the June 22, 2010 merger dissolution decision. This took away the rights of the requester as to the use of the Rosen reference (the confirmation of the claims in the ACP of the *inter partes* proceeding does not constitute a rejection that the requester could appeal). Accordingly, the examiner of record is directed to recreate the record in the '471 proceeding and issue an appropriate Office action presenting all issues of patentability appropriate to this proceeding, to including the issues of patentability regarding the Rosen reference, to recreate the record and preserve all party participation rights.

c. The June 22, 2010 Office decision is not Substantive Rule Making

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. *Requester's counsel has explicitly recognized the Office's authority and discretion extending to demerge in accordance with special dispatch in previous proceedings.*[12] Additionally, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the administrative act of a consolidation of cases does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights'

[12] See e.g. Petition to Demerge 95/000283 and 90/008,170 filed August 16, 2008.

were established in accordance with the relevant statutes before the issuance of the merger and dissolution of the merger decisions.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.[13]

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

d. The June 22, 2010 Office decision is not Contrary to Special Dispatch

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. The '10542 proceeding has advanced to issuance of a reexamination certificate and the '471 proceeding has advanced to the appeal stage. Issuance of a new ACP in the '471 proceeding, recreating the record therefore better serves special dispatch. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 22, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on

[13] It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

the same patent is still pending. As the '471 proceeding has advanced to the appeal stage and a reexamination certificate has issued in the '10542 proceeding, special dispatch would not be served by remerging the proceedings and re-opening prosecution back to the point in prosecution just prior to the initial merger of the proceedings.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties . In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Regarding previous Office decisions, to include the '50 *inter partes* reexamination proceeding cited by requester, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.[14] Furthermore, as noted in section III a. of this decision, the facts and circumstances of the '50 proceeding significantly differ from the facts and circumstances of the present proceeding. In the present instance, as noted in the June 22, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

e. The June 22, 2010 Office decision is not Contrary to Public and Office policy

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Policy considerations that requester asserts dictate that merger must occur when multiple, co-pending proceedings on the same patent exist.

In response, the June 22, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 22, 2010 dissolution decision is in accord with and not contrary to public policy, as the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued

[14] See MPEP 2686.01 IV.

patent. Requester's institution of two separate reexamination proceedings on the same day for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Requester asked for separate proceedings for separate issues of patentability on the same patent. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The June 22, 2010 dissolution decision, the MPEP, and Office practice and procedure provides a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.[15] As of October 12, 2010 a certificate has issued in the '10542 proceeding containing an appropriate notice regarding the existence of an outstanding reexamination proceeding.[16] The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 22, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.[17] As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the June 22, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to recreate the record by

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[15] See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g. Ex Parte* Reexamination Certificate (7412th) No. 6188988 C1, right column notice under the abstract.
[16] *Ex Parte* Reexamination Certificate (7809th) No. 7209997 C1, right column notice under the abstract.
[17] See Petition at page 10, section E.

issuing an appropriate Office action presenting all issues of patentability appropriate for the '471 proceeding, including the issues of patentability regarding the Rosen reference rejection. The record is being recreated to preserve all party participation rights, to thereby address the requester petition.

CONCLUSION

1. The petition is **dismissed**.

2. The examiner of record is directed to recreate the record by issuing an appropriate Office action in the '471 proceeding presenting all issues of patentability, which is to include the issues of patentability regarding the Rosen reference.

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

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

1-5-11

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,471	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 04/13/2011

Paul M. Anderson, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes NVIDIA CORP.
v.
RAMBUS, INC.

Reexamination Control No. 95/000,471
Patent No. 7,209,997
Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner "Petition to Expunge Portions of Third-Party Requester's Corrected Appeal Brief that Includes *Ex Parte* Issues" of January 4, 2011 ("present petition") in *Inter Partes* Reexamination Control No. 95/000,471. The petition fee of $400 pursuant to 37 C.F.R. §1.17(f) has been charged to petitioner's credit card on January 4, 2011.

A review of the record reveals that a non-final Office action was mailed on February 22, 2011. Accordingly, since prosecution has been reopened, the present petition is **dismissed as moot.**

CONCLUSION

The present petition is DISMISSED.

James T. Moore

Acting Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

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

COUNSEL FOR THIRD PARTY REQUESTER:

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(For Patent Owner)

APR 27 2011

CENTRAL REEXAMINATION UNIT

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

(For Requester)

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

In re: Farmwald *et alia*
Reexamination Proceeding
Control No. 95/000,471
Request Deposited: May 15, 2009
For: U.S. Patent No. 7,209,997

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

This is a decision on the October 28, 2010 paper entitled "PETITION TO EXPUNGE THIRD-PARTY REQUESTER'S NOTICE OF APPEAL THAT INCLUDES *EX PARTE* ISSUES".

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

Subsequent to the October 28, 2010 petition and consistent with the petition decision mailed January 6, 2011, the Office re-opened prosecution and issued a new non-final office action on February 22, 2011.

Therefore, the petition of October 28, 2010 is **dismissed as moot**.

CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611

Eric Keasel
SPE, Central Reexamination Unit

United States Patent and Trademark Office

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United States Patent and Trademark Office
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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
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1000 Louisiana Avenue
Fifty-Third Floor
Houston, TX 77002

(For Third Party Requester)

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CENTRAL REEXAMINATIO

In re Farmwald *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/000,471
Filed: May 15, 2009
For: U.S. Patent No. 7,209,997

: DECISION
: DISMISSING
: PETITION

This is a decision on the April 22, 2011 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943(b) FOR PATENT OWNER'S RESPONSE TO OFFICE ACTION," which is being taken as a petition under 37 C.F.R. § 1.183.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended by 6 pages. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is dismissed.

DECISION

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on April 22, 2011 to address the February 22, 2011 non-final Office action, and requests that the page limit be extended by 6 pages.[1]

[1] Petition at 2.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of the resulting response paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response submission: (1) for justification that more pages are needed to complete the response submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response submission.

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's April 22, 2011 response includes 34 pages of remarks, which are subject to the 50 page limit.

The patent owner response includes a 22-page declaration by Robert Murphy under 37 CFR 1.132. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 22-page declaration by Murphy presents only objective and technical opinion evidence, and is free of legal argument. Therefore the Murphy declaration does not count against the regulatory page limit.

Further, patent owner's April 22, 2011 submissions have been reviewed by the Central Reexamination unit (CRU) and determined to be compliant with the 50-page limit requirement of 37 CFR 1.943(b).

For the reasons given above, waiver of 37 CFR 1.943(b) is not necessary for patent owner's April 22, 2011 submission. Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. Patent owner's April 22, 2011 petition is dismissed. Patent owner's response filed on April 22, 2011 is page-length compliant.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,471	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 12/16/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/16/2011

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

RAMBUS, INC.
Patent Owner
v.
NVIDIA CORPORATION
Third Party Requester

Inter partes Reexamination Control 95/000,471
Patent 7,209,997B2
Technology Center 3900

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 November 23, 2011 (present petition). Petitioner requests waiver of 37 C.F.R. §1.943(c) to permit requester to file an appellant brief up to 41 pages or 16,489 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on November 25, 2011, along with the appellant brief fee.

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

FINDINGS

1. Patent 7,209,997B2 issued on April 24, 2007 with 38 claims. The '997 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. On May 15, 2009, third party requester NVIDIA filed a request for *inter partes* reexamination of the '997 patent, which was assigned control no. 95/000,471. Third party requester also filed a request for *ex parte* reexamination of the '281 patent, which was assigned control no. 90/010,542.
3. On July 7, 2009, reexamination was ordered in *inter partes* reexamination proceeding 95/000,471 and in *ex parte* reexamination proceeding 90/010,542.
4. A decision merging *inter partes* reexamination proceeding 95/000,471 and *ex parte* reexamination proceeding 90/010,542 was mailed on September 23, 2009.
5. Prosecution was conducted but on June 22, 2010, a petition decision was mailed indicating that the merger of *inter partes* reexamination proceeding 95/000,471 and *ex parte* reexamination proceeding 90/010,542 was dissolved. The petition decision stated: "[a]ny Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision." Petition Decision of Jun. 22, 2010, at 6. The decision also directed that "[r]eexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. All Office actions and

party responses from the time of merger to the present will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public." *Id.*

6. On July 2, 2010, an Action Closing Prosecution (ACP) was mailed; and on August 20, 2010, a Right of Appeal Notice (RAN) was mailed in *inter partes* reexamination proceeding 95/000,471.

7. Further prosecution was conducted, numerous petitions were filed, and on January 6, 2011, the Office of Patent Legal Administration mailed a petition decision stating:

> Accordingly, for all the reasons stated above requester's petition to reconsider the June 22, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to recreate the record by issuing an appropriate Office action presenting all issues of patentability appropriate for the '471 proceeding, including the issues of patentability regarding the Rosen reference rejection. The record is being recreated to preserve all party participation rights, to thereby address the requester petition.

Petition Decision of Jan. 6, 2011, at 13-14.

8. On April 13, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision dismissing the petition of January 4, 2011, as moot in view of the petition decision of January 6, 2011, and reopening of prosecution.

9. On February 22, 2011, a non-final Office action was mailed.

10. Prosecution was conducted and on August 26, 2011, a Right of Appeal Notice was mailed.

11. Requester filed a Notice of Appeal on September 23, 2011.

12. Requester filed an appellant brief on November 23, 2011, accompanied by the present petition.

DISCUSSION

Petitioner requests waiver of 37 C.F.R. § 1.943(c), which limits requester's appellant brief to thirty pages or 14,000 words in length. Petitioner is seeking permission to file an appellant brief of up to 41 pages or 164,489 words.

Petitioner states that throughout prosecution the parties responded and commented on 93 proposed rejections as presented in Issues 11-30, and 41-93, including alternative proposed rejections based on the Rosen reference. Petition 1. Petitioner indicates that in the RAN, the Office did not adopt any of the issues and all claims 1-38 are confirmed. Petitioner asserts that:

> Justice requires waiver of the provision of 37 C.F.R. § 1.943 and granting NVIDIA 16,489 words or 41 pages for its Appeal Brief so that NVIDIA may appeal all of the proposed rejections not adopted by the Office in the RAN. . . . Moreover, an extraordinary situation results should the Office deny NVIDIA the opportunity to properly appeal all issues as provided under 35 U.S.C. § 134 which provides a third party requester the right to appeal to the BPAI from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent.

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

Requester'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, requester 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. Requester is seeking permission to file an appellant brief of up to 41 pages or 16,489 words, which exceeds the limit of 30 pages or 14,000 words.

Requester's reasons provided in support of waiving the page/word limits focus on the RAN and the 93 proposed rejections that were not adopted. The requester presents 94 issues in its brief, pp. 2-6. However, the record reveals that requester chose to present numerous proposed rejections in the original request. It is not surprising that requester is now challenged by the page and word limit, given the number of proposed rejections set

forth in the original request. Hence, the challenge presented is of the requester's own making.

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 present petition is **denied**. The appellant brief of November 23, 2011, is **not entered**.

DECISION

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

Requester 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 requester's appeal will be dismissed. If a compliant appellant brief is timely filed, then patent owner will have one month from the date of service to file a respondent brief.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

Counsel for Third Party Requester:
Tracy W. Druce
Novak Druce & Quigg, LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,471	05/15/2009	7,209,997	9278.002.RXUS00	5654

86497 7590 04/04/2012

Paul M. Anderson, PLLC
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Austin, TX 78716

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes

RAMBUS, INC.
Patent Owner
v.
NVIDIA CORPORATION
Third Party Requester

Inter partes Reexamination Control 95/000,471
Patent 7,209,997 B2
Technology Center 3900

DECISION ON PETITION

This is a decision on the "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief" filed February 10, 2012 (petition). Petitioner requests waiver of 37 C.F.R. §1.943(c) to permit patent owner to file a respondent brief of up to 22 pages or 9,529 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on March 23, 2012, along with the respondent brief fee.

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

DECISION

A "NOTICE OF WITHDRAWAL OF THIRD-PARTY REQUESTER'S APPEAL" was filed by the requester on February 20, 2012.

The requester's appeal is DISMISSED.

The present petition is DISMISSED as moot.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
Paul M. Anderson, PLLC
P.O. Box 160006
Austin, TX 78716

Counsel for Third Party Requester:
Tracy W. Druce
Novak Druce & Quigg, LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,472	07/08/2009	6,596,944	096001-0110	1514

22428 7590 02/24/2012

FOLEY AND LARDNER LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: 2-24-12

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000472
PATENT NO. : 6596944
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Foley & Lardner, LLP (For Patent Owner)
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MAILED

FEB 24 2012

CENTRAL REEXAMINATION UNIT

King & Spalding (For Requester)
1180 Peachtree Street, NE
Atlanta, GA 30309 - 3521

In re Clark et al :
Inter Partes Reexamination Proceeding : **DECISION GRANTING**
Control No. 95/000,472 : **PETITION TO TERMINATE**
Filed: July 8, 2009 : ***INTER PARTES* REEXAMINATION**
For: U.S. Patent No.: 6,596,944 : **PROCEEDING**

This is a decision on patent owner's December 8, 2011 petition entitled "Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the December 8, 2011 petition to terminate), and on patent owner's February 16, 2012 paper entitled "Supplement to Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the February 16, 2012 supplement).

The December 8, 2011 petition to terminate, the February 16, 2012 supplement, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,472, filed on December 8, 2011, is **granted**.

Inter partes reexamination proceeding 95/000,472 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,472 (the '472 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 issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that 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 6,596,944 (the '944 patent), was the subject of a civil action in district court, i.e., *Belden Technologies Inc. v. Superior Essex Communications LP*, Case No. Civ. No. 08-63-SLR (D. Del.). The patent owner submits a copy of a consent judgment, entered by the district court on November 10, 2011, in which the district court stated that "Superior Essex [the defendant/requester of the '472 proceeding] has not sustained its burden of proving the invalidity of any of the asserted claims (1-12) of the '944 Patent [the patent under reexamination]". The court also stated that "[a]ny remaining claims or counterclaims of the parties are dismissed with prejudice", and that "[t]he parties waive their right to appeal or otherwise contest this Consent Final Judgment". Thus, the patent owner has provided sufficient evidence that (1) the requester Superior Essex was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant had not sustained its burden of proving the invalidity of the claims in suit. The patent owner has also submitted, on February 16, 2012, an amendment cancelling claims 17, 20-23, and 25-30, which renders the claims under reexamination to be identical to the patent claims in suit. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the patent owner has submitted a copy of a document entitled "Stipulation and Order Amending Revised Scheduling Order", showing that discovery did not close until August 14, 2009, which was after the July 8, 2009 filing date for the request for reexamination in the present proceeding. In addition, the patent owner has submitted a copy of a document entitled "Proposed Trial Exhibit List", showing that requester had the opportunity to file with the court three expert reports between September and November of 2009, and has also submitted another document entitled "Proposed Joint Pre-Trial Order", which indicates, on page 7, that trial did not begin until at least September 7, 2010.[1] These documents, in addition to the other evidence submitted by the patent owner with the present petition, provide sufficient evidence that the prior art, and any other issues present in the '472 reexamination proceeding, were either raised or could have been raised by the defendant/requester in the civil action. Thus, element 4 has been shown to be satisfied.

[1] With the February 16, 2012 supplement to the present petition, the patent owner has also provided evidence that the "Stipulation and Order Amending Revised Scheduling Order" and the "Proposed Joint Pre-Trial Order" were signed and ordered by the court.

For the reasons given above, patent owner's December 8, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,472 (the '472 proceeding) is hereby **terminated**.

The '472 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 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

- Patent owner's December 8, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,472 is **granted**.
- The prosecution of the '472 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '472 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for entry of the February 16, 2012 amendment and for further processing to conclude the '472 proceeding, as set forth in 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,474	07/06/2009	6570095	M0506-702350	5251

22428 7590 03/07/2011

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

Date:
MAILED
MAR 07 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000474
PATENT NO. : 6570095
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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Attn: Matthew A. Smith
Foley Lardner LLP
3000 K Street NW Ste 600
Washington, DC 20007

(For Patent Owner)

MAILED
MAR 07 2011
CENTRAL REEXAMINATION UNIT

Attn: W. Scott Petty
King & Spalding LLP
1180 Peachtree Street NE
Atlanta, Georgia 30309-4530

(For Third Party Requester)

In re Clark *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,474
Filed: July 6, 2009
For: U.S. Patent No. 6,570,095 B2

: **DECISION**
: **ADDRESSING PETITIONS**
: **UNDER § 1.182**

This is a decision on the December 23, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED RREEXAMINATION OF U.S. PATENT NO. 6,570,095," and on the January 24, 2011 third party requester petition entitled "THIRD PARTY REQUESTER'S RESPONSIVE PETITION UNDER 37 C.F.R. § 1.182."

The patent owner and third party requester petitions are before the Office of Patent Legal Administration.

The patent owner petition under 37 C.F.R. § 1.182 is dismissed.

The third party requester petition under 37 C.F.R. § 1.182 is refused entry and expunged from the record of the instant reexamination proceeding.

BACKGROUND

- On May 19, 2009, a request for *inter partes* reexamination of U.S. Patent Number 6,570,095 B2 was deposited by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,474 ("the '474 proceeding"). The filing date requirements of 37 C.F.R. § 1.915 were met on July 6, 2009.

- On September 10, 2009, reexamination was ordered and a first Office action was mailed in the proceeding.

- Prosecution progressed, until, on March 16, 2010, an Office action closing prosecution ("ACP") was mailed, confirming unamended patent claims 6, 7, 13, 17, and 18, finding

claims 24-26 patentable as amended, and rejecting claims 1-5, 8-12, 14-16, 19-23, and 27-40.

- On April 16, 2010, patent owner filed a reply to the March 16, 2010 ACP.

- On May 14, 2010, third party requester filed comments responsive to the March 16, 2010 ACP and the April 16, 2010 patent owner reply.

- On June 24, 2010, patent owner filed an IDS, including numerous documents from the copending litigation styled *Belden Technologies v. Superior Essex Communications* No. 08-063, District Court in and for the District of Delaware. Patent owner submitted further documents from that litigation in an IDS filed on September 30, 2010.

- On December 23, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION OF U.S. PATENT NO. 6,570,095," seeking entry of ten evidence submissions (including over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony) and a publicly available product bulletin, and comments addressed to those evidence submissions.

- On January 24, 2011, third party requester filed the instant petition entitled "THIRD PARTY REQUESTER'S RESPONSIVE PETITION UNDER 37 C.F.R. § 1.182."

PERTINENT STATUTES AND REGULATIONS

37 C.F.R. § 1.182 provides:

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

MPEP 2686 provides, in pertinent part:

> [T]he Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in

the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment. If the argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.
It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return, expunge or discard, at its sole discretion, all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers.

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 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.

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 will 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. Furthermore, any such Office decision will also consider whether 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, such that prosecution would be furthered by the submission's entry.

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

In this instance, patent owner petitions for reopening of prosecution after the ACP based upon ten evidence submissions. These evidence submissions are from copending litigation involving claims 27 and 31 of the '095 patent at issue in the instant '474 proceeding.[2] These ten evidence submissions include over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony. The court proceedings involved, in addition to the '095 patent at issue in the current proceeding, four other patents not at issue in the current reexamination proceeding. The evidence submission also includes a product bulletin, stated to be obtained from the internet, separate from the litigation proceeding.

The instant petition requests entry of evidence in the form of a publicly available product bulletin and a full transcript of a related court proceeding.

Entry of a publicly available document and/or court documents does not require reopening of prosecution for its entry;[3] thus, no basis for the reopening of prosecution has been provided. Should the ten evidence submissions (include over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony) not be entered, if information in the submissions raise a substantial new question of patentability not yet raised as to the '095 patent, patent owner may file a new request for reexamination based on such information, to the extent permitted by 35 U.S.C. § 301 *et seq.*

Further, if enterable, the product bulletin document may be entered into the proceeding through an IDS submission. With respect to the court transcripts, to the extent that submission of the proceedings would be limited to bare notice and copies of such proceedings, may be enterable under 37 C.F.R. § 1.985. *See* MPEP 2686 for the criteria for such entry. Furthermore, the court transcripts are overwhelmingly directed to material not germane to the merits of the instant reexamination proceeding. The transcripts include discussions extraneous to the merits of the proceeding such as *voir dire*. The transcripts further are directed to discussions of references not applied to rejections in the current proceeding (*e.g.*, U.S. 5,796,046); and further, are directed to patents not under reexamination in the instant proceeding (i.e., the '999, '503, '491, and '537 patents).

As a final point, neither the product bulletin nor the transcripts have been denied entry as yet by the examiner. The Notice upon which petitioner relies clearly states 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 an action closing prosecution in an *inter partes* reexamination proceeding. As the evidence submissions have not been denied entry, the petition fails to meet that requirement of the Notice upon which it relies.

For these reasons, relief under § 1.182 would be inappropriate in the present proceeding.

Additional discussion:

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[2] *Belden Technologies v. Superior Essex*, No. 08-063, District Court in and for the District of Delaware.

[3] *See, e.g.*, the IDS filed by patent owner on June 24, 2010 and September 13, 2010, containing numerous documents from the copending litigation.

It is further noted that the petition provided no showing that need for evidence was occasioned by positions first taken by the Office in the ACP; rather petitioner attempts to show that availability of evidence only occurred after ACP. However, as the prospective submission addresses issues arising at an earlier point in the prosecution, petitioner did not aver that the evidence in the submission could not have been presented earlier. For example, petitioner states that the product bulletin was discovered only on December 16, 2010, despite being known to petitioner at a much earlier date. Petitioner has not provided a reason for the delay in locating and submitting the product bulletin, despite its alleged relevance, in accordance with the language of 37 C.F.R. § 1.555(a).[4]

It is additionally noted that, of the thirty claims (1-5, 8-12, 14-16, 19-23, and 27-40) currently under rejection in the instant reexamination proceeding, only two were addressed in the court. With respect to evidence relating to secondary considerations of nonobviousness, it is noted that these were unpersuasive in the litigation, as claim 31 of the '095 patent was found invalid as obvious despite the secondary considerations of nonobviousness offered in the litigation.[5] It is also noted that evidence of secondary considerations may be brought in through an affidavit so long as the regulations (*e.g.*, 37 C.F.R. § 1.116) provide for a right of entry.

In view of the above, the petition is **dismissed**.

The Opposition Paper Has No Right Of Entry

With respect to the January 24, 2011 requester paper opposing patent owner's petition under 37 CFR 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 petition to request continuing reexamination. A request for continued reexamination 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 provide relief not expressly provided for by 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 granting of a petition that requests continuing

[4] 37 C.F.R. § 1.555(a) states: "Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. . . . Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible."

[5] "Verdict Sheet", point 7, dated September 15, 2010, in Belden Technologies v. Superior Essex, Civ. No. 08-063, submitted in this proceeding on 12/23/2010 as Exhibit 2 to the instant petition.

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 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 for continued reexamination 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,[6] the consideration of a request for continued reexamination (including a limited reopening) is clearly within the Office's jurisdiction,[7] and the Office may exercise its discretion to grant such relief to provide a limited reopening of prosecution. 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 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 opposition, filed on January 24, 2011 to the patent owner's petition for continuing reexamination filed on December 23, 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 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.

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[6] 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.

[7] 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.

CONCLUSION

1. The December 23, 2010 petition for continued reexamination is **dismissed**.

2. The January 24, 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 present reexamination proceeding, because such a submission is not authorized by the reexamination statute or the regulations promulgated under the statute.

3. 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.

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

5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

March 4, 2011
Kenpet8/...

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,475	05/19/2009	7179999	M0506-702651	1283

37462 7590 09/07/2010

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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1180 Peachtree Street
Atlanta, GA 30309

Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000475
PATENT NO. : 7179999
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Scott Petty : (For Third Party Requester)
KING & SPALDING :
1180 PEACHTREE STREET :
ATLANTA, GA 30309 :

In re: Clark *et al.* :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,475 : UNDER 37 CFR § 1.181
Deposited: May 19, 2009 :
For: U.S. Patent No.: 7,179,999 :

This is a decision on a petition filed by the patent owner on July 12, 2010, entitled: "PETITION UNDER 37 CFR. § 1.181 TO OPEN PROSECUTION IN AN *INTER PARTES* REEXAMINATION PROCEEDING" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to reopen prosecution in light of an allegedly improper Action Closing Prosecution.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,179,999 issued on February, 20, 2007.
- A request for *inter partes* reexamination was filed on May 19, 2009 and assigned control no. 95/000,475.
- *Inter partes* reexamination was ordered and prosecution progressed until an Action Closing Prosecution was mailed for the proceeding on June 11, 2010.
- On July 12, 2010, patent owner responded to the Office action and also filed the instant petition.
- On August 11, 2010, the third party requester filed comments to the patent owner's response. The third party did not file a separate paper responsive to the petition, as is provided for in MPEP § 2673(VI).

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP § 2673.01 Reopening Prosecution After ACP (in part)

I. MANDATORY REOPENING

* * *

The patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. A Right of Appeal Notice (RAN) cannot be issued until the patent owner has had the opportunity to address each and every rejection prior to the appeal stage. Thus, the examiner should reopen prosecution where any new ground of rejection is made or any additional claim is rejected. Prosecution is ordinarily reopened in this situation by issuing a non-ACP action, i.e., an Office action prior to the ACP stage. If prosecution were reopened at the ACP stage, the patent owner loses rights as to amending the claims in response to the change in the examiner's position, because the patent owner's amendment rights are limited after ACP, - see MPEP § 2673.

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party 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 (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond).

DECISION

Patent owner ["petitioner"] argues that the Action Closing Prosecution ["ACP"] is improper and prosecution should be reopened. Among other things, the examiner rejected claims in the ACP in "Ground A" as being anticipated by a reference to Beggs. Both the Table of Contents of the ACP and the heading of Ground A list claims 1, 14, and 23 as rejected in Ground A. ACP pp. 2, 8. The body of the rejection supplies a claim chart addressing the limitations of claim 1 and explains that claims 14 and 23 have substantially the same limitations as claim 1, therefore it instructs to look to the rejection of claim 1. The body of the rejection also gives a heading for claim 20 and states "Independent claim 20 recites substantially the same limitations as independent claim 1, and dependent claim 5, *supra*, and therefore, for remarks and rejection, see claims 1 and 5, *supra*." ACP p. 13. Petitioner's argument is that it is not clear whether claims 5 and 20 are to be included in the rejection, and if so, how they would be rejected as there is no application of the art to claim 5. Petitioner requests that the ACP be withdrawn and a new action issued to address this.

The Director does not agree that this situation requires the ACP be withdrawn. While the Director agrees that any rejection of claims 5 or 20 in Ground A is not explained or supported, it appears that, given that these claims were not included in the heading of the rejection or table of contents of the action and were not explained at all, their inclusion in Ground A is merely a typographical error. In any case, the situation here goes to the merits of the rejection of these claims, not to the propriety of the action itself. That is, just because a particular rejection is unsupported, confusing, or wholly improper does not render the entire action improper. Petitioner states that it cannot properly respond to any rejection of claims 5 and 20 because reasoning for the rejections are absent from the Office action. But petitioner has, in fact, responded to any rejection of claims 5 and 20 in the July 12, 2010 response at pp. 15-16. Very little response was needed, as any rejection of claims 5 and 20 was not supported in the action, but petitioner has indeed sufficiently responded.

The Director does caution the examiner that, if claims 5 and 20 were intended to be part of Ground A, and if the examiner again rejects those claims in Ground A with additional explanation, it would not be proper for the next action to be a Right of Appeal Notice ["RAN"].

In such case the Patent owner would not have had a sufficient opportunity to address the rejections of those claims as newly explained. *See* 2673.01(I). If those claims were not intended to be a part of Ground A, and the examiner simply drops those claims from Ground A, this would not prevent the next action from being a RAN. *See id.* (explaining that a new finding of patentability does not prevent a RAN).

This result is the most reasonable course of action in light of the circumstances of this case. Prosecution will not be halted or go backwards, which is to be avoided in light of the statutory mandate for special dispatch. Petitioner has argued against the merits of the rejections, and the examiner will consider these arguments in the next Office action. If the rejections are to be withdrawn, prosecution may go forward with a RAN, assuming such action is otherwise warranted. If the rejections are to be maintained, the examiner will have to thoroughly explain the rejections without making the next action a RAN, alleviating petitioner's concern that it has not had the opportunity to respond.

Accordingly, even if the particular rejections are improper, the ACP itself is not improper, and the petition is denied.

CONCLUSION

1. The petition filed July 12, 2010 is denied. The ACP is not withdrawn.

2. The response to the ACP and corresponding comments by the third party will be considered by the examiner in due course.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,475	05/19/2009	7179999	096001-0107	1283

22428 7590 02/25/2011

FOLEY AND LARDNER LLP
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WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

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KING & SPALDING
1180 Peachtree Street
Atlanta, GA 30309

Date:
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FEB 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000475
PATENT NO. : 7179999
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95000475	5/19/09	7179999	

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

EXAMINER	
JAMES R. MATTHEWS	
ART UNIT	**PAPER**
3999	20110225

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DATE MAILED:

FEB 25 2011

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Lando & Anastasi, LLP
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(For Patent Owner)

MAILED

FEB 25 2011

W. Scott Petty
King Spalding, LLP
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(For Requester)

CENTRAL REEXAMINATION UNIT

Foley and Lardner LLP
Suite 500
3000 K Street NW
Washington, DC 20007

(Courtesy Copy)

In re Clark *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,475
Filed: May 19, 2009
For: U.S. Patent No. 7,179,999 B2

: **DECISION**
: **DISMISSING PETITION**
: **TO WAIVE 37 C.F.R § 1.945(b)**

This is a decision on the December 17, 2010 patent owner petition entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND 37 C.F.R. § 1.945(b) IN *INTER PARTES* REEXAMINATION. The signature on the petition was ratified on January 11, 2011.

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

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

The petition is **dismissed as premature**.

BACKGROUND

1. On May 19, 2009, a request for *inter partes* reexamination of U.S. Patent Number 7,179,999 B2 was filed by the third party requester meeting the filing date requirements of 37 C.F.R. § 1.915; the resulting reexamination proceeding was given a filing date and assigned control number 95/000,475 ("the '475 proceeding").

2. On July 17, 2009, an order granting reexamination of the '999 patent was mailed in the '475 proceeding, and a non-final Office action was mailed in the '475 proceeding.

3. Prosecution advanced to the point at which, on December 6, 2010, patent owner filed a submission in response to the outstanding Office action, a non-final Office action, including a proposed amendment to the claims. However, patent owner later discovered additional evidence.

4. On December 17, 2010, the instant petition entitled "Patent Owner's Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. §1.945(b)" was filed seeking entry of the additional evidence. On the same date, patent owner filed a "Supplemental Response Under 37 C.F.R. §1.945(b)"for the same purpose.

5. On January 5, 2011, third party requester filed comments.

6. On January 11, 2011, patent owner filed papers ratifying signatures affixed to the December 17, 2010 papers.

PERTINENT REGULATIONS

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.951 provides:

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

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

37 C.F.R. § 1.945(b) provides:

> Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
> (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
> (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
> (3) A compelling reason to enter the supplemental response.

DECISION

Patent owner files the instant petition under § 1.183 for waiver of § 1.945(b), to thereby gain entry of a supplemental response to a nonfinal Office action. However, patent owner has also stated, in the paper filed on the same date as the instant petition, that the supplemental response meets the requirements of § 1.945(b). As § 1.183 affords extraordinary relief, waiver under that rule would not be granted where a submission would be proper under the rule itself. Furthermore, should the submission be entered under § 1.945(b) as requested by patent owner, the instant petition would be moot as the desired relief would have been granted.

The supplemental response will be addressed under § 1.945(b). Therefore, any question of waiver of § 1.945(b) is not ripe for review by the Office at this time.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 C.F.R. § 1.33(c), and it is that of Lando & Anastasi, LLP, One Main Street, Suite 1100, Cambridge, MA 02142. Accordingly, all future correspondence will be directed to that address, until patent owner changes the correspondence address of record in the patent (form PTO/SB/123 may be used).

CONCLUSION

- The petition is **dismissed as premature**.
- Prosecution of the reexamination proceeding will continue before the Central Reexamination Unit.

- 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

February 23, 2011
Kenpet8/

Change of Address
Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the USPTO of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address must be signed by an attorney or agent of record.

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Notification of Withdrawal of Attorney
A power of attorney or authorization of agent may be revoked at any stage in the proceedings of an application, and a registered attorney or agent may withdraw, upon application to and approval by the USPTO. The applicant or patent owner will be notified of the withdrawal of the registered attorney or agent by the USPTO.

Customer Number Update
The Electronic Business Center (EBC) is the USPTO contact for establishing Customer Numbers. A Customer Number is uniquely assigned by the USPTO and associates a single correspondence address and group of patent practitioners with submitted patents and applications. It is used to permit online customer access to patent application status information (Private PAIR) and required to file an electronic patent application using EFS. To send a change of correspondence address for each file, applicant's attorney can use the USPTO assigned Customer Number to expedite the process. When a change of correspondence address is registered by the EBC, this information is entered into the IFW.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,475	05/19/2009	7179999	096001-0107	1283

22428 7590 06/24/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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Date:

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JUN 24 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000475
PATENT NO. : 7179999
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

Matthew A. Smith : (For Patent Owner)
FOLEY AND LARDNER LLP :
SUITE 500 :
3000 K STREET NW :
WASHINGTON, DC 20007 :

Scott Petty : (For Third Party
KING & SPALDING : Requester)
1180 PEACHTREE STREET :
ATLANTA, GA 30309 :

In re: Clark *et al.* :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,475 : UNDER 37 CFR § 1.181
Deposited: May 19, 2009 :
For: U.S. Patent No.: 7,179,999 :

This is a decision on a petition filed by the patent owner on June 2, 2011, entitled: "EMERGENCY PETITION UNDER 37 C.F.R. § 1.181 REQUESTING THAT THE ACTION CLOSING PROSECUTION BE VACATED AND A NON-FINAL OFFICE ACTION ISSUED" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to reopen prosecution in light of an allegedly improper Action Closing Prosecution.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,179,999 issued on February, 20, 2007.
- A request for *inter partes* reexamination was filed on May 19, 2009 and assigned control no. 95/000,475.
- *Inter partes* reexamination was ordered and prosecution progressed until a non-final Office action was mailed on October 4, 2010.
- An Action Closing Prosecution was mailed for the proceeding on May 24, 2011.
- On June 2, 2011, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.949 Examiner's Office Action Closing Prosecution in *Inter Partes* Reexamination

> 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.

DECISION

Patent owner ["petitioner"] argues that the Action Closing Prosecution ["ACP"] is improper and prosecution should be reopened because the ACP includes a new ground of rejection not necessitated by amendment. An 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." 37 CFR § 1.949. Petitioner argues that the ACP

improperly includes a new ground of rejection of unamended claims, as rejection "D" has been changed since the previous action.

The issue of whether a ground of rejection is "new" and precludes an ACP (or a final rejection)[1] is not subject to appeal, therefore we have little case law on the issue. Nor is there much in the way of MPEP guidance. We can, however, look at the MPEP and case law for the analogous issue of whether the Board has issued a new ground of rejection. While the situations are not identical, they rest on the similar premise that the appellant/patent owner should be given an opportunity to address a rejection before appeal. *See* 37 CFR § 1.949 (action will not usually close prosecution if it includes a new ground of rejection not previously addressed by patent owner); *Kronig, infra* (rejection is new if appellant has not had an opportunity to address the thrust of the rejection). Such case law therefore does carry some weight and will be examined.

"[T]he ultimate criterion of whether a rejection is considered "new" . . . is whether [the parties] have had a fair opportunity to react to the thrust of the rejection." *In re Kronig*, 190 USPQ 425, 426 (CCPA 1976). "Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection." MPEP § 1207.03(III) (citing *Kronig*). Merely providing additional explanation in response to an appellant's arguments does not necessarily change the thrust of the rejection. *In re Jung*, 98 USPQ2d 1174, 1180 (Fed. Cir. 2011). However, finding new facts regarding the differences between the invention and the prior art might constitute a new rejection, which in fairness requires an opportunity for response. *In re Kumar*, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005).

In the instant case, we are concerned with rejection "D" and whether it is a new ground in the ACP different from that of the non-final rejection. *See* Non-final Rejection mailed October 4, 2010, pp. 36-45; ACP mailed May 24, 2001, pp. 41-51. In each action, unamended claims 1-4, 6, 7, and 13-16 are rejected under the same statutory basis (35 U.S.C. 103). In the non-final, the rejection was over the references Backmann, Roberts, Clark, and Gaeris. In the ACP, the rejection was over the references Backmann, Roberts, Clark, Gaeris, and the admitted prior art.

It is a clear that the rejection in the ACP is a new ground, having a new and different thrust than that of the non-final action. First, the rejection in the ACP relies on an additional "reference" in that it relies on the teachings of the admitted prior art, teachings that were not relied upon in the earlier rejection. *See* ACP pp. 48-50. The evidence is therefore not the same as the evidence presented in the prior Office action. While the admitted prior art appears to only be used for buttressing the argument by providing additional examples of what was known in the prior art

[1] "The criteria for issuing an ACP is analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application." MPEP § 2671.02.

and reasoning to combine, it remains that this new evidence is a part of the rejection, and the examiner even included it in the rejection heading on page 41. *See In re Waymouth*, 179 USPQ 627, 629 (CCPA 1973) (merely advancing an additional reason for affirming the examiner, with wholly different reasoning, was a new rejection); *see also In re Hoch*, 166 USPQ 406, 407 n.3 (CCPA 1970) (where a reference is relied upon to support a rejection, even in a minor capacity, it is a part of the rejection). Patent owner has never had an opportunity to respond to this rejection including the teachings of the admitted prior art.

Additionally, the examiner has relied on new teachings from the old references to support the rejection. For example, in the non-final action the examiner relied solely on Backmann as teaching "an unshielded twisted pair communications cable." Non-final Rejection pp. 39-40. In the ACP, however, the examiner stated that Backmann teaches "a twisted pair communications cable" and relied upon Roberts as showing it obvious to use an unshielded cable. ACP pp. 43-45. It is apparent that the thrust of the rejection has been altered, as before patent owner only had to respond to whether Backmann included the "unshielded" limitation, whereas now patent owner must respond to whether Roberts teaches this feature, and whether it would have been obvious to modify Backmann to include it. Even if these references are the same, the rejection itself, at least as to this limitation, is quite different.

Accordingly, the Director finds that the ACP included a new ground of rejection that was not previously addressed by patent owner or necessitated by an amendment. As 37 CFR § 1.949 states that such an action will not usually close prosecution, the action should have been a non-final Office action. The petition filed June 2, 2011 is granted.

As to the relief sought, the Director sees no reason to physically reissue the action; the action is the same, except it is re-characterized as a non-final Office action rather than an ACP. The date of the action is considered to be the mailing date of this decision. Additionally, patent owner has already had approximately one month to reply to the ACP. The procedural and strategic differences in responding to these different types of action (for example the types of evidence that might be presented) necessitate additional time to reply, but as patent owner has already been aware of the substance of the action for an entire month, a full normal two-month period is unnecessary. Accordingly, patent owner is given one month from the mailing date of this decision to respond to the action, keeping in mind that the action is the same as that issued May 24, 2011 but is a non-final Office action.

If, upon the mailing of this decision, patent owner has already responded to the ACP, such response will not be considered a response to the action, as the action does not, in effect, exist until the date of this decision. Patent owner must re-file any such response within one month of the date of this decision, or must file a ratification stating that the already-filed submission is to be considered the response. The date of service of any such re-filing or ratification would then

be considered the date of service triggering the time period for third party comments under 37 CFR § 1.947.

CONCLUSION

1. The petition filed June 2, 2011 is granted. The ACP mailed May 24, 2011 is re-characterized as a non-final Office action, though the substance of the action remains the same.

2. Patent owner is given one month from the mailing date of this decision to file a response to the Office action under 37 CFR § 1.945.

3. If a response to the ACP has already been filed, it must either be re-filed or patent owner must file a ratification stating that the already-filed submission constitutes the response. Either must be done within the one month period from the date of this decision.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,476	07/13/2009	6998537	M0506-702650	8496

22428 7590 03/07/2011

FOLEY AND LARDNER LLP
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WASHINGTON, DC 20007

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DATE MAILED: 03/07/2011

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Date:
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MAR 07 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000476
PATENT NO. : 6998537
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95000476	7/13/09	6998537	

EXAMINER

LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE, MA 02142

ART UNIT	PAPER
3999	20110307

DATE MAILED: MAILED

MAR 07 2011

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(For Third Party Requester)

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Foley Lardner LLP
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Washington, DC 20007

(Courtesy Copy)

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MAR 07 2011

CENTRAL REEXAMINATION UNIT

In re Clark *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,476
Filed: July 13, 2009
For: U.S. Patent No. 6,998,537 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER § 1.182**

This is a decision on the January 19, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED RREEXAMINATION OF U.S. PATENT NO. 6,998,537."

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

The patent owner petition under 37 C.F.R. § 1.182 is dismissed.

BACKGROUND

- On May 19, 2009, a request for *inter partes* reexamination of claims 1-22 of U.S. Patent Number 6,998,537 B2 was deposited by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,476 ("the '476 proceeding"). The filing date requirements of 37 C.F.R. § 1.915 were met on July 13, 2009.

- On September 28, 2009, reexamination was ordered and a first Office action was mailed in the proceeding.

- Prosecution progressed, until, on March 30, 2010, an Office action closing prosecution ("ACP") was mailed, rejecting claims 1, 4-11, 15, and 17-34. Claims 2, 3, 12-14, and 16 have been canceled. No claims have been confirmed or found patentable.

- On April 28, 2010, patent owner filed a reply to the March 30, 2010 ACP.

- On May 28, 2010, third party requester filed comments responsive to the March 30, 2010 ACP and the April 28, 2010 patent owner reply.

- On June 24, 2010, patent owner filed an IDS; including numerous documents from the copending litigation styled *Belden Technologies v. Superior Essex Communications* No. 08-063, District Court in and for the District of Delaware. Patent owner submitted further documents from that litigation in an IDS filed on September 30, 2010.

- On January 19, 2011, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION OF U.S. PATENT NO. 6,998,537," seeking entry of ten evidence submissions (including over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony) and a publicly available product bulletin, and comments addressed to those evidence submissions.

PERTINENT STATUTES AND REGULATIONS

37 C.F.R. § 1.182 provides:

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

MPEP 2686 provides, in pertinent part:

> [T]he Office will, at any time, accept from any parties, for entry into the reexamination file, copies of notices of suits and other proceedings involving the patent and copies of decisions or papers filed in the court from litigations or other proceedings involving the patent. Such decisions include final court decisions (even if the decision is still appealable), decisions to vacate, decisions to remand, and decisions as to the merits of the patent claims. Non-merit decisions on motions such as for a new venue, a new trial/discovery date, or sanctions will not be entered into the patent file, and will be expunged from the patent file by closing the appropriate paper if they were entered before discovery of their nature. Further, papers filed in the court from litigations or other proceedings involving the patent will not be entered into the record (and will be expunged if already entered) if they provide a party's arguments, such as a memorandum in support of summary judgment. If the

argument has an entry right in the reexamination proceeding, it must be submitted via the vehicle (provision(s) of the rules) that provides for that entry right. It is not required nor is it permitted that parties submit copies of copending reexamination proceedings and applications (which copies can be mistaken for a new request/filing); rather, submitters may provide a notice identifying the application/proceeding number and its status. Any submission that is not permitted entry will be returned, expunged, or discarded, at the sole discretion of the Office.
It is to be noted that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive/lengthy, the Office may return, expunge or discard, at its sole discretion, all or part of the submission. In such an instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers.

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 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.

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 will 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. Furthermore, any such Office decision will also consider whether 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, such that prosecution would be furthered by the submission's entry.

In this instance, patent owner petitions for reopening of prosecution after the ACP based upon ten evidence submissions. These evidence submissions are from copending litigation involving

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

claim 19 of the '095 patent at issue in the instant '476 proceeding.[2] These ten evidence submissions include over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony. The court proceedings involved, in addition to the '537 patent at issue in the current proceeding, four other patents not at issue in the current reexamination proceeding. The evidence submission also includes a product bulletin, stated to be obtained from the internet, separate from the litigation proceeding.

The instant petition requests entry of evidence in the form of a publicly available product bulletin and a full transcript of a related court proceeding.

Entry of a publicly available document and/or court documents does not require reopening of prosecution for its entry;[3] thus, no basis for the reopening of prosecution has been provided. Should the ten evidence submissions (including over 1000 pages of transcripts of the court proceedings, including *voir dire*, opening statements, and witness testimony) not be entered, if information in the submissions raise a substantial new question of patentability not yet raised as to the '537 patent, patent owner may file a new request for reexamination based on such information, to the extent permitted by 35 U.S.C. § 301 *et seq*.

Further, if enterable, the product bulletin document may be entered into the proceeding through an IDS submission. With respect to the court transcripts, to the extent that submission of the proceedings would be limited to bare notice and copies of such proceedings, may be enterable under 37 C.F.R. § 1.985. *See* MPEP 2686 for the criteria for such entry. Furthermore, the court transcripts are overwhelmingly directed to material not germane to the merits of the instant reexamination proceeding. The transcripts include discussions extraneous to the merits of the proceeding such as *voir dire*. The transcripts further are directed to discussions of references not applied to rejections in the current proceeding (*e.g.*, U.S. 5,796,046); and further, are directed to patents not under reexamination in the instant proceeding (i.e., the '999, '503, '491, and '095 patents).

As a final point, neither the product bulletin nor the transcripts have been denied entry as yet by the examiner. The Notice upon which petitioner relies clearly states 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 an action closing prosecution in an *inter partes* reexamination proceeding. As the evidence submissions have not been denied entry, the petition fails to meet that requirement of the Notice upon which it relies.

For these reasons, relief under § 1.182 would be inappropriate in the present proceeding.

Additional discussion:

It is further noted that the petition provided no showing that need for evidence was occasioned by positions first taken by the Office in the ACP; rather petitioner attempts to show that

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[2] *Belden Technologies v. Superior Essex*, No. 08-063, District Court in and for the District of Delaware.

[3] *See, e.g.*, the IDS filed by patent owner on June 24, 2010 and September 13, 2010, containing numerous documents from the copending litigation.

availability of evidence only occurred after ACP. However, as the prospective submission addresses issues arising at an earlier point in the prosecution, petitioner did not aver that the evidence in the submission could not have been presented earlier. For example, petitioner states that the product bulletin was discovered only on December 16, 2010, despite being known to petitioner at a much earlier date. Petitioner has not provided a reason for the delay in locating and submitting the product bulletin, despite its alleged relevance, in accordance with the language of 37 C.F.R. § 1.555(a).[4]

It is additionally noted that, of the twenty-seven claims (1, 4-11, 15, and 17-34) currently under rejection in the instant reexamination proceeding, only one was addressed in the court. It is also noted that evidence of secondary considerations of nonobviousness may be brought in through an affidavit so long as the regulations (*e.g.*, 37 C.F.R. § 1.116) provide for a right of entry.

In view of the above, the petition is **dismissed**.

PATENT OWNER'S ADDRESS

The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c). The current correspondence address of record for the 6,998,537 patent file is that of Lando & Anastasi, LLP One Main Street, Suite 1100, Cambridge, MA 02142. However, the correspondence address of record in the reexamination file is that of Foley & Lardner LLP, 3000 K Street NW Ste 600 Washington, DC 20007. As a courtesy, this decision is being mailed to both addresses.

The address of Lando & Anastasi LLP, One Main Street, Suite 1100, Cambridge, MA 02142, will be the sole address used in future correspondence, until a change in correspondence address in the 6,998,537 patent file is made in accordance with 37 CFR 1.33(c).

[4] 37 C.F.R. § 1.555(a) states: "Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. . . . Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible."

CONCLUSION

1. The January 19, 2011 petition for continued reexamination is **dismissed**.

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

3. The address of Lando & Anastasi LLP, One Main Street, Suite 1100, Cambridge, MA 02142, will be the sole address used in future correspondence, until a change in correspondence address in the 6,998,537 patent file is made in accordance with 37 CFR 1.33(c).

4. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

March 4, 2011
Kenpet8/...

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.
95/000,477	06/16/2009	7283340	26166-186902	8889

44564 7590 02/07/2011

BOND, SCHOENECK & KING, PLLC
10 BROWN ROAD, SUITE 201
ITHACA, NY 14850-1248

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/07/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANDREWS KURTH, LLP
1350 I STREET, NW
SUITE 1100
WASHINGTON, DC 20005

Date:
MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000477
PATENT NO. : 7283340
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,477 & 95/001,224 MAILED

FEB 07 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 01 February 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on 07 January 2011 which sets a one (1) month period for filing a response thereto, be extended by and additional two (2) months.

   - A. ☒ Petition fee per 37 CFR §1.17(g)):
     - i. ☐ Petition includes authorization to debit a deposit account.
     - ii. ☐ Petition includes authorization to charge a credit card account.
     - iii. ☐ Other: electronic payment via EFS.
   - 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 an additional one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
     ☒ Other/comment: MPEP § 2265 notes "requests for more than one month will be granted only in extraordinary situations."
   - B. ☐ Dismissed because:
     - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
     - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
     - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
     - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
     - v. ☐ The petition is moot.
     - vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/Mark Reinhart/_____ ____SPE AU 3992__
[*Signature*] (Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

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Bond, Schoeneck & King, PLLC
10 Brown Road, Suite 201
Ithaca, NY 14850-1248

(For Patent Owner)

Andrews Kurth LLP
1350 I Street, N.W.
Suite 1100
Washington, DC 20005

(For '477 Third Party Requester)

MAILED

DEC 16 2011

CENTRAL REEXAMINATION UNIT

Sutherland, Asbill & Brennan, LLP
999 Peachtree Street, NE
Atlanta, GA 30309-3996

(For '1224 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,477
Filed: June 16, 2009
For: U.S. Patent No. 7,283,340

Inter Partes Reexamination Proceeding
Control No. 95/001,224
Filed: October 22, 2009
For: U.S. Patent No. 7,283,340

DECISION DIMISSING PETITIONS AND EXPUNGING IMPROPER PAPER

This is a decision on: (1) the patent owner paper entitled "PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" (patent owner petition to strike corrected notice of cross appeal), filed on September 13, 2011, (2) the '1224 third party requester's paper entitled "THIRD-PARTY REQUESTER'S OPPOSITION PAPER IN RESPONSE TO THE PATENT OWNER'S PETITION TO DISMISS CORRECTED NOTICE OF CROSS APPEAL" (third party requester opposition), filed on October 13, 2011, and (3) the patent owner paper entitled "RESPONSE TO REQUESTER'S OPPOSITION PAPER IN RESPONSE TO PATENT OWNER'S PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" (patent owner opposition paper), filed on October 20, 2011.

The papers are before the Office of Patent Legal Administration.

In light of the November 17, 2011 communication from the Central Reexamination Unit (CRU), finding the '1224 third party requester's August 26, 2011 corrected notice of cross appeal defective, the September 13, 2011 patent owner petition to strike the corrected notice of cross appeal and the October 13, 2011 third party requester opposition are dismissed as moot.

IMPROPER PAPER

The patent owner petition to strike the '1224 third party requester's corrected notice of cross appeal was filed on September 13, 2011. The '1224 third party requester opposition to patent owner's petition to strike the corrected notice of cross appeal was filed on October 13, 2011. On October 20, 2011, patent owner filed an opposition paper in response to the October 13, 2011 third party requester opposition. The October 20, 2011 patent owner opposition paper is an unauthorized paper in the instant merged 95/000,477 and 95/001,224 reexamination proceeding (the merged proceeding). After an opposition to a patent owner petition is filed by a third party requester (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal or response to the third party requester opposition paper is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. See MPEP § 2267. There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, the October 20, 2011 patent owner opposition paper is an improper paper, and it will not be made of record in the files of the merged proceeding. Because the October 20, 2011 patent owner opposition paper has been scanned into the electronic Image File Wrapper (IFW) of the 95/001,224 proceeding, the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the merged proceeding. No copy of the October 20, 2011 patent owner opposition paper will be maintained of record in the Office. A copy of this decision will be made of record in the files of the merged proceeding.

CONCLUSION

1. The September 13, 2011 "PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" and October 13, 2011 "THIRD-PARTY REQUESTER'S OPPOSITION PAPER IN RESPONSE TO THE PATENT OWNER'S PETITION TO DISMISS CORRECTED NOTICE OF CROSS APPEAL" are dismissed as moot.

2. The October 20, 2011 "RESPONSE TO OPPOSITION PAPER IN RESPONSE TO PATENT OWNER'S PETITION TO DISMISS THIRD PARTY'S CORRECTED NOTICE OF CROSS APPEAL UNDER 37 C.F.R. §§ 1.182" is an improper paper and is being expunged from the record of the merged proceeding.

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

12-15-2011

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.
95/000,478	05/21/2009	7378992	2855.002REX5	7980

26111 7590 09/28/2010

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,478	05/21/09	7378992	080272-0019

MCDERMOTT WILL & EMERY LLP
600 13th STREET,NW
WASHINGTON, DC 20005-3096

EXAMINER
TON, MY TRANG

ART UNIT	PAPER
3992	

DATE MAILED:
MAILED
SEP 28 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,478	05/21/09	7378992	080272-0019

MCDERMOTT WILL & EMERY LLP
600 13th STREET,NW
WASHINGTON, DC 20005-3096

EXAMINER
TON, MY TRANG

ART UNIT	PAPER
3992	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

: (For Patent Owner)

MAILED

SEP 28 2010

CENTRAL REEXAMINATION UNIT

Kenneth L. Cage, Esq.
McDERMOTT WILL & EMORY
600 13th Street NW
Washington DC 2005-3096

: (For *Inter Partes* Requester)

In re Fallon
Inter partes Reexamination Proceeding
Control No.: 95/000,478
Filed: May 21, 2009

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

This is a decision on the September 14, 2010 patent owner "Petition for an Extension of time Pursuant to 37 CFR § 1.956," requesting the time for responding to the Office action mailed August 23, 2010 to be extended by two-months.

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

The petition is Dismissed for the reasons set forth below.

Statement of Relevant Facts

1. On May 28, 2009 a request was deposited for *inter partes* reexamination with the Office requesting claims 1-4, 7-15, 18-21, 26-29, 32, 33 and 36 of US Patent 7,378,992 (the '992 patent) be reexamined. The request was assigned Control No. 95/000,478 ('478 request).

2. On August 13, 2009 the Office issued an order granting the '478 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that claims 1-4, 7-15, 18-21, 26-29, 32, 33 and 36 would be subject to reexamination.

3. On December 15, 2009, the Office issued a first Office action on the merits setting a two month period for response.

4. On December 28, 2009 patent owner requested a two month extension of time for preparing a response. The Office granted a one month extension on December 30, 2009.

5. On March 15, 2010, an response was received from owner. Third party requester did not file a response to the Office action.

6. On August 12, 2010 a change in power of attorney was received from owner.

7. On August 25, a petition was filed under 35 USC 317(b) and 37 CFR 1.907(b) to terminate the instant proceeding.

8. On August 23, 2010 the Office issued an Action Closing Prosecution (ACP).

9. On September 17, 2010 the instant petition for a two month extension of time was filed.

Discussion

The Patent Owner requested a two (2) month extension of time on September 14, 2010 in which to file a response to the Office action was mailed August 27, 2010. The Office action provided a one (1) month period for response. The petition request included payment for the $200 petition fee under 37 CFR §1.17 (g). This is the second request for reconsideration for the extension of time in this *inter partes* proceeding.

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

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

> As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...
>
> Evaluation of whether "sufficient cause" has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...
>
> Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

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

Decision

Patent owner requests, pursuant to 37 CFR 1.956, that the time for responding to the Office action mailed August 27, 2010 to be extended by two-months. It is noted the petition is entitled as requesting an extension of time "To file Appellant's Brief on Appeal" which is being viewed as a typographical error in that the instant file is not presently under appeal.

In the petition, owner submits that he filed petitions prior to the ACP being issued and that if granted the proceeding would terminate. Owner submits he must commit significant resources to prepare a full and complete response to the ACP which would become moot if the petition to terminate were granted. Owner further argues that the extension is justified as he has responses due in other additional proceedings. See pages 3-4 of the petition.

The petition fails to demonstrate sufficient cause to warrant the requested extension of time. No discussion of the efforts to date patent owner has taken to provide a response and why in spite of those actions the requested additional time is necessary. No factual accounting of reasonably diligent behavior has been provided. It is further noted prosecution of the instant *inter partes* reexamination proceeding has been pending over one year. Even a modest extension of one month at this point in the proceeding, absent sufficient cause, would impact the mandate for special dispatch. Finally, it is noted that the mere filing of a petition does not render the proceeding in stasis until the petition decision is rendered.

On balance, it does not appear patent owners reasoning as to why additional time is needed, in light of the review actions taken thus far outweigh the need for special dispatch given the prolonged prosecution in the instant proceeding. Sufficient cause has not been shown.

Therefore, the request fails to meet the requirements as outlined in MPEP 2665 for granting of a request for extension of time under 37 CFR 1.956.

The petition for extension of time is hereby dismissed.

Conclusion

1. The Patent Owner's petition for reconsideration of the extension of time filed on September 1, 2010 is dismissed.

2. The period for response is not extended beyond the shortened statutory period for response of one (1) month as recited in the outstanding Office action mailed August 27, 2010.

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
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Central Reexamination Unit

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

/J. Harrison/

J. Harrison
Supervisory Patent Examiner AU 3992
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,478	05/21/2009	7378992	2855.002REX5	7980

26111 7590 01/25/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,478	05/21/09	7378992	080272-0019

MCDERMOTT WILL & EMERY LLP
600 13th STREET,NW
WASHINGTON, DC 20005-3096

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ART UNIT	PAPER
3992	

DATE MAILED:
MAILED
JAN 25 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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McDermott Will & Emery, LLP (For Requester)
600 13th Street, N.W.
Washington, D.C. 20005-3096

MAILED

JAN 25 2011

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne, Esq. (For Patent Owner)
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

In re Fallon :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/000,478 : **DISMISSING**
Filing Date: May 27, 2008 : **PETITION**
For: U.S. Patent No.: 7,378,992 :

This is a decision on the following petition, filed on August 25, 2010:

- The patent owner petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (the patent owner petition to terminate); and

The August 25, 2010 patent owner petition to terminate, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

The $400 fee under 37 CFR 1.17(f) for the August 25, 2010 petition has been paid.

SUMMARY

The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

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 August 25, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

The patent owner argues that termination of the '464 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). 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 argues that, pursuant to the statute, a final decision has been entered against the requester/co-defendant in a civil action. The patent owner has provided a copy of a stipulated order of dismissal by the United States District Court for the Eastern District of Texas, Tyler Division (district court) on January 26, 2010, between the patent owner/plaintiff, Realtime Data,

Inc., and requester/co-defendant Blue Coat Systems, 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 *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010), the district court ordered "that said stipulation is in all things granted", and that the action [before the district court] "including the amended complaint, answers and counterclaims, be dismissed with prejudice, pursuant to the Settlement and License Agreement dated January 12, 2010 executed by the parties". The district court further ordered that that "this Court shall retain continuing jurisdiction over the parties and the subject matter to enforce the aforesaid Settlement and License Agreement", 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 January 26, 2010 district court judgment is deemed 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

The patent owner further argues that, pursuant to the statute, "[t]he Order of Dismissal was a final decision that Blue Coat did not sustain its burden of proving the invalidity of any patent claim" in suit. Citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1473 (Fed. Cir. 1989), the patent owner states that "[a] stipulated judgment in a District Court litigation 'operates as an adverse adjudication on the merits of a claim'". The patent owner points out that the requester, who had the burden of proving invalidity, "stipulated by agreement to dismiss its invalidity defenses and counterclaims with prejudice". Thus, argues the patent owner, "the Order of Dismissal establishes that the Requester did not sustain its burden of proving invalidity in the District Court litigation".

In *Hartley*, however, the issue of validity was actually litigated in an earlier suit, when a court ruled on summary judgment that the patent was invalid under 35 U.S.C. 102(b). The parties then settled and a stipulated judgment was entered dismissing the plaintiff's (Hartley's) infringement claim. The judgment did not address the invalidity ruling already entered by the court. Hartley later sued a different defendant, Mentor, on the same patent, who defended on issue preclusion grounds, i.e., that the patent was already held invalid in the earlier litigation. Hartley argued that issue preclusion did not apply because the earlier suit had been finally resolved via a stipulated judgment, i.e., that any preclusive effects of the earlier invalidity judgment were erased when the earlier suit settled with a stipulated judgment. The Federal Circuit disagreed. "Where rulings made after a full and fair opportunity to litigate are firm and consistent with the subsequent settlement agreement by the parties and judgment actually entered into the case, issue preclusion has been applied as to those issues when raised in a subsequent suit." *Hartley v. Mentor Corp.*, 869 F.2d at 1472. The court further noted that "a stipulated final judgment may rest in part on a court's rulings during the course of a trial," and such a judgment "like a contract, must be construed to determine its effect in light of all the circumstances." *Id.* The issue preclusion in

[1] See Exhibit E, Order of Dismissal, *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010). Exhibit E is attached to the present petition.

Hartley was created by the actual litigation and *summary judgment* of invalidity, and not by the dismissal.

Unlike *Hartley*, however, the issue of invalidity was never actually litigated in the present case. The present case solely involves a 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). Finally, while the Federal Circuit in *Hartley* suggested that a stipulated judgment should be construed like a contract to determine its effect, the patent owner in the present case points to no language in the court's dismissal or in the related Settlement and License Agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue. In fact, the Settlement and License Agreement expressly states that "the issues in the Action are disputed".[2] Thus, 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 action was 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, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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).

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 the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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 August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

CONCLUSION

- The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

[2] See Exhibit D, "Settlement and License Agreement between Realtime Data, LLC D/B/A, IXO and Blue Coat Systems, Inc.", page 2. Exhibit D is attached to the present petition.

- 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.
95/000,479	05/28/2009	7161506	2855.002REX3	2572

26111 7590 01/25/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MCDERMOTT WILL & EMERY LLP
600 13TH STREET N.W.
WASHINGTON, D.C. 20005-3096

Date:

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JAN 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000479
PATENT NO. : 7161506
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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McDermott Will & Emery, LLP (For Requester)
600 13th Street, N.W.
Washington, D.C. 20005-3096

Robert Greene Sterne, Esq. (For Patent Owner)
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Ave, N.W.
Washington, D.C. 20005-3934

MAILED
JAN 25 2011
CENTRAL REEXAMINATION UNIT

In re Fallon :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/000,479 : **DISMISSING**
Filing Date: May 28, 2009 : **PETITIONS**
For: U.S. Patent No.: 7,161,506 :

This is a decision on the following petitions, filed concurrently on August 25, 2010:

- The patent owner petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (the patent owner petition to terminate); and

- The patent owner petition under 37 C.F.R. 1.183, entitled "Petition Under 37 C.F.R. 1.183 to Transfer Jurisdiction of *Inter Partes* Reexamination" (the patent owner petition to transfer jurisdiction).

The August 25, 2010 patent owner petitions to terminate and to transfer jurisdiction, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

The $400 fee under 37 CFR 1.17(f) for each petition has been paid.

SUMMARY

The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

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 August 25, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

The patent owner argues that termination of the '464 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). 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 argues that, pursuant to the statute, a final decision has been entered against the requester/co-defendant in a civil action. The patent owner has provided a copy of a stipulated order of dismissal by the United States District Court for the Eastern District of Texas, Tyler Division (district court) on January 26, 2010, between the patent owner/plaintiff, Realtime Data, Inc., and requester/co-defendant Blue Coat Systems, 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 *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010), the district court ordered "that said stipulation is in all things granted", and that the action [before the district court] "including the amended complaint, answers and counterclaims, be dismissed with prejudice, pursuant to the Settlement and License Agreement dated January 12, 2010 executed by the parties". The district court further ordered that that "this Court shall retain continuing jurisdiction over the parties and the subject matter to enforce the aforesaid Settlement and License Agreement", 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 January 26, 2010 district court judgment is deemed 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

The patent owner further argues that, pursuant to the statute, "[t]he Order of Dismissal was a final decision that Blue Coat did not sustain its burden of proving the invalidity of any patent claim" in suit. Citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1473 (Fed. Cir. 1989), the patent owner states that "[a] stipulated judgment in a District Court litigation 'operates as an adverse adjudication on the merits of a claim'". The patent owner points out that the requester, who had the burden of proving invalidity, "stipulated by agreement to dismiss its invalidity defenses and counterclaims with prejudice". Thus, argues the patent owner, "the Order of Dismissal establishes that the Requester did not sustain its burden of proving invalidity in the District Court litigation".

In *Hartley*, however, the issue of validity was actually litigated in an earlier suit, when a court ruled on summary judgment that the patent was invalid under 35 U.S.C. 102(b). The parties then settled and a stipulated judgment was entered dismissing the plaintiff's (Hartley's) infringement claim. The judgment did not address the invalidity ruling already entered by the court. Hartley

[1] See Exhibit E, Order of Dismissal, *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010). Exhibit E is attached to the present petition.

later sued a different defendant, Mentor, on the same patent, who defended on issue preclusion grounds, i.e., that the patent was already held invalid in the earlier litigation. Hartley argued that issue preclusion did not apply because the earlier suit had been finally resolved via a stipulated judgment, i.e., that any preclusive effects of the earlier invalidity judgment were erased when the earlier suit settled with a stipulated judgment. The Federal Circuit disagreed. "Where rulings made after a full and fair opportunity to litigate are firm and consistent with the subsequent settlement agreement by the parties and judgment actually entered into the case, issue preclusion has been applied as to those issues when raised in a subsequent suit." *Hartley v. Mentor Corp.*, 869 F.2d at 1472. The court further noted that "a stipulated final judgment may rest in part on a court's rulings during the course of a trial," and such a judgment "like a contract, must be construed to determine its effect in light of all the circumstances." *Id.* The issue preclusion in *Hartley* was created by the actual litigation and *summary judgment* of invalidity, and not by the dismissal.

Unlike *Hartley*, however, the issue of invalidity was never actually litigated in the present case. The present case solely involves a 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). Finally, while the Federal Circuit in *Hartley* suggested that a stipulated judgment should be construed like a contract to determine its effect, the patent owner in the present case points to no language in the court's dismissal or in the related Settlement and License Agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue. In fact, the Settlement and License Agreement expressly states that "the issues in the Action are disputed".[2] Thus, 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 action was 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, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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).

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 the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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.

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[2] See Exhibit D, "Settlement and License Agreement between Realtime Data, LLC D/B/A, IXO and Blue Coat Systems, Inc.", page 2. Exhibit D is attached to the present petition.

Accordingly, the August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

II. The August 25, 2010 Patent Owner Petition under 37 CFR 1.183 to Transfer Jurisdiction to OPLA

The patent owner requests that jurisdiction of the present reexamination proceeding be transferred from the Central Reexamination Unit (CRU) to the Office of Patent Legal Administration (OPLA) until a decision on the petition to terminate (also filed on August 25, 2010) has been decided. The present petition under 37 CFR 1.183 is taken as a petition under 37 CFR 1.182.[3]

In essence, the patent owner requests that OPLA take control of the present proceeding to prevent the CRU from taking any further action until OPLA decides the petition to terminate *inter partes* reexamination. This is essentially a request to delay the prosecution in this proceeding. Such a petition is contrary to the statutory mandate that *inter partes* reexamination proceedings be conducted with special dispatch in the Office (35 U.S.C. § 314(c)). Accordingly, the petition is dismissed. [4]

In addition to the above, the patent owner's request, i.e., that OPLA take jurisdiction until a decision on the petition to terminate has been issued, is moot because a decision on the petition to terminate has now been rendered.

For all of the foregoing reasons, the petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182 to transfer jurisdiction, is **dismissed**.

CONCLUSION

- The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

- The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

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[3] A petition under 37 CFR 1.183 requires waiver of the rules, and requires a showing of extraordinary circumstances, such that justice requires waiver of the rule. The requested relief, however, has not been shown to require waiver of a rule in the present instance. Furthermore, the patent owner fails to request a waiver of an identified rule. Since transfer of jurisdiction is not specifically provided for in the rules, the present petition is taken under 37 CFR 1.182.

[4] To the extent the patent owner may be relying on MPEP § 2686.04(III) as a basis for submitting the instant petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding, this reliance is misplaced as that section is directed to the situation where such petition is accompanied by a petition to suspend a reexamination proceeding, which must be supported by a showing of "good cause", which did not occur here.

- 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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Date:

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MAR 25 2011
CENTRAL REEXAMINATION U

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000479
PATENT NO. : 7161506
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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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(For Patent Owner)

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

MAILED
MAR 25 2011
CENTRAL REEXAMINATION UNIT

(For Requester)

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096.

In re: Fallon
Reexamination Proceeding
Control No. 95/000,479
Request Deposited: May 28, 2009
For: U.S. Patent No. 7,161,506

This is a decision on the September 14, 2010 paper entitled "Petition to Vacate Action Closing Prosecution or, In Alternative, for Extension of Time to File Appellant's Brief on Appeal Pursuant to 37 CFR §1.550(c)".

Initially, it is noted that the present proceeding is an *inter partes* reexamination and 37 CFR §1.550(c) pertains to extensions of time for *ex parte* reexaminations. Furthermore, 37 CFR 41.66 states, in part, "[t]he time for filing an appellant's brief or an amended appellant's brief may not be extended."

Additionally, 37 CFR 1.4(c) states:

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

Finally, the requested relief is based on the filing of a petition to terminate the proceeding, which was dismissed on January 25, 2011.

In view of the above, the petition is **dismissed**.

CONCLUSION

1. The petition is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611

Eric Keasel
SPE, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 09/29/2010

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP SUITE 1100
777 6TH STREET N.W.
WASHINGTON, D.C. 20001

Date:

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SEP 2 9 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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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CENTRAL REEXAMINATION UNIT

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Mountain View, CA 94039-0460

In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,480
Filed: June 15, 2009
For: U.S. Patent No. 7,475;180

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the September 3, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission, "or, in the alternative" waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration).

The September 3, 2010 requester petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The September 3, 2010 requester petition is **dismissed**.

The revised Richter 37 CFR 1.132 rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 6, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 5, 2010, the requester filed its comments submission.

Also on February 5, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 4, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 6, 2010 response submission, and requester's February 5, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

DECISION

The September 3, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

The requester requests entry and consideration of a supplement to requester's July 19, 2010 comments submission, i.e., a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition. The requester requests a waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission "or, in the alternative", a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission.

The July 19, 2010 Corrected Requester Comments Submission Fails to Comply with 37 CFR 1.943(b)

The July 19, 2010 corrected requester comments submission includes a 38-page remarks paper, a two-page single-spaced declaration under 37 CFR 1.132 by Frans Tol (the Tol declaration), a 10-page single-spaced declaration under 37 CFR 1.132 by Jake Richter (the Richter rebuttal declaration), and a three-page double-spaced declaration under 37 CFR 1.132 by Wim van Maasakkers (the van Maasakkers declaration). Furthermore, the July 19, 2010 corrected requester comments submission incorporates the double-spaced corrected Richter and Ryan declarations filed on June 28, 2010 (see page 3 of the July 19, 2010 comments submission).

The Tol, van Maasakkers, and corrected Ryan declarations are determined to be free of legal argument.

The original Richter rebuttal declaration is a duplicate of the original Richter rebuttal declaration filed with the February 5, 2010 original requester comments submission, and is replete with legal argument for the same reasons given in the June 4, 2010 decision. If the 10-page single-spaced declaration were **double-spaced, as required on pages 11-12 of the June 4, 2010 decision**, the declaration would be at least 15 pages long.

Furthermore, the 37-page corrected Richter declaration filed on June 28, 2010, which is incorporated on page 3 of the corrected comments submission, and which is replete with legal argument for the same reasons set forth in the June 4, 2010 decision, is also included in the page count.

Accordingly, the 38-page remarks section, the at least 15 pages of the Richter rebuttal declaration, and the 37-page corrected Richter declaration, totaling at least **90** pages, are subject to the 50-page limit.

The requester, however, has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). The requester states that it has made every effort to make the comments as brief as possible. The requester, however, provides no explanation for the need for **40** additional pages.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. The requester provides no facts to establish an extraordinary situation where justice requires suspension of the rule to permit the filing of an additional 40 pages. The failure of requester to comply with the rules does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

Furthermore, the Tol and original Richter rebuttal declarations are single-spaced, contrary to the June 4, 2010 decision, which expressly stated on pages 11-12, in bold print:

> **To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:**
>
> **1) is double-spaced;**
> **2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);**
> **3) has a font size no smaller than 12-point;**
> **4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and**
> **5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).**
>
> **See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.**

In addition, the June 4, 2010 decision expressly stated, on page 13:

> Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. . See MPEP 2609 which 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.

Upon reconsideration, however, the requester is given one opportunity to correct the above-discussed defects. The June 4, 2010 decision determined that the January 6, 2010 patent owner response was improper. The January 6, 2010 patent owner response was expunged, the February 5, 2010 requester petition was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was also improper and was expunged. Had the January 6, 2010 patent owner response been properly filed, and had the February 5, 2010 requester petition been directly dismissed for the reasons provided to the requester by the Office in an advisory capacity in the June 4, 2010 decision, the Office would not have been permitted to allow the requester another opportunity for resubmission. However, the June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response", as set forth in MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. **However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response.** Supplemental third party comments are also permitted in response to a supplemental patent owner response.

Accordingly, the July 19, 2010 requester petition is **dismissed**. The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

The "Alternative" Petition under 37 CFR 1.183 for Waiver of 37 CFR 1.947

The requester requests, "in the alternative", a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission. However, any "alternative" petition must be submitted under separate cover pursuant to 37 CFR 1.4(c). Accordingly, the "alternative' petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.947 will not be addressed on the merits.

The Filing of the September 3, 2010 Declaration Under 37 CFR 1.132 by Jake Richter is Improper

The filing of the declaration under 37 CFR 1.132 by Jake Richter, deposited on September 3, 2010 (the revised Richter rebuttal declaration) is improper. The requester timely filed a corrected comments submission on July 19, 2010, in response to the June 18, 2010 corrected patent owner response submission. The date of service of the June 18, 2010 corrected patent owner response submission is also June 18, 2010.

35 U.S.C. 314(b)(2) provides (emphasis added):

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

By statute, therefore, the requester is permitted only **one opportunity** to file written comments addressing issues raised by the Office action or by patent owner's response thereto. The **30-day time period** to file requester's comments is also a statutory requirement. **Statutory requirements cannot be waived.** 37 CFR 1.947 tracks the language of the statute and provides, in pertinent part (emphasis added):

> . . . may **once** file written comments **within a period of 30 days from the date of service of the patent owner's response**. These comments shall be limited to issues raised by the Office action or the patent owner's response."

The statute does not permit the filing of a supplemental requester comments submission, because the requester is statutorily given only "one" opportunity to file a written

comments submission that is a proper paper, after each patent owner response. See also MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> **Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed.** Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

In the present case, the June 4, 2010 decision determined that the January 6, 2010 patent owner response was improper. The January 6, 2010 patent owner response was expunged, the February 5, 2010 requester petition under 37 CFR 1.183 to waive the page length requirements of 37 CFR 1.943(b) for requester's February 5, 2010 comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was also improper and was expunged. In response to the June 4, 2010 decision, the patent owner filed the June 18, 2010 corrected patent owner response submission. The July 19, 2010 corrected requester comments submission was filed after patent owner's June 18, 2010 corrected response submission, which is a "completion of a proper response", as permitted by MPEP 2667. Thus, the revised Richter declaration deposited on September 3, 2010, in addition to being untimely filed (outside the statutory 30 day period), is clearly a submission which is supplemental to the July 19, 2010 corrected requester comments submission, and is **improper**.

Accordingly, the revised Richter rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

Additional Comment

As expressly discussed on page 12 of the June 4, 2010 decision and in the companion decision mailed on even date, the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective** for the reasons given in those decisions. A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

CONCLUSION

- The September 3, 2010 requester petition is **dismissed**.

- The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

- The "alternative" September 3, 2010 requester petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.947 will not be addressed on the merits.

- The revised Richter rebuttal declaration, deposited on September 3, 2010, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,022, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- 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

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 09/29/2010

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MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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WASHINGTON, D.C. 20001

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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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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In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,480
Filed: June 15, 2009
For: U.S. Patent No.7,475,180

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the June 28, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations"(the June 28, 2010 requester petition).

This decision also addresses the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The June 28, 2010 requester petition under 37 CFR 1.182, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**. The original declaration under 37 CFR 1.132 by Jake Richter and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The patent owner's October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address are **ineffective**.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 6, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 5, 2010, the requester filed its comments submission.

Also on February 5, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 6, 2010 response submission, and requester's February 5, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On January 6, 2009, the Office issued U.S. Patent No. 7,475,180 (the '180 patent) to Arai *et al.*

- On June 4, 2009, a request for *inter partes* reexamination of the '180 patent was filed. The request was assigned Control No. 95/000,480 (the '480 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 24, 2009, *inter partes* reexamination was ordered.

- On September 24, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 24, 2009 requester petition).

- On October 6, 2009, the Office mailed a non-final Office action.

- On October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition). [1]

[1] The September 24, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by the April 21, 2010 Office decision. The subject matter of the September 24, 2009 and October 9, 2009 petitions, and the April 21, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On April 21, 2010, the Office mailed a decision granting-in-part the

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 18, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

- On January 6, 2010, the patent owner timely filed a response submission to the October 6, 2009 Office action (the January 6, 2010 patent owner response submission).

- On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- On February 5, 2010, the requester filed a comments submission after patent owner's January 4, 2010 response submission (the February 5, 2010 requester comments submission). The February 5, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration), a declaration under 37 CFR 1.132 by David Lesh (the Lesh declaration) and a declaration under 37 CFR 1.132 by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 5, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183" requesting waiver of the provisions of 37 CFR 1.948(a) and 1.943(b) (the February 5, 2010 requester petition).

- On February 24, 2010, the requester filed a petition entitled, "Petition Under 37 CFR § 1.182 for Replacement of Papers Previously Submitted" (the February 24, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 5, 2010 and February 24, 2010 requester petitions; 2) expunging, as improper, the January 6, 2010 patent owner response submission and the February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations; and 3) determining that the October 9, 2009 power of

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October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was considered with respect to the September 24, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 24, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

- On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 4, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[2] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 5, 2010 comments submission, of the Tols declaration and the original Richter rebuttal declaration.

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission, "or, in the alternative" waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration) as a replacement for the original Richter rebuttal declaration. The September 3, 2010 requester petition is addressed by a companion decision being mailed on even date.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

[2] July 18, 2010 was a Sunday.

DECISION

The June 28, 2010 Requester Petition Under 37 CFR 1.182 Is Dismissed

The examiner, in the October 6, 2009 non-final Office action, determined that two declarations filed together with the request for reexamination, i.e., the declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and the declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration), failed to comply with the formal requirements of 37 CFR 1.68.[3]

On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the present June 28, 2010 requester petition). Concurrently, the requester filed copies of two corrected declarations under 37 CFR 1.132, which were originally filed on February 4, 2010 and incorporated in the February 5, 2010 requester comments submission,[4] i.e., the corrected Richter declaration and the corrected Ryan declaration. The corrected declarations, re-executed by the declarants, contain language that tracks the formal requirements of 37 CFR 1.68. The requester, in the instant petition, requests that the concurrently-filed corrected declarations be accepted as replacement copies for the original Richter and Ryan declarations. The petition further requests that the original Richter and Ryan declarations be expunged from the record.

There is no vehicle, however, that will permit the Office to expunge the original Richter and Ryan declarations from the record. The original Richter and Ryan declarations, while defective, were not improperly filed; i.e., they had an entry right. When a paper is defective, such as an unsigned paper, or where, as here, a declaration fails to comply with the requirements of 37 CFR 1.68, the party filing the paper is informed of the defect, and the paper is not considered on the merits, but remains in the file, and is not returned. For this reason, the original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

Furthermore, 35 U.S.C. 314(b)(2) expressly states that "requester shall have **one** opportunity to file written comments **addressing issues raised by the action of the Office** or the patent owner's response thereto" (emphasis added). 37 CFR 1.947 states that the requester "may **once** file written comments . . . These comments shall be limited to issues raised by the Office action or the patent owner's response." (emphasis added). As admitted by requester, the corrected declarations are being submitted to address an issue raised by the examiner in the October 6, 2009 non-final

[3] See the October 6, 2009, Office action at page 5. Specifically the declarations were determined to not clearly and accurately warn declarants that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

[4] The February 5, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was determined to be improper and was expunged by the June 4, 2010 decision.

Office action, i.e., to address the examiner's determination that the original declarations were defective. The separate submission of the declarations, in order to address such an issue raised by the examiner in a non-final Office action, renders the record unclear as to whether or not requester is exercising its comment right pursuant to 35 U.S.C. 314(b)(2). If the declarations are to be taken as requester's written comments pursuant 35 U.S.C. § 314(b)(2), then no petition is necessary for their entry.[5] **The requester's statutory right to comment, however, would be exhausted, as no supplemental comments are permissible under the statute.**[6] However, on July 19, 2010, the requester filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" (the July 19, 2010 corrected requester comments submission). Accordingly, the Office presumes that the requester intended to exercise its comment right under 35 U.S.C. 314(b)(2) by filing the July 19, 2010 corrected requester comments submission, and not by the filing of the instant petition and its accompanying declarations.[7] If this is the case, then the only manner by which the corrected declarations may be entered would be by filing the corrected declarations as part of a requester's comment submission pursuant to 35 U.S.C. 314(b)(2), because the sole reason for the filing of the corrected declarations is to directly respond to the examiner's determination, in the non-final Office action, that the declarations were formally defective. There is no other rule or Office procedure that will permit the Office to enter the corrected declarations. Since the requester has separately and timely filed a corrected comments submission, the filing of the corrected declarations with the present petition is an attempt to file a supplemental comments submission, contrary to 35 U.S.C. 314(b)(2), and is **improper**.[8] See MPEP 2667, subsection I B 3.

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[5] No petition is necessary where evidence, such as a declaration, is **timely** filed in response to an issue raised in a **non-final** Office action. However, if an affidavit or evidence is filed, for example, after a right of appeal notice (RAN) (which is not the case here), the timely filing of a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.116(f) would be required for entry of the affidavit or other evidence.

[6] See also MPEP 2667, subsection I B 3, which provides, in pertinent part:

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

[7] If this is not the case, the requester is required to so inform the Office, and the Office will enter the June 28, 2010 corrected Richter and Ryan declarations as a requester comments submission pursuant to 35 U.S.C. 314(b)(2), and will expunge the July 19, 2010 requester comments submission as improper, since no supplemental comments are permissible as explained in detail above.

[8] Note that the July 19, 2010 corrected requester comments submission was filed in response to patent owner's completion of a proper response, pursuant to MPEP 2667, subsection I B 3 (see footnote 7). The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission. Specifically, in the present case, the Office dismissed as moot requester's earlier February 5, 2010 petition under 37 CFR 1.183 to waive 37 CFR 1.943(b) and enter requester's earlier February 5, 2010 comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, because patent owner's response was also determined to be improper, as failing to comply with 37 CFR 1.943(b). See the June 4, 2010 decision. This decision also informed the requester

Accordingly, the June 28, 2010 requester petition is **dismissed**. The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

As expressly discussed on page 12 of the June 4, 2010 Office decision, the patent owner's October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address are **ineffective**, because they do not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, 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. 10/160,022. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

Once again, a courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for 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., 10/160,022, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.**

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that even if the patent owner's response had been proper, the February 5, 2010 requester petition would not have been granted, and that the February 5, 2010 requester comments submission, incorporating the February 4, 2010 corrected Richter and Ryan declarations, was expunged as improper, for failing to comply with 37 CFR 1.943(b). The June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response". The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission.

THIS DECISION HAS NOT TREATED THE JULY 19, 2010 CORRECTED REQUESTER COMMENTS SUBMISSION WITH REGARD TO ANY OTHER ISSUES, SUCH AS COMPLIANCE WITH 37 CFR 1.48.

CONCLUSION

- The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**.

- The original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

- The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,022, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 08/31/2011

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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

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COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP SUITE 1100
777 6TH STREET N.W.
WASHINGTON, D.C. 20001

Date:

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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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CENTRAL REEXAMINATION UNIT

COOLEY GODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6th STREET, NW
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WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,480
Filed: June 4, 2009
For: U.S. Patent No. 7,475,180

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on August 13, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on July 19, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.943, 1.947, and 1.948; and (2) Requester's opposition petition, filed on September 10, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on August 13, 2010. The petition and the opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on August 13, 2010 is dismissed as moot.

The opposition petition filed by the Requester on September 10, 2010 is dismissed as untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,180 (the '180 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '180 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,480 (the '480 proceeding).

3. On July 24, 2009, the Office ordered that the '180 patent be reexamined.

4. On October 6, 2009, the Office issued a non-final Office action.

5. On January 6, 2010, the Patent Owner filed a response to the Office action.

6. On February 5, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 5, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 6, 2009.

10. On August 13, 2010, the Patent Owner filed the instant petition, which is treated as under 37 CFR 1.181 requesting supervisory review as to whether Requester's comments filed on July 19, 2010 fail to comply with 35 U.S.C. § 314(b)(2) and 37 CFR 1.943(b), 1.947 and 1.948.

11. On September 10, 2010, the Requester filed a petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement of August 13, 2010.

12. On September 29, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements of 37 CFR 1.943(b). The Office gave the Requester 15 days to submit corrected comments.

DECISION

As pointed out, the Patent Owner filed an August 13, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the July 19, 2010 comments. On September 29, 2010, Office mailed a decision, which addressed other petitions and found the July 19, 2010 comments to be improper papers. The decision expunged the July 19, 2010 comments from the proceeding record. Accordingly, the relief requested by the August 13, 2010 Patent Owner petition has already been granted. Thus, the Patent Owner's August 13,

2010 petition is moot, and thereby dismissed.

The third party Requester's September 10, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the September 10, 2010 opposition was filed more than two weeks from August 13, 2010, the date of service for the original petition.

CONCLUSION

1. The August 13, 2010 Patent Owner petition is **dismissed as moot**.

2. The September 10, 2010 Requester opposition petition is **dismissed as untimely**.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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 31 2011

CENTRAL REEXAMINATION UNIT

COOLEY GODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6th STREET, NW
SUITE 1100
WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,480
Filed: June 4, 2009
For: U.S. Patent No. 7,475,180

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

This is a decision on Requester's petition, filed on September 24, 2009, which seeks relief to resolve allegedly contradictory findings of fact in copending, related reexamination proceedings. The petition is being treated as a petition under 37 CFR 1.181, requesting supervisory review of the July 24, 2009 order granting reexamination. The Requester's petition was entered into the proceeding record by the April 21, 2010 Office decision, which addressed other petitions and waived 37 CFR 1.939 to the extent that the September 24, 2009 petition is considered an authorized paper.

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

The instant petition filed by the Requester on September 24, 2009 is dismissed as moot.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,180 (the '180 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '180 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,480 (the '480 proceeding).

3. On July 24, 2009, the Office ordered that the '180 patent be reexamined. The order found that the VDDP document was not considered prior art. See page 18 of the order.

4. On September 24, 2009, the third party Requester filed the instant petition.

5. On October 6, 2009, the Office issued a non-final Office action, which upon reconsideration, found that the VDDP document was prior art that raises a substantial new question of patentability.

6. On October 9, 2009, the patent owner filed a petition requesting the Office to strike Requester's September 24, 2009 petition as an improper paper.

7. On January 6, 2010, the Patent Owner filed a response to the Office action.

8. On February 5, 2010, the Requester submitted comments.

9. On April 21, 2010, the Office, in a decision addressing Patent Owner's October 9, 2009 petition, waived 37 CFR 1.939 to the extent that the September 24, 2009 petition is considered an authorized paper. The decision also remanded the proceedings to the Central Reexamination Unit for consideration of the September 24, 2009 petition.

DECISION

As pointed out, the Requester filed a September 24, 2009 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to review the July 24, 2009 order. The petition was disputing the examiner's finding in the July 24, 2009 order that the VDDP document was not prior art. On October 6, 2009, Office mailed an action that reconsidered the initial determination in the order that the VDDP document was not prior art. The Office action found that the VDDP document was prior art and that it did raise a substantial new question of patentability. See pages 4-6 of the Office action. Accordingly, the relief requested by the September 24, 2009 Requester petition has already been granted. Thus, the Requester's September 24, 2009 petition is moot, and thereby dismissed.

CONCLUSION

1. The September 24, 2009 Requester petition is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,480	06/04/2009	7475180	INNL-009-00US	4857

37509 7590 08/31/2011

DECHERT LLP
P.O. BOX 390460
MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP SUITE 1100
777 6TH STREET N.W.
WASHINGTON, D.C. 20001

Date:

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000480
PATENT NO. : 7475180
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 31 2011

CENTRAL REEXAMINATION UNIT

DECHERT LLP
PO BOX 390460
MOUNTAN VIEW, CA 94039-0460

(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: Arai *et al.*
Control No. 95/000,480
Filed: June 4, 2009
For: U.S. Patent No. 7,475,180

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on November 23, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on October 14, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.947; and (2) Requester's opposition petition, filed on December 30, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on November 23, 2010. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on November 23, 2010 is dismissed as premature.

The opposition petition filed by the Requester on December 30, 2010 is dismissed as premature and untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,180 (the '180 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '180 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,480 (the '480 proceeding).

3. On July 24, 2009, the Office ordered that the '180 patent be reexamined.

4. On October 6, 2009, the Office issued a non-final Office action.

5. On January 6, 2010, the Patent Owner filed a response to the Office action.

6. On February 5, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 5, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 6, 2009.

10. On September 29, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements in 37 CFR 1.943(b). The Office gave the Requester 15 days to submit replacement comments.

13. On October 14, 2010, Requester submitted replacement comments, which included declarations and exhibits.

14. On November 23, 2010, the Patent Owner filed the instant petition, which is treated as a petition under 37 CFR 1.181 requesting supervisory review as to whether the Requester's comments filed on October 14, 2010 fail to comply with 35 USC 314(b)(2) and 37 CFR 1.947.

15. On December 30, 2010, the Requester filed the instant petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement, filed on November 23, 2010.

DECISION

As pointed out, the Patent Owner filed a November 23, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the October 14, 2010 replacement comments. On December 30, 2010, Requester filed an opposition to Patent Owner's November 23, 2010 petition. However, there has been no decision by the examiner if the Requester's October 14, 2010 replacement comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the October 14, 2010 replacement comments because the examiner has not made his or her decision. Thus, the Patent Owner's November 23, 2010 petition and third party Requester's December 30, 2010 opposition are premature, and they are dismissed.

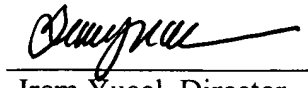
In addition, the December 30, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the December 30, 2010 opposition was filed more than two weeks from November 23, 2010, the date of service for the original petition.

CONCLUSION

1. The November 23, 2010 Patent Owner petition is **dismissed as premature**.

2. The December 30, 2010 Requester opposition petition is **dismissed as premature and untimely**.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.



Irem Yucel, Director
Technology Center 1600

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In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,481
Filed: June 4, 2009
For: U.S. Patent No. 7,475,181

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the September 3, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule", requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission, "or, in the alternative" waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration).

The September 3, 2010 requester petition and the record as a whole are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The September 3, 2010 requester petition is **dismissed**.

The revised Richter 37 CFR 1.132 rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 11, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 10, 2010, the requester filed its comments submission.

Also on February 10, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 11, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 11, 2010 response submission, and requester's February 10, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

DECISION

The September 3, 2010 Requester Petition Under 37 CFR 1.183 Is Dismissed

The requester requests entry and consideration of a supplement to requester's July 19, 2010 comments submission, i.e., a declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration), which has been deposited with the instant petition. The requester requests a waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission "or, in the alternative", a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission.

The July 19, 2010 Corrected Requester Comments Submission Fails to Comply with 37 CFR 1.943(b)

The July 19, 2010 corrected requester comments submission includes a 36-page remarks paper, a two-page single-spaced declaration under 37 CFR 1.132 by Frans Tol (the Tol declaration), a 10-page single-spaced declaration under 37 CFR 1.132 by Jake Richter (the Richter rebuttal declaration), a three-page double-spaced declaration under 37 CFR 1.132 by Wim van Maasakkers (the van Maasakkers declaration), and an 8-page claim chart. Furthermore, the July 19, 2010 corrected requester comments submission incorporates the double-spaced corrected Richter and Ryan declarations filed on June 28, 2010 (see page 3 of the July 19, 2010 comments submission).

The Tol, van Maasakkers, and corrected Ryan declarations are determined to be free of legal argument. The 8-page claim chart is not subject to the 50-page regulatory limit for the reasons given on pages 11-12 of the June 4, 2010 decision.

The original Richter rebuttal declaration is a duplicate of the original Richter rebuttal declaration filed with the February 10, 2010 original requester comments submission, and is replete with legal argument for the same reasons given in the June 4, 2010 decision. If

the 10-page single-spaced declaration were **double-spaced, as required on pages 11-12 of the June 4, 2010 decision**, the declaration would be at least 15 pages long. Furthermore, the 37-page corrected Richter declaration filed on June 28, 2010, which is incorporated on page 3 of the corrected comments submission, and which is replete with legal argument for the same reasons set forth in the June 4, 2010 decision, is also included in the page count.

Accordingly, the 36-page remarks section, the at least 15 pages of the Richter rebuttal declaration, and the 37-page corrected Richter declaration, totaling at least **88** pages, are subject to the 50-page limit.

The requester, however, has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). The requester states that it has made every effort to make the comments as brief as possible. The requester, however, provides no explanation for the need for **38** additional pages.

Waiver of the rules under 37 CFR 1.183 may be suspended in an ***extraordinary situation when justice requires***. The requester provides no facts to establish an extraordinary situation where justice requires suspension of the rule to permit the filing of an additional 38 pages. The failure of requester to comply with the rules does not rise to an ***extraordinary situation*** under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice would not require suspension of 37 CFR 1.943(b).

Furthermore, the Tol and original Richter rebuttal declarations are single-spaced, contrary to the June 4, 2010 decision, which expressly stated on pages 11-12, in bold print:

> **To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:**
>
> **1) is double-spaced;**
> **2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);**
> **3) has a font size no smaller than 12-point;**
> **4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and**
> **5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).**
>
> **See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.**

In addition, the June 4, 2010 decision expressly stated, on page 13:

> Both parties are on specific notice as to the format and font requirements as set forth in this decision for the submission of responses and comments for an *inter partes* reexamination proceeding when a waiver of the 50-page length requirement of 37 CFR 1.943(b) is sought. Accordingly, any subsequent noncompliant submissions may not be considered, and may be expunged **without** an opportunity for resubmission, because such noncompliant submissions **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding. . See MPEP 2609 which 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.

Upon reconsideration, however, the requester is given one opportunity to correct the above-discussed defects. The June 4, 2010 decision determined that the January 11, 2010 patent owner response was improper. The January 11, 2010 patent owner response was expunged, the February 10, 2010 requester petition was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 10, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was also improper and was expunged. Had the January 11, 2010 patent owner response been properly filed, and had the February 10, 2010 requester petition been directly dismissed for the reasons provided to the requester by the Office in an advisory capacity in the June 4, 2010 decision, the Office would not have been permitted to allow the requester another opportunity for resubmission. However, the June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response", as set forth in MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. **However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response.** Supplemental third party comments are also permitted in response to a supplemental patent owner response.

Accordingly, the July 19, 2010 requester petition is **dismissed**. The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

The "Alternative" Petition under 37 CFR 1.183 for Waiver of 37 CFR 1.947

The requester requests, "in the alternative", a waiver of the provisions of 37 CFR 1.947 to permit the late entry of the revised Richter rebuttal declaration, and to replace the original Richter rebuttal declaration that was earlier filed with requester's July 19, 2010 comments submission. However, any "alternative" petition must be submitted under separate cover pursuant to 37 CFR 1.4(c). Accordingly, the "alternative' petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.947 will not be addressed on the merits.

The Filing of the September 3, 2010 Declaration under 37 CFR 1.132 by Jake Richter is Improper

The filing of the declaration under 37 CFR 1.132 by Jake Richter, deposited on September 3, 2010 (the revised Richter rebuttal declaration) is improper. The requester timely filed a corrected comments submission on July 19, 2010, in response to the June 18, 2010 corrected patent owner response submission. The date of service of the June 18, 2010 corrected patent owner response submission is also June 18, 2010.

35 U.S.C. 314(b)(2) provides (emphasis added):

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

By statute, therefore, the requester is permitted only **one opportunity** to file written comments addressing issues raised by the Office action or by patent owner's response thereto. The **30-day time period** to file requester's comments is also a statutory requirement. **Statutory requirements cannot be waived.** 37 CFR 1.947 tracks the language of the statute and provides, in pertinent part (emphasis added):

> . . . may **once** file written comments **within a period of 30 days from the date of service of the patent owner's response**. These comments shall be limited to issues raised by the Office action or the patent owner's response."

The statute does not permit the filing of a supplemental requester comments submission, because the requester is statutorily given only "one" opportunity to file a written

comments submission that is a proper paper, after each patent owner response. See also MPEP 2667, subsection I B 3, which provides, in pertinent part (emphasis added):

> **Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed.** Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

In the present case, the June 4, 2010 decision determined that the January 11, 2010 patent owner response was improper. The January 11, 2010 patent owner response was expunged, the February 10, 2010 requester petition under 37 CFR 1.183 to waive the page length requirements of 37 CFR 1.943(b) for requester's February 10, 2010 comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was dismissed as moot, and the requester was informed by the Office, in an advisory capacity, of the reasons why the February 10, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was also improper and was expunged. In response to the June 4, 2010 decision, the patent owner filed the June 18, 2010 corrected patent owner response submission. The July 19, 2010 corrected requester comments submission was filed after patent owner's June 18, 2010 corrected response submission, which is a "completion of a proper response", as permitted by MPEP 2667. Thus, the revised Richter declaration deposited on September 3, 2010, in addition to being untimely filed (outside the statutory 30 day period), is clearly a submission which is supplemental to the July 19, 2010 corrected requester comments submission, and is **improper**.

Accordingly, the revised Richter rebuttal declaration, deposited on September 3, 2010 with the present petition, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

Additional Comment

As expressly discussed on page 12 of the June 4, 2010 decision and in the companion decision mailed on even date, the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address for the patent owner is **ineffective** for the reasons given in those decisions. A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

CONCLUSION

- The September 3, 2010 requester petition is **dismissed**.

- The July 19, 2010 requester comments submission is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The requester is given **15 days from the mail date of this decision** to file a corrected comments submission, pursuant to MPEP 2667, subsection I B 2. If the requester files a noncompliant comments submission in response to this decision, the submission may not be considered, and may be expunged **without** an opportunity for resubmission, because such a noncompliant submission **would not be considered a *bona fide* attempt** to respond and advance prosecution in this *inter partes* reexamination proceeding.

- The "alternative" September 3, 2010 requester petition under 37 CFR 1.183 requesting waiver of the provisions of 37 CFR 1.947 will not be addressed on the merits.

- The revised Richter rebuttal declaration, deposited on September 3, 2010, is **improper**, will not be considered, and **is being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. This paper will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,056, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- 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

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

09/27/2010
Kimpropa/comments

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SEP 30 2010
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In re Arai *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/000,481
Filed: June 4, 2009
For: U.S. Patent No.7,475,181

: **DECISION DISMISSING**
: **REQUESTER PETITION**
: **AND *SUA SPONTE***
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the June 28, 2010 requester petition entitled "Petition under 37 C.F.R. § 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations"(the June 28, 2010 requester petition).

This decision also addresses the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner.

The June 28, 2010 requester petition under 37 CFR 1.182, the October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

A petition fee of $400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's Deposit Account No. 50-1283, as authorized by requester's EFS-WEB fee transmittal.

SUMMARY

The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**. The original declaration under 37 CFR 1.132 by Jake Richter and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The patent owner's October 9, 2009 power of attorney, statement under 3.73(b), and change of correspondence address are **ineffective**.

THE PROFFERED RICHTER AND RYAN DECLARATIONS

A summary of the proffered Richter and Ryan declarations under 37 CFR 1.132, that were deposited in the present proceeding, is included here for convenience and for clarification purposes.

The requester filed, with the request for reexamination, a first proffered declaration by Jake Richter **(the original Richter declaration)** and a first proffered declaration by Tom Ryan **(the original Ryan declaration)**. The examiner, in the first Office action, determined that the original Richter and Ryan declarations were defective for failing to comply with the requirements of 37 CFR 1.68, and did not consider these declarations on the merits.

On January 11, 2010, the patent owner filed a response submission in reply to the first Office action.

On February 4, 2010, the requester filed a second proffered declaration by Jake Richter and a second proffered declaration by Tom Ryan, for the purpose of correcting the original Richter and Ryan declarations by complying with the provisions of 37 CFR 1.68 **(the corrected Richter declaration and the corrected Ryan declaration)**.

On February 10, 2010, the requester filed its comments submission.

Also on February 10, 2010, the requester filed a third proffered declaration by Jake Richter, which addressed an issue that differed from the first and second proffered Richter declarations, i.e., the third proffered Richter declaration was filed in rebuttal to evidence filed by the patent owner with the January 11, 2010 patent owner response submission **(the original Richter rebuttal declaration).**

Patent owner's January 11, 2010 response submission, and requester's February 10, 2010 comments submission which incorporated the corrected Richter and Ryan declarations filed on February 4, 2010, and the original Richter rebuttal declaration, were all expunged by the June 4, 2010 Office decision.

On June 18, 2010, the patent owner filed a corrected response submission.

On June 28, 2010, the requester filed, with the present petition, a fourth proffered declaration by Jake Richter and a third proffered declaration by Tom Ryan, which were identical to the corrected Richter and Ryan declarations filed on February 4, 2010.

On July 19, 2010, the requester filed, with its corrected comments submission, a fifth proffered declaration by Jake Richter, which is identical to the original Richter rebuttal declaration.

On September 3, 2010, the requester filed, with a petition under 37 CFR 1.183 (which will be addressed in a companion decision on even date), a sixth proffered declaration by Jake Richter, which is a revised version of the original Richter rebuttal declaration (**the revised Richter rebuttal declaration**).

REVIEW OF RELEVANT FACTS

- On January 6, 2009, the Office issued U.S. Patent No. 7,475,181 (the '181 patent) to Arai *et al.*

- On June 4, 2009, a request for *inter partes* reexamination of the '181 patent was filed. The request was assigned Control No. 95/000,81 (the '481 proceeding). The request included a declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and a declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration).

- On July 27, 2009, *inter partes* reexamination was ordered.

- On September 25, 2009, the requester filed a petition entitled "Petition Under 37 C.F.R. §§ 1.182 – 1.183 to Resolve Contradictory Examiner Findings in Copending Reexamination Proceedings" (the September 25, 2009 requester petition).

- On October 9, 2009, the Office mailed a non-final Office action.

- Also on October 9, 2009, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Dismiss and Expunge an Impermissible Filing from the Record" (the October 9, 2009 patent owner petition). [1]

[1] The September 25, 2009 requester petition and the October 9, 2009 patent owner petition were addressed by the February 22, 2010 Office decision. The subject matter of the September 25, 2009 and October 9, 2009 petitions, and the February 22, 2010 decision, is not directly related to the present petition, and is included in this footnote for convenience only. On February 22, 2010, the Office mailed a decision

- Also on October 9, 2009, the patent owner submitted a paper entitled "Combined Revocation and Power of Attorney and Statements under 37 CFR §§ 3.73(b) & 3.71".

- On November 16, 2009, the patent owner filed a request for a one-month extension of time to file a response to the October 2, 2009 Office action.

- On November 18, 2009, the Office mailed a decision granting patent owner's November 16, 2009 request for a one-month extension of time.

- On January 11, 2010, the patent owner timely filed a response submission to the October 9, 2009 Office action (the January 11, 2010 patent owner response submission).

- On February 4, 2010, the requester filed a paper entitled "Submission of Corrected Declarations", accompanied by a declaration by executed Jake Richter on February 1, 2010, which corrected the original Richter declaration (the corrected Richter declaration) and a declaration executed by Mr. Tom Ryan on February 2, 2010, which corrected the original Ryan declaration (the corrected Ryan declaration).

- On February 10, 2010, the requester filed a comments submission after patent owner's January 11, 2010 response submission (the February 10, 2010 requester comments submission). The February 10, 2010 comments submission included a declaration under 37 CFR 1.132 by Frans Tols (the Tols declaration), a declaration under 37 CFR 1.132 by David Lesh (the Lesh declaration) and a declaration under 37 CFR 1.132 by Jake Richter, filed in rebuttal to evidence filed by the patent owner with the January 6, 2010 patent owner response submission (the original Richter rebuttal declaration).

- Also on February 10, 2010, the requester filed a petition entitled "Petition for Suspension of Rule under 37 C.F.R. § 1.183" requesting waiver of the provisions of 37 CFR 1.948(a) and 1.943(b) (the February 10, 2010 requester petition).

- On June 4, 2010, the Office issued a decision 1) dismissing as moot the February 10, 2010 requester petition; 2) expunging, as improper, the January 11, 2010 patent owner response submission and the February 10, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations; and 3) determining that the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner was ineffective (the June 4, 2010 decision).

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granting-in-part the October 9, 2009 patent owner petition, to the extent that waiver of 37 CFR 1.939 was considered with respect to the September 25, 2009 petition. The October 9, 2009 patent owner petition was dismissed as to the underlying expungement relief requested by the patent owner. The decision waived the provisions of 37 CFR 1.939 to authorize entry of the September 25, 2009 requester petition filed under 37 CFR 1.182/1.183, for consideration by the Central Reexamination Unit (CRU) as a petition requesting relief under 37 CFR 1.181.

- On June 18, 2010, the patent owner timely filed, in response to the June 4, 2010 decision, a corrected response submission (the June 18, 2010 corrected patent owner response submission).

- On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the June 28, 2010 requester petition), accompanied by copies of two corrected declarations originally submitted on February 4, 2010, i.e., the corrected Richter declaration and the corrected Ryan declaration.

- On July 19, 2010, the requester timely filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" after the June 18, 2010 corrected patent owner response submission (the July 19, 2010 corrected requester comments submission).[2] The July 19, 2010 corrected comments submission included copies, originally submitted with the February 10, 2010 comments submission, of the Tol declaration and the original Richter rebuttal declaration.

- On August 13, 2010, the patent owner filed a petition entitled "Petition Under 37 CFR §§ 1.182 and 1.183 to Expunge Innolux's Improper Comments Submission" (the August 13, 2010 patent owner petition).

- On September 3, 2010, the requester filed a petition entitled "Petition under 37 C.F.R. § 1.183 for Suspension of Rule" (the September 3, 2010 requester petition), requesting waiver of the page length requirements of 37 CFR 1.943(b) for requester's July 19, 2010 corrected comments submission, "or, in the alternative" waiver of the provisions of 37 CFR 1.947, to permit the late entry of a concurrently-filed declaration under 37 CFR 1.132 by Jake Richter (the revised Richter rebuttal declaration) as a replacement for the original Richter rebuttal declaration. The September 3, 2010 requester petition is addressed by a companion decision being mailed on even date.

- On September 10, 2010, the requester filed a petition entitled "Petition Under 37 C.F.R. § 1.181 to Oppose Petition Filed by Patent Owners for Expungement of Third Party Comments".

[2] July 18, 2010 was a Sunday.

DECISION

The June 28, 2010 Requester Petition Under 37 CFR 1.182 Is Dismissed

The examiner, in the October 9, 2009 non-final Office action, determined that two declarations filed together with the request for reexamination, i.e., the declaration under 37 CFR 1.132 by Jake Richter (the original Richter declaration) and the declaration under 37 CFR 1.132 by Tom Ryan (the original Ryan declaration), failed to comply with the formal requirements of 37 CFR 1.68.[3]

On June 28, 2010, the requester filed the instant petition entitled "Petition under 37 C.F.R. §§ 1.182 for Expungement of Declarations Previously Submitted and Replacement with Corrected Declarations" (the present June 28, 2010 requester petition). Concurrently, the requester filed copies of two corrected declarations under 37 CFR 1.132, which were originally filed on February 4, 2010 and incorporated in the February 5, 2010 requester comments submission,[4] i.e., the corrected Richter declaration and the corrected Ryan declaration. The corrected declarations, re-executed by the declarants, contain language that tracks the formal requirements of 37 CFR 1.68. The requester, in the instant petition, requests that the concurrently-filed corrected declarations be accepted as replacement copies for the original Richter and Ryan declarations. The petition further requests that the original Richter and Ryan declarations be expunged from the record.

There is no vehicle, however, that will permit the Office to expunge the original Richter and Ryan declarations from the record. The original Richter and Ryan declarations, while defective, were not improperly filed; i.e., they had an entry right. When a paper is defective, such as an unsigned paper, or where, as here, a declaration fails to comply with the requirements of 37 CFR 1.68, the party filing the paper is informed of the defect, and the paper is not considered on the merits, but remains in the file, and is not returned. For this reason, the original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

Furthermore, 35 U.S.C. 314(b)(2) expressly states that "requester shall have **one** opportunity to file written comments **addressing issues raised by the action of the Office** or the patent owner's response thereto" (emphasis added). 37 CFR 1.947 states that the requester "may **once** file written comments . . . These comments shall be limited to issues raised by the Office action or the patent owner's response." (emphasis added). As admitted by requester, the corrected declarations are being submitted to address an issue raised by the examiner in the October 9, 2009 non-final

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[3] See the October 9, 2009, Office action at page 5. Specifically the declarations were determined to not clearly and accurately warn declarants that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

[4] The February 10, 2010 requester comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, was determined to be improper and was expunged by the June 4, 2010 decision.

Office action, i.e., to address the examiner's determination that the original declarations were defective. The separate submission of the declarations, in order to address such an issue raised by the examiner in a non-final Office action, renders the record unclear as to whether or not requester is exercising its comment right pursuant to 35 U.S.C. 314(b)(2). If the declarations are to be taken as requester's written comments pursuant 35 U.S.C. § 314(b)(2), then no petition is necessary for their entry.[5] **The requester's statutory right to comment, however, would be exhausted, as no supplemental comments are permissible under the statute.**[6] However, on July 19, 2010, the requester filed a paper entitled "Comments by Third Party Requester to Patent Owner's Response to Office Action in *Inter Partes* Reexamination under 37 C.F.R. § 1.947" (the July 19, 2010 corrected requester comments submission). Accordingly, the Office presumes that the requester intended to exercise its comment right under 35 U.S.C. 314(b)(2) by filing the July 19, 2010 corrected requester comments submission, and not by the filing of the instant petition and its accompanying declarations.[7] If this is the case, then the only manner by which the corrected declarations may be entered would be by filing the corrected declarations as part of a requester's comment submission pursuant to 35 U.S.C. 314(b)(2), because the sole reason for the filing of the corrected declarations is to directly respond to the examiner's determination, in the non-final Office action, that the declarations were formally defective. There is no other rule or Office procedure that will permit the Office to enter the corrected declarations. Since the requester has separately and timely filed a corrected comments submission, the filing of the corrected declarations with the present petition is an attempt to file a supplemental comments submission, contrary to 35 U.S.C. 314(b)(2), and is **improper**.[8] See MPEP 2667, subsection I B 3.

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[5] No petition is necessary where evidence, such as a declaration, is **timely** filed in response to an issue raised in a **non-final** Office action. However, if an affidavit or evidence is filed, for example, after a right of appeal notice (RAN) (which is not the case here), the timely filing of a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.116(f) would be required for entry of the affidavit or other evidence.

[6] See also MPEP 2667, subsection I B 3, which provides, in pertinent part:

> Supplemental third party requester comments are improper since 37 CFR 1.947 states that comments can "once" be filed. Such supplemental comments are improper, will not be considered, and will be returned. However, supplemental third party comments are permitted in response to the patent owner's completion of a response, even where the initial third party comments were provided after the incomplete patent owner response. Supplemental third party comments are also permitted in response to a supplemental patent owner response.

[7] If this is not the case, the requester is required to so inform the Office, and the Office will enter the June 28, 2010 corrected Richter and Ryan declarations as a requester comments submission pursuant to 35 U.S.C. 314(b)(2), and will expunge the July 19, 2010 requester comments submission as improper, since no supplemental comments are permissible as explained in detail above.

[8] Note that the July 19, 2010 corrected requester comments submission was filed in response to patent owner's completion of a proper response, pursuant to MPEP 2667, subsection I B 3 (see footnote 7). The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission. Specifically, in the present case, the Office dismissed as moot requester's earlier February 10, 2010 petition under 37 CFR 1.183 to waive 37 CFR 1.943(b) and enter requester's earlier February 10, 2010 comments submission, which incorporated the February 4, 2010 corrected Richter and Ryan declarations, because patent owner's response was also determined to be improper, as failing to comply with 37 CFR 1.943(b). See the June 4, 2010 decision. This decision also informed the requester

Accordingly, the June 28, 2010 requester petition is **dismissed**. The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being *sua sponte* expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

The October 9, 2009 Power of Attorney, Statement under 37 CFR 3.73(b), and Change of Correspondence Address is Ineffective

As expressly discussed on page 12 of the June 4, 2010 Office decision, the patent owner's October 9, 2009 power of attorney, statement under 37 CFR 3.73(b) and change of correspondence address are **ineffective**, because they do not comply with 37 CFR 1.5(a) and 37 CFR 1.4(c). Each paper must separately identify, on the top page in a conspicuous location, the control number of the proceeding. 37 CFR 1.5(a). Furthermore, a power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address must be submitted as a separate paper in each application or reexamination proceeding to which it relates. 37 CFR 1.4(c).

In addition, 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. 10/160,056. In the present case, the official correspondence address of record for the patent owner as recorded in the patent file is that of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

Once again, a courtesy copy of this decision will be mailed to the correspondence address indicated on the October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for 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., 10/160,056, however, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.**

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that even if the patent owner's response had been proper, the February 10, 2010 requester petition would not have been granted, and that the February 10, 2010 requester comments submission, incorporating the February 4, 2010 corrected Richter and Ryan declarations, was expunged as improper, for failing to comply with 37 CFR 1.943(b). The June 18, 2010 corrected patent owner response submission was filed in response to the June 4, 2010 decision. The July 19, 2010 corrected requester comments submission was filed in response to patent owner's June 18, 2010 corrected response, which is a "completion of a proper response". The June 28, 2010 corrected declarations, however, are separately filed in addition to, i.e., as a supplement to, requester's corrected comment submission, and are therefore determined to be an improper supplemental comments submission.

THIS DECISION HAS NOT TREATED THE JULY 19, 2010 CORRECTED REQUESTER COMMENTS SUBMISSION WITH REGARD TO ANY OTHER ISSUES, SUCH AS COMPLIANCE WITH 37 CFR 1.48.

CONCLUSION

- The June 28, 2010 requester petition under 37 CFR 1.182 is **dismissed**.

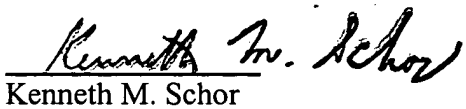
- The original declaration under 37 CFR 1.132 by Jake Richter, and the original declaration under 37 CFR 1.132 by Tom Ryan, each of which were filed with the request for reexamination, will not be considered on the merits, but **will remain in the file**, and **will not be expunged** from the record.

- The corrected Richter and Ryan declarations, filed on June 28, 2010, are **improper**, will not be considered, and **are being expunged** from the official record by closing the file in the Office's Image File Wrapper (IFW) system, and by marking the file non-public. These papers will not constitute part of the official record of the present reexamination proceeding.

- The October 9, 2009 power of attorney, statement under 37 CFR 3.73(b), and change of correspondence address for the patent owner is **ineffective** A courtesy copy of this decision will be mailed to the address provided in the ineffective October 9, 2009 change of correspondence address.

- In the absence of a proper submission of a change of correspondence address for the patent owner in the patent file, application no. 10/160,056, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, i.e., the address of ANTONELLI, TERRY, STOUT & KRAUS, LLP, 1300 NORTH SEVENTEENTH STREET, SUITE 1800, ARLINGTON VA 22209-3873.

- Telephone inquiries with regard to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, the Office of Patent Legal Administration, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
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for Patent Examining Policy

09/27/2010
Kimpropa/comments

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(For Patent Owner)

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AUG 31 2011

CENTRAL REEXAMINATION UNIT

COOLEY GOODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6th STREET, NW
SUITE 1100
WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,481
Filed: June 4, 2009
For: U.S. Patent No. 7,475,181

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on August 13, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on July 19, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.943, 1.947 and 1.948; and (2) Requester's opposition petition, filed on September 10, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on August 13, 2010. The petition and the opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on August 13, 2010 is dismissed as moot.

The opposition petition filed by the Requester on September 10, 2010 is dismissed as untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,181 (the '181 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '181 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,481 (the '481 proceeding).

3. On July 27, 2009, the Office ordered that the '181 patent be reexamined.

4. On October 9, 2009, the Office issued a non-final Office action.

5. On January 11, 2010, the Patent Owner filed a response to the Office action.

6. On February 4 and 10, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 4 and 10, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 9, 2009.

10. On August 13, 2010, the Patent Owner filed the instant petition, which is treated as under 37 CFR 1.181 requesting supervisory review as to whether Requester's comments filed on July 19, 2010 fail to comply with 35 U.S.C. § 314(b)(2) and 37 CFR 1.943(b), 1.947 and 1.948.

11. On September 10, 2010, the Requester filed a petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement of August 13, 2010.

12. On September 30, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements of 37 CFR 1.943(b). The Office gave the Requester 15 days to submit corrected comments.

DECISION

As pointed out, the Patent Owner filed an August 13, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the July 19, 2010 comments. On September 30, 2010, Office mailed a decision, which addressed other petitions and found the July 19, 2010 comments to be improper papers. The decision expunged the July 19, 2010 comments from the proceeding record. Accordingly, the relief requested by the August

13, 2010 Patent Owner petition has already been granted. Thus, the Patent Owner's August 13, 2010 petition is moot, and thereby dismissed.

The third party Requester's September 10, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the September 10, 2010 opposition was filed more than two weeks from August 13, 2010, the date of service for the original petition.

CONCLUSION

1. The August 13, 2010 Patent Owner petition is **dismissed as moot**.

2. The September 10, 2010 Requester opposition petition is **dismissed as untimely**.

3. Telephone inquiries related to this decision should be directed Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

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(For Patent Owner)

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CENTRAL REEXAMINATION UN

COOLEY GOODWARD KRONISH, LLP
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777 6th STREET, NW
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(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,481
Filed: June 4, 2009
For: U.S. Patent No. 7,475,181

: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

This is a decision on (1) Patent Owner's petition, filed on November 23, 2010, under 37 CFR 1.182 and 1.183 requesting the Director expunge the Requester's comments submitted on October 15, 2010 for failure to comply with 35 USC 314(b)(2) and 37 CFR 1.947; and (2) Requester's opposition petition, filed on December 30, 2010, which seeks relief under 37 CFR 1.181 by requesting that the Director dismiss Patent Owner's petition filed on November 23, 2010. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The petition filed by the Patent Owner on November 23, 2010 is dismissed as premature.

The opposition petition filed by the Requester on December 30, 2010 is dismissed as premature and untimely.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,181 (the '181 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '181 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,481 (the '481 proceeding).

3. On July 27, 2009, the Office ordered that the '181 patent be reexamined.

4. On October 9, 2009, the Office issued a non-final Office action.

5. On January 11, 2010, the Patent Owner filed a response to the Office action.

6. On February 4 and 10, 2010, the Requester submitted comments.

7. On June 4, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Patent Owner's response to the Office action for not complying with the requirements of 37 CFR 1.52 and 1.943. The decision also expunged the Requester comments of February 4 and 10, 2010.

8. On June 18, 2010, the Patent Owner filed a replacement response to the Office action.

9. On July 19, 2010, the Requester submitted comments to Patent Owner's response and to the Office action of October 9, 2009.

10. On September 30, 2010, the Office, in a decision addressing Requester's petition to waive certain regulations, *sua sponte* expunged Requester's July 19, 2010 comments for failing to comply with the requirements in 37 CFR 1.943(b). The Office gave the Requester 15 days to submit replacement comments.

13. On October 15, 2010, Requester submitted replacement comments, which included declarations and exhibits.

14. On November 23, 2010, the Patent Owner filed the instant petition, which is treated as a petition under 37 CFR 1.181 requesting supervisory review as to whether the Requester's comments filed on October 15, 2010 fail to comply with 35 USC 314(b)(2) and 37 CFR 1.947.

15. On December 30, 2010, the Requester filed the instant petition under 37 CFR 1.181 in opposition to the Patent Owner's petition for expungement, filed on November 23, 2010.

DECISION

As pointed out, the Patent Owner filed a November 23, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the October 15, 2010 replacement comments. On December 30, 2010, Requester filed an opposition to Patent Owner's November 23, 2010 petition. However, there has been no decision by the examiner if the Requester's October 15, 2010 replacement comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the October 15, 2010 replacement comments because the examiner has not made his or her decision. Thus, the Patent Owner's November 23, 2010 petition and third party Requester's December 30, 2010 opposition are premature, and they are dismissed.

In addition, the December 30, 2010 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the December 30, 2010 opposition was filed more than two weeks from November 23, 2010, the date of service for the original petition.

CONCLUSION

1. The November 23, 2010 Patent Owner petition is **dismissed as premature**.

2. The December 30, 2010 Requester opposition petition is **dismissed as premature and untimely**.

3. Telephone inquiries related to this decision should be directed Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yücel, Director
Technology Center 1600

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DECHERT LLP
PO BOX 390460
MOUNTAN VIEW, CA 94039-0460

(For Patent Owner)

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

COOLEY GOODWARD KRONISH, LLP
ATTN: PATENT GROUP
777 6th STREET, NW
SUITE 1100
WASHINGTON, DC 20001

(For Third Party Requester)

In re Application of: Arai *et al.*
Control No. 95/000,481
Filed: June 4, 2009
For: U.S. Patent No. 7,475,181

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

This is a decision on Requester's petition, filed on September 25, 2009, which seeks relief to resolve allegedly contradictory findings of fact in copending, related reexamination proceedings. The petition is being treated as a petition under 37 CFR 1.181, requesting supervisory review of the July 27, 2009 order granting reexamination. The Requester's petition was entered into the proceeding record by the February 22, 2010 Office decision, which addressed other petitions and waived 37 CFR 1.939 to the extent that the September 25, 2009 petition is considered an authorized paper.

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

The instant petition filed by the Requester on September 25, 2009 is dismissed as moot.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,475,181 (the '181 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination of the '181 patent was filed on June 4, 2009. The request was assigned Control No. 95/000,481 (the '481 proceeding).

3. On July 27, 2009, the Office ordered that the '181 patent be reexamined. The order found that the VDDP document was not considered prior art. See page 15 of the order.

4. On September 25, 2009, the third party Requester filed the instant petition.

5. On October 9, 2009, the Office issued a non-final Office action, which upon reconsideration, found that the VDDP document was prior art that raises a substantial new question of patentability.

6. On October 9, 2009, the patent owner filed a petition requesting the Office to strike Requester's September 25, 2009 petition as an improper paper.

7. On January 11, 2010, the Patent Owner filed a response to the Office action.

8. On February 4 and 10, 2010, the Requester submitted comments.

9. On February 22, 2010, the Office, in a decision addressing Patent Owner's October 9, 2009 petition, waived 37 CFR 1.939 to the extent that the September 25, 2009 petition is considered an authorized paper. The decision also remanded the proceedings to the Central Reexamination Unit for consideration of the September 25, 2009 petition.

DECISION

As pointed out, the Requester filed a September 25, 2009 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to review the July 27, 2009 order. The petition was disputing the examiner's finding in the July 27, 2009 order that the VDDP document was not prior art. On October 9, 2009, Office mailed an action that reconsidered the initial determination in the order that the VDDP document was not prior art. The Office action found that the VDDP document was prior art and that it did raise a substantial new question of patentability. See pages 4-5 of the Office action. Accordingly, the relief requested by the September 25, 2009 Requester petition has already been granted. Thus, the Requester's September 25, 2009 petition is moot, and thereby dismissed.

CONCLUSION

1. The September 25, 2009 Requester petition is **dismissed as moot**.

2. Telephone inquiries related to this decision should be directed Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,482	06/09/2009	7,176,489	7773.095.60	6380

30827 7590 10/14/2010

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/14/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BABAK REDJAIAN, IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

Date: MAILED

OCT 14 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009483
PATENT NO. : 7176489
ART UNIT : 3992

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.:95/000,482 & 90/009,483

1. THIS IS A DECISION ON THE PETITION FILED 11 October 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on 20 September 2010, which sets a one (1) month period for filing a response thereto, be extended by one (1) month

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel, at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	Supervisory Patent Examiner AU 3992
[*Signature*]	(Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Fujitsu, Ltd., Inc. v. Tellabs Operations, Inc.

Reexamination Control No. 95/000,485
Patent 7,369,772
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c)," filed November 10, 2010. Petitioner requests waiver of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the third party requester's appellant brief indicated to have a word count of less than 18,000 words. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on November 11, 2010, along with the appeal brief fee.

FINDINGS

1. On July 6, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,369,772.

2. Reexamination was ordered and a non-final Office action was mailed on September 25, 2009.

3. Patent owner filed a response to the Office action on November 25, 2009, and third party requester filed corrected-rectified comments in reply to the Office action and patent owner's response on March 31, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On June 24, 2010, an Action Closing Prosecution (ACP) was mailed, and on August 21, 2010, a Right of Appeal Notice (RAN) was mailed incorporating the reasons for patentability of claims 2 and 6-24 set forth in the ACP.

5. Requester filed a Notice of Appeal on September 10, 2010, appealing the refusal to adopt 33 proposed rejections of the claims, each rejection based on at least one of 8 different primary prior art references.

6. On November 10, 2010, requester filed an appellant's brief appealing the refusal to adopt 24 of the original 33 proposed rejections, based on at least one of 6 different primary prior art references, and accompanied by the present petition.

DISCUSSION

In the present Petition, third party requester requests waiver of 37 CFR 1.943(c), which limits third party requester's appellant brief to thirty pages or 14,000 words in length. The third party requester's appellant brief is 70 pages and stated to be less than 18,000 words.

Waiver is requested for the following reasons:

(1) The length of appellant's brief is due, in part, to the sheer number of proposed rejections that were refused adoption by the examiner and therefore must be appealed.

(2) In an effort to minimize the length of appellant's brief, requester has reduced the issues to 24 of the 33 proposed rejections not adopted, based on at least one of 6 different primary prior art references, noting that this is a voluntary reduction of issues on appeal; and appellant cannot further reduce the scope of the brief without compromising requester's position on appeal.

(3) The length of appellant's brief is due to the substantial length of the ACP, as the examiner's explanation for not adopting requester's proposed rejections is approximately 25,000 words and 116 pages; the portion of the ACP that explains the examiner's reasons for not adopting the 24 proposed grounds of rejection being appealed is 19,500 words in length.

(4) Appellant's brief responds to these words with under 18,000 words, i.e., in 1500 fewer words than the examiner's explanation in the ACP. Petitioner asserts that it is both equitable and just to permit requester to exceed the word limit so as to adequately respond to the lengthy ACP.

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 filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Third party requester's appellant brief filed on November 10, 2010, has a length of 70 pages and is stated to contain less than 18,000 words which count toward the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous proposed rejections which were not adopted. However, it is apparent that it was the third party requester who chose to present 33 proposed rejections of claims 1-24 over 8 different primary prior art references in the original request for reexamination. It is not surprising that appellant is now challenged by the page and word limit, given the multitude of proposed grounds of rejections presented in the request. The requester caused this challenge itself. Presenting the Office with a multitude of prior art references without selectivity is not the most efficient manner of proposing rejections of patent claims in *inter partes* reexamination. Note that 37 CFR 1.104(c)(2) requires that in "rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." Where possible, a party to an appeal should limit the number of prior art references submitted to the closest prior art, as well as avoid presenting an undue multiplicity of proposed rejections and/or various combinations of prior art references.

Prior to appeal, the examiner refused to adopt all 33 proposed rejections for most of the claims, and only adopted-in-part 5 of the proposed rejections (A,H,R,U and V) encompassing claims 1-5 and 24. Such refusal to adopt the balance of the 33 proposed rejections for the remainder of the claims was adequately addressed in significantly fewer pages (i.e., 22 pages) in requester's comments of March 31, 2010, than in the appellant brief (70 pages).

Requester asserts that the length of appellant's brief is due to the substantial length of the ACP, as the examiner's explanation for not adopting the 24 proposed grounds of rejection being appealed is 19,500 words in length, however, the examiner's refusal to adopt the proposed rejections were previously argued in requester's comments filed March 31, 2010, subsequent to the non-final Office action. It is noted that the ACP differs from the non-final Office action in that it contains a refusal to adopt the proposed rejections of claims 2 and 24 (previously adopted-in-part rejections A and U), however, that difference does not appear to justify permitting approximately 40 additional pages/4000 words over the limit, especially since requester previously argued the refusal to adopt the rejections (A and U) on the balance of claims.

Although petitioner has voluntarily reduced the number of issues appealed from 33 to 24, there do not appear to be any additional efforts made to reduce the number of pages or words by, for example, consolidating issues. The page/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 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

Counsel for Patent Owner:
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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.
95/000,485	07/06/2009	7369772	02495.000001.36	7173

5514 7590 01/24/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Fujitsu, Ltd., Inc. v. Tellabs Operations, Inc.

Reexamination Control No. 95/000,485
Patent 7,369,772
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 page and word count requirements of 37 C.F.R. § 1.943(c)," filed December 17, 2010. Petitioner requests waiver of the 7,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the patent owner's respondent brief indicated to be 35 pages in length and have a word count of approximately 12,100 words. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on December 17, 2010, along with the appeal brief fee.

FINDINGS

1. On July 6, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,369,772.

2. Reexamination was ordered and a non-final Office action was mailed on September 25, 2009.

3. Patent owner filed a response to the Office action on November 25, 2009, and third party requester filed corrected-rectified comments in reply to the Office action and patent owner's response on March 31, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On June 24, 2010, an Action Closing Prosecution (ACP) was mailed, and on August 21, 2010, a Right of Appeal Notice (RAN) was mailed incorporating the reasons for patentability of claims 2 and 6-24 set forth in the ACP.

5. Requester filed a Notice of Appeal on September 10, 2010, appealing the refusal to adopt 33 proposed rejections of the claims, each rejection based on at least one of 8 different primary prior art references.

6. On November 10, 2010, requester filed an appellant's brief, accompanied by a petition under 37 C.F.R. § 1.183 to waive the provisions of 37 C.F.R. § 1.943(c).

7. A decision was mailed on December 10, 2010, denying the petition, and setting a one month time limit for requester to file a corrected appellant brief.

8. On December 17, 2010, a respondent brief was filed by patent owner, and was accompanied by the instant petition.

9. Third party requester filed an appellant brief on January 10, 2011.

DISCUSSION

In the present Petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's respondent brief to fifteen pages or 7,000 words in length. The patent owner's respondent brief is 35 pages and stated to be approximately 12,100 words.

Waiver is requested for the following reasons:

(1) The third party requester's appellant brief of November 10, 2010, is 70 pages in length, contains at least 41 drawings, and presents issues relating to 22 proposed rejections that involved all confirmed claims 2 and 6-24.

(2) The Action Closing Prosecution ("ACP") of June 24, 2010, from which third party requester appealed is 117 pages in length.

(3) Patent owner made a *bona fide* effort to reduce the length of its Respondent Brief by addressing third party requester's 70 page appellant brief with a respondent brief that is one-half the page length thereof, to provide responsive arguments in a focused and concise manner.

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.

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 respondent brief filed subsequent to appeal is significantly longer, whereas

the rules require that the briefs be more limited than pre-appeal responses. Patent owner's respondent brief filed on December 17, 2010, has a length of 35 pages and is stated to contain less than 12,100 words which count toward the limit of 15 pages and 7,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of third party requester's appellant's brief and the numerous issues on appeal. However, the appellant's brief of November 10, 2010, was not entered, and the appellant's petition to exceed the page/word limit was denied. Therefore, the respondent brief of December 17, 2010, does not have an entry right. The instant petition is **dismissed as moot**.

DECISION

Respondent has one opportunity to file a respondent brief in compliance with of 37 C.F.R. § 1.943(c), within a non-extendable time period of 30 days from the certificate of service date of the appellant brief filed on January 10, 2011.

In view of the foregoing, the Petition is DISMISSED.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:
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Counsel for Third Party Requester:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,485	07/06/2009	7369772	02495.000001.36	7173

5514 7590 03/25/2011

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1290 Avenue of the Americas
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ORRICK HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPT.
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558

Date: 3-25-11

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000485
PATENT NO. : 7369772
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

MAILED

MAR 25 2011

CENTRAL REEXAMINATION UNIT

Commissioner for Patents
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(For Patent Owner)

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(For Requester)

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IRVINE, CA 92614-2558

In re: Gerstel *et alia*
Reexamination Proceeding
Control No. 95/000,485
Request Deposited: July 6, 2009
For: U.S. Patent No. 7,369,772

DECISION

This is a decision on the February 19, 2010 paper entitled "PETITION UNDER 37 C.F.R. § 1.181 TO NOT ENTER THIRD PARTY REQUESTER COMMENTS" and the March 5, 2010 paper entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.181 to Not Enter Third Party Requester Comments".

Initially, it is noted that the request is premature under 37 CFR 1.181 as the examiner had not yet taken action. Furthermore, the examiner took action on March 2, 2010 and held the comments to be defective.

Accordingly, the February 19, 2010 petition is **dismissed** as either premature or moot.

Regarding the third-party paper filed March 5, 2010, the present opposition petition is non-statutory, and is being **expunged** as will now be explained.

Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. This right is implemented by 37 CFR 1.947, which

provides that a third party requester may once file written comments within a period of 30 days from the date of service of a patent owner's response to an Office action on the merits pursuant to 37 CFR 1.945.

With respect to the March 5, 2010 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 requesting the 3PR response not be entered. Such a petition 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 requirement of "special dispatch" against 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 from an action of an examiner. 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 relief. No mechanism has been provided for the third party requester to file a paper, such as the March 5, 2010 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 relief 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 not a submission of written comments to a patent owner's response to an Office action; 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, the consideration of a request for holding comments defective is clearly within the Office's jurisdiction, and the Office may exercise its discretion in appropriate instances to grant such relief. Note 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) and compare to the discussion in MPEP § 2667 regarding improper opposition petitions to challenge procedural issues (such as extensions of time, revival of terminated prosecution, withdrawal of finality, and the like). Therefore, the requester's opposition to patent owner's request to deny

entry of 3PR's comments 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 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 March 5, 2010 opposition to the patent owner's February 19, 2010 petition does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the 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 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. Petitioner's request to deny entry of the 3PR's comments is **dismissed**.

2. The March 5, 2010 requester opposition paper petition is refused entry and **expunged** from the file.

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

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

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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In re Fallon	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/000,486	:	**DISMISSING**
Filing Date: July 8, 2009	:	**PETITIONS**
For: U.S. Patent No.: 6,604,158	:	

This is a decision on the following petitions, filed concurrently on August 25, 2010:

- The patent owner petition under 37 CFR 1.182, entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (the patent owner petition to terminate); and

- The patent owner petition under 37 C.F.R. 1.183, entitled "Petition Under 37 C.F.R. 1.183 to Transfer Jurisdiction of *Inter Partes* Reexamination" (the patent owner petition to transfer jurisdiction).

The August 25, 2010 patent owner petitions to terminate and to transfer jurisdiction, and the record as a whole, are before the Office of Patent Legal Administration (OPLA) for consideration.

The $400 fee under 37 CFR 1.17(f) for each petition has been paid.

SUMMARY

The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

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 August 25, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

The patent owner argues that termination of the '464 *inter partes* reexamination proceeding is required by 35 U.S.C. 317(b). 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 argues that, pursuant to the statute, a final decision has been entered against the requester/co-defendant in a civil action. The patent owner has provided a copy of a stipulated order of dismissal by the United States District Court for the Eastern District of Texas, Tyler Division (district court) on January 26, 2010, between the patent owner/plaintiff, Realtime Data, Inc., and requester/co-defendant Blue Coat Systems, 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 *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010), the district court ordered "that said stipulation is in all things granted", and that the action [before the district court] "including the amended complaint, answers and counterclaims, be dismissed with prejudice, pursuant to the Settlement and License Agreement dated January 12, 2010 executed by the parties". The district court further ordered that that "this Court shall retain continuing jurisdiction over the parties and the subject matter to enforce the aforesaid Settlement and License Agreement", 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 January 26, 2010 district court judgment is deemed 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

The patent owner further argues that, pursuant to the statute, "[t]he Order of Dismissal was a final decision that Blue Coat did not sustain its burden of proving the invalidity of any patent claim" in suit. Citing *Hartley v. Mentor Corp.*, 869 F.2d 1469, 1473 (Fed. Cir. 1989), the patent owner states that "[a] stipulated judgment in a District Court litigation 'operates as an adverse adjudication on the merits of a claim'". The patent owner points out that the requester, who had the burden of proving invalidity, "stipulated by agreement to dismiss its invalidity defenses and counterclaims with prejudice". Thus, argues the patent owner, "the Order of Dismissal establishes that the Requester did not sustain its burden of proving invalidity in the District Court litigation".

In *Hartley*, however, the issue of validity was actually litigated in an earlier suit, when a court ruled on summary judgment that the patent was invalid under 35 U.S.C. 102(b). The parties then settled and a stipulated judgment was entered dismissing the plaintiff's (Hartley's) infringement claim. The judgment did not address the invalidity ruling already entered by the court. Hartley

[1] See Exhibit E, Order of Dismissal, *Realtime Data LLC v. Packeteer, et al,* 6:08-cv-144-LED-JDL (E.D. Texas, January 26, 2010). Exhibit E is attached to the present petition.

later sued a different defendant, Mentor, on the same patent, who defended on issue preclusion grounds, i.e., that the patent was already held invalid in the earlier litigation. Hartley argued that issue preclusion did not apply because the earlier suit had been finally resolved via a stipulated judgment, i.e., that any preclusive effects of the earlier invalidity judgment were erased when the earlier suit settled with a stipulated judgment. The Federal Circuit disagreed. "Where rulings made after a full and fair opportunity to litigate are firm and consistent with the subsequent settlement agreement by the parties and judgment actually entered into the case, issue preclusion has been applied as to those issues when raised in a subsequent suit." *Hartley v. Mentor Corp.*, 869 F.2d at 1472. The court further noted that "a stipulated final judgment may rest in part on a court's rulings during the course of a trial," and such a judgment "like a contract, must be construed to determine its effect in light of all the circumstances." *Id.* The issue preclusion in *Hartley* was created by the actual litigation and *summary judgment* of invalidity, and not by the dismissal.

Unlike *Hartley*, however, the issue of invalidity was never actually litigated in the present case. The present case solely involves a 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). Finally, while the Federal Circuit in *Hartley* suggested that a stipulated judgment should be construed like a contract to determine its effect, the patent owner in the present case points to no language in the court's dismissal or in the related Settlement and License Agreement that suggests that the parties, or the court, intended the dismissal to resolve the invalidity issue. In fact, the Settlement and License Agreement expressly states that "the issues in the Action are disputed".[2] Thus, 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 action was 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, the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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).

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 the patent owner has not provided any evidence of a final decision by a federal court that the requester/co-defendant in *Realtime Data* 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.

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[2] See Exhibit D, "Settlement and License Agreement between Realtime Data, LLC D/B/A, IXO and Blue Coat Systems, Inc.", page 2. Exhibit D is attached to the present petition.

Accordingly, the August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

II. The August 25, 2010 Patent Owner Petition under 37 CFR 1.183 to Transfer Jurisdiction to OPLA

The patent owner requests that jurisdiction of the present reexamination proceeding be transferred from the Central Reexamination Unit (CRU) to the Office of Patent Legal Administration (OPLA) until a decision on the petition to terminate (also filed on August 25, 2010) has been decided. The present petition under 37 CFR 1.183 is taken as a petition under 37 CFR 1.182.[3]

In essence, the patent owner requests that OPLA take control of the present proceeding to prevent the CRU from taking any further action until OPLA decides the petition to terminate *inter partes* reexamination. This is essentially a request to delay the prosecution in this proceeding. Such a petition is contrary to the statutory mandate that *inter partes* reexamination proceedings be conducted with special dispatch in the Office (35 U.S.C. § 314(c)). Accordingly, the petition is dismissed. [4]

In addition to the above, the patent owner's request, i.e., that OPLA take jurisdiction until a decision on the petition to terminate has been issued, is moot because a decision on the petition to terminate has now been rendered.

For all of the foregoing reasons, the petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182 to transfer jurisdiction, is **dismissed**.

CONCLUSION

- The August 25, 2010 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

- The August 25, 2010 patent owner petition under 37 CFR 1.183, taken as a petition under 37 CFR 1.182, to transfer jurisdiction to OPLA is **dismissed**.

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[3] A petition under 37 CFR 1.183 requires waiver of the rules, and requires a showing of extraordinary circumstances, such that justice requires waiver of the rule. The requested relief, however, has not been shown to require waiver of a rule in the present instance. Furthermore, the patent owner fails to request a waiver of an identified rule. Since transfer of jurisdiction is not specifically provided for in the rules, the present petition is taken under 37 CFR 1.182.

[4] To the extent the patent owner may be relying on MPEP § 2686.04(III) as a basis for submitting the instant petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding, this reliance is misplaced as that section is directed to the situation where such petition is accompanied by a petition to suspend a reexamination proceeding, which must be supported by a showing of "good cause", which did not occur here.

- 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.
95/000,486	07/08/2009	6604158	2855.003REXC	6777

26111 7590 03/29/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/29/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Kenneth L. Cage
MCDERMOTT WILL & EMERY, LLP
600 13th Street, N.W.
Washington, DC 20005-3096

Date:
MAILED

MAR 2 9 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000486
PATENT NO. : 6604158
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.: 95/000,486

1. THIS IS A DECISION ON THE PETITION FILED March 28, 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on March 7, 2011, which sets a one month period for filing a response thereto, be extended by **one month**.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☒ Other: paid via EFS Web.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION
   ONE MONTH Extension of time **GRANTED**.
   Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449 . In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

/J. Harrison/	SPE, AU 3992
[*Signature*]	(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,487	08/21/2009	6505172	54848-5016-US	8473

70813 7590 06/24/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes LAWSON SOFTWARE, INC.
Requester
v.
EPLUS, INC.
Patent Owner

Reexamination Control No. 95/000,487
Patent No. 6,505,172
Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner "Petition under 37 C.F.R. § 1.181," ("present petition") filed on June 8, 2011. The petition requests that the requester's respondent brief of May 25, 2011, be expunged for not being compliant with 37 C.F.R. § 1.943(c), because it is 45 pages in length, and does not contain a certificate of word count.

FINDINGS

1. A request for *inter partes* reexamination of U.S. Patent No. 6,505,172 was filed on August 21, 2009, and was assigned control no. 95/000,487.
2. On October 23, 2009, reexamination was ordered, and a non-final Office action was mailed.
3. Prosecution was conducted and on January 13, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Patent owner filed a Notice of Appeal on February 11, 2011, and an appellant brief on April 25, 2011.
5. Requester filed a respondent brief on May 25, 2011.
6. Patent owner filed the present petition on June 8, 2011.
7. On June 15, 2011, a Notice of Defective Brief was mailed.

ANALYSIS

A review of the record reveals that a Notice of Defective Brief was mailed on June 15, 2011, indicating that the requester's respondent brief of May 25, 2011, exceeds the page limit. The requester has been given one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), in response to the Notice. Accordingly, the present petition is **dismissed as moot.** The requested relief of expunging the respondent brief and removing it from the Office's Image File Wrapper (IFW) system is **denied**, as the respondent brief is an authorized submission pursuant to 37 C.F.R. § 41.68.

CONCLUSION

The present petition is DISMISSED.

James Donald Smith
Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

GOODWIN PROCTOR LLP
901 New York Avenue, NW
Washington, DC 20001

COUNSEL FOR THIRD PARTY REQUESTER:

MERCHANT & GOULD P.C.
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Minneapolis, MN 55402-0903

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,487	08/21/2009	6505172	54848-5016-US	8473

70813 7590 07/06/2011

GOODWIN PROCTER LLP
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WASHINGTON, DC 20001

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2011

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MERCHANT & GOULD PC
P O BOX 2903
MINNEAPOLIS, MN 55402-0903

Date:

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JUL 03 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000487
PATENT NO. : 6505172
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)

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(For Requester)

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P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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CENTRAL REEXAMINATION UNIT

In re: Johnson *et alia*
Reexamination Proceeding
Control No. 95/000,487
Request Deposited: August 21, 2009
For: U.S. Patent No. 6,505,172

DECISION

This is a decision on the May 18, 2011 paper entitled "PETITION UNDER 37 C.F.R. § 1.181".

On June 30, 2011, a decision expunging papers filed May 12, 2011 was mailed.

Therefore, the May 18, 2011 petition is **dismissed** as moot.

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

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

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,487	08/21/2009	6505172	54848-5016-US	8473

70813 7590 08/30/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes LAWSON SOFTWARE, INC.
v.
EPLUS, INC.

Reexamination Control No. 95/000,487
Patent No. 6,505,172
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 of 37 C.F.R. § 1.943," ("present petition") filed on July 21, 2011. The petition requests waiver of 37 C.F.R. § 1.943(c), to permit entry of a respondent brief filed on July 21, 2011, that is stated to be 38 pages in length, and does not contain a certificate of word count. The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to petitioner's credit card on July 22, 2011, along with the appeal brief fee.

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

FINDINGS

1. A request for *inter partes* reexamination of U.S. Patent No. 6,505,172 was filed on August 21, 2009, and was assigned control no. 95/000,487.
2. On October 23, 2009, reexamination was ordered, and a non-final Office action was mailed.
3. Prosecution was conducted and on January 13, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Patent owner filed a Notice of Appeal on February 11, 2011, and an appellant brief on April 25, 2011.
5. Requester filed a respondent brief on May 25, 2011.
6. Patent owner filed a petition to expunge the requester's respondent brief on June 8, 2011.
7. On June 21, 2011, a Notice of Defective Brief was mailed.
8. On June 24, 2011, a decision dismissing the petition of June 8, 2011, was mailed.
9. The requester filed a revised respondent brief, and a respondent brief that exceeds the page limit, accompanied by the present petition, on July 21, 2011.

ANALYSIS

A review of the record reveals that a Notice of Defective Brief was mailed on June 15, 2011, indicating that the requester's respondent brief of May 25, 2011, exceeded the page limit. The requester was given one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), in response to the Notice. In the present petition, requester requests that the Office accept the

respondent brief filed on July 21, 2011, that is stated to be 38 pages in length, and does not contain a certificate of word count. Alternatively, petitioner requests that the Office accept the revised respondent brief that is 15 pages in length should the Office not grant the petition to waive the page count of the respondent brief.

The Office appreciates the filing of a corrected respondent brief in compliance with of 37 C.F.R. § 1.943(c), and accepts the revised respondent brief that is 15 pages in length. The 15-page revised respondent brief of July 21, 2011, is **entered**. The 38-page respondent brief of July 21, 2011, is **not entered**.

In view of the filing of a compliant respondent brief, the present petition is **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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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,489	07/20/2009	6304975	159291-0011(975)	8274

6449 7590 04/13/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Juniper Networks, Inc.
v.
Enhanced Security Research LLC

Reexamination Control Nos. 95/000,489
Patent 6,304,975
Technology Center 3900

DECISION ON PETITIONS

This is a decision on patent owner's "Petition for Waiver of Page Limit under 37 C.F.R. § 1.183" filed February 28, 2011 ("Petition #1"). Petitioner requests waiver of the 30 page limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief indicated to be 130 pages or 37,059 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on February 28, 2011, along with the appeal brief fee.

This is also a decision on requester's "Petition under 37 C.F.R. § 1.183 for Waiver of Page Limit for Requestor's Response to Appellant's Appeal Brief" filed April 1, 2011("Petition #2"). Petitioner requests waiver of the 15 page or 7,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the requester's respondent brief indicated to be 105 pages and 34,901 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on April 1, 2011, along with the appeal brief fee.

FINDINGS

1. On July 20, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,304,975.

2. Reexamination was ordered on August 28, 2009, and a non-final Office action was mailed on September 29, 2009.

3. Patent owner filed a response to the Office action on January 29, 2010, accompanied by a petition to waive the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On April 15, 2010, a decision granting the petition was mailed, in which the decision permitted the 53 page patent owner response plus the 76 pages of declarations, and *sua sponte* permitted 129 pages for requester's comments as well.

5. Requester filed comments in reply to the Office action and patent owner's response on May 17, 2010.

6. On September 29, 2010, an Action Closing Prosecution (ACP) was mailed.

7. On November 30, 2010, a Right of Appeal Notice (RAN) was mailed.

8. Patent Owner filed a Notice of Appeal on December 29, 2010, appealing the rejections of claims 1-13.

9. On February 28, 2011, patent owner filed an appellant's brief, accompanied by Petition #1.

10. On April 1, 2011, requester filed a respondent's brief, accompanied by Petition #2.

DISCUSSION

In Petition #1, 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 stated to be 130 pages and 37,059 words.

Waiver is requested for the following reasons stated by patent owner:

(1) Petitioner indicates that the RAN is over 260 pages, and includes 230 pages of arguments and incorporates by reference an additional 131 pages of arguments from the request.

(2) The RAN maintains 29 sets of rejections and relies on 30 different references.

(3) The brief addresses whether the NetStalker reference qualifies as a "printed publication" and the citation of references having publication dates after the '975 patent's priority date of October 7, 1996.

(4) It was not possible for ESR to fully respond in 30 pages in spite of diligent efforts to do so.

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 105 pages and 34,901 words.

Waiver is requested for the following reasons stated by requester:

(1) Petitioner indicates that the appellant brief is 130 pages, and refers to multiple appendices.

(2) Close to 30 rejections are at issue in this appeal, and approximately 30 different references are relied upon.

(3) The appellant brief is replete with new arguments, newly presented constructions, and newly presented characterizations of the prior art.

(4) Substantial portions of appellant's brief are directed at impugning the evidence and testimony, making a response necessary.

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 exceeded the page limit requirements, per the decision of April 15, 2010, granting a petition. The patent owner was permitted a response of 53

pages, plus 76 pages of declarations containing arguments. The requester was *sua sponte* permitted 129 pages for comments. The *inter partes* reexamination rules require that the appellant brief be more limited than pre-appeal responses, and that the respondent brief be half the size of an appellant brief.

In this case, patent owner's appellant brief filed on February 28, 2011, is stated to be 130 pages and 37,059 words, which count toward the limit of 30 pages and 14,000 words. The appellant brief far exceeds the permitted limit, and also far exceeds the 53-page pre-appeal response, not including the declarations. It additionally contains numerous attachments which would count toward the page limit per MPEP 2667 I.A.2, *e.g.*, copies of Office actions, responses to Office actions, declarations containing arguments, *etc.*,.

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 number of references applied in the rejections. However, the prosecution history reveals that the RAN contains a multitude of rejections of 13 claims under 35 U.S.C. 102 and 103 over 9 primary references. The majority of the rejections being argued by appellant are either over a single reference alone or in combination with 1 or 2 other references. Only a few rejections are based on 3-5 other teachings in combination with the primary reference. Prior to appeal, the examiner included the same/similar multitude of rejections of 13 claims in the non-final Office action. Patent owner's response of January 29, 2010, to the non-final action addressed the rejections in 53 pages, *i.e.*, the rejections were

addressed in significantly fewer pages than in the present appellant brief of 130 pages. While it is true that the use of 9 different primary references alone or in combination with a few other references may cause a challenge, at the same time, the number of references being applied is a relatively small, finite number and the number of claims rejected is limited to 13. The appellant brief filed subsequent to appeal is significantly longer than the permitted limits, whereas the rules require that the brief 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.

Petitioner also indicates that the brief addresses whether the NetStalker reference qualifies as a "printed publication" and the citation of references having publication dates after the '975 patent's priority date of October 7, 1996. While petitioner's 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 petition makes the statement that it was not possible for ESR to fully respond in 30 pages in spite of diligent efforts to do so. 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. Petition #1 is **denied**. The appellant brief of February 28, 2011, is **not entered**.

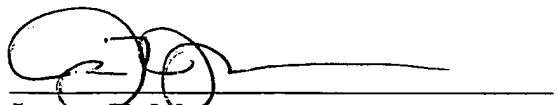
The respondent brief of April 1, 2011, is premature since an appellant brief has not been properly filed (37 C.F.R. § 41.66(b)). The respondent brief is **not entered**. Petition #2 is **dismissed as moot.**

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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Counsel for Third Party Requester:
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1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

(For Patent Owner)

MAILED

AUG 26 2011

CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS, SUITE 900
LOS ANGELES, CA 90067

(For Third Party Requester)

In re Application of: Shipley
Control No. 95/000,489
Filed: July 20, 2009
For: U.S. Patent No. 6,304,975 B1

: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's petition, filed on June 9, 2010, which requests that the director strike the Requestor's Comments submitted on May 14, 2010 for failure to comply with 37 C.F.R. § 1.947. This decision is also in response to Requestor's petition, filed on June 17, 2010, under 37 CFR §§ 1.181-183 requesting that the Director suspend the rules and allow entry of Requestor's Opposition to Patent Owner's petition filed on June 9, 2010. The petitions are before the Director of the Central Reexamination Unit. Both petitions are being treated as petitions filed under 37 CFR 1.181.

The Patent Owner's Petition is dismissed as moot.

The Requester's Petition is dismissed as moot.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,304,975 B1 (the '975 patent) issued on October 16, 2001.

2. A request for reexamination of the '975 patent was filed on July 20, 2009. The request was assigned control No. 95/000,489 (the '489 proceeding).

3. On August 28, 2009, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-13 of '975 patent.

4. On September 29, 2009, the Office mailed an Office action in the '489 proceeding.

5. On January 29, 2010, the Patent Owner filed a Response to the Office action. Prosecution proceeded.

6. On May 17, 2010, the Requestor timely filed[1] Comments to the Patent Owner's Response.

7. On June 9, 2010, the Patent Owner filed the instant petition under 37 C.F.R. §§ 1.182 and/or 1.183 requesting that the Requestor's Comments be stricken from the file for failure to comply with 37 C.F.R. § 1.947.

8. On June 17, 2010, the Requester filed a petition under 37 CFR §§ 1.181-183 requesting that the Director suspend the rules and allow entry of Requestor's Opposition to Patent Owner's petition filed on June 9, 2010.

9. Prosecution proceeded and on September 29, 2010, the Office mailed Action Closing Prosecution (ACP) rejecting claims 1-13 and stating that the new proposed rejections in the Requestor's Comments filed on May 17, 2010 were inappropriate and improper.

10. On November 30, 2010, the Office mailed Right of Appeal, which maintained the rejections in the ACP.

11. On December 29, 2010, the Patent Owner filed a Notice of Appeal.

12. The current status of the proceeding is that Patent Owner has recently filed a replacement appeal brief and Requester has filed a replacement respondent brief.

DISCUSSION

Although the petitions contain statements that an alternative relief sought is under 37 CFR 1.182 and/or 1.183, the petitions are being decided solely under 37 CFR 1.181. The

[1] A decision mailed April 15, 2010 granted Patent Owner's request for additional pages for their response and gave the Requester 1 month to file their comments.

combined petitions under 37 CFR 1.181, 1.182, and/or 1.183 are deemed improper because it combines multiple distinct petitions, which is not compliant with 37 CFR 1.4. Patent Owner and Requester must file multiple issues, such as under 37 CFR 1.181, 1.182 and/or 1.183, in a single petition. In summary, this decision solely addresses the issues raised under 37 CFR 1.181, e.g., requesting supervisory review on whether the Requester's May 17, 2009 comments followed the reexamination laws and procedures.

The relief sought by Patent Owner that is being addressed by this decision is for supervisory review to expunge the Requestor's Comments as improper for failure to comply with 37 CFR 1.947. In their opposition, Requester states that the new proposed obviousness rejections were made in accordance with 37 CFR 1.947. Relief requested under 37 CFR 1.182 and 1.183 is dismissed as not being compliant with 37 CFR 1.4 as explained above.

The relief requested by the Patent Owner and opposed by the third party Requester has, in essence, been granted by the examiner in the ACP. See page 34 of the ACP that stated that the new proposed rejections in the Requestor's Comments (p. 52-57) to be improper. Upon review of the record, the examiner properly determined that the new proposed rejections are improperly raised. 37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. See MPEP 2666.05. The new proposed obviousness rejections based on already cited art were not caused by the patent owner response because the response did not amend claims or add new claims. Requester asserts that Patent Owner's arguments regarding how the claims distinguish over rejections with different bases permits Requester to submit new proposed rejections based art already of record. Such reasoning is clearly against the statutory mandate of special dispatch because entry of new proposed rejections, not necessitated by amendment, would result in prosecution remaining open as long as Patent Owner continues to rebut rejections. Therefore, the new proposed rejections cannot be said to be responsive to issues raised by the patent owner's remarks or the Office action. Accordingly, the examiner properly determined that the new proposed rejections were not raised in accordance with the requirements of 37 CFR 1.947 and 1.948.

The record shows that the examiner, in the interest of special dispatch, acted upon the Patent Owner's response and the Third Party Requester's comments. The record is clear that the examiner did not consider the newly proposed obviousness rejections as properly presented. See, e.g., page 34 of the ACP. In other words, the record is clear that the newly proposed obviousness rejections were not considered because they were improperly raised. As such, the Requester has no rights to appeal any of the newly proposed obviousness rejection in their comments of May 17, 2010.

Because the relief request was, in essence, already granted in the ACP, and in the interest of the statutory mandate of special dispatch, Patent Owner's request to expunge the May 17, 2010 comments is dismissed as moot. Specifically, prosecution has now advanced to a point where appeal and respondent brief have been filed, and special dispatch would not be served if prosecution is delayed by expunging the May 17, 2010 comments and backing up prosecution to the prior to the ACP.

CONCLUSION

1. The Patent Owner's petition, which is treated as a petition under 37 CFR 1.181, filed June 9, 2010, is DISMISSED as moot for the reasons discussed above.

2. The Requester's petition, which is treated as a petition under 37 CFR 1.181, filed June 17, 2010, is DISMISSED for the reasons discussed above.

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

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,489	07/20/2009	6304975	159291-0011(975)	8274

6449 7590 08/30/2011

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
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WASHINGTON, DC 20005

EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
Juniper Networks, Inc.
v.
Enhanced Security Research LLC

Reexamination Control Nos. 95/000,489
Patent 6,304,975
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Contingent Petition under 37 C.F.R. § 1.183 for Waiver of Page/Word Limit Requirement of 37 C.F.R. § 1.943(c) " filed July 6, 2011 (present petition). Petitioner requests waiver of the 30 page limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief indicated to be 30 pages or 13,986 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on August 2, 2011.

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

FINDINGS

1. On July 20, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,304,975.

2. Reexamination was ordered on August 28, 2009, and a non-final Office action was mailed on September 29, 2009.

3. Patent owner filed a response to the Office action on January 29, 2010, accompanied by a petition to waive the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On April 15, 2010, a decision granting the petition was mailed, in which the decision permitted the 53 page patent owner response plus the 76 pages of declarations, and *sua sponte* permitted 129 pages for requester's comments as well.

5. Requester filed comments in reply to the Office action and patent owner's response on May 17, 2010.

6. On September 29, 2010, an Action Closing Prosecution (ACP) was mailed.

7. On November 30, 2010, a Right of Appeal Notice (RAN) was mailed.

8. Patent Owner filed a Notice of Appeal on December 29, 2010, appealing the rejections of claims 1-13.

9. On February 28, 2011, patent owner filed an appellant's brief, accompanied by a first petition to waive the page/word limits.

10. On April 1, 2011, requester filed a respondent's brief, accompanied by a petition to waive the page/word limits.

11. On April 13, 2011, a petition decision was mailed denying patent owner's petition of February 28, 2011 and dismissing requester's petition of April 1, 2011.

12. Patent owner filed an appellant brief on May 13, 2011.

13. On June 6, 2011, a Notice of non-compliant appellant brief was mailed, indicating that the appellant brief of May 13, 2011, exceeds the page/word limits due to declarations that count toward the page/word limits.

14. Patent owner filed a corrected appellant brief and the present petition on July 6, 2011.

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 stated to be 30 pages or 13,986 words. The petition states that ESR believes that its appeal brief is in compliance with the page/word limit requirement. It also indicates that the present petition is submitted "contingent upon a determination by the Office that ESR's revised appeal brief exceeds the page/word count requirement of 37 C.F.R. 1.943(c)."

A review of the record reveals that the appellant brief of July 6, 2011, is approximately 30 pages and includes an affidavit/declaration from each of S. Smaha, Peter M. Shipley, Bruce F. Webster, and Walter Bratic. A

declaration 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, . . . and is subject to the page limit requirements of 37 CFR 1.943." (MPEP 2667I.A.2.) The appellant brief also includes a certificate of word count that states that it "includes the cited portions of any expert declaration that contains opinions or arguments as to how an outstanding rejection is overcome, including that the art does not anticipate or render obvious the claims or specific claim elements." This certificate is signed by the instant petitioner, Martin M. Zoltick (37 C.F.R. § 11.18).

The appellant brief of July 6, 2011, is entered.

The present petition is **dismissed as moot**.

DECISION

The appellant brief of July 6, 2011, is entered.

In view of the foregoing, the present petition is DISMISSED AS MOOT.

James Donald Smith
Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

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6449 7590 09/27/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
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Inter partes
Juniper Networks, Inc.
v.
Enhanced Security Research, LLC

Reexamination Control No. 95/000,489
Patent 6,304,975 B1
Technology Center 3900

DECISION ON PETITION

This is a decision on requester's "Contingent Petition under 37 C.F.R. § 1.183 for Waiver of Page/Word Limit Requirement of 37 C.F.R. § 1.943(c)" filed August 11, 2011 (petition). Petitioner requests waiver of the 15 page limit of 37 C.F.R. § 1.943(c) to permit entry of the requester's respondent brief indicated to be 15 pages or 6,579 words. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on September 22, 2011, as authorized on page 2 of the petition.

Best Available Copy

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

FINDINGS

1. On July 20, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,304,975 B1.

2. Reexamination was ordered on August 28, 2009, and a non-final Office action was mailed on September 29, 2009.

3. Patent owner filed a response to the Office action on January 29, 2010, accompanied by a petition to waive the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On April 15, 2010, a decision granting the petition was mailed, permitting entry of the 53-page patent owner response plus the 76 pages of declarations, and *sua sponte*, permitting 129 pages for requester's comments as well.

5. Requester filed comments in reply to the Office action and patent owner's response on May 17, 2010.

6. On September 29, 2010, an Action Closing Prosecution (ACP) was mailed.

7. On November 30, 2010, a Right of Appeal Notice (RAN) was mailed.

8. Patent Owner filed a Notice of Appeal on December 29, 2010, appealing the rejections of claims 1-13.

9. On February 28, 2011, patent owner filed an appellant's brief, accompanied by a first petition to waive the page/word limits.

10. On April 1, 2011, requester filed a respondent's brief, accompanied by a petition to waive the page/word limits.

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11. On April 13, 2011, a petition decision was mailed denying patent owner's petition of February 28, 2011 and dismissing requester's petition of April 1, 2011.

12. Patent owner filed an appellant brief on May 13, 2011.

13. On June 6, 2011, a Notice of Non-Compliant Appellant Brief was mailed, indicating that the appellant brief of May 13, 2011, exceeds the page/word limits due to declarations that count toward the page/word limits.

14. Patent owner filed a corrected appellant brief and a petition on July 6, 2011.

15. Requester filed a respondent brief and the instant petition on August 11, 2011.

16. On August 30, 2011, a decision entering the appellant brief and dismissing the petition of July 6, 2011, was mailed.

DISCUSSION

In the petition, requester requests waiver of 37 C.F.R. § 1.943(c), which limits requester's respondent brief to 15 pages or 7,000 words in length. The requester's respondent brief is stated to be 15 pages or 6,579 words. The petition states that requester believes that its respondent brief complies with the page/word limit requirements of 37 C.F.R. § 1.943(c), but respectfully requests that the Office grant this contingent petition for waiver of page and word limits, if it concludes otherwise.

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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.

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

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> 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

Requester'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. A review of the record reveals that the respondent brief of August 11, 2011, is approximately 15 pages and includes an affidavit/declaration from each of Daniel Klein, Keith R. Ugone, and Stephen Smaha. The respondent brief also includes a certificate of word count that states that the response brief "including footnotes, contains 6,579 words." The certificate of word count does not include the cited portions of any expert declaration that contains opinions or

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arguments as to how an outstanding rejection is overcome, including that the art does not anticipate or render obvious the claims or specific claim elements. The respondent brief therefore far exceeds the page/word limit requirements of 37 C.F.R. § 1.943(c), due to the declarations (*see* MPEP § 2667 I.).

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of appellant's brief. Petitioner asserts that the multiple appendices to which the brief refers are "collectively thousands of pages long" and "are replete with new argument." Petitioner explains that such new arguments have forced requester to rebut the arguments, to adjust its discussions of the prior art accordingly, and to argue extensively from the prior art references themselves.

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

The respondent brief of August 11, 2011, is entered.

DECISION

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

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Jurisdiction of this *inter partes* reexamination proceeding 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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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.
95/000,490	07/31/2009	7309605	2000706.00137US1	5289

22852 7590 03/21/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2011

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 Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,490
Patent 7,309,605
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition Pursuant to 37 C.F.R. § 1.181 and/or § 1.183 to Strike Portions or Entirely Deny Entry of Appellant's Appeal Brief," filed January 26, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of January 19, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's credit card on January 26, 2011. Patent owner filed an opposition to the petition on February 17,

2011. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner's deposit account, per the authorization on page 5 of the opposition.

FINDINGS

1. On July 31, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,309,605.

2. Reexamination was ordered and a non-final Office action was mailed on September 17, 2009.

3. Patent owner filed a response to the Office action on November 17, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on December 17, 2009.

4. On June 7, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on July 7, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on August 6, 2010.

6. On October 22, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on November 22, 2010, appealing the rejections of claims 1-18.

8. Patent Owner filed an appellant brief on January 19, 2011.

9. Requester filed the present petition on January 26, 2011.

10. Patent owner filed an opposition to the petition on February 17, 2011.

11. On February 22, 2011, requester filed a respondent brief.

DISCUSSION

In the present petition, third party requester requests that the patent owner's appellant brief of January 19, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner asserts that the appellant's brief contains a "Figure 1" at page 10, a "Figure 2" at page 17, and a "Figure 3" at page 19, which have not been previously entered nor considered. Petitioner alleges that these new figures contain numerous errors and distortions relating to the teachings of the key prior art references, and that respondent cannot easily counter these new figures using only the evidence of record. Petitioner purports that to most effectively respond to the "new evidence," that respondent would cite new references and/or obtain new declarations of experts explaining why the figures are false and misleading. Petitioner proposes that the figures have not been counted towards the page limit or word limit for appellant's brief, yet they present a "visual argument" which would have required many pages and many thousands of words to present verbally. Petitioner speculates that appellants are using newly created figures as if they were evidence of record in an unfair means of avoiding the page and word limits for the appellant's brief set forth in 37 C.F.R. § 1.943(c). Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief. Petitioner also asserts that the appellant's brief includes an evidence appendix that contains declarations by experts which were submitted in other *inter partes* reexaminations. Petitioner states that none of these

exhibits were entered into the record by the examiner, because they were crossed off the Form PTO/SB/08 on September 24, 2010.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 provides:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

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. § 41.63(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).

37 C.F.R. § 41.67(c)(2) provides:

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.

37 C.F.R. § 41.68(a)(1) provides:

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.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner's arguments focus on the "new figures" in appellant's brief relating to the teachings of the key prior art references, and assert that respondent cannot easily counter these new figures using only the evidence of record. Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief.

However, a review of the record reveals that the requester filed a respondent brief on February 22, 2011, within the page/word limit pursuant to 37 C.F.R. § 1.943(c). The respondent brief was timely filed and contains arguments concerning the "new figures." Petitioner has characterized the "new figures" in appellant's brief as "visual arguments." However, 37 C.F.R. § 41.67 does not preclude an appellant from presenting new or visual arguments in a brief. Petitioner criticizes appellant's efforts to comply with 37 C.F.R. § 1.943(c), by consolidating the appellant brief. With regard to the exhibits that were crossed off the Form PTO/SB/08 on September 24, 2010, note that the RAN includes the following statement on page 5:

> Copies of multiple declarations originally filed in related reexamination proceedings, Court proceedings, Office actions, amendments and responses filed in the related Patent Applications (listed in the 7/7/10 and 8/31/10 IDs) are considered but are crossed out since these documents are not printed publications.

Therefore, the statement above makes it clear that the exhibits in question were considered. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of the rules pursuant to C.F.R. § 1.183

The appellant brief of January 19, 2010, has been entered. Requester has already filed their one respondent brief pursuant to 37 C.F.R. § 41.68 in reply to the appellant brief. A persuasive showing has not been made that this situation is extraordinary nor that justice requires the relief requested by petitioner. The present petition is **denied**.

DECISION

In view of the foregoing, the Petition is DENIED.

Jurisdiction of this *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,490	07/31/2009	7309605	2000706.00137US1	5289

22852 7590 04/20/2011

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ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:

MAILED
APR 20 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000490
PATENT NO. : 7309605
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

(FOR PATENT OWNER)

MAILED
APR 20 2011
CENTRAL REEXAMINATION UNIT

WILMER CUTLER PICKERING
HALE & DORR LLP
60 STATE STREET
BOSTON, MA 02109

(FOR THIRD PARTY
REQUESTER)

In re Dujon et al.
Reexamination Proceeding
Control No. : 95/000,490
Filed: July 31, 2009
Patent No. 7,309,605

: DECISION UNDER
: 37 CFR 1.181 FOR
: WITHDRAWAL OF
: OPPOSITION FILED
: FEBRUARY 17, 2011

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 25, 2011 patent owner petition, entitled "Request for Withdrawal of Opposition Petition under § 1.181 to Deny Requester's Petition." The petition is requesting that the February 17, 2011 opposition petition be withdrawn from the record in light of the March 21, 2011 decision by the Board of Patent Appeals and Interferences (BPAI).

The patent owner's petition is denied.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,309,605 (the '605 patent) issued on December 18, 2007.

2. A request for reexamination, assigned Control No. 95/000,490 (the '490 proceeding), was filed by a third party requester on July 31, 2009.

3. Reexamination was ordered in the '490 reexamination proceeding on September 17, 2009. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on January 19, 2011, patent owner filed an appellant brief.

5. On January 26, 2011, third party requester filed a petition to expunge patent owner's appellant brief.

6. On February 17, 2011, patent owner filed a petition to oppose requester's petition to expunge patent owner's appellant brief.

7. On March 21, 2011, the Office mailed a decision that denied the requester's petition of January 26, 2011. The decision also addressed the opposition petition of February 17, 2011.

8. On March 25, 2011, patent owner filed the instant petition under 37 CFR 1.181 to withdraw the opposition petition of February 17, 2011.

DECISION

As pointed out, the patent owner filed a March 25, 2011 petition, which is a petition withdrawal of the opposition petition of February 17, 2011. On March 21, 2011, the Office mailed a decision that denied the requester's petition of January 26, 2011. The decision also addressed the opposition petition of February 17, 2011. See pages 1-2 of the March 21, 2011 decision. Therefore, the request to withdraw the February 17, 2011 opposition petition is untimely because a decision addressing the opposition petition was of record prior to the request for withdrawal. No Office resources would be saved by withdrawing the February 17, 2011 opposition petition, as asserted in the March 25, 2011 petition. In fact, more Office resources would be required to withdraw an opposition petition for which a decision was been rendered. Thus, the patent owner's March 25, 2011 petition is hereby denied.

CONCLUSION

1. The March 25, 2011 patent owner's petition is denied.

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

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,491	07/31/2009	6,610,545	2000706.00136US1	6324

22852 7590 01/24/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,491
Patent 6,610,545
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 seeking waiver of 37 C.F.R. § 1.943(c) for Patent Owner's Appeal Brief," filed December 29, 2010. Petitioner requests waiver of the 30 page/14,000 word limit of 37 C.F.R. § 1.943(c), to permit entry of the patent owner's appellant brief, indicated in the petition to be not more than 73 pages. The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a), and the appeal brief fee, accompanied the petition.

FINDINGS

1. On July 31, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,610,545.

2. Reexamination was ordered and a non-final Office action was mailed on September 17, 2009.

3. Patent owner filed a response to the Office action on November 17, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on December 17, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

4. On February 18, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on April 19, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on May 19, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. On September 30, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 29, 2010, appealing the rejections of claims 7-10 and 12-27.

8. On December 29, 2010, patent owner filed the present petition, which was accompanied by an appellant brief.

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 stated to be not more than 73 pages, and it was filed with the present petition.

Waiver is requested for the following reasons:

(1) The Right of Appeal Notice addresses 44 adopted grounds of rejection and is 79 pages long.

(2) Under 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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."

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.

37 C.F.R. § 41.67(c)(vii) provides:

(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.

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.

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 this appeal have been within the respective page limit requirements for responses. However, the appellant brief filed subsequent to appeal is significantly longer than even those prior responses. The rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief is 73 pages, which is far in excess of the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the numerous proposed rejections which were adopted. However, prior to appeal, the examiner included the rejections in the non-final Office action and the Action Closing Prosecution. These rejections were addressed in significantly fewer pages (*i.e.*, less than 50 pages) in patent owner's responses of November 17, 2009, and April 19, 2010, than in the appellant brief (73 pages).

Patent owner asserts that the length of appellant's brief is due to the substantial length of the Right of Appeal Notice (RAN), because the examiner's explanation for the 44 grounds of rejection being appealed is 79 pages long. Patent owner also cites portions of 37 C.F.R. § 41.67(vii), "each issue must be treated under a separate heading," and "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." While these are all 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 present 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 C.F.R. § 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,491	07/31/2009	6,610,545	2000706.00136US1	6324

22852 7590 03/23/2011

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

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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

Inter partes Precision Biosciences, Inc. v. Institut Pasteur and Université Pierre et Marie Curie.

Reexamination Control No. 95/000,491
Patent 6,610,545
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition Pursuant to 37 C.F.R. § 1.181 and/or § 1.183 to Strike Portions or Entirely Deny Entry of Appellant's Appeal Brief," filed March 11, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of February 17, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to petitioner's credit card on March 11, 2011.

FINDINGS

1. On July 31, 2009, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,610,545.

2. Reexamination was ordered and a non-final Office action was mailed on September 17, 2009.

3. Patent owner filed a response to the Office action on November 17, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on December 17, 2009.

4. On February 18, 2010, an Action Closing Prosecution (ACP) was mailed.

5. Patent owner filed a response to the Office action on April 19, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on May 19, 2010.

6. On September 30, 2010, a Right of Appeal Notice (RAN) was mailed.

7. Patent Owner filed a Notice of Appeal on October 29, 2010, appealing the rejections of claims 7-10 and 12-27.

8. Patent Owner filed an appellant brief on February 17, 2011.

9. Requester filed the present petition on March 11, 2011.

10. On March 17, 2011, requester filed a respondent brief.

DISCUSSION

In the present petition, third party requester requests that the patent owner's appellant brief of February 17, 2011, be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner asserts that the appellant's brief contains a "Figure 1" at page 10, a "Figure 2" at page 28, and a "Figure 3" at page 31, which have not been previously entered nor considered. Petitioner alleges that these new figures contain numerous errors and distortions relating to the teachings of the key prior art references, and that respondent cannot easily counter these new figures using only the evidence of record. Petitioner purports that to most effectively respond to the "new evidence," that respondent would cite new references and/or obtain new declarations of experts explaining why the figures are false and misleading. Petitioner proposes that the figures have not been counted towards the page limit or word limit for appellant's brief, yet they present a "visual argument" which would have required many pages and many thousands of words to present verbally. Petitioner speculates that appellants are using newly created figures as if they were evidence of record in an unfair means of avoiding the page and word limits for the appellant's brief set forth in 37 C.F.R. § 1.943(c). Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief. Petitioner also asserts that the appellant's brief includes an evidence appendix that contains declarations by experts which were submitted in other *inter partes* reexaminations. Petitioner states that none of these

exhibits were entered into the record by the examiner, because they are crossed off on the Form PTO/SB/08 considered by the examiner on September 17, 2010.

RELEVANT AUTHORITY

37 C.F.R. § 1.181 provides:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

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. § 41.63(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).

37 C.F.R. § 41.67(c)(2) provides:

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.

37 C.F.R. § 41.68(a)(1) provides:

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.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 41.63 and 37 C.F.R. § 41.67 because it introduces new evidence which was not previously made of record. Petitioner's arguments focus on the "new figures" in appellant's brief relating to the teachings of the key prior art references, and assert that respondent cannot easily counter these new figures using only the evidence of record. Petitioner contends that respondent would be unfairly prejudiced because a substantial portion of respondent's brief would be used in

rebutting appellants' "new evidence" which is not counted towards the page and word limits for the appellants' brief.

However, a review of the record reveals that the requester filed a respondent brief on March 17, 2011, stated to be within the word limit pursuant to 37 C.F.R. § 1.943(c). The respondent brief was timely filed and contains arguments concerning the "new figures." Petitioner has characterized the "new figures" in appellant's brief as "visual arguments." However, 37 C.F.R. § 41.67 does not preclude an appellant from presenting new or visual arguments in a brief. Petitioner criticizes appellant's efforts to comply with 37 C.F.R. § 1.943(c), by consolidating the appellant brief. With regard to the exhibits crossed off of the Form PTO/SB/08, it is noted that the RAN indicates on the bottom of page 3 that all documents have been considered, but those not appropriate for printing on the reexamination certificate have been lined through. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of the rules pursuant to C.F.R. § 1.183

The appellant brief of February 17, 2011, has been entered. Requester has already filed their one respondent brief pursuant to 37 C.F.R. § 41.68 in reply to the appellant brief on March 17, 2011. A persuasive showing has not been made that this situation is extraordinary nor that justice requires the relief requested by petitioner. The present petition is **denied.**

DECISION

In view of the foregoing, the Petition is DENIED.

Jurisdiction of this *inter partes* reexamination proceeding is returned to the Central Reexamination Unit for preparation of the next appropriate Office action.

James T. Moore
Acting Chief Administrative Patent Judge

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(FOR PATENT OWNER)

MAILED

APR 20 2011

CENTRAL REEXAMINATION UNIT

WILMER CUTLER PICKERING
HALE & DORR LLP
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BOSTON, MA 02109

(FOR THIRD PARTY
REQUESTER)

In re Dujon et al.
Reexamination Proceeding
Control No. : 95/000,491
Filed: July 31, 2009
Patent No. 6,610,545

: DECISION UNDER
: 37 CFR 1.181 FOR
: WITHDRAWAL OF
: OPPOSITION
: PETITION

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a March 28, 2011 patent owner petition, entitled "Request for Withdrawal of Opposition Petition under § 1.181 to Deny Requester's Petition." The petition is requesting that the patent owner's opposition petition be withdrawn from the record in light of the March 23, 2011 decision by the Board of Patent Appeals and Interferences (BPAI).

The patent owner's petition is dismissed.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,610,545 (the '545 patent) issued on August 26, 2003.

2. A request for reexamination, assigned Control No. 95/000,491 (the '491 proceeding), was filed by a third party requester on July 31, 2009.

3. Reexamination was ordered in the '491 reexamination proceeding on September 17, 2009. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on February 17, 2011, patent owner filed an appellant brief.

5. On March 11, 2011, third party requester filed a petition to expunge patent owner's appellant brief.

6. On March 23, 2011, the Office mailed a decision that denied the requester's petition of March 11, 2011.

8. On March 28, 2011, patent owner filed the instant petition under 37 CFR 1.181 to withdraw the opposition petition.

DECISION

As pointed out, the patent owner filed a March 28, 2011 petition, which is a petition withdrawal of the opposition petition, allegedly filed on March 24, 2011. However, a review of the record does not show that an opposition petition was filed by patent owner on March 24, 2011. Therefore, the request to withdraw the March 24, 2011 opposition petition is deemed unnecessary as the record does not reflect that such an opposition petition was filed. Thus, the patent owner's March 28, 2011 petition is hereby dismissed.

CONCLUSION

1. The March 28, 2011 patent owner's petition is dismissed.

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

Irem Yucel, Director
Technology Center 1600

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(For Requester)

MAILED
MAY 05 2011
CENTRAL REEXAMINATION UNIT

In re Clark
Inter Partes Reexamination Proceeding
Control No. 95/000,492
Filed: August 12, 2009
For: U.S. Patent No. 7,135,641

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

This is a decision on the January 26, 2011 patent owner petition entitled "Petition under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.181(f)" (the January 26, 2011 petition under 37 CFR 1.183).

The January 26, 2011 petition under 37 CFR 1.183, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the January 26, 2011 petition under 37 CFR 1.183 has been received.

The January 26, 2011 petition under 37 CFR 1.183 is **dismissed**.

DECISION

The patent owner's petition under 37 CFR 1.183 requests waiver of the provisions of 37 CFR 1.181(f) to permit the entry of a concurrently-filed petition under 37 CFR 1.181. 37 CFR 1.181(f) provides, in pertinent part:

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

The patent owner, in its concurrently-filed petition under 37 CFR 1.181, requests relief from the order granting reexamination mailed on October 23, 2009. Thus, the concurrently-filed petition was filed more than two months from the mail date of the action from which relief is requested, and is untimely pursuant to 37 CFR 1.181(f). To obtain a waiver of the rule pursuant to 37 CFR 1.183, the patent owner must show an extraordinary situation such that justice requires such a waiver.

As an initial matter, however, the Office notes that the patent owner's concurrently-filed petition under 37 CFR 1.181, which requests review of the Office's determination of whether a

substantial new question (SNQ) is raised by the request, is filed contrary to statute. See 35 U.S.C. 312, which provides, in pertinent part (emphasis added):

> (a) REEXAMINATION. — . . . **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.
> *
> *
> (c) FINAL DECISION. — **A determination by the Director under subsection (a) shall be final and non-appealable.**

The *inter partes* reexamination statute provides that the Office's determination of "whether an SNQ is raised", i.e., a determination that an SNQ is raised, or a determination that no SNQ is raised, is **final and non-appealable.** Thus, unlike the *ex parte* reexamination statute, [1] the *inter partes* reexamination statute provides that a determination by the Office that an SNQ is raised by the request is final and non-appealable. The Office cannot waive a statutory provision to provide a review on the merits of a determination finding an SNQ in an *inter partes* reexamination. For this reason, the patent owner has not provided a sufficient showing of extraordinary circumstances such that justice required suspension of the timeliness provisions of 37 CFR 1.181(f).

To show extraordinary circumstances as required by 37 CFR 1.183, the patent owner argues that the provisions of 37 CFR 1.181(f) do not apply to petitions alleging *ultra vires* actions on the part of the Office because, if the patent owner is correct that no SNQ is properly raised, then the Office would not have the statutory authority to order reexamination. This argument, however, is circular. It is equally true that if the timeliness provisions of 37 CFR 1.181(f) do not apply to petitions alleging *ultra vires* actions on the part of the Office, then there would be no need for the patent owner to file a petition requesting waiver of the rule. In any event, in order to resolve the issue, the petition must first be treated. It is only the patent owner's position that the examiner's determination that an SNQ is raised is an *ultra vires* action. Whether the examiner's finding that an SNQ is raised is an *ultra vires* action is a debatable issue.

Furthermore, the patent owner did not file the present petition until January 26, 2011, more than seven months after the June 18, 2010 mail date of the action closing prosecution, and ***more than one year and three months after the order granting reexamination.*** The Office is required to conduct *inter partes* reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). It is not in the interests of special dispatch to address the issue of whether the examiner's

---

[1] Compare the provisions of the *ex parte* reexamination statute, specifically, 35 U.S.C. 303(c), which provides, in pertinent part (emphasis added):

> A determination by the Director pursuant to subsection (a) of this section that **no** substantial new question of patentability has been raised is final and nonappealable.

finding that an SNQ is raised is an *ultra vires* action, after extensive prosecution of the proceeding. The patent owner has provided no explanation for the more than 15-month delay in filing its petition.

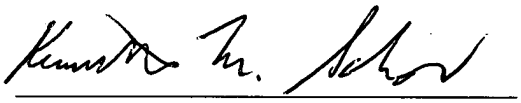
Finally, the patent owner has not shown extraordinary circumstances, since any assertion as to the propriety of any particular rejection of record, on the basis that the rejection is not properly supported by an SNQ, can be resolved on appeal. See, for example, *In re Swanson*, 540 F.3d 1368, 88 USPQ2d 1196 (Fed. Cir. 2008). Thus, justice does not require that the issue of the propriety of the examiner's determination, i.e., that an SNQ is raised, must be resolved by petition even if it were statutorily authorized.

The Office further notes, in any event, that patent owner's concurrently-filed petition under 37 CFR 1.181 only addresses one of two primary references found by the examiner to raise an SNQ in the order. The patent owner makes no mention, in its concurrently-filed petition under 37 CFR 1.181, of JP 29-15973 (the JP'973 reference), which, in combination with the Grandy '612 reference, was expressly found by the examiner to raise an SNQ.[2] Thus, even if treatment of the issue of whether an SNQ is raised by the request were statutorily authorized, the treatment of patent owner's concurrently-filed petition under 37 CFR 1.181 would result in a dismissal, because the Office would still have statutory authority to conduct reexamination based on, at a minimum, the JP '973 reference.

Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

CONCLUSION

- The July 22, 2010 requester petition is **dismissed**.
- Any inquiry concerning this communication should be directed to the Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or to the undersigned, at (571) 272-7710.



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

05/04/2011
Kenpet8

[2] See page 16 of the October 23, 2009 order granting reexamination. Furthermore, rejections of the claims citing the JP '973 reference have been maintained by the examiner throughout the prosecution.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,492	08/12/2009	7,135,641	096001-0106	8191

22428 7590 05/06/2011

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING
1180 PEACHTREE STREET, NE
ATLANTA, GA 30309-3521

Date: MAILED

MAY 06 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000492
PATENT NO. : 7135641
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAY 06 2011

CENTRAL REEXAMINATION UNIT

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In re Clark
Inter Partes Reexamination Proceeding
Control No. 95/000,492
Filed: August 12, 2009
For: U.S. Patent No. 7,135,641

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

This is a decision on the January 26, 2011 patent owner petition entitled "Petition under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 1.181(f)" (the January 26, 2011 petition under 37 CFR 1.183).

The January 26, 2011 petition under 37 CFR 1.183, and the record as a whole are before the Office of Patent Legal Administration for consideration.

The $400 fee pursuant to 37 CFR 1.17(f) for the January 26, 2011 petition under 37 CFR 1.183 has been received.

The January 26, 2011 petition under 37 CFR 1.183 is **dismissed**.

DECISION

The patent owner's petition under 37 CFR 1.183 requests waiver of the provisions of 37 CFR 1.181(f) to permit the entry of a concurrently-filed petition under 37 CFR 1.181. 37 CFR 1.181(f) provides, in pertinent part:

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

The patent owner, in its concurrently-filed petition under 37 CFR 1.181, requests relief from the order granting reexamination mailed on October 23, 2009. Thus, the concurrently-filed petition was filed more than two months from the mail date of the action from which relief is requested, and is untimely pursuant to 37 CFR 1.181(f). To obtain a waiver of the rule pursuant to 37 CFR 1.183, the patent owner must show an extraordinary situation such that justice requires such a waiver.

As an initial matter, however, the Office notes that the patent owner's concurrently-filed petition under 37 CFR 1.181, which requests review of the Office's determination of whether a

substantial new question (SNQ) is raised by the request, is filed contrary to statute. See 35 U.S.C. 312, which provides, in pertinent part (emphasis added):

> (a) REEXAMINATION. — . . . **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.
> *
> *
> (c) FINAL DECISION. — **A determination by the Director under subsection (a) shall be final and non-appealable**.

The *inter partes* reexamination statute provides that the Office's determination of "whether an SNQ is raised", i.e., a determination that an SNQ is raised, or a determination that no SNQ is raised, is **final and non-appealable**. Thus, unlike the *ex parte* reexamination statute, [1] the *inter partes* reexamination statute provides that a determination by the Office that an SNQ is raised by the request is final and non-appealable. The Office cannot waive a statutory provision to provide a review on the merits of a determination finding an SNQ in an *inter partes* reexamination. For this reason, the patent owner has not provided a sufficient showing of extraordinary circumstances such that justice required suspension of the timeliness provisions of 37 CFR 1.181(f).

To show extraordinary circumstances as required by 37 CFR 1.183, the patent owner argues that the provisions of 37 CFR 1.181(f) do not apply to petitions alleging *ultra vires* actions on the part of the Office because, if the patent owner is correct that no SNQ is properly raised, then the Office would not have the statutory authority to order reexamination. This argument, however, is circular. It is equally true that if the timeliness provisions of 37 CFR 1.181(f) do not apply to petitions alleging *ultra vires* actions on the part of the Office, then there would be no need for the patent owner to file a petition requesting waiver of the rule. In any event, in order to resolve the issue, the petition must first be treated. It is only the patent owner's position that the examiner's determination that an SNQ is raised is an *ultra vires* action. Whether the examiner's finding that an SNQ is raised is an *ultra vires* action is a debatable issue.

Furthermore, the patent owner did not file the present petition until January 26, 2011, more than seven months after the June 18, 2010 mail date of the action closing prosecution, and ***more than one year and three months after the order granting reexamination***. The Office is required to conduct *inter partes* reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). It is not in the interests of special dispatch to address the issue of whether the examiner's

---

[1] Compare the provisions of the *ex parte* reexamination statute, specifically, 35 U.S.C. 303(c), which provides, in pertinent part (emphasis added):

> A determination by the Director pursuant to subsection (a) of this section that **no** substantial new question of patentability has been raised is final and nonappealable.

finding that an SNQ is raised is an *ultra vires* action, after extensive prosecution of the proceeding. The patent owner has provided no explanation for the more than 15-month delay in filing its petition.

Finally, the patent owner has not shown extraordinary circumstances, since any assertion as to the propriety of any particular rejection of record, on the basis that the rejection is not properly supported by an SNQ, can be resolved on appeal. See, for example, *In re Swanson*, 540 F.3d 1368, 88 USPQ2d 1196 (Fed. Cir. 2008). Thus, justice does not require that the issue of the propriety of the examiner's determination, i.e., that an SNQ is raised, must be resolved by petition even if it were statutorily authorized.

The Office further notes, in any event, that patent owner's concurrently-filed petition under 37 CFR 1.181 only addresses one of two primary references found by the examiner to raise an SNQ in the order. The patent owner makes no mention, in its concurrently-filed petition under 37 CFR 1.181, of JP 29-15973 (the JP'973 reference), which, in combination with the Grandy '612 reference, was expressly found by the examiner to raise an SNQ.[2] Thus, even if treatment of the issue of whether an SNQ is raised by the request were statutorily authorized, the treatment of patent owner's concurrently-filed petition under 37 CFR 1.181 would result in a dismissal, because the Office would still have statutory authority to conduct reexamination based on, at a minimum, the JP '973 reference.

Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

CONCLUSION

- The January 26, 2011 petition under 37 CFR 1.183 is **dismissed**.
- Any inquiry concerning this communication should be directed to the Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or to the undersigned, at (571) 272-7710.

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

05/04/2011
Kenpet8

[2] See page 16 of the October 23, 2009 order granting reexamination. Furthermore, rejections of the claims citing the JP '973 reference have been maintained by the examiner throughout the prosecution.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,492	08/12/2009	7,135,641	096001-0106	8191

22428 7590 02/24/2012

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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

Date: 2-24-12

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000492
PATENT NO. : 7135641
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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Washington, D.C. 20007

King & Spalding (For Requester)
1180 Peachtree Street, NE
Atlanta, GA 30309 - 3521

In re Clark	:	
Inter Partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No. 95/000,492	:	**PETITION TO TERMINATE**
Filed: August 12, 2009	:	***INTER PARTES* REEXAMINATION**
For: U.S. Patent No.: 7,135,641	:	**PROCEEDING**

This is a decision on patent owner's December 8, 2011 petition entitled "Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the December 8, 2011 petition to terminate), and on patent owner's February 16, 2012 paper entitled "Supplement to Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the February 16, 2012 supplement).

The December 8, 2011 petition to terminate, the February 16, 2012 supplement, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,492, filed on December 8, 2011, is **granted**.

Inter partes reexamination proceeding 95/000,492 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,492 (the '492 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 issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that 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 7,135,641 (the '641 patent), was the subject of a civil action in district court, i.e., *Belden Technologies Inc. v. Superior Essex Communications LP*, Case No. Civ. No. 08-63-SLR (D. Del.). The patent owner submits a copy of a consent judgment, entered by the district court on November 10, 2011, in which the district court stated that "Superior Essex [the defendant/requester of the '492 proceeding] has not sustained its burden of proving the invalidity of any of the asserted claims (1-22) of the '641 Patent [the patent under reexamination]". The court also stated that "[a]ny remaining claims or counterclaims of the parties are dismissed with prejudice", and that "[t]he parties waive their right to appeal or otherwise contest this Consent Final Judgment". Thus, the patent owner has provided sufficient evidence that (1) the requester Superior Essex was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant had not sustained its burden of proving the invalidity of the claims in suit. The patent owner has also submitted, on February 16, 2012, an amendment cancelling claims 23-26, which renders the claims under reexamination to be identical to the patent claims in suit. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the patent owner has submitted a copy of a document entitled "Stipulation and Order Amending Revised Scheduling Order", showing that discovery did not close until August 14, 2009, which was after the August 12, 2009 filing date for the request for reexamination in the present proceeding. In addition, the patent owner has submitted a copy of a another document entitled "Proposed Joint Pre-Trial Order", which indicates, on page 7, that trial did not begin until at least September 7, 2010.[1] These documents, in addition to the other evidence submitted by the patent owner with the present petition, such as a copy of the document entitled "Proposed Trial Exhibit List", provide sufficient evidence that the prior art, and any other issues present in the '492 reexamination proceeding, were either raised or could have been raised by the defendant/requester in the civil action. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's December 8, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

---

[1] With the February 16, 2012 supplement to the present petition, the patent owner has also provided evidence that the "Stipulation and Order Amending Revised Scheduling Order" and the "Proposed Joint Pre-Trial Order" were signed and ordered by the court.

Inter partes reexamination proceeding control no. 95/000,492 (the '492 proceeding) is hereby **terminated**.

The '492 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 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

- Patent owner's December 8, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,492 is **granted**.

- The prosecution of the '492 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.

- The '492 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for entry of the February 16, 2012 amendment and for further processing to conclude the '492 proceeding, as set forth in 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,494	10/21/2009	7507468	070163-9005-06	1141

23409 7590 08/04/2011

MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2011

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CHARLOTTE, NC 28280-4000

Date:
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AUG 04 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000494
PATENT NO. : 7507468
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)

Alston & Bird LLP
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Charlotte, NC 28280-4000

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,494
Filed: October 21, 2009
For: U.S. Patent No. 7,507,468

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

This is a decision on the patent owner's June 7, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. §1.182", which is being treated as a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.945.[1]

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

BACKGROUND

1. On March 24, 2009, United States Patent No. 7,507,468 (the '468 patent) issued to Landvik et al.

2. On August 21, 2009, a request for *inter partes* reexamination of claims 1-27 of the '468 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,494 (the '0494 proceeding).

3. On October 21, 2009, the third party requester filed a corrected request for *inter partes* reexamination in the '0494 proceeding, and the '0494 proceeding was assigned a filing date of October 21, 2009.

4. On January 15, 2010, the Office issued an order granting *inter partes* reexamination in the '0494 proceeding.

5. On February 4, 2010, the Office issued a non-final Office action in the '0494 proceeding.

[1] *See* Section II below.

6. On April 5, 2010, the patent owner filed a response to the February 4, 2010 Office action.

7. On May 5, 2010, the third party requester filed comments after the patent owner's April 5, 2010 response and the February 4, 2010 Office action.

8. On June 7, 2010, the patent owner filed a supplemental response, concurrently with the instant petition.

9. On August 2, 2011, the examiner mailed a communication denying entry of the patent owner's June 7, 2010 supplemental response.

DECISION

I. 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 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 1.945(b) provides (emphasis added):

> Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
> (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
> (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
> (3) A compelling reason to enter the supplemental response.

37 CFR 1.111(a)(2)(i) provides:

> The Office may enter a supplemental reply if the supplemental reply is clearly limited to:
> (A) Cancellation of a claim(s);
> (B) Adoption of the examiner suggestion(s);
> (C) Placement of the application in condition for allowance;
> (D) Reply to an Office requirement made after the first reply was filed;
> (E) Correction of informalities (e.g., typographical errors); or
> (F) Simplification of issues for appeal.

II. Patent owner's petition

In the instant petition, patent owner states that "[t]his is a Petition to permit entry of the attached Patent Owner Remarks filed in response to the Comments of Third Party Requestor, filed May 5, 2010, which is not specifically provided for in the regulations." A petition under 37 CFR 1.182 applies to "situations not specifically provided for in the regulations"; however, in the instant case, 37 CFR 1.945(b) provides for a supplemental patent owner response. Further, the August 2, 2011 Office communication indicates that the June 7, 2010 supplemental response is not being entered because it does not comply with 37 CFR 1.945(b). In view of these circumstances, the instant petition is being treated as a petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.945(b) for entry of the June 7, 2010 supplemental response.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In this instance, patent owner has failed to make any showing why the facts and circumstances in this particular instance give rise to an extraordinary situation in which justice requires waiver of 37 CFR 1.945(b) for entry of the June 7, 2010 supplemental response.[2] Accordingly, the instant petition is dismissed.

Because patent owner's June 7, 2010 supplemental response was previously incorporated into the IFW of the '0494 proceeding, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '0494 proceeding.[3]

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[2] Rather, patent owner merely states, "This is a Petition to permit entry of the attached Patent Owner Remarks filed in response to the Comments of Third Party Requestor, filed May 5, 2010, which is not specifically provided for in the regulations."

[3] *See* MPEP 2666(III) stating, "If the supplemental response is scanned into the IFW for the reexamination proceeding, and thus, the papers cannot be physically returned or discarded, then the supplemental response entries will be marked "closed" and "non-public," and they will not constitute part of the record of the reexamination proceeding. Such papers will not be displayed in the Office's image file wrapper that is made available to the public, patent owners, and representatives of patent owners (i.e., they will not be displayed in the Patent Application Information Retrieval (PAIR) at the Office's website)."

CONCLUSION

1. Patent owner's June 7, 2010 petition is dismissed.

2. Patent owner's June 7, 2010 supplemental response is being expunged from the record of the '0494 proceeding by marking it "closed" and "non-public" in the IFW of the '0494 proceeding.

3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

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

08-03-2011
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,499	11/17/2009	7194094	CSM-012Xq700	9463

207 7590 07/08/2011

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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Date: JUL 08 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000499
PATENT NO. : 7194094
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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WEINGARTEN, SCHURGIN, GAGNEBIN
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BOSTON, MA 02109

(For Patent Owner)

MAILED
OCT 28 2011
CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester)

In re Horrall et al.
Inter Partes Reexamination Proceeding
Control No. 95/000,499
Filed: November 17, 2009
For: U.S. Patent No. 7,194,094

: **DECISION**
: **DISMISSING**
: **REQUESTER'S PETITION**
: **AND EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the April 21, 2011 third party requester ("the requester") petition entitled "PETITION UNDER 37 C.F.R. § 1.183 REQUESTING SUSPENSION OF RULES 37 C.F.R. § 41.116(f) [sic], 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)," requesting entry of evidence after issuance of the Right to Appeal Notice (RAN). The evidence for which entry is requested is attached as Exhibits A-I to the April 21, 2011 requester petition.

This decision also addresses the May 5, 2011 patent owner opposition under 37 CFR 1.182 to the requester's petition requesting entry of the attached evidence after the RAN.

The requester petition and the patent owner opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the requester petition under 37 CFR 1.183, requesting entry of evidence after the RAN, is **dismissed.**

In addition, for the reasons explained below, the April 21, 2011 requester petition and the evidence attached thereto (collectively the requester petition submission) and the May 5, 2011 patent owner opposition are both being expunged from the record as improper papers.

BACKGROUND

- On March 20, 2007, U.S. Patent 7,194,094 B2 (the '094 patent) issued to Horrall et al., with claims 1-34.

- On August 24, 2009, a request for *inter partes* reexamination of the '094 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,499 (the '499 proceeding).

- On November 17, 2009, a corrected request for *inter partes* reexamination of the '094 patent was filed by the third party requester in the '499 proceeding.

- On January 4, 2010, the Office mailed an order granting *inter partes* reexamination concurrently with a non-final Office action rejecting claims 1-34 of the '094 patent.

- On March 4, 2010, the patent owner filed a response to the January 4, 2010 non-final Office action, including an amendment amending only independent claims 1, 14, and 28 by amending the limitation "wherein each of the loudspeaker assemblies has a low directivity index" in each of these claims to "wherein each of the loudspeaker assemblies comprises a cone loudspeaker having a low directivity index."

- On April 1, 2010, the requester filed comments pursuant to 37 CFR 1.947.

- On September 23, 2010, the Office mailed an action closing prosecution (ACP), confirming claims 1-34.

- On November 1, 2010, the requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING WITHDRAWAL OF ACTION CLOSING PROSECUTION."

- On November 15, 2010, the patent owner filed an opposition entitled "OPPOSITION TO THIRD PARTY REQUESTER'S PETITION TO WITHDRAW ACTION CLOSING PROSECUTION" and a petition entitled "PETITION UNDER 37 C.F.R. §1.183 TO ALLOW PATENT OWNER'S OPPOSITION TO THIRD PARTY REQUESTER'S PETITION TO WITHDRAW ACTION CLOSING PROSECUTION."

- On January 25, 2011, the Office mailed a decision expunging the November 1, 2010 third party requester petition and the November 15, 2010 patent owner papers. The Office concurrently mailed a right of appeal notice (RAN), again confirming claims 1-34.

- On February 24, 2011, the requester filed a Notice of Appeal.

- On April 21, 2011, the requester filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 REQUESTING SUSPENSION OF RULES 37 C.F.R. § 41.116(f) [sic], 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)" requesting entry of evidence after issuance of the RAN, the petition being accompanied by the evidence attached as

Exhibits A-I. The requester also filed an appellant's brief[1] concurrently with the instant petition.

- On May 5, 2011, the patent owner filed an opposition to the April 21, 2011 requester requester petition. The May 5, 2011 requester opposition is entitled "OPPOSITION UNDER 37 C.F.R. § 1.182 TO THIRD PARTY REQUESTOR'S PETITION UNDER 37 C.F.R. § 1.183 REQUESTING SUSPENSION OF RULES 37 C.F.R. § 41.116(f), 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)."

- On May 23, 2011, the patent owner filed a respondent's brief.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states (emphasis added):

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

35 U.S.C. § 315(b)(1) states:

> 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.

37 CFR 1.183 states:

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

37 CFR 1.116(f) states:

> Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

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[1] The propriety of the requester's appellant brief will be reviewed in due course by the Board of Patent Appeals and Interferences (BPAI).

37 CFR 41.63(c) states (for *inter partes* reexamination appeals):

> 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).

The Manual of Patent Examining Procedure (MPEP), Section 2673.01, subsection I, states (in part):

> As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party 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 (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond).

The Manual of Patent Examining Procedure (MPEP), Section 2671.02, subsection III, states:

> Where the examiner withdraws a ground of rejection originally initiated by the examiner, such withdrawal should be clearly stated in the ACP as a decision favorable to patentability with respect to the withdrawn rejection. The third party requester's next set of comments that may be filed (after a patent owner response to an action) may propose the withdrawn rejection as a "rejection proposed by the third party requester." In the event the patent owner fails to respond to the ACP and a Right of Appeal Notice (RAN) is then issued, the third party requester may appeal this withdrawal of rejection as a final decision favorable to patentability - see 37 CFR 41.61(a)(2). Where the examiner withdraws a ground of rejection previously proposed by the third party requester, the examiner should treat the issue as rejection proposed by the third party requester that the examiner refuses to adopt.

II. Issues Raised in the Requester's Petition and Relief Requested

In the instant petition, the requester alleges that the examiner raised for the first time in the ACP, a legally incorrect new claim construction with respect to the claim limitation "low directivity index"[2] to find a new ground for patentability, and that this was a reversal of the claim construction adopted in the initial Office action.[3] The requester also contends that the present situation is extraordinary warranting suspension of the rules "because the guidelines articulated in MPEP 2671.02(III)...violate the rights of parties in agency actions as provided for under 5

[2] Requester petition at page 6.
[3] *Id.* at page 16

U.S. C. 554(c)(1) of the Administration Procedures ACT ("APA").[4] The requester argues that these specific guidelines in the MPEP "permit and encourage an Examiner, for the very first time in an ACP, to reverse a previously adopted proposed rejection" and "create a procedural prohibition against the submission of rebuttal evidence by the Requester,"[5] where the patent owner does not submit a response to the ACP.

The evidence for which the requester seeks entry includes technical information regarding "[t]he relationship between the frequency and wavelength of a sound signal"[6] and that "all cone loudspeakers inherently have a low directivity when the diameter of the speaker is less than or equal to the wavelength at the highest frequency of interest."[7] The requester alleges that "[i]n the ACP, the Examiner found that the cone loudspeakers in the claims achieved a low directivity when the diameter of the speakers were less than or equal to the wavelength of the sound signal at the highest frequency of interest in the sound masking spectrum."[8]

The requester argues that the submission of evidence was necessitated by the "[e]xaminer's failure to correctly apply basic laws of physics during the reexamination" and that the requester should be allowed to present evidence to rebut "the legally incorrect claim construction of a key term, which the Examiner improperly relied on in withdrawing the rejections and finding all of the claims of the Horrall '094 patent to be patentable." [9]

Requester requests the following relief: (1) Waiver of the evidentiary rules 37 CFR 1.116(f) and 37 CFR 41.63(c) and *inter partes* reexamination rule 37 CFR 1.939(a) and (2) entry of "evidence relating to the inherent characteristics of cone loudspeakers, which would have been known to those skilled in the art at the time of the priority date of the Horrall '094 patent." [10]

III. Findings and Analysis

A. The Examiner Did Not Adopt a New Claim Construction in the ACP

The requester alleges that the examiner raised, for the first time in the ACP, a new claim construction with respect to the claim limitation "low directivity index"[11] and that the examiner in the ACP is no longer interpreting the amended claims to require a reflector to achieve a low directivity index. This allegation is not borne out by the record. **In the January 4, 2010 non-final Office action,** the examiner did not explicitly construe the term "low directivity index" to require a reflector. Instead, in the non-final Office action at page 22, under the section entitled "Non-Adopted Rejections Proposed by Third Party," the examiner reiterated the statement "[t]he Horrall patent discloses a way of achieving a low directivity loudspeaker by placing a small reflector in front of the loudspeaker aperture ...," that appears on page 19 of the corrected November 17, 2009 request, to rebut requester's argument that WO'958 discloses a low

[4] *Id.* at page 7.
[5] *Id.*
[6] *Id.* at page 13
[7] *Id.* at page 14
[8] *Id.* at page 13.
[9] *Id.* at page 8.
[10] *Id.* at page 8.
[11] *Id.* at page 6.

directivity loudspeaker. The requester relied on this statement from the Horrall '094 patent to argue that the WO '958 achieves the same result by turning the loudspeaker module toward the base rather than toward the grill to provide for a loudspeaker assembly having low directivity index. The examiner simply did not find this argument to be persuasive. The examiner clearly was not construing the term "low directivity index" to require a reflector in this section of the non-final Office action.

In the non-final action, the examiner did not even mention that the prior art which was relied upon in the adopted rejections disclosed a small reflector in front of the loudspeaker aperture to achieve a low directivity loudspeaker. Rather, the examiner argued that the Dzubay reference and the Atlas Manual, which were relied upon in the adopted rejections, both teach loudspeaker assemblies having a low directivity index because the Dzubay reference teaches "flat or planar loudspeakers providing omnidirectional coverage"[12] and the Atlas Manual teaches "4-in ceiling speakers which have wider dispersion."[13] The examiner did not mention in the non-final Office action that the Dzubay reference or the Atlas Manual teaches a reflector.

The examiner's broadest reasonable interpretation of a loudspeaker with a low directivity index is consistent with the Horrall '094 patent which defines a loudspeaker with a low directivity index in column 9, lines 45-59 (reproduced below), and its definition in the '094 patent specification does not involve a reflector:

> Referring to FIG. 8, a loudspeaker with a low directivity index is one that, with reference to the axial direction 802 of the speaker, at location 804 provides an output sound intensity 806 at an angle of 20.degree., preferably 45.degree., and most preferably 60.degree. from the axial direction, that is not more than 3 dB, and not less than 1 dB, lower than the output sound intensity 808 at the same angle from an infinitesimally small sound source at the same location in an infinite baffle at frequencies less than 6000 Hz, as measured in any 1/3 octave band. Accordingly, the loudspeakers used herein provide a substantially uniform acoustic output that extends nearly 180 degrees, i.e., +/-90 degrees from the axial direction of the loudspeaker assembly.

The Horrall '094 patent also explains that there are <u>different methods to achieve a loudspeaker with a low directivity index</u>. One method that does <u>not</u> involve a reflector to achieve a loudspeaker with a low directivity is discussed at column 10, lines 13- 27 of the Horrall '094 patent. This relevant portion of the Horrall '094 patent is reproduced below:

> One method of achieving a loudspeaker with a low directivity index is to have the diameter of the effective aperture of emitter 306 less than or equal to the wavelength of the highest frequency of interest in the sound masking spectrum. Such a low directivity index is most easily achieved when the speaker output of each of the loudspeaker assemblies has an effective aperture area that is equal to the area of a circle of an diameter of between 1.25" and 3". In a preferred embodiment, the diameter of the effective aperture of the emitter 306 is 1.25". This diameter of the effective aperture of emitter 306 provides an emitter with an axial directional index at 3000 Hz that is less

[12] The January 4, 2010 non-final Office action at page 4.
[13] *Id.* at page 9.

> than 1 dB greater than an infinitesimally small sound source and an axial directional index at 6000 Hz that is less than 3 dB greater than an infinitesimally small sound source.

Another method, one that does involve a reflector to achieve a loudspeaker with a low directivity index, is discussed at column 10, lines 13- 27 of the Horrall '094 patent as follows:

> Another method to achieve a loudspeaker with a low directivity index is to place a small reflector in front of the loudspeaker aperture to scatter the high frequency sounds to the sides of the loudspeaker and preventing the high frequency sounds from being axially projected by the loudspeaker. The small effective aperture of the emitter 306 also allows extending the low frequency response in the small airtight enclosure 301 due to the minimization of the mechanical stiffness of the cavity
> air spring.

These two different embodiments discussed in the Horrall '094 patent achieve a loudspeaker with a low directivity index, one with a reflector, and one without a reflector. From the discussion above, the examiner, in the non-final Office action, clearly did not limit the interpretation of loudspeakers with low directivity recited in the claims to require reflectors.

Contrary to the requester's assertion, it was the patent owner's claim amendment - adding the limitation "cone loudspeaker" with respect to the loudspeaker having a low directivity index - that resulted in confirmation of all the claims, not a change in claim construction by the examiner. As stated on page 3 of the ACP, it was the amended limitation in combination with all of the other elements in the claims that distinguished the amended claims over the prior art. At page 3 of the ACP, the examiner states:

> The prior art of record does not specifically disclose or fairly teach a direct field sound masking system including the combination of all of the elements and limitations recited in claims 1-34, particularly wherein each of the loudspeaker assemblies comprises a cone loudspeaker having a low directivity index, and wherein each of the plurality of loudspeaker assemblies is constructed and oriented to provide the acoustic sound masking signal in a direct path to the ears of the listener in the predetermined area.

Thus, in view of the record, the examiner clearly did not (contrary to the allegation by requester) adopt a new claim construction for the term "low directivity index" in the ACP to find patentability for the claims. Furthermore, the same discussion regarding the reflector in the non-final Office action is reproduced in the ACP under the section entitled "Additional Non-Adopted Rejections Proposed by Third Party."

Therefore, the requester's argument that a new claim construction for the term "low directivity index" was first raised by the examiner in the ACP is unpersuasive in view of the facts in this present proceeding.

B. The Requester Could Have Submitted Its Evidence Earlier

In the present petition, requester requests that the relevant rules be waived to permit the requester "the opportunity to submit evidence relating to the inherent characteristics of cone loudspeakers, which would have been known to those skilled in the art at the time of the priority date of the Horrall '094 patent."[14] In response, from the comments filed on April 1, 2010, it is clear that the requester understood that the amended claims did not require a reflector for the cone loudspeakers to achieve a low directivity index. Requester states the following on pages 16-17 of the April 1, 2010 comments:

> If a cone loudspeaker were selected with an aperture of between 1.25" and 3" so that a reflector was not required to achieve the desired low directivity characteristics, as the Horrall '094 patent teaches, the low directivity would simply result from the ***inherent characteristics*** of the cone loudspeaker and not from an inventive modification. The inherent characteristics of a typical cone loudspeaker are not patentable. [Emphasis in original.]

The requester could have clearly submitted its evidence with its April 1, 2010 comments to bolster its argument regarding the inherent characteristics of a typical cone loudspeaker, but requester chose not to do so until after the ACP.

The requester also requests in the present petition to submit evidence regarding the relationship between the frequency and wavelength of a sound signal to show that on page 6 of the ACP, the "[e]xaminer erred in finding that the loudspeakers in the claims, with diameters of up to 3", have a low directivity index at 'the highest frequency of interest in the sound masking spectrum.'"[15] In response, the examiner, at page 6 of the ACP, is reciting column 10, lines 13-27 of the Horrall patent that discloses that a method of achieving a loudspeaker with a low directivity index is to make the diameter of the aperture of the loudspeaker less than or equal to the wavelength of the highest frequency of interest in the sound masking system and that an effective diameter is between 1.25" and 3". This same passage of the Horrall patent was cited and discussed by requester on pages 16-17 of its April 1, 2010 comments. In these comments, the requester only presents arguments and not any evidence that a cone loudspeaker with a cone diameter of less than 3 inches has a distorted output at low frequencies.[16] The requester could have presented the evidence regarding the relationship between the frequency and wavelength of a sound signal at the time of its April 1, 2010 comments, but requester chose not to do so until after the ACP.

In view of the present facts and circumstances, the requester clearly had the opportunity to present the evidence before the ACP, contrary to requester's allegation that the MPEP violates the requester's rights under the APA to present rebuttal evidence. The requester should have foreseen the possibility that the examiner would find patent owner's proffered evidence and arguments to be persuasive and requester's proffered evidence and arguments filed with its April 1, 2010 comments to be unpersuasive. Accordingly, the requester should have filed all of the necessary rebuttal evidence to address issues that were already raised prior to the ACP during the time period provided to the requester by statute.

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[14] Requester petition at page 8.
[15] *Id.* at page 4.
[16] April 1, 2010 Requester comments at page 17.

Therefore, the requester's argument that the issues raised for the first time in the ACP necessitated the submission of evidence is unpersuasive. Contrary to the requester's allegations that the guidelines set forth in MPEP 2671.02(III) violate the requester's right under the APA when the patent owner does not respond to the ACP, the statute and the MPEP guidelines provided requester with the opportunity to address certain matters more fully at a point where requester had an entry right of more evidence, but requester chose not to do so (as discussed above). Further, the rules which preclude further evidence after the RAN (or where patent owner fails to respond to an Office action prior to RAN) were established through notice and comment to implement the *inter partes* reexamination statues. The actions by the examiner are found to not violate the requester's rights for the reasons discussed above, and requester has not established an equitable case (for an extraordinary situation) to waive the rules, for the reasons pointed out above.

In view of the facts and circumstances of this proceeding, the requester has not made a showing of an extraordinary situation to justify waiver of the rules to enter its evidence after the RAN. Accordingly, the requester's April 21, 2011 petition is dismissed.

IV. Additional Ground of Dismissal of Requester's Petition

The present requester petition is accompanied by Exhibits A-I, for which entry is requested by suspension of the rules. However, these exhibits should have been provided as a separate paper and not as part of the requester's petition. According to 37 CFR 1.4(c),

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

Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. The requester's petition and the requester's evidence should be in separate papers.

Accordingly, the Requester's petition is also dismissed for failure to comply with 37 CFR 1.4(c). Notwithstanding the requirements of 37 CFR 1.4(c), submission of evidence as a separate paper would also be prohibited by statute for the reasons set forth immediately below.

V. The Requester's Comments in the Present Petition and Submission of the Accompanying Exhibits Attached Thereto are Prohibited by Statute

The requester's present petition includes arguments that are directed to the merits of the proceeding, which basically amount to comments under 35 U.S.C. 314(b) by the requester, and such comments are prohibited by statute if patent owner does not respond to the Office action. For example, arguments directed to the merits of the proceeding appear on pages 10-15 of the present petition and the evidence accompanying the petition were relied upon by the requester to support some of these arguments. The requester has the opportunity to present comments directed to the merits in an appellant's brief, not with the petition. Likewise, even where

supporting evidence is submitted with a petition under 37 CFR 1.183 to waive 37 CFR 41.63(c) and 37 CFR 1.116(f) to permit entry of evidence after the RAN, the evidence is not to be included in the petition.

Accordingly, the present petition is an improper paper because it contains requester's comments directed to the merits of the proceeding, which is prohibited by statute. Therefore, the third party requester's petition submission lacks an entry right in the present '499 proceeding. The present requester petition and attached exhibits were entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the requester petition submission is being expunged from the record by closing it and marking it "not public" in the IFW of the present reexamination proceeding.

VI. The Patent Owner's Opposition Lacks Entry Right and is an Improper Paper

Since the May 5, 2011 patent owner opposition responds to an improper requester paper that is being expunged, the patent owner opposition is also improper paper.

In addition, the May 5, 2011 patent owner opposition opposing requester's petition under 37 CFR 1.183 requesting entry of evidence after the RAN lacks an entry right because a party may not oppose another party's petition seeking relief that is within the discretion of the Office.

Neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the patent owner to file an opposition to a requester petition to waive the rules. A petition to waive the rules is not directed to the substantive merits of the case. Rather, it goes to an issue that is a matter within the discretion of the Office in balancing the requirement of "special dispatch" against the needs of a specific situation to accept a submission prohibited by the rules. Stated differently, as pointed out above, the patent owner is not responding to an Office action on the merits, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to provide relief expressly prohibited by the rules. The latter is clearly a matter within the discretion of the USPTO Director, for which parties were not granted an opposition right by statute. The 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, and 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 rule waiver. No mechanism has been provided for parties to file a paper, such as the present paper, that is in response to an event other than an Office action or 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. Therefore, the patent owner's opposition to requester's petition under 37 CFR 1.183 is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the requester's petition. Accordingly, the opposition is refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a), "If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the patent owner's paper opposing requester's petition does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not

an authorized paper. Because the 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 patent owner. Rather, the patent owner's paper opposing requester's petition will be expunged from the record by marking it "non-public" and "closed" in the IFW. See MPEP § 2667. A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. Third party requester's April 21, 2011 petition under 37 CFR 1.183 is dismissed.

2. The requester's April 21, 2011 petition submission and May 5, 2011 patent owner opposition are also improper papers, and therefore will NOT be made a part of the record of the '499 proceeding.

3. Since third party requester's petition submission with accompanying exhibits and patent owner's opposition were scanned into the electronic Image File Wrapper (IFW) of the '499 proceeding, these papers are expunged by closing them in the '499 reexamination proceeding's IFW file and marking them as "non-public."

4. 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

7-8-2011
Kenappeal/decisions/entry issues/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,501	10/03/2009	7,127,631	1426-631RE	2732

37509 7590 12/27/2010

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MOUNTAIN VIEW, CA 94039-0460

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/27/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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11800 SUNRISE VALLEY DRIVE
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RESTON, VA 20191

Date:

MAILED

DEC 27 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000501
PATENT NO. : 7127631
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAILED

DEC 27 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,501
Filed: October 3, 2009
For: U.S. Patent No. 7,127,631

: **DECISION**
: **DISMISSING**
: **PETITION UNDER**
: **37 CFR § 1.183**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 CFR § 1.183 TO SUSPEND PAGE LENGTH REQUIREMENT UNDER 37 CFR § 1.943(b)," filed on October 15, 2010.

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

Patent owner's deposit account was charged the petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 on October 18, 2010.

REVIEW OF THE RELEVANT FACTS

1. On October 24, 2006, United States Patent No. 7,127,631 (the '631 patent) issued.

2. On October 3, 2009, a corrected request for *inter partes* reexamination of the '631 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,501 (the '501 proceeding).

3. On December 29, 2009, the Office issued an order granting *inter partes* reexamination in the '501 proceeding.

4. On October 4, 2010, the Office issued a non-final office action on the merits in the '501 proceeding.

5. On October 15, 2010, patent owner filed the instant "PETITION UNDER 37 CFR § 1.183 TO SUSPEND PAGE LENGTH REQUIREMENT UNDER 37 CFR § 1.943(b)" (the petition under 37 CFR 1.183).

6. On November 1, 2010 patent owner filed an "AMENDMENT AND RESPONSE UNDER 37 CFR §§ 1.941, 1.943 AND 1.945" (the response submission).

7. On November 30, 2010, third party requester filed "COMMENTS BY THIRD PARTY REQUESTOR IN INTER-PARTES REEXAMINATION UNDER 35 U.S.C. § 314 and 37 C.F.R. § 1.947".

DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

In the instant petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response totaling 64 pages in length to the October 4, 2010 Office action. *Pet. at 1.* The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth, with specificity, the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

In support of waiver of the rule, patent owner asserts that it "believes that an additional 14 pages, for a total of 64 pages, is necessary to fully and adequately respond to the outstanding Office action, and is reasonable in light of the 64-page effective length of the Office action and the large number of asserted references and rejections." *Pet. at 2.* In particular, patent owner asserts that "[w]hile totaling 21 pages, the Office action also expressly incorporated by reference 43 pages from the Request for *Inter Partes* Reexamination for a total effective length of 64 pages." *Pet. at 2.* Additionally, patent owner asserts that "the Office action sets forth 101 rejections of the claims as allegedly being anticipated or rendered obvious by 11 distinct references, alone or in

combination." *Pet at 2.* Patent owner further asserts that "[f]or these reasons, despite Patent Owner's intention to streamline and economize its arguments wherever possible, Patent Owner does not believe that 50 pages will be sufficient for it to fully and adequately respond to the Office action, as it must to preserve its rights in the '631 patent, currently in litigation." *Pet. at 2.*

Patent owner filed its November 1, 2010 response submission subsequent to the filing of the instant petition. In this instance, patent owner's November 1, 2010 response submission is page-length compliant, because a total of 49 pages count toward the page limit of 1.943(b).[1] Thus, patent owner's November 1, 2010 response submission does not exceed 50 pages, and no waiver of 37 CFR 1.943(b) is required for entry of the November 1, 2010 response. Accordingly, patent owner's request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. The October 15, 2010 patent owner petition under 37 CFR 1.183 is **dismissed**.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole Dretar Haines, Legal Advisor, at 571-272-7717.

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

12-27-2010
Kenpet8/

[1] Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments as to how an outstanding rejection is overcome appear are included against the page limit count. Thus, the cover page of the November 1, 2010 response submission is excluded from the page count, as no arguments appear on that page. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count, the 5 pages of claim amendments do not count toward the page limit. Patent owner also filed an IDS on November 1, 2010, citing two Office action responses filed in related patents and applications that only include claim amendments. As these documents do not include patent owner arguments as to how an outstanding rejection is overcome, no pages of such documents are included against the page limit count.

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Mountain View, CA 94039-0460

(For Patent Owner)

MAILED

AUG 16 2011

CENTRAL REEXAMINATION UNIT

Robert M. Hansen
The Marbury Law Group, PLLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191

(For Requester)

In re Application of: D'Angelo *et alia*
Control No.: 95/000,501
Deposited: October 3, 2009
For: US Patent No. 7,127,631 B2

RESPONSE TO PETITION UNDER 37 CFR 1.59

This is a response to the petition under 37 CFR 1.59(b), filed on March 10, 2010, by which patent owner requests to expunge information from the above identified proceeding.

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

Petitioner requests that the information submitted under seal and identified as Citation No. L7 in an in the Information Disclosure Statement citation form, filed March 9, 2010, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

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

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

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

CONCLUSION

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

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

Andy Kashnikow
SPE AU 3993
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

AUG 26 2011

CENTRAL REEXAMINATION UNIT

Robert M. Hansen
The Marbury Law Group, PLLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191

(For Third Party Requester)

In re Application of: D'Angelo *et al.*
Control No. 95/000,501
Filed: October 3, 2009
For: U.S. Patent No. 7,127,631 B2

: **DECISION**
: **ON**
: **PETITIONS**

This decision addresses the (1) Patent Owner's petition, filed on January 3, 2011 under 37 CFR § 1.182 requesting that the Director expunge Requestor's Comments filed November 30, 2010, and (2) Requestor's petition, filed on January 17, 2010, in opposition to Patent Owner Petition. Both petitions are being treated as petitions filed under 37 CFR 1.181.

Both petitions are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The Patent Owner's Petition to Expunge filed on January 3, 2011 is granted-in-part.
The Requestor's Petition in Opposition to Patent Owner's petition of January 3, 2011 is dismissed.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 7,127,631 B2 (the '631 patent) issued on October 24, 2006.

2. A request for reexamination of the '631 patent was filed on October 3, 2009. The request was assigned control No. 95/000501 (the '501 proceeding).

3. On December 29, 2009, the Office ordered that the patent be reexamined.

4. On October 4, 2010, the Office mailed a first Office action in the '501 proceeding.

5. On November 1, 2010 the Patent Owner filed a Response to the Office action, and added thirty-one, new dependent claims 28-58.

6. On November 30, 2010, the Requestor filed Comments to the Patent Owner's Response.

7. On January 3, 2011, the Patent Owner filed the instant petition under 37 CFR § 1.182 requesting that the Director expunge Requestor's Comments of November 30, 2010 pursuant to 35 U.S.C. § 314(b)(2) and 37 C.F.R. § 1.947.

8. On January 17, 2011, the Requester filed a petition in Opposition to Patent Owner's petition of January 3, 2011.

9. On May 27, 2011, the Office mailed an Action Closing Prosecution (ACP).

10. On June 27, 2011, the Patent Owner filed a Response to the ACP.

11. On July 25, 2011, the Requestor filed Comments to the Response and ACP.

RELEVANT LAW AND REGULATIONS

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;

(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 1.947 states:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2666.05 states, in part:

> Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.
>
> As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.
>
> As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.
>
> As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.
>
> As to items (A) - (C) above where 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.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

DISCUSSION

The Patent Owner's petition, treated as a petition under 37 CFR § 1.181, requests that the Director expunge Requestor's Comments filed November 30, 2010 pursuant to policies set forth in MPEP 2666.05(II). The alleged improper contents of the Requestor's Comments identified by the Patent Owner are five, newly proposed grounds of rejection applied to unamended claims. See pages 4-5 of the petition.

The Requester's opposition asserts that the newly proposed rejections were properly raised in response to patent owner's arguments. See pages 1-2 of the opposition. The Requester also advances that the requirements of 37 CFR 1.104 support the introduction of the new proposed rejections. See page 3 of the opposition.

In the request for reexamination, the Requester identified 15 grounds of rejection based on 14 prior art references. None of the 15 grounds included the proposed obviousness rejections identified on page 3 of the Patent Owner's petition. In the first Office action of October 4, 2010, the Examiner adopted 12 proposed grounds of rejection based on 11 prior art references. In the Patent Owner's Response of November 1, 2010, the Patent Owner responded to all 12 grounds of rejection and proposed thirty-one new dependent claims. In the Requestor's Comments of November 30, 2010, the Requestor addressed the 12 adopted grounds of rejection, as well as one non-adopted ground of rejection. In addition, the Requestor proposed three new grounds of rejection with respect to the newly added claims.

Upon review of the record, the newly proposed grounds of rejections, identified on page 3 of the patent owner's petition, are all directed at original patent claims 1, 8, 14, and 22 that were not proposed to be amended in this proceeding. The record is clear that none of these proposed rejections were identified and explained in the request for reexamination in accordance with the requirements of 37 CFR 1.915. All of the newly proposed grounds of rejections are based upon obviousness relying on the prior art reference Adlhoch, which was already discussed by the Examiner with regard to an adopted anticipation grounds of rejection and by the Patent Owner in its Response.

In their opposition, Requester states that the proposed obviousness rejection was made in accordance with 37 CFR 1.947. 37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. See MPEP 2666.05. The new proposed obviousness rejection based on Adlhoch was not caused by the patent owner amendment in the paper of November 1, 2010 because the amendment did not amend claims 1, 8, 14, and 22. In addition, the patent owner's remarks, dated November 1, 2010, do not bring forth the issue of obviousness of claims 1, 8, 14, and 22 based on Adlhoch. See, e.g., pages 3-9 of the November 1, 2010 remarks. Therefore, the new proposed rejection cannot be said to be responsive to issues raised by the patent owner's remarks.

The Requester also argues that the content of the request for reexamination does not limit the scope of the examination during the reexamination proceeding. As discussed in more detail below, while it is true that the Office has the discretion to make rejections that are not explicitly set forth in the request for reexamination, this discretion does not give the third party requesters any rights to demand that proposed rejections that are not set forth in the request for reexamination in compliance with 35 U.S.C. 311 and 37 CFR 1.915 be adopted or not adopted by the examiner. Neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must explicitly consider on the record and explain why they are making or not making every possible rejection that is not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Reexamination laws and policies are clear that examiners are only required to consider whether the claims define a novel and nonobvious invention over the prior art of record in order to answer the issues of patentability raised by the request, and to articulate any grounds of rejection, or reasons for patentability that meets the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), so that the patent owner and the third party requester can understand the grounds and appropriately reply to the Office action. See MPEP 706 and 2660. Therefore, the record does not support Requester's view that a thorough examination of the claims was not performed unless the examiner explicitly considered on the record the proposed obviousness rejection based on Adlhoch, which were not identified and explained in accordance with the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination.

The record shows that the examiner, in the interest of special dispatch, acted upon the Patent Owner's response and the Third Party Requester's comments of November 30, 2010. The record is clear that the examiner did not consider the newly proposed obviousness rejections based on Adlhoch as properly presented. See, e.g., pages 27-32 and 41 of the ACP. In other words, the record is clear that the newly proposed obviousness rejections based on Adlhoch were not considered because they were improperly raised. As such, the Requester has no rights to appeal any of the newly proposed obviousness rejection based on Adlhoch.

Because the record is clear as to what grounds of rejection were properly considered and in the interest of the statutory mandate of special dispatch, Patent Owner's request to expunge the November 30, 2010 comments is denied. Specifically, prosecution has now advanced to a point where a response and comments submitted in response to the ACP, and special dispatch would not be served if prosecution is delayed by expunging the November 30, 2010 comments and backing up prosecution to the prior to the ACP.

Patent owner's petition is granted to the extent that this decision affirms that the new proposed obviousness rejections based on Adlhoch on pages 16-17 (subsection II. D), 21-22 (subsection III. D), 28-29 (subsections IV. D and V-VI), and 44-45 (subsection XV) of the November 30, 2010 comments are improperly raised and will not be subject to any appeal in this proceeding.

Upon review of the record, the Requester's comments submitted July 26, 2011 improperly raise the same new proposed obviousness rejections based on Adlhoch. See, e.g., pages 18-20 and 30-31 of the July 26, 2011 comments. Therefore, the Requester's comments of July 26,

2011 are expunged from the record. The Requester is given fifteen (15) days from the mailing date of this decision to file replacement comments that do not discuss the new proposed obviousness rejections based on Adlhoch. If, upon the second submission, the comments are still not proper, the comments will be returned to Requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry. See MPEP 2666.05. Requester is further notified that any future papers that discuss the new proposed obviousness rejections based on Adlhoch will not be entered, or if entered, will be expunged from the record of this proceeding.

CONCLUSION

1. The Patent Owner's petition, which is treated as a petition under 37 C.F.R. § 1.181, filed January 3, 2011, is granted-in-part for the reasons discussed above.

2. The Requestor's petition, filed January 17, 2011, in opposition to Patent Owner's petition is dismissed for the reasons discussed above.

3. The Requester's comments, filed July 26, 2011, are expunged from the record. The Requester has fifteen days (15) to file replacement comments that do not discuss the new proposed obviousness rejections based on Adlhoch.

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

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895

38939 7590 12/28/2010

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960

38939 7590 12/28/2010

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421

38939 7590 12/28/2010

DYKEMA GOSSETT PLLC
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EXAMINER	
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DATE MAILED: 12/28/2010

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Post Office Box 1404
Alexandria, VA 22313-1404

MAILED

DEC 28 2010

CENTRAL REEXAMINATION UNIT

In re Anthony D. Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,509 :
Filed: October 7, 2009 :
For: U.S. Patent No. 6,781,231 :
: **DECISION, *SUA SPONTE*,**
In re Anthony D. Minervini : **TO MERGE**
Inter Partes Reexamination Proceeding : **REEXAMINATION**
Control No.: 95/001,251 : **PROCEEDINGS**
Filed: November 24, 2009 :
For: U.S. Patent No. 6,781,231 :
:
In re Anthony D. Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,363 :
Filed: June 30, 2010 :
For: US. Patent No. 6,781,231 :

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

BACKGROUND

1. U.S. Patent No. 6,781,231 ("the '231 patent") issued to Anthony D. Minervini on August 24, 2004, with 22 claims.

2. A request for *inter partes* reexamination of claims 1-22 of the '231 patent was filed on October 7, 2009, by a third party requester, and was assigned control number 95/000,509 ("the '509 *inter partes* proceeding"). The real party in interest is Analog Devices, Inc.

3. On November 25, 2009, *inter partes* reexamination was ordered for claims 1-22 of the '231 patent based on the examiner's determination that the October 7, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by an Office action rejecting Claims 1-4 and confirming the patentability of claims 5-22.

4. On January 28, 2010, patent owner submitted a response to the November 25, 2009 non-final rejection action. The January 28, 2010 patent owner response included the addition of new claims 23-26.

5. The '509 requester filed comments on February 24, 2010, on patent owner's January 28, 2010 response.

6. A request for *inter partes* reexamination of claims 1-4 of the '231 patent was filed on November 24, 2009, by a third party requester, and was assigned control number 95/001,251 ("the '1251 *inter partes* proceeding"). The real party in interest is Wolfson Microelectronics, PLC.

7. On February 23, 2010, *inter partes* reexamination was ordered for claims 1-4 of the '231 patent based on the examiner's determination that the November 24, 2009 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final an Office action rejecting Claims 1-4.

8. On April 26, 2010, patent owner submitted a response to the February 23, 2010 non-final rejection action. The April 26, 2010 patent owner response included the addition of new claims 23-26, which are identical to claims 23-26 added by patent owner in the January 28, 2010 response filed in the '509 *inter partes* proceeding.

9. The '1251 requester filed comments on May 21, 2010, on patent owner's April 26, 2010 response.

10. A request for *inter partes* reexamination of claims 1-4 of the '231 patent was also filed on June 30, 2010, by a third party requester, and was assigned control number 95/001,363 ("the 1363 inter partes proceeding"). The real party in interest is BSE Co., Ltd.

11. On September 8, 2010, *inter partes* reexamination was ordered for claims 1-4 of the '231 patent based on the examiner's determination that the June 30, 2010 request raised a substantial new question of patentability affecting these claims. No Office action has been issued in the '1363 proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

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

In accordance with 37 CFR 1.989(a), the 95/000,509, 95/001,251 and 95/001,363 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all three files throughout the merged proceeding. Presently, the '509 and '1251 proceedings, but not the '1363 proceeding, include additional claims 23-26. Thus, the claims are not currently the same in all three files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-22 of the '231 patent in the '509 proceeding, for claims 1-4 of the '231 patent in the '1251 proceeding, and for claims 1-4 of the '231 patent in the '1363 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-22 of the '231 patent and for the newly added claims 23-26.

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,509, *inter partes* Reexamination No. 95/001,251 and *inter partes* Reexamination Control No. 95/001,363 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

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

Pinchus M. Laufer
Legal Advisor
Office of Patent Legal Administration

October 7, 2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895

38939 7590 05/03/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/03/2011

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

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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421

38939 7590 05/03/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960

38939 7590 05/03/2011

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LADAS & PARRY LLP
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CHICAGO, IL 60604

Date: MAILED

MAY 03 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001363
PATENT NO. : 6781231
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
MAY 03 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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BOSTON, MA 02210-2206

Date: MAILED
MAY 03 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
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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Commissioner for Patents
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Alexandria, VA 22313-1450
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DYKEMA GOSSETT PLLC : (For Patent Owner)
10 S. WACKER DR. STE. 2300 :
CHICAGO, IL 60606 :

MAILED
MAY 03 2011
CENTRAL REEXAMINATION UNIT

SUNSTEIN KANN MURPHY & : (For 95/000,509 Requester)
TIMBERS LLP :
125 SUMMER STREET :
BOSTON, MA 02110 :

WOLF GREENFIELD & SACKS, P.C. : (For 95/001,251 Requester)
600 ATLANTIC AVE. :
BOSTON, MA 02110 :

BUCHANAN, INGERSOLL & : (For 95/001,363 Requester)
ROONEY PC :
POST OFFICE BOX 1404 :
ALEXANDRIA, VA 22313-1404 :

In re: Minervini :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,509 :
Deposited: October 7, 2009 :
For: U.S. Patent No.: 6,781,231 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,251 :
Deposited: November 24, 2009 :
For: U.S. Patent No.: 6,781,231 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,363 :
Deposited: June 30, 2010 :
For: U.S. Patent No.: 6,781,231 :

This is a decision on a petition filed by the patent owner on January 28, 2011, entitled "PETITION UNDER 37 C.F.R.. § 1.182 TO STRIKE THIRD PARTY REQUESTER'S COMMENTS" [hereinafter "the petition"]. The petition is being treated as a petition under 37

C.F.R. § 1.181 as a request to the Director to exercise his discretion to review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. The petition is dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,781,231 issued on August 24, 2004.
- A request for *inter partes* reexamination was filed October 7, 2009 and assigned control no. 95/000,509.
- A second request for *inter partes* reexamination met the requirements for receiving a filing date on November 24, 2009 and was assigned control no. 95/001,251.
- A third request for *inter partes* reexamination met the requirements for receiving a filing date on June 30, 2010 and was assigned control no. 95/001,363.
- *Inter partes* reexamination was ordered and prosecution progressed in each proceeding. The third party in the '1251 proceeding filed comments responsive to an Office action and patent owner response on May 21, 2010.
- The proceedings were merged in a decision mailed December 28, 2010.
- A Non-final Rejection was mailed on December 28, 2010 in the merged proceeding.
- On January 28, 2011, the instant petition was filed along with a response to the Office action

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is

requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 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

Patent owner ["petitioner"] argues that the comments filed by the third party requester on May 21, 2010 are improper and should be stricken from the record as being longer than the permissible page limit, and also as being drawn beyond the permissible scope.

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.[1]

A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the reexamination record. Thus, the allegedly improper action, the entry of the paper into the record, took place on May 21, 2010, the filing date of the third party comments submission.

The petition was filed on January 28, 2011, nearly six months after the entry of the paper into the record. It was therefore not filed within two months of the act of entering the paper, from which relief is requested. The petition is therefore untimely under 37 CFR § 1.181(f), and is dismissed.

---

[1] Note that this does not change the result herein, as 1.182 petitions are also subject to the time limit discussed in this decision. "The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided . . . . The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed." MPEP 1002.01.

CONCLUSION

1. The petition filed January 28, 2011 is dismissed as untimely.

2. Jurisdiction remains with the Central Reexamination Unit for consideration of the January 28, 2011 patent owner response and subsequent third party requester comments.

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.

Bruce Kisliuk
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895

38939 7590 05/11/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960

38939 7590 05/11/2011

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95/001,363	06/30/2010	6,781,231	092771-0035	7421

38939 7590 05/11/2011

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125 SUMMER STREET
BOSTON, MA 02110-1618

Date: MAILED
MAY 1 1 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date: MAILED
MAY 11 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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CHICAGO, IL 60604

Date:

MAILED
MAY 11 2009
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
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REEXAMINATION CONTROL NO. : 95001363
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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Boston, MA 02210-2206

(For 95/001,251 Requester)

MAILED
MAY 11 2011
CENTRAL REEXAMINATION UNI

Ladas & Parry LLP
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Chicago, IL 60604

(For 95/001,363 Requester)

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/000,509
Filed: October 7, 2009
For: U.S. Patent No. 6,781,231

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,251
Filed: November 24, 2009
For: U.S. Patent No. 6,781,231

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,363
Filed: June 30, 2010
For: U.S. Patent No. 6,781,231

DECISION DISMISSING PETITION AND *SUA SPONTE* EXPUNGING IMPROPER PAPERS

This is a decision on the petition entitled "Petition under 37 CFR § 1.183 For Waiver of Page Limit", filed on February 18, 2011, by the requester of *inter partes* reexamination proceeding control no. 95/001,251 (the February 18, 2011 requester petition).

The February 18, 2011 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.

SUMMARY

The February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

The May 21, 2010 and February 28, 2011 comments submissions, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, ***facially*** fail to comply with Office regulations and procedures, are **improper,** and are being ***sua sponte*** **expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The February 18, 2011 Petition Under 37 CFR 1.183 to Waive the Page Length Requirements of 37 CFR 1.943(b)

In the instant petition, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b) for the comments submission filed on May 21, 2010 in *inter partes* reexamination control no. 95/001,251. The May 21, 2010 written comments submission is in excess of 50 pages.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In the present case, however, the requester did not file its petition until nearly two months after a decision merging the '1251 proceeding with two other *inter partes* reexamination proceedings, control nos. 95/000,509 and 95/001,363, as well as a non-final Office action in the merged proceeding, had been mailed. Furthermore, the requester did not file its petition until ***nearly nine months after*** the filing of its comments submission, for which waiver of the rule is requested.

The requester argues that the present petition "is belated . . . because the Requester was unaware of the page limit at the time the Comments were filed". That the requester was unaware of the page limit requirements is not considered to reflect an extraordinary situation, such that justice requires waiver of the rule, particularly in view of requester's substantial delay in filing its petition.

Accordingly, the February 18, 2011 petition, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

Requester's May 21, 2010 and February 28, 2011 Comments Submissions Facially Fail to Comply with Office Regulations and Published Procedures

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The Office, however, notes that requester's May 21, 2010 and February 28, 2011 comments submissions ***facially*** fail to comply with Office regulations and published procedures.

For example, requester's May 21, 2010 and February 28, 2011 comments submissions fail to comply with MPEP 2666.05 and MPEP 2617. See MPEP 2666.05 which provides, in pertinent part (emphasis added):

> . . . where 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.

Requester's comments submissions propose new grounds of rejection. The submissions, however, fail to provide a clear and complete explanation for every claim for which a rejection is proposed, due to the lumping together of the identification and explanation of multiple proposed rejections. See, for example, the rejections newly proposed on pages 47 and 14 of the May 21, 2010 and February 28, 2011 comments submissions, respectively, where the requester proposes a rejection over "the combination of **either** Torkkeli **or** Bamhauer with Sjursen".

Also, the requester's comments submissions do not clearly specify what new non-cumulative technological teaching, which forms the basis for a substantial new question (SNQ), is taught by at least one of the documents cited for *each* newly proposed ground of rejection. For at least one of the documents cited for each newly proposed ground of rejection, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number). If a ground of rejection citing only one document is newly proposed, the requester must specify where, in the document, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number).

Finally, the requester is reminded that a proper comments submission must specifically explain, for each newly proposed rejection, *how patent owner's amendment necessitated each newly proposed new ground of rejection*, and why each reference of any proposed combination is needed to address the amendment. **For each newly submitted document**, the requester must ***specifically*** explain **a)** how the presence of a teaching in the newly submitted document, if cited alone in a proposed rejection, **corresponds to at least one claim limitation newly added by**

patent owner's amendment, or **b)** if the newly submitted document is cited as one of the documents of a document combination, how the presence of a teaching in at least one of the documents of the document combination **corresponds to at least one claim limitation newly added by patent owner's amendment**. See MPEP 2666.05.

For the reasons given above, the May 21, 2010 and February 28, 2011 requester comments submissions ***facially*** fail to comply with Office regulations and procedures, are **improper,** and are being ***sua sponte* expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

This decision addresses requester's comments submissions solely for the purpose of determining their compliance with the page length requirements of 37 CFR 1.943(b), and is not intended to provide a full analysis of requester's comments submissions for compliance with any other Office regulations or procedures. The examiner should review all pending, and later-filed papers of record for compliance with Office regulations and published procedures.

Requester's Recourse

The requester is given **15 days to file a replacement comments submission**, which may include the content of both the May 21, 2010 and the February 28, 2010 comments submissions, including any appendices, **and any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission**. Any petition under 37 CFR 1.183 requesting waiver of the page length requirements is to be filed concurrently with the replacement comments submission for which waiver is requested.

This decision does **not** *sua sponte* waive the page length requirements of 37 CFR 1.943(b) with respect to any replacement comments submission that is filed in response to this decision, nor is this decision intended to imply a *sua sponte* waiver of any specific number of pages in excess of 50. The requester, in fact, should attempt to file a replacement comments submission within the regulatory 50-page limit.

In order to request waiver of the page length requirements pursuant to 37 CFR 1.183, if a waiver is needed, the requester is reminded that 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. **The burden is on the petitioner** to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a comments submission in compliance with the 50-page limit, and the filing of a resulting comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the comments submission. Such a

submission can be evaluated for economizing, extraneous material,[1] and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed submission: (1) for justification that more pages are needed to complete the submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the submission.

The requester is also reminded that 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 of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count 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.[2] Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The requester is further reminded that, **in order to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:**

1) is one-and-a-half or double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes

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[1] For example, a brief review of the May 21, 2010 comments submission reveals the presence of an entire section devoted to a legal analysis of the broadest reasonable interpretation standard, which may be considered to be extraneous material.

[2] For example, a brief review of the May 21, 2010 comments submission reveals the presence of a brief, submitted in the United States Court of Appeals for the Federal Circuit. The brief includes arguments regarding the invalidity of the patent under reexamination in this proceeding, and would, if later filed, be considered as replete with legal arguments that are an extension of the arguments of counsel, which would be counted toward the regulatory page limit.

and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR § 1.52(a)(1)(v).

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

CONCLUSION

- The February 18, 2011 petition under 37 CFR 1.183, filed by the requester of *inter partes* reexamination proceeding control no. 95/001,251, is **dismissed**.

- The May 21, 2010 and February 28, 2011 requester comments submissions ***facially*** fail to comply with Office regulations and procedures, are **improper,** and are being ***sua sponte*** **expunged** from the record due to their failure to comply, at a minimum, with MPEP 2617 and MPEP 2666.05. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

- The requester of the '1251 *inter partes* reexamination proceeding is given **15 days to file a replacement comments submission** in this merged proceeding, pursuant to the guidance set forth in this decision, and to concurrently file **any petition under 37 CFR 1.183 requesting waiver of the page length requirements of 37 CFR 1.943(b) for the replacement comments submission**.

- If no response to this decision is timely filed by the requester of the '1251 *inter partes* reexamination proceeding, prosecution of this merged proceeding, including the mailing of an Office action, will proceed in due course, without consideration of the May 21, 2010 and February 28, 2010 comments submissions filed by the third party requester of the '1251 *inter partes* reexamination proceeding.

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

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

5/10/11
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,509	10/07/2009	6781231	092771-0021C	5895

38939 7590 06/27/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,251	11/24/2009	6,781,231	092771-0021D	6960

38939 7590 06/27/2011

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10 S. WACKER DR., STE. 2300
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,363	06/30/2010	6,781,231	092771-0035	7421

38939 7590 06/27/2011

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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Date: MAILED
JAN 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000509
PATENT NO. : 6784231
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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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001251
PATENT NO. : 6781231
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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Date: MAILED
JUN 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001363
PATENT NO. : 6781231
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Patent Owner)

MAILED

JUN 27 2011

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(For 95/001,363 Requester)

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/000,509
Filed: October 7, 2009
For: U.S. Patent No. 6,781,231

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,251
Filed: November 24, 2009
For: U.S. Patent No. 6,781,231

DECISION

GRANTING

PETITION

In re Minervini
Inter Partes Reexamination Proceeding
Control No. 95/001,363
Filed: June 30, 2010
For: U.S. Patent No. 6,781,231

This is a decision on the petition entitled "Petition under 37 CFR § 1.183 For Waiver of Page Limit", filed on May 26, 2011, by the requester of *inter partes* reexamination proceeding control no. 95/001,251 (the May 26, 2011 requester petition).

The May 26, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration.

DECISION

Requester's May 26, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response 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 response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the requester requests that the Office waive the page length requirements of 37 CFR 1.943(b). Specifically, the requester argues that the requester must present proposed rejections of newly added claims 23-27 (including independent claim 24), a detailed discussion of the newly added claims, and must also satisfy the applicable requirements of 37 CFR 1.948 and MPEP 2666.05.

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(b), the requester has submitted, on May 25, 2011, a comments submission that is in excess of 50 pages. Upon brief review, the May 26, 2011 comments submission includes 50 pages of comments and an eight-page declaration under 37 CFR 1.132 of Dr. Khalil Najafi. The 50 pages of comments are included in the page count. Two pages, i.e., pages 7 and 8, of the declaration under 37 CFR 1.132 of Dr. Khalil Najafi are deemed to be an extension of the arguments of counsel (see, for example, the heading "Obvious Design Choices and Modifications", and, for example, the following statements: "It would have

been obvious to provide solder pads on the bottom of the package of Sjursen . . . to achieve a package that can be mounted to [the] next level of interconnection from the underside" (paragraph 20); "and therefore the use of a printed circuit board as a package substrate is a matter of design choice" (paragraph 21). Thus, the 50 pages of comments and the two pages of the Najafi declaration, resulting in a total of 52 pages, are included in the page count.

Based on the individual facts and circumstances of this case including, for example, the five claims, including one independent claim, newly added by the patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's May 26, 2011 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that the pages of requester's comments submission that are deemed to be subject to the page limit not exceed 52 pages. Accordingly, requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent that requester's May 26, 2011 comments submission may exceed the page limit by up to 52 pages. This waiver makes requester's May 26, 2011 comments submission page-length compliant.

CONCLUSION

- The May 26, 2011 requester petition is **granted** and the page limit of 37 CFR 1.943(b) is **waived to the extent** that requester's May 26, 2011 comments submission may exceed the page limit by up to 52 pages. **This waiver makes requester's May 26, 2011 comments submission page-length compliant**.

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

Cynthia L. Nessler

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

6/26/11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,510	10/06/2009	6741969	OPENG969REX	2752

909 7590 01/19/2012

Pillsbury Winthrop Shaw Pittman, LLP (NV)
PO Box 10500
McLean, VA 22102

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/19/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Michael J. Schallop
VAN PELT, YI & JAMES LLP
10050 N. Foothill Blvd. #20
Cupertino, CA 95014

Date:

MAILED

JAN 19 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000510
PATENT NO. : 6741969
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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PILLSBURY WINTHROP
SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

(For Patent Owner)

MAILED
JAN 19 2012
CENTRAL REEXAMINATION UNIT

Michael J. Schallop
VAN PELT, YI & JAMES LLP
10050 N. FOOTHILL BLVD. #20
CUPERTINO, CA 95014

(For Third Party Requester)

In re Chen et al.
Reexamination Control No. 95/000,510
Filed: October 6, 2009
For: U.S. Patent No. 6,741,969

: **DECISION**
: **ON PETITION**
: **UNDER**
: **37 CFR 1.181**

This decision is in response the October 13, 2010 patent owner petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of September 28, 2010.

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

The patent owner's petition, filed October 13, 2010, is granted.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 6,741,969 (the '969 patent) issued on May 25, 2004.

2. A completed request for reexamination of the '831 patent was filed on October 6, 2009. The request was assigned control No. 95/000,510 (the '510 proceeding).

3. On December 7, 2009, the Office ordered that the patent be reexamined. On the same day, the Office mailed a first Office action in the '510 proceeding.

4. On February 12, 2010, the patent owner filed a response submission to the Office action. The response submission included 42 pages of arguments, a 19 page declaration by Christopher C. Mueller, 44 page "Patentee Statement Under 37 CFR 1.530(e)", and 2 page supporting Exhibit B.

5. On March 12, 2010, the third party requester filed comments.

6. On September 28, 2010, the Office mailed a Notice of Defective Papers ("Notice") which stated that the patent owner's comments of February 12, 2010 were noncompliant with the requirements of 37 CFR 1.943. The Notice gave the patent owner 15 days to file a replacement response.

7. On October 13, 2010, the patent owner filed a petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of September 28, 2010. On the same day, the patent owner filed a replacement response.

8. On November 11, 2010, the third party requester filed comments on the October 13, 2010 replacement response.

DECISION

In the October 13, 2010 petition, the patent owner requests withdrawal of the September 28, 2010 Notice from the proceeding record. Patent owner alleges that the September 28, 2010 Notice was not permitted because the Notice is not in accordance with reexamination laws and policies. See, e.g., pages 3-5 of the petition. Specifically, patent owner asserts that the February 12, 2010 response only includes 43 pages that are counted towards the 37 CFR 1.943(b) page limit. See pages 3-4 of the petition. Patent owner argues that no pages of Exhibit B and the "Patentee Statement Under 37 CFR 1.530(e)" should be counted in the page limit requirement of 37 CFR 1.943(b). Patent owner also states that, at most, only 4 pages of the Mueller declaration should be counted in the page limit requirement of 37 CFR 1.943(b). For these reasons, patent owner asserts that the September 28, 2010 Notice should be expunged from the proceeding record and the February 12, 2010 response should be entered.

First, the portion of the petition regarding relief under 37 CFR 1.182 is procedurally dismissed under 37 CFR 1.4(c). The petition is properly filed and considered under 37 CFR 1.181.

In regard to patent owner's assertion that the September 28, 2010 Notice is an unauthorized action, the instructions in MPEP 2666.05 require the examiner to notify the patent owner of the reasons for noncompliance and to give the patent owner an additional opportunity to file replacement response. Upon review of the record, the director finds that the September 28, 2010 Notice incorrectly determined that patent owner's February 12, 2010 response submission exceeded the 50 page limit of 37 CFR 1.943(b). Specifically, the response itself was 42 pages and 41 pages count towards the 50 page limit of 37 CFR 1.943(b). However, 43 pages of the "Patentee Statement Under 37 CFR 1.530(e)" are not counted towards the 50 page limit because it shows the required support in accordance with 37 CFR 1.530(e). The 2 pages of Exhibit B are counted towards the 50 page limit. In addition, the Notice of noncompliance did incorrectly

indicate that all 9 pages of the Mueller declaration would be counted towards the 50 page limit of 37 CFR 1.943(b). Upon review of the record, only 4 pages of the Mueller declaration contain legal argument, and therefore, only 4 pages count towards the 50 page limit. In total, the February 12, 2010 submission included 47 pages which count towards the page limit requirement of 37 CFR 1.943(b). Therefore, the September 28, 2010 Notice was not in accordance with Office regulations and procedures, and for this reason, will be vacated.

For these reasons, the Patent Owner's October 13, 2010 petition is granted to the extent that the September 28, 2010 Notice is vacated. Because the September 28, 2010 Notice is vacated, the replacement response of October 13, 2010 and replacement comments of November 11, 2010 will be expunged from the record. The original response of February 12, 2010 and comments of March 12, 2010 will remain in the record and will be acted upon by the examiner in due course.

CONCLUSION

1. Patent owner's October 13, 2010 petition is granted to the extent that the September 28, 2010 Notice will be vacated.

2. Patent owner's replacement October 13, 2010 response submission will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

3. Third party requester's replacement November 11, 2010 comment submission will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

4. The examiner will review the response of February 12, 2010 and comments of March 12, 2010 and act, as appropriate, in due course.

5. Telephone inquiries related to this decision should be directed Alexander J. Kosowski, Supervisory Patent Examiner, at (571) 272-3744.

Irem Yucel, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 12/03/2010

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2010

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BOSTON, MA 02210-2206

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
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.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,515	11/04/2009	7242089	092771-0021E	2611

38939 7590 12/03/2010

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert M. Asher, Esq.
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:

MAILED

DEC 0 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
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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DEC 03 2010

CENTRAL REEXAMINATION UNIT

Dykema Gossett PLLC
10 S. Wacker Dr., Suite 2300
Chicago, Illinois 60606

(For Patent Owner)

Attn: Marc Johannes
Wolf, Greenfield, & Sacks, P.C.
600 Atlantic Ave.
Boston, Massachussetts 02110-2206

(For *Inter Partes* '513 Requester)

Attn: Robert Asher
Sunstein, Kann, Murphy, & Timbers LLP
125 Summer Street
Boston, Massachussetts 02110-1618

(For *Inter Partes* '515 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,513
Filed: December 14, 2009
For: U.S. Patent No. 7,242,089

Inter Partes Reexamination Proceeding
Control No. 95/000,515
Filed: November 4, 2009
For: U.S. Patent No. 7,242,089

DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,242,089 (the '089 patent) issued to Anthony D. Minervini on July 10, 2007, with 29 claims.

2. On November 4, 2009, a request for *inter partes* reexamination of claims 1-29 of the '089 patent was deposited by third party requester; the request was assigned control number 95/000,515 (the '515 *inter partes* proceeding). Analog Devices, Inc. is identified as the real party in interest. Reexamination was ordered on January 8, 2010, and a first action on the merits was issued on the same date. On March 11, 2010, patent owner filed a response, adding new claims 20-39. Third party requester filed comments on April 6, 2010.

3. On October 29, 2008, a request for *inter partes* reexamination of claims 1-4, 6, 7, 9, 11, 12, 15-26, 28, and 29 of the '089 patent was deposited by third party requester real party in interest Wolfson Microelectronics, PLC. The request was assigned control number 95/000,513 (the '513 *inter partes* proceeding), and a filing date of December 14, 2009, the date at which the filing requirements of 37 CFR 1.915 were met. Reexamination was ordered on March 3, 2010, and a first action on the merits was issued on the same date. On May 6, 2010, patent owner filed a response, including new claims 30-39 identical to those added in the '513 *inter partes* proceeding. Third party requester filed comments on April 6, 2010.

4. On May 5, 2010, *ex parte* reexamination was requested by third party requester Brett Carlson for claims 1, 2, 4, 6, 15, 16, 18, 20, 22-24, 28, and 29 of the '089 patent, and the request was assigned control number 90/009,739 (the '9739 *ex parte* reexamination proceeding. Reexamination was ordered on July 27, 2010. No action has been issued in this proceeding as of the date of mailing of this decision.

5. On May 28, 2010, *inter partes* reexamination was requested by third party for claims 1-4, 6-10, 13-20, 22, 28, and 29 of the '089 patent, and the request was assigned control number 95/001,365, and a filing date of June 30, 2010, the date at which the filing requirements of 37 CFR 1.915 were met. Reexamination was ordered on September 8, 2010. BSE Co., Ltd. is identified as the real party in interest.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '513 and the '515 reexamination proceedings are currently pending. Orders granting reexamination of the '089 patent, of claims

1-29 in the '515 reexamination, and of claims 1-4, 6, 7, 9, 11, 12, 15-26, 28, and 29 in the '513 reexamination, have been mailed in the respective reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely. Both proceedings are at the same stage, in which responses by each party to the first Office action on the merits have been filed.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the '513 and '515 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the '513 and '515 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

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

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

By hand (or delivery service) to:

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

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

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all

amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,513 and *inter partes* Reexamination Control No. 95/000,515 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.

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

12-2-2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 03/23/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:
MAILED
MAR 23 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 07/08/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:
MAILED
JUL 08 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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95/000,515	11/04/2009	7242089	092771-0021E	2611

38939 7590 07/08/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

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Robert M. Asher, Esq.
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

Steven McMahon Zeller : (For Patent Owner)
DYKEMA GOSSETT PLLC :
10 S. WACKER DR. STE. 2300 :
CHICAGO, IL 60606 :

WOLF GREENFIELD & SACKS, P.C. : (For Third Party
600 ATLANTIC AVE. : Requester)
BOSTON, MA 02110 :

SUNSTEIN KANN MURPHY & : (For Third Party
TIMBERS LLP : Requester)
125 SUMMER STREET :
BOSTON, MA 02110 :

In re: Minervini :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/000,513 :
Deposited: December 14, 2009 :
For: U.S. Patent No.: 7,242,089 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,515 :
Deposited: November 4, 2009 :
For: U.S. Patent No.: 7,242,089 :

This is a decision on three petitions filed by the patent owner: a petition filed on December 23, 2010, entitled "PETITION UNDER 37 C.F.R. § 1.182 TO STRIKE THIRD PARTY REQUESTER'S COMMENTS" [hereinafter "petition 1"], a petition filed on January 6, 2011, entitled "PETITION UNDER 37 C.F.R.. § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION" [hereinafter "petition 2"], and a petition filed on January 18, 2011 entitled "PETITION UNDER 37 C.F.R.. § 1.181 TO RECLASSIFY ACTION CLOSING PROSECUTION ION AS A NON-FINAL OFFICE ACTION" [hereinafter "petition 3"].

Petitions 2 and 3 are a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Action Closing Prosecution. Petition 1 is also treated as a petition under 37 CFR § 1.181.

The petitions are before the Director of the Central Reexamination Unit. The petitions are dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,242,089 issued on July 10, 2007.
- A request for *inter partes* reexamination was November 4, 2009 and assigned control no. 95/000,515.
- A second request for *inter partes* reexamination met the requirements for receiving a filing date on December 14, 2009 and was assigned control no. 95/000,513.
- *Inter partes* reexamination was ordered and prosecution progressed in each proceeding. The third party in the '513 proceeding filed comments responsive to an Office action and patent owner response on June 2, 2010.
- The proceedings were merged in a decision mailed December 3, 2010.
- An Action Closing Prosecution was mailed December 17, 2010.
- Petition 1 was filed December 23, 2010, petition 2 was filed January 6, 2011, and petition 3 was filed January 18, 2011.
- A new Office action was mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 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

Patent owner ["petitioner"] argues in petition 1 that the comments filed by the third party requester on June 2, 2010 are improper and should be stricken from record as being longer than the permissible page limit, and as being drawn beyond the permissible scope. Petitioner argues in petitions 2 and 3 that the Action Closing Prosecution mailed December 17, 2010 is improper. In Petition 2, patent owner argues that the examiner relied on third party comments that were improper, and that the examiner relied on an appellant's brief to the Court of Appeals for the Federal Circuit as if it were a decision of the court itself. In Petition 3, patent owner argues that the Action Closing Prosecution has various defects and should be reclassified as a non-final action.

Petition 1

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.[1]

A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the

[1] Note that this does not change the result herein, as 1.182 petitions are also subject to the time limit discussed in this decision. "The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided . . . . The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed." MPEP 1002.01.

reexamination record. Thus, the allegedly improper action, the entry of the paper into the record, took place on June 2, 2010, the filing date of the third party comments submission.

The petition was filed on December 23, 2010, approximately six months after the entry of the paper into the record. It was therefore not filed within two months of the act of entering the paper, from which relief is requested. The petition is therefore untimely under 37 CFR § 1.181(f), and is dismissed.

Petition 2

Petitioner argues that the Action Closing Prosecution mailed December 17, 2010 should be withdrawn. Petitioner argues that the ACP relies on the improper comments discussed above as to petition 1, and that the ACP improperly relies on an appellant's brief as if it were a decision of the Federal Circuit. Petitioner argues these facts make the ACP so tainted that it must be withdrawn.

As to the argument that the examiner relied on improperly long third party comments, patent owner's argument goes to the propriety of the comments. As discussed above as to petition 1, any argument as to the propriety of the comments is untimely, therefore the petition is dismissed to the extent it argues the comments are improper.

In any event, it is further noted that patent owner's January 18, 2011 submission has been entered in the record, along with comments from each third party requester filed February 16, 2011. As stated in the above listing of facts, a new Office action has since been issued in light of those submissions, making no reference to the June 2010 comments. While it does reference the more recent comments, those submissions are not improper. The petition is therefore additionally dismissed as moot, in that the currently outstanding Office action no longer references the June 2010 comments.

As to the argument that the examiner improperly relied upon a brief in the ACP, again the Office has since issued a new Office action. This new action makes no substantive reference to the brief. The argument that the ACP is improper for referencing the brief is therefore dismissed as moot.

For the foregoing reasons, petition 2 is dismissed.

Petition 3

Petitioner argues that the ACP mailed December 17, 2010 fails to properly develop the issues and should be reclassified as a non-final Office action. Again, a new Office action has been issued by the Office, effectively replacing the one which petitioner argues is defective. In light of that, petitioner's arguments are no longer relevant, and petitioner should instead respond to the

newly issued Office action. As petition 3 concerns the action that was replaced, it is dismissed as moot.

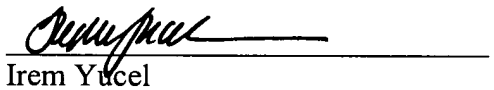
Accordingly, petitions 1, 2 and 3 are each dismissed. Any arguments as to the propriety of the comments submission of June 2, 2010 are untimely, and any of the alleged defects in the ACP mailed December 17, 2010 have effectively been cured with the mailing of the new Office action.

CONCLUSION

1. The petitions filed December 23, 2010, January 6, 2011 and January 18, 2011 are dismissed.

2. The most-recent Office action, as listed in the statement of facts herein, remains outstanding and patent owner's response is due as set forth in that action.

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.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 10/27/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

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ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

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600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date: MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,515	11/04/2009	7242089	092771-0021E	2611

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10 S. WACKER DR., STE. 2300
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert M. Asher, Esq.
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125 Summer Street
Boston, MA 02110-1618

Date:
MAILED
OCT 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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OCT 27 2011

CENTRAL REEXAMINATION UNIT

Steven McMahon Zeller : (For Patent Owner)
DYKEMA GOSSETT PLLC :
10 S. WACKER DR. STE. 2300 :
CHICAGO, IL 60606 :

WOLF GREENFIELD & SACKS, P.C. : (For Third Party
600 ATLANTIC AVE. : Requester)
BOSTON, MA 02110 :

SUNSTEIN KANN MURPHY & : (For Third Party
TIMBERS LLP : Requester)
125 SUMMER STREET :
BOSTON, MA 02110 :

In re: Minervini :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,513 : UNDER 37 C.F.R. § 1.181
Deposited: December 14, 2009 :
For: U.S. Patent No.: 7,242,089 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,515 :
Deposited: November 4, 2009 :
For: U.S. Patent No.: 7,242,089 :

This is a decision on a petition filed by the patent owner on June 3, 2011 entitled "SUPPLEMENTAL PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION". It is supplemental to patent owner's petition filed January 6, 2011, which requested the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Action Closing Prosecution. That petition was dismissed in a decision mailed July 8, 2011, but the decision did not reference the supplemental petition. The supplemental petition provides nothing that alters the Director's previous decision, therefore the supplemental petition filed June 3, 2011 is dismissed for the same reasons as given in the July 8, 2011 decision.

CONCLUSION

1. The supplemental petition filed June 3, 2011 is dismissed for the same reasons as those presented in the July 8, 2011 decision concerning the January 6, 2011 petition.

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.
95/000,514	01/08/2010	7376993	CH13-1K	6127

34431 7590 10/28/2010

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CHICAGO, IL 60606

EXAMINER	
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000514
PATENT NO. : 7376993
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.

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HANLEY, FLIGHT & ZIMMERMAN, LLC
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: (For Patent Owner)

VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

: (For Third Party Requester)

In re Meyers *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,514
Filed: January 8, 2010
For: U.S. Patent No. 7,376,993 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**

This is a decision on the September 21, 2010 patent owner petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER 37 C.F.R. 1.182."

The petition is before the Office of Patent Legal Administration.

The petition was accompanied by the petition fee under 37 C.F.R. § 1.17(f) of $400.

For the reasons set forth below, the petition is **dismissed.**

BACKGROUND

- On November 2, 2009, a request for *inter partes* reexamination of all of the claims of U.S. Patent Number 7,376,993 B2, having 31 claims, was deposited by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,514("the '514 proceeding"). A subsequently filed January 8, 2010 corrected request meeting the filing requirements of 37 C.F.R. § 1.915 accorded the proceeding a filing date of January 8, 2010.

- Reexamination was ordered on February 12, 2010 and a first Office action was issued on that same date.

- Prosecution progressed until, on July 6, 2010, an Action Closing Prosecution (ACP) was issued.

- On September 21, 2010, patent owner filed the following papers:

    - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which includes proposed amendments to claims 1-4, 13, 14, 17-20, 22, 32, 41, 43, 44, 50, and 57-59, and proposed claim cancellations of claims 51, 61, and 62, and an affidavit filed under 37 C.F.R. § 1.131.

    - The instant petition entitled "PETITION FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182," requesting entry of the amendment and remarks filed on the same date.

- On October 18, 2010, the third party requester filed comments pursuant to 37 C.F.R. § 1.947.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 CFR 1.182 provides:

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

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

37 CFR 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.

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 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 available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances.

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 C.F.R. § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 C.F.R. § 1.116.

The September 21, 2010 patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of amendments and remarks submitted on the same date therewith. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.951(a). Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence **that was denied entry** . . . after an action closing prosecution" (emphasis added), as is required for the procedure set forth in the March 2005 Notice.

Furthermore, although it was filed under 37 C.F.R. § 1.182 to request entry of the September 21, 2010 amendment, the September 21, 2010 patent owner petition has been filed within the time period set forth for response in the ACP. During this period, 37 C.F.R. § 1.951(a) specifically provides for the consideration of the comments and amendment, subject to the criteria of 37 C.F.R. § 1.116. Since it is possible that the relief requested patent owner's submission may be provided through 37 C.F.R. § 1.951, i.e., relief is still possible under one of the rules of practice, consideration of the present petition under 37 C.F.R. § 1.182 is premature.

For the instant petition to be proper for consideration and not premature, the instant petition must be filed (1) after the time for response under 37 C.F.R. § 1.951, (2) after entry of the amendment has been denied by the examiner in an action, and (3)(a) without a petition under 37 C.F.R § 1.181 that could moot the petition under 37 C.F.R. §1.182, or (3)(b) within two months after

---

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

such a petition is dismissed or denied, when the 37 C.F.R § 1.181 is not further pursued (e.g., no request for reconsideration of the Office decision is filed).[2]

Accordingly, the petition is **dismissed**.

CONCLUSION

1. The petition under 37 C.F.R. § 1.182 is dismissed.

2. Prosecution is not being reopened by this decision.

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 28, 2010
Kentpet8/...

[2] Note, however, that a situation which is covered by § 1.181 does not become "not provided for" merely because the § 1.181 petition is dismissed or denied by the Office.

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34431 7590 07/25/2011

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ART UNIT	PAPER NUMBER

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PHILADELPHIA, PA 19103

Date: MAILED

JUL 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000514
PATENT NO. : 7376993
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.

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(For Patent Owner)

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JUL 25 2011
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Volpe and Koenig, P.C.
United Plaza, Suite 1600
30 South 17th Street
Philadelphia, PA 19103

(For Requester)

In re Myers et al
Inter Partes Reexamination Proceeding
Control No. 95/000,514
Filed: January 8, 2010
For: U.S. Patent No. 7,376,993

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

This is a decision on requester's petition entitled "Third Party *Inter Partes* Reexamination Requester's Emergency Petition under 37 CFR 1.183 Requesting Waiver of the Page Limitation Requirement under 37 CFR § 1.943(B) [sic]," filed on July 5, 2011.

The July 5, 2011 requester petition is before the Office of Patent Legal Administration.

SUMMARY

Requester's July 5, 2011 petition under 37 CFR 1.183 is **dismissed**. Requester's February 23, 2011 comments submission **remains expunged** from the official file, and will not be considered.

Requester's July 18, 2011 comments submission is **page-length compliant**.

DECISION

Requester's July 5, 2011 petition under 37 CFR 1.183 was filed in response to the Office communication mailed on July 1, 2011, informing the requester that its comments submission filed on February 23, 2011 exceeded the 50-page regulatory page limit set forth in 37 CFR 1.943(b), and that for this reason, requester's February 23, 2011 comments submission was deemed to be improper and has been expunged. Requester's July 5, 2011 petition requests waiver of the 50-page limit of 37 CFR 1.943(b) for its comments filed on February 23, 2011, and also effectively requests entry of these comments.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page

limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response 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 response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response.

In the instant petition under 37 CFR 1.183, the requester requests waiver of 37 CFR 1.943(b). The requester argues that the 72-page claim chart, filed by the requester with its February 23, 2011 comments submission, is not subject to the 50-page limit, because claim charts are "appendices of claims", which are excluded from the 50-page limit pursuant to 37 CFR 1.943(b). Contrary to requester's arguments, however, claim charts are not merely "appendices of claims". "Appendices of claims" refers to a mere listing of the claims, not to a chart which proposes rejections of those claims. The 72-page claim chart filed by the requester proposes rejections of the existing claims, which, by definition, include legal arguments that the claims are unpatentable, and thus is subject to the 50-page limit.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, such as 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.

Upon brief review, requester's February 23, 2011 comments submission includes 34 pages of remarks, an eight-page declaration under 37 CFR 1.132 by Ryan W. O'Donnell, and 72 pages of claim charts. The 34 pages of remarks are subject to the 50-page limit. The 72 pages of claim charts are also subject to the 50-page limit, for the reasons discussed *supra*.

The eight-page O'Donnell declaration is replete with legal arguments which are extensions of the arguments of counsel, including arguments that the claims are obvious in view of a reference combination (see, e.g., the heading on page 3, and the claim chart incorporated into the

declaration on pages 5-7). For this reason, the entirety of the declaration is subject to the 50-page limit.

Thus, requester's February 23, 2011 comments submission includes 116 pages that are subject to the 50-page limit.

The requester argues that the additional pages were necessary because the requester "had to address numerous claim amendments, additional claims, and belabored prosecution of this reexamination proceeding". The requester points to each amendment made by the patent owner during the entire prosecution of this proceeding. Requester's February 23, 2011 comments submission, however, is limited, by statute, to issues raised by the December 22, 2010 Office action and patent owner's January 31, 2011 response. No new claims were added in patent owner's amendment of January 31, 2011. The amendment to the existing claims was, primarily, to add a limitation regarding first, second and third connectors.[1] The requester has simply not explained why it was necessary to include 66 additional pages with its February 23, 2011 comments submission, in order to address such a limited number of new limitations added by patent owner's amendment. For these reasons, the inclusion of 66 additional pages with requester's February 23, 2011 comments submission has not been shown to be reasonable.

Accordingly, requester's July 5, 2011 petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.943(b) for its February 23, 2011 comments submission is **dismissed**. Requester's February 23, 2011 comments submission **remains expunged** from the official file, and will not be considered.

The Office also notes that on July 18, 2011, requester timely filed a corrected comments submission in response to the July 1, 2011 Office communication. Requester's July 18, 2011 comments submission is **page-length compliant**. For this reason, it is not necessary to provide the requester with 15 days in order to file corrected comments.[2]

CONCLUSION

- Requester's July 5, 2011 petition under 37 CFR 1.183 is **dismissed**.
- Requester's February 23, 2011 comments submission **remains expunged** from the official file, and will not be considered.
- Requester's July 18, 2011 comments submission is **page-length compliant**.

[1] Claim 41 was also amended to add the limitation "rigid".
[2] See, generally, MPEP 2666.05.

- 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

7/22/11

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38939 7590 12/03/2010

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 12/03/2010

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/03/2010

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

Date:

MAILED

DEC 0 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
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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DEC 03 2010

CENTRAL REEXAMINATION UNIT

Dykema Gossett PLLC
10 S. Wacker Dr., Suite 2300
Chicago, Illinois 60606

(For Patent Owner)

Attn: Marc Johannes
Wolf, Greenfield, & Sacks, P.C.
600 Atlantic Ave.
Boston, Massachussetts 02110-2206

(For *Inter Partes* '513 Requester)

Attn: Robert Asher
Sunstein, Kann, Murphy, & Timbers LLP
125 Summer Street
Boston, Massachussetts 02110-1618

(For *Inter Partes* '515 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,513
Filed: December 14, 2009
For: U.S. Patent No. 7,242,089

Inter Partes Reexamination Proceeding
Control No. 95/000,515
Filed: November 4, 2009
For: U.S. Patent No. 7,242,089

DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,242,089 (the '089 patent) issued to Anthony D. Minervini on July 10, 2007, with 29 claims.

2. On November 4, 2009, a request for *inter partes* reexamination of claims 1-29 of the '089 patent was deposited by third party requester; the request was assigned control number 95/000,515 (the '515 *inter partes* proceeding). Analog Devices, Inc. is identified as the real party in interest. Reexamination was ordered on January 8, 2010, and a first action on the merits was issued on the same date. On March 11, 2010, patent owner filed a response, adding new claims 20-39. Third party requester filed comments on April 6, 2010.

3. On October 29, 2008, a request for *inter partes* reexamination of claims 1-4, 6, 7, 9, 11, 12, 15-26, 28, and 29 of the '089 patent was deposited by third party requester real party in interest Wolfson Microelectronics, PLC. The request was assigned control number 95/000,513 (the '513 *inter partes* proceeding), and a filing date of December 14, 2009, the date at which the filing requirements of 37 CFR 1.915 were met. Reexamination was ordered on March 3, 2010, and a first action on the merits was issued on the same date. On May 6, 2010, patent owner filed a response, including new claims 30-39 identical to those added in the '513 *inter partes* proceeding. Third party requester filed comments on April 6, 2010.

4. On May 5, 2010, *ex parte* reexamination was requested by third party requester Brett Carlson for claims 1, 2, 4, 6, 15, 16, 18, 20, 22-24, 28, and 29 of the '089 patent, and the request was assigned control number 90/009,739 (the '9739 *ex parte* reexamination proceeding. Reexamination was ordered on July 27, 2010. No action has been issued in this proceeding as of the date of mailing of this decision.

5. On May 28, 2010, *inter partes* reexamination was requested by third party for claims 1-4, 6-10, 13-20, 22, 28, and 29 of the '089 patent, and the request was assigned control number 95/001,365, and a filing date of June 30, 2010, the date at which the filing requirements of 37 CFR 1.915 were met. Reexamination was ordered on September 8, 2010. BSE Co., Ltd. is identified as the real party in interest.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 CFR 1.989(a):

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

As evidenced by the above review of facts, both the '513 and the '515 reexamination proceedings are currently pending. Orders granting reexamination of the '089 patent, of claims

1-29 in the '515 reexamination, and of claims 1-4, 6, 7, 9, 11, 12, 15-26, 28, and 29 in the '513 reexamination, have been mailed in the respective reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely. Both proceedings are at the same stage, in which responses by each party to the first Office action on the merits have been filed.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the '513 and '515 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the '513 and '515 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. Papers mailed/filed:

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

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

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

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

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

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

By hand (or delivery service) to:

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

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

C. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666. 37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Amendments are not to be made relative to previous amendments. Thus, for all

amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,513 and *inter partes* Reexamination Control No. 95/000,515 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.

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

12-2-2010

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,515	11/04/2009	7242089	092771-0021E	2611

38939 7590 03/23/2011

DYKEMA GOSSETT PLLC
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CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert M. Asher, Esq.
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:
MAILED
MAR 23 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
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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38939 7590 03/23/2011

DYKEMA GOSSETT PLLC
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600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:

MAILED

MAR 23 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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MAR 23 2011

CENTRAL REEXAMINATION UNIT

Dykema Gossett PLLC
10 S. Wacker Dr., Suite 2300
Chicago, IL 60606

(For Patent Owner)

Attn: Marc Johannes
Wolf, Greenfield, & Sacks, P.C.
600 Atlantic Ave.
Boston, MA 02110-2206

(For *Inter Partes* '513 Requester)

Attn: Robert Asher
Sunstein, Kann, Murphy, & Timbers LLP
125 Summer Street
Boston, MA 02110-1618

(For *Inter Partes* '515 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,513
Filed: December 14, 2009
For: U.S. Patent No. 7,242,089

DECISION ON PETITION

Inter Partes Reexamination Proceeding
Control No. 95/000,515
Filed: November 4, 2009
For: U.S. Patent No. 7,242,089

SUMMARY

This is a decision on patent owner's January 18, 2011 petition entitled "CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. § 1.951 AND ALLOW ENTRY OF PATENT OWNER'S ADDITIONAL COMMENTS AND EVIDENCE IN RESPONSE TO THE ACTION CLOSING PROSECUTION" and patent owner's January 19, 2011 petition entitled "CORRECTED CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. § 1.951 AND ALLOW ENTRY OF PATENT OWNER'S ADDITIONAL COMMENTS AND EVIDENCE IN RESPONSE TO THE ACTION CLOSING PROSECUTION".

The petitions are before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petitions for waiver of 37 CFR 1.951 filed on January 18, 2011, and January 19, 2011, are both dismissed as premature.

REVIEW OF RELEVANT FACTS

1. On July 10, 2007, the Office issued U.S. Patent No. 7,242,089 (the '089 patent) to Anthony D. Minervini.

2. On November 4, 2009, a request for *inter partes* reexamination of the '089 patent was filed, which was assigned reexamination proceeding control no. 95/000,515 ("the '515 proceeding"), by a first third party requester.

3. On December 14, 2009, a request for *inter partes* reexamination of the '089 patent, compliant with 37 CFR 1.915, was filed, which was assigned reexamination proceeding control no. 95/000,513 ("the '513 proceeding"), by a second third party requester.[1]

4. On January 8, 2010, the Office ordered reexamination in the '515 proceeding and concurrently issued a first action on the merits.

5. On March 3, 2010, the Office ordered reexamination in the '513 proceeding and concurrently issued a first action on the merits.

6. On March 11, 2010, patent owner timely filed, in the '515 proceeding, a response to the January 8, 2010 Office action.

7. On April 6, 2010, third party requester time filed comments in the '515 proceeding.

8. On May 6, 2010, patent owner timely filed, in the '513 proceeding, a response to the March 3, 2010 Office action.

9. On June 2, 2010, third party requester time filed comments in the '513 proceeding.

10. On December 17, 2010, the Office issued, *sua sponte*, a decision merging the '513 and '515 proceedings ("the merged proceeding").

11. On December 17, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

12. On January 6, 2011, patent owner filed a petition under 37 CFR 1.181 requesting withdrawal of the December 17, 2010 ACP.

13. On January 18, 2011, patent owner timely filed 37 CFR 1.951(a) comments addressing the December 17, 2010 ACP.

14. Concurrently on January 18, 2011, patent owner filed a petition under 37 CFR 1.181 requesting the December 17, 2010 ACP be "reclassified" as a non-final Office action, i.e. a request for reopening of prosecution.

---

[1] On October 29, 2009, requester deposited papers requesting reexamination of the '089 patent, which were not compliant with 37 CFR 1.915. Accordingly, the original request was not accorded an October 29, 2009 filing date.

15. Also concurrently on January 18, 2011, patent owner filed a second petition under 37 CFR 1.183 "conditionally" requesting waiver of 37 CFR 1.951, if the petitions to withdraw or reclassify the December 17, 2010 ACP are not successful.

16. On January 19, 2011, patent owner filed a "corrected" petition under 37 CFR 1.183 "conditionally" requesting waiver of 37 CFR 1.951, if the petitions to withdraw or reclassify the December 17, 2010 ACP are not successful.

17. On February 16, 2011, third party requester time filed 37 CFR 1.951(b) comments after ACP in the merged proceeding.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(2)(b) provides:

> 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 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. § 1.951 provides:

> (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.
> (b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

DECISION

Patent owner seeks waiver of 37 CFR 1.951, which restricts a patent owner's 37 CFR 1.951(a) comments to addressing only those issues raised in an ACP. The requested waiver is conditioned upon the denial of relief requested by patent owner under 37 CFR 1.181. Patent owner seeks entry of comments and evidence that is responsive to an issue alleged by patent owner as not being raised in an ACP.

In the petitions, patent owner asserts that the petition need only be granted if the petition to reclassify the ACP as a non-final action is denied, *i.e.* a request for reopening due to issuance of an improper ACP. Thus, the necessity of patent owner's request for relief is conditioned upon the Office dismissing patent owner's request for reopening due to the issuance of an allegedly improper ACP. The granting of the petition to reopen due to the issuance of an improper ACP could obviate the need for a decision on the present petitions. Currently, the petition requesting a reopening of prosecution due to the issuance of an improper ACP is pending before the Office, awaiting decision. Because patent owner's present request for waiver of 37 CFR 1.951 is conditioned upon the denial of relief requested in a pending undecided petition, a decisional condition that may not occur, the present petitions are unripe for decision and hence premature at this time. Accordingly, the petitions are **dismissed as premature**.

A petition to waive 37 CFR 1.951 is subject to renewal if a determination is made that such relief becomes necessary; however, such a renewed petition would not hold in abeyance any time periods for response that may be running against the parties in the merged reexamination proceeding.

CONCLUSION

1. The patent owner petition for waiver of the 37 CFR 1.951 is **dismissed as premature.**

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

/Kenneth M. Schor/

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

March 21, 2011
Kenpet8/IP/

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:

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MAR 23 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For *Inter Partes* '513 Requester)

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(For *Inter Partes* '515 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,513
Filed: December 14, 2009
For: U.S. Patent No. 7,242,089

Inter Partes Reexamination Proceeding
Control No. 95/000,515
Filed: November 4, 2009
For: U.S. Patent No. 7,242,089

DECISION ON PETITION

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REVIEW OF RELEVANT FACTS

1. On July 10, 2007, the Office issued U.S. Patent No. 7,242,089 (the '089 patent) to Anthony D. Minervini.

2. On November 4, 2009, a request for *inter partes* reexamination of the '089 patent was filed, which was assigned reexamination proceeding control no. 95/000,515 ("the '515 proceeding"), by a first third party requester.

3. On December 14, 2009, a request for *inter partes* reexamination of the '089 patent, compliant with 37 CFR 1.915, was filed, which was assigned reexamination proceeding control no. 95/000,513 ("the '513 proceeding"), by a second third party requester.[1]

4. On January 8, 2010, the Office ordered reexamination in the '515 proceeding and concurrently issued a first action on the merits.

5. On March 3, 2010, the Office ordered reexamination in the '513 proceeding and concurrently issued a first action on the merits.

6. On March 11, 2010, patent owner timely filed, in the '515 proceeding, a response to the January 8, 2010 Office action.

7. On April 6, 2010, third party requester time filed comments in the '515 proceeding.

8. On May 6, 2010, patent owner timely filed, in the '513 proceeding, a response to the March 3, 2010 Office action.

9. On June 2, 2010, third party requester time filed comments in the '513 proceeding.

10. On December 17, 2010, the Office issued, *sua sponte*, a decision merging the '513 and '515 proceedings ("the merged proceeding").

11. On December 17, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.

12. On January 6, 2011, patent owner filed a petition under 37 CFR 1.181 requesting withdrawal of the December 17, 2010 ACP.

13. On January 18, 2011, patent owner timely filed 37 CFR 1.951(a) comments addressing the December 17, 2010 ACP.

14. Concurrently on January 18, 2011, patent owner filed a petition under 37 CFR 1.181 requesting the December 17, 2010 ACP be "reclassified" as a non-final Office action, i.e. a request for reopening of prosecution.

---

[1] On October 29, 2009, requester deposited papers requesting reexamination of the '089 patent, which were not compliant with 37 CFR 1.915. Accordingly, the original request was not accorded an October 29, 2009 filing date.

15. Also concurrently on January 18, 2011, patent owner filed a second petition under 37 CFR 1.183 "conditionally" requesting waiver of 37 CFR 1.951, if the petitions to withdraw or reclassify the December 17, 2010 ACP are not successful.

16. On January 19, 2011, patent owner filed a "corrected" petition under 37 CFR 1.183 "conditionally" requesting waiver of 37 CFR 1.951, if the petitions to withdraw or reclassify the December 17, 2010 ACP are not successful.

17. On February 16, 2011, third party requester time filed 37 CFR 1.951(b) comments after ACP in the merged proceeding.

RELEVANT STATUTES, REGULATIONS AND GUIDANCE

35 U.S.C. 314(2)(b) provides:

> 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 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. § 1.951 provides:

> (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.
> (b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

DECISION

Patent owner seeks waiver of 37 CFR 1.951, which restricts a patent owner's 37 CFR 1.951(a) comments to addressing only those issues raised in an ACP. The requested waiver is conditioned upon the denial of relief requested by patent owner under 37 CFR 1.181. Patent owner seeks entry of comments and evidence that is responsive to an issue alleged by patent owner as not being raised in an ACP.

In the petitions, patent owner asserts that the petition need only be granted if the petition to reclassify the ACP as a non-final action is denied, *i.e.* a request for reopening due to issuance of an improper ACP. Thus, the necessity of patent owner's request for relief is conditioned upon the Office dismissing patent owner's request for reopening due to the issuance of an allegedly improper ACP. The granting of the petition to reopen due to the issuance of an improper ACP could obviate the need for a decision on the present petitions. Currently, the petition requesting a reopening of prosecution due to the issuance of an improper ACP is pending before the Office, awaiting decision. Because patent owner's present request for waiver of 37 CFR 1.951 is conditioned upon the denial of relief requested in a pending undecided petition, a decisional condition that may not occur, the present petitions are unripe for decision and hence premature at this time. Accordingly, the petitions are **dismissed as premature**.

A petition to waive 37 CFR 1.951 is subject to renewal if a determination is made that such relief becomes necessary; however, such a renewed petition would not hold in abeyance any time periods for response that may be running against the parties in the merged reexamination proceeding.

CONCLUSION

1. The patent owner petition for waiver of the 37 CFR 1.951 is **dismissed as premature.**

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

/Kenneth M. Schor/

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

March 21, 2011
Kenpet8/IP/

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,515	11/04/2009	7242089	092771-0021E	2611

38939 7590 07/08/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Robert M. Asher, Esq.
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 07/08/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date:
MAILED
JUL 08 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
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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JUL 08 2011

CENTRAL REEXAMINATION UNIT

Steven McMahon Zeller : (For Patent Owner)
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10 S. WACKER DR. STE. 2300 :
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WOLF GREENFIELD & SACKS, P.C. : (For Third Party
600 ATLANTIC AVE. : Requester)
BOSTON, MA 02110 :

SUNSTEIN KANN MURPHY & : (For Third Party
TIMBERS LLP : Requester)
125 SUMMER STREET :
BOSTON, MA 02110 :

In re: Minervini :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/000,513 :
Deposited: December 14, 2009 :
For: U.S. Patent No.: 7,242,089 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,515 :
Deposited: November 4, 2009 :
For: U.S. Patent No.: 7,242,089 :

This is a decision on three petitions filed by the patent owner: a petition filed on December 23, 2010, entitled "PETITION UNDER 37 C.F.R. § 1.182 TO STRIKE THIRD PARTY REQUESTER'S COMMENTS" [hereinafter "petition 1"], a petition filed on January 6, 2011, entitled "PETITION UNDER 37 C.F.R.. § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION" [hereinafter "petition 2"], and a petition filed on January 18, 2011 entitled "PETITION UNDER 37 C.F.R.. § 1.181 TO RECLASSIFY ACTION CLOSING PROSECUTION ION AS A NON-FINAL OFFICE ACTION" [hereinafter "petition 3"].

Petitions 2 and 3 are a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Action Closing Prosecution. Petition 1 is also treated as a petition under 37 CFR § 1.181.

The petitions are before the Director of the Central Reexamination Unit. The petitions are dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,242,089 issued on July 10, 2007.
- A request for *inter partes* reexamination was November 4, 2009 and assigned control no. 95/000,515.
- A second request for *inter partes* reexamination met the requirements for receiving a filing date on December 14, 2009 and was assigned control no. 95/000,513.
- *Inter partes* reexamination was ordered and prosecution progressed in each proceeding. The third party in the '513 proceeding filed comments responsive to an Office action and patent owner response on June 2, 2010.
- The proceedings were merged in a decision mailed December 3, 2010.
- An Action Closing Prosecution was mailed December 17, 2010.
- Petition 1 was filed December 23, 2010, petition 2 was filed January 6, 2011, and petition 3 was filed January 18, 2011.
- A new Office action was mailed.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 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

Patent owner ["petitioner"] argues in petition 1 that the comments filed by the third party requester on June 2, 2010 are improper and should be stricken from record as being longer than the permissible page limit, and as being drawn beyond the permissible scope. Petitioner argues in petitions 2 and 3 that the Action Closing Prosecution mailed December 17, 2010 is improper. In Petition 2, patent owner argues that the examiner relied on third party comments that were improper, and that the examiner relied on an appellant's brief to the Court of Appeals for the Federal Circuit as if it were a decision of the court itself. In Petition 3, patent owner argues that the Action Closing Prosecution has various defects and should be reclassified as a non-final action.

Petition 1

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.[1]

A paper such as a third party comments submission is entered into the record when it is filed. After the scanning period, the paper is available for viewing on public PAIR as a part of the

[1] Note that this does not change the result herein, as 1.182 petitions are also subject to the time limit discussed in this decision. "The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided . . . . The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed." MPEP 1002.01.

reexamination record. Thus, the allegedly improper action, the entry of the paper into the record, took place on June 2, 2010, the filing date of the third party comments submission.

The petition was filed on December 23, 2010, approximately six months after the entry of the paper into the record. It was therefore not filed within two months of the act of entering the paper, from which relief is requested. The petition is therefore untimely under 37 CFR § 1.181(f), and is dismissed.

Petition 2

Petitioner argues that the Action Closing Prosecution mailed December 17, 2010 should be withdrawn. Petitioner argues that the ACP relies on the improper comments discussed above as to petition 1, and that the ACP improperly relies on an appellant's brief as if it were a decision of the Federal Circuit. Petitioner argues these facts make the ACP so tainted that it must be withdrawn.

As to the argument that the examiner relied on improperly long third party comments, patent owner's argument goes to the propriety of the comments. As discussed above as to petition 1, any argument as to the propriety of the comments is untimely, therefore the petition is dismissed to the extent it argues the comments are improper.

In any event, it is further noted that patent owner's January 18, 2011 submission has been entered in the record, along with comments from each third party requester filed February 16, 2011. As stated in the above listing of facts, a new Office action has since been issued in light of those submissions, making no reference to the June 2010 comments. While it does reference the more recent comments, those submissions are not improper. The petition is therefore additionally dismissed as moot, in that the currently outstanding Office action no longer references the June 2010 comments.

As to the argument that the examiner improperly relied upon a brief in the ACP, again the Office has since issued a new Office action. This new action makes no substantive reference to the brief. The argument that the ACP is improper for referencing the brief is therefore dismissed as moot.

For the foregoing reasons, petition 2 is dismissed.

Petition 3

Petitioner argues that the ACP mailed December 17, 2010 fails to properly develop the issues and should be reclassified as a non-final Office action. Again, a new Office action has been issued by the Office, effectively replacing the one which petitioner argues is defective. In light of that, petitioner's arguments are no longer relevant, and petitioner should instead respond to the

newly issued Office action. As petition 3 concerns the action that was replaced, it is dismissed as moot.

Accordingly, petitions 1, 2 and 3 are each dismissed. Any arguments as to the propriety of the comments submission of June 2, 2010 are untimely, and any of the alleged defects in the ACP mailed December 17, 2010 have effectively been cured with the mailing of the new Office action.

CONCLUSION

1. The petitions filed December 23, 2010, January 6, 2011 and January 18, 2011 are dismissed.

2. The most-recent Office action, as listed in the statement of facts herein, remains outstanding and patent owner's response is due as set forth in that action.

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.
95/000,515	11/04/2009	7242089	092771-0021E	2611

38939 7590 10/27/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert M. Asher, Esq.
SUNSTEIN KANN MURPHY & TIMBERS LLP
125 Summer Street
Boston, MA 02110-1618

Date:

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000515
PATENT NO. : 7242089
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,513	12/14/2009	7242089	092771-0021F	7214

38939 7590 10/27/2011

DYKEMA GOSSETT PLLC
10 S. WACKER DR., STE. 2300
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

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

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Date: **MAILED**

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000513
PATENT NO. : 7242089
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 27 2011

CENTRAL REEXAMINATION UNIT

Steven McMahon Zeller : (For Patent Owner)
DYKEMA GOSSETT PLLC :
10 S. WACKER DR. STE. 2300 :
CHICAGO, IL 60606 :

WOLF GREENFIELD & SACKS, P.C. : (For Third Party
600 ATLANTIC AVE. : Requester)
BOSTON, MA 02110 :

SUNSTEIN KANN MURPHY & : (For Third Party
TIMBERS LLP : Requester)
125 SUMMER STREET :
BOSTON, MA 02110 :

In re: Minervini :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/000,513 : UNDER 37 C.F.R. § 1.181
Deposited: December 14, 2009 :
For: U.S. Patent No.: 7,242,089 :

In re: Minervini :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,515 :
Deposited: November 4, 2009 :
For: U.S. Patent No.: 7,242,089 :

This is a decision on a petition filed by the patent owner on June 3, 2011 entitled "SUPPLEMENTAL PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW ACTION CLOSING PROSECUTION". It is supplemental to patent owner's petition filed January 6, 2011, which requested the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Action Closing Prosecution. That petition was dismissed in a decision mailed July 8, 2011, but the decision did not reference the supplemental petition. The supplemental petition provides nothing that alters the Director's previous decision, therefore the supplemental petition filed June 3, 2011 is dismissed for the same reasons as given in the July 8, 2011 decision.

CONCLUSION

1. The supplemental petition filed June 3, 2011 is dismissed for the same reasons as those presented in the July 8, 2011 decision concerning the January 6, 2011 petition.

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.
95/000,517	11/23/2009	6917696	110630-IRX002	3888

27809 7590 12/29/2010

PATTRIC J. RAWLINS / Aperio Technologies, Inc.
Procopio, Cory, Hargreaves & Savitch, LLP
525 B Street
Suite 2200
SAN DIEGO, CA 92101

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2010

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Date:
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DEC 29 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000517
PATENT NO. : 6917696
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.: 95/000,517

1. THIS IS A DECISION ON THE PETITION FILED December 20, 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 Action Closing Prosecution mailed on December 20, 2010, be extended by one month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment:

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.

[*Signature*]	ERIC S. KEASEL CRU SPE-AU 3992 (Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UN

Dewey & LeBoeuf LLP
1101 New York Avenue, N.W.
Washington DC 20005

(For Patent Owner)

Dickstein Shapiro, LLP
1825 Eye Street, N.W.
Washington DC 20006

(For Third Party Requester)

In re Chisrtian Boemler
Reexamination Proceeding
Control No. 95/000,521
Filed: December 8, 2009
For: U.S. Patent No. 6,818,877

: DECISION
: DISMISSING
: PETITION

This is a decision on third party requester's March 14, 2011 petition entitled "PETITION UNDER 35 U.S.C. § 314, 37 C.F.R. §§ 1.182, 1.937 AND 1.987 AND M.P.E.P. 2686.04 TO SUSPEND THE REEXAMINATION DUE TO A § 112, SECOND PARAGRAPH, INVALIDITY FINDING IN CO-PENDING LITIGATION."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

BACKGROUND

1. On November 16, 2004, the Office issued U.S. Patent No. 6,818,877 (the '877 patent) to Sun *et al.*

2. A request for *inter partes* reexamination of claims (claims 1-4) of the '877 patent was filed by third party requester Micron Technology Inc. and Aptina Imaging Corp., (both to collectively be hereinafter identified as "requester") on December 8, 2009. The request was assigned Control No. 95/000,521 (the '521 proceeding).

3. The '877 patent is subject to litigation in the United States District Court for the Central District of California, in *Panavision Imaging LLC v. Omnivision Technologies, Inc., et al.*, {Civil Action No. 2:09-CV-01577-MRP (CTx)}. The initial complaint was filed March 6, 2009. Based upon the initial complaint, patent owner appears to be filing suit to enforce at least one of '877 patent claims 1-7 against the requester in the litigation, in addition to asserting U.S. Patent Nos. 6,590,198 (the '198 patent), 6,633,029 (the '029 patent), and 7,057,150 (the '150 patent).

4. On January 29, 2010, the Office issued an order granting the '521 request for reexamination of claims 1-4 of the '877 patent. A first Office action on the merits concurrently issued with the order granting reexamination.

5. Prosecution has advanced to appeal with the filing of a notice of appeal on January 13, 2011, and both parties have submitted their appellant's briefs.

6. On February 7, 2011, the District Court for the Central District of California issued a Claim Construction and Summary Judgment Order granting summary judgment to defendants, finding claims 1, 3-4 of the '877 patent invalid for indefiniteness.

7. On March 14, 2011, third party requester filed the present petition, citing 35 U.S.C. § 314(c) and 37 CFR 1.987, and requesting suspension of the '521 *inter partes* reexamination proceeding. The requester has attached a copy of the February 7, 2011 District Court Order for Summary Judgment.

8. On March 22, 2011, patent owner filed a paper informing the Office that patent owner does not oppose requester's petition to stay the '521 proceeding.

DECISION

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. § 314(c) states:

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

35 U.S.C. § 317(b) states:

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

35 U.S.C. 318 states:

> Once an order for inter partes reexamination of a patent has been issued under section, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

37 CFR 1.182 states:

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

37 C.F.R. § 1.907 states:

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

37 C.F.R. § 1.933 states:

> (a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).
>
> (b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

37 C.F.R. 1.985 states:

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

37 C.F.R. § 1.987 states:

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

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

> . . . . suspension will not be considered on its merits when there is an outstanding Office action. In order to ensure consideration on the merits of a petition to suspend where there is an outstanding Office action, the patent owner must (1) provide a complete response to the outstanding Office action, (2) include a petition to suspend under 37 CFR 1.182, and (3) include a petition under 37 CFR 1.182 for OPLA to take jurisdiction of the proceeding prior to issuing an Office action on the submitted response and retain such jurisdiction until OPLA issues its decision on the petition to suspend.

DECISION

I. Introductory Information

A. The Patent Reexamination System

In 1980, Congress added a new administrative procedure known as *ex parte* reexamination. 35 U.S.C. §§ 301-307. *Ex parte* reexamination allows third parties to call to the Office's attention new prior art issues that might affect a patent's validity that the examiner did not consider during the patent's initial examination. *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601 (Fed. Cir. 1985) (*Patlex I*). Congress contemplated three principal benefits of reexamination: (i) settle validity disputes more quickly and less expensively than protracted litigation; (ii) allow courts to refer patent validity questions to the expertise of the Office; and (iii) reinforce "investor confidence in the certainty of patent rights" by affording the Office an opportunity to review doubtful patents. *Patlex I*, 758 F.2d at 602. Thus, reexamination furthers the interests of both the public and patent owners in ensuring a strong, reliable patent system by allowing the Office a second look and testing the validity of patents in view of new evidence, thereby weeding out dubious patents. The Office's expertise in science and technology as well as patent law places the agency in a unique position to assess a patent's validity correctly and efficiently. Moreover, a paramount obligation mandated by Congress upon the Office is to conduct all reexaminations with "special dispatch." 35 U.S.C. § 305. In the only Federal Circuit case to consider the meaning of "special dispatch," the court ruled that the Office incorrectly suspended a reexamination of a patent in view of a validity challenge in a concurrent litigation, because such a suspension ran contrary to the statutory "special dispatch" requirement for reexamination proceedings. *See Ethicon v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

Ex parte reexamination, however, does not provide a meaningful opportunity for the requester to participate once reexamination is ordered. 35 U.S.C. §§ 301-307. As a result, "such reexamination had been used infrequently" since it was enacted in 1980. 145 Cong. Rec. S14720 (Nov. 17, 1999). In order to encourage more third parties to use reexamination, Congress enacted in 1999 the *inter partes* reexamination procedure "as an option to the existing *ex parte* reexamination proceedings." *Id.* With this new option, third parties can now fully participate

throughout the reexamination proceeding. Moreover, "[w]ith *inter partes* reexamination, it is believed that a better balance can be achieved toward the goal of improving patent quality and validity." H.R. Rep. 107-121 (June 28, 2001).

In creating the *inter partes* reexamination statutory framework, Congress borrowed heavily from the existing *ex parte* reexamination regime. For example, "[a]ny third party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of prior art cited under the provisions of section 301." 35 U.S.C. § 311. In addition, as is the case for *ex parte* reexamination, within 3 months from the filing of an *inter partes* reexamination request, the USPTO Director must determine whether a substantial new question of patentability has been raised by the request to justify initiating a reexamination proceeding. 35 U.S.C. § 312. Further, *inter partes* reexamination proceedings must likewise be conducted with "special dispatch." 35 U.S.C. § 314(c).

A key difference between *inter partes* and *ex parte* reexamination, is that Congress provided the requester with an opportunity to meaningfully participate throughout the proceeding. 35 U.S.C. § 314(b). Further, although Congress continued with its overarching mandate that *inter partes* reexaminations be conducted with "special dispatch," in contrast to *ex parte* reexamination, Congress provided the Office with discretion to suspend *inter partes* reexamination proceedings for "good cause." *See* 35 U.S.C. § 314(c). Another difference is that while Congress gave patent owners a specific right to file a statement in response to the order for an *ex parte* reexamination (35 U.S.C. § 304), Congress chose not to provide a similar provision in *inter partes* reexamination. In fact, Congress specifically gave the Office the authority to issue the first action on the merits on the same day as the order for reexamination is issued. 35 U.S.C. § 313. Additionally, with *inter partes* reexamination, Congress specifically provided estoppel provisions when a "final decision" upholding the validity of patent claims has been reached in a civil action or in a prior *inter partes* reexamination. *See* 35 U.S.C. § 317(b); 35 U.S.C. § 315(c). Thus, if a party's challenge to the validity of certain patent claims has been finally resolved, either through civil litigation or through the *inter partes* reexamination process, then that party is barred from making a subsequent request for *inter partes* reexamination (or filing a new civil action) challenging the validity of those same claims. *Id.* Accordingly, while Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also contemplated in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other. Until that time, however, the Office is obligated, by statutory mandate, to move forward in the *inter partes* reexamination with "special dispatch." Only "good cause" will permit the Office to deviate from that statutory mandate.

B. Established Standards Demonstrating the Existence of "Good Cause" For Suspension of *Inter Partes* Reexamination Proceedings

35 U.S.C. § 305 requires that all *ex parte* reexamination proceedings be conducted with special dispatch within the Office. The Court of Appeals for the Federal Circuit has held that, based on the unequivocal statutory requirement for special dispatch, the Office may not suspend a pending *ex parte* reexamination proceeding merely because of the existence of concurrent litigation on the patent being reexamined. *Ethicon, Inc., v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988). *Ethicon* discusses certain fundamental concepts regarding concurrent *ex parte* reexamination and litigation proceedings for a patent, which apply equally to *inter partes* reexamination. The *Ethicon* court quoted extensively from the decision of the Federal Circuit in *In re Etter*, 756 F.2d 852, 857, 225 USPQ 1, 4, (Fed Cir. 1985) (en banc) to point out:

> "That one challenging validity in court bears the burden assigned by [35 U.S.C.] § 282, that the same party may request reexamination upon submission of art not previously cited, and that, if that art raises a substantial new question of patentability, the PTO may during reexamination consider the same and new and amended claims in light of that art free of any presumption, *are concepts not in conflict*. On the contrary, those concepts are but further indication that *litigation and reexamination are distinct proceedings, with distinct parties, purposes, procedures, and outcomes*." [Emphasis is the Court's.]

The *Ethicon* court also cited *Etter* in order to point out that when reexamination and litigation for the same patent are conducted concurrently:

> "...precise duplication of effort does not occur because the PTO and the courts employ different standards of proof when considering validity, and the courts, unlike the PTO during a reexamination of patent claims, are not limited to review of prior art patents or printed publications." Id., at 856, at 4.

It is clear that reexamination and litigation proceedings bring different benefits "to the table," and proceeding concurrently with both proceedings permits obtaining the benefits of each other. 35 U.S.C. § 305 applies to *ex parte* reexamination and requires that both proceedings continue concurrently throughout, since§ 305 authorizes no exception to the mandate for special dispatch. In contrast, 35 U.S.C. § 314(c) authorizes a narrow exception to the mandate for special dispatch in an *inter partes* reexamination proceeding, within the discretion of the Director "for good cause." Thus, the question of suspending an *inter partes* reexamination proceeding being conducted concurrently with litigation may be considered as to whether there is a clear showing of "good cause" for the suspension that outweighs the benefits of conducting both proceedings

concurrently. Pursuant to 35 U.S.C. § 314(c), and 37 CFR 1.987 that implements the statutory provision, the USPTO Director has, within his discretion, authority to evaluate whether facts and circumstances amount to "good cause" for suspension of an *inter partes* reexamination proceeding, on a case-by-case basis.

In *inter partes* reexamination proceeding control numbers 95/000,093 and 95/000,094 (collectively referred to hereinafter as the Immersion-Sony '093 and '094 reexamination proceedings), the Office issued a decision [1] granting a patent owner petition to stay the *inter partes* reexamination proceedings due to the existence of concurrent litigation of the patents that were being reexamined. The decision pointed out that MPEP § 2686.04 set forth certain criteria as indicia of "good cause" for suspension of an *inter partes* reexamination proceeding, and that these criteria were merely exemplary.[2] The decision then proceeded to grant a stay based upon a set of facts and circumstances as to the reexamination and litigation proceedings enunciated in that decision in detail. The criteria for suspension relied upon by the Office in the Immersion-Sony *inter partes* reexamination proceedings to support a finding of "good cause" to suspend was upheld by the U.S. District Court, Eastern District of Virginia, *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D. Va. May 22, 2006), Slip Copy, 2006 U.S. Dist. LEXIS 36856. These suspension criteria establish a benchmark and standard which the Office uses to test the facts and circumstances of record in *inter partes* reexamination proceedings, in order to determine whether there is "good cause" to suspend that *inter partes* reexamination proceeding based on the existence of concurrent litigation of the patent being reexamined.

C. In the *Sony* scenario

In the Immersion-Sony '093 and '094 reexamination proceedings, the patent claims for which *inter partes* reexamination was requested were initially not identical to the claims being litigated; there was one non-litigated patent claim (claim 1) in each instance, for which reexamination had been requested in each proceeding. The Office accordingly denied patent owner Immersion's first petition to suspend the *inter partes* reexamination proceedings, noting that even if the proceedings were suspended in the Office and judgment was rendered adverse to requester Sony in the concurrent litigation, that would *not* dispose of all claims in the existing *inter partes* reexamination proceedings. The Office pointed out that the requested suspension would lead to a piecemeal reexamination, and a delay in reexamination of the new question of patentability raised as to the non-litigated claims. [3] The patent owner then disclaimed claim 1 of each patent, leaving only identical patent claims to be the subject of both the *inter partes* reexamination

[1] See the '093 and '094 proceedings, Decision Granting Petitions To Suspend, November 17, 2005
[2] *Id.*, Decision Granting Petitions to Suspend, November 17, 2005, footnote 6.
[3] *Id.*, Decision Denying Petitions, August 23, 2005, at page 6.

proceedings and the concurrent litigation. After the claims were made congruent in the litigation and reexamination proceedings, the Office then granted patent owner Immersion's second petition to suspend the '093 and '094 inter *partes* reexamination proceedings.

Factors in Sony: At the point in time that the Immersion-Sony *inter partes* reexamination proceedings were suspended, the reexamination proceedings were at an early stage; the Office's work had been limited solely to a finding that the two requests for reexamination had raised a substantial new question of patentability. The concurrent litigation, on the other hand, was at a significantly advanced stage: (a) a District Court had issued a decision adverse to requester Sony, holding the litigated patent claims to be valid, (b) an appeal of the District Court had been filed in the Court of Appeals for the Federal Circuit ("the Federal Circuit"), and (c) the matter had already been briefed. Thus, there was a substantial likelihood that suspension of the reexamination proceedings would serve to conserve Office resources, since a final holding of claim validity would statutorily require termination of the Immersion-Sony *inter partes* reexamination proceedings with respect to all of the claims subject to the litigation, which were also *all* the claims subject to reexamination in the two reexamination proceedings. It was not in the Office's and the parties' interests to engage resources in administrative proceedings, where there was a substantial likelihood that the reexamination proceedings could very reasonably be mooted by the concurrent litigation which was *soon* to be finally resolved. The substantial likelihood that prosecution of the reexamination proceedings would soon terminate and the proceedings then concluded, taken together with the identity of claims in the litigation and the *inter partes* reexamination proceedings, led the Office to conclude that, on balance, there was "good cause" to suspend the Immersion-Sony *inter partes* reexamination proceedings, to await the decision by the Federal Circuit. The decision granting suspension pointed out that, should circumstances change (*e.g.*, if the matter were remanded to the District Court by the Federal Circuit without a holding on claim validity), the third party requester would be free to petition for a resumption of the *inter partes* reexamination proceeding at that point, based upon the change in circumstances. As pointed out, the Office's position was ratified by the District Court for the Eastern District of Virginia.

II. Analysis

The facts and circumstances in the present '521 *inter partes* reexamination proceeding differ significantly from those present in the Immersion-Sony *inter partes* reexamination proceeding. First and foremost, the court document submitted by the requester with the petition for a stay of reexamination reveals, the litigation involving the present '877 patent is actually at an early stage, relative to a final disposition of the matter, despite the fact that the District Court has issued a decision on summary judgment that claims 1, 3-4 are indefinite. The result of any decision on summary judgment by the court would likely not result in a final decision regarding

the claims, as the court's decision may not preclude the need for a trial phase, and even if it does preclude the need for a trial phase, there is the potential for an appeal. Thus, unlike the Immersion-Sony *inter partes* proceedings, in which the litigation had already resulted in an appealable holding of claim validity, with the appeal having been filed and briefed to the appellate court, in this instance, the court's proceedings are still at a very early stage in regards to a final disposition on the merits of the case. No final holding of claim invalidity in the litigation is forthcoming in the very near future that could justify the Director to exercise his narrow "good cause" discretion exception to the statutory special dispatch mandate to suspend the '521 *inter partes* proceeding. Accordingly, good cause to suspend the '521 *inter partes* proceeding clearly has not been shown.

Futher, as to the differences between the Immersion-Sony *inter partes* reexamination proceedings and the present *inter partes* reexamination proceedings: The third party requester Sony chose to permit the District Court litigation to proceed for three years before filing its two requests for reexamination AFTER the District Court judgment was entered in Immersion's favor in the litigation. Had Sony filed its requests for reexamination BEFORE entry of the District Court judgment, the reexamination proceedings could have been farther along in the process, and may likely have been completed at the Office before the District Court issued a decision. The present '521 proceeding is at a very mature stage and on appeal. Significant resources have already been consumed and the issues are well developed and ripe for review by the Board of Patent Appeals and Interference (BPAI). Therefore, the conservation of resources is nowhere near what was conserved in the Sony scenario, and it is possible the BPAI's proceedings will be concluded before District Court's full proceedings have concluded, as litigation is on going at least with regard to *the other patents asserted in the District Court proceeding*. The results of the Office's board decision may prove beneficial to the District Court or the Court of Appeals for the Federal Circuit, if appeal is sought upon the conclusion of the District Court proceedings.

For the above reasons, third party requester's arguments are not persuasive. Accordingly, the petition to stay the '521 *inter partes* reexamination is dismissed.

CONCLUSION

1. The March 14, 2011 third party requester petition is dismissed.

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

/Kenneth M. Schor/

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

6-07-11
Kenpet8/IP/suspend