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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595 + 95/001499 + 95/001455	12/14/2010	7528782	3008.003REX1	8977

26111 7590 05/24/2011

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

ART UNIT	PAPER NUMBER

DATE MAILED: 05/24/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard C. Kim
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER 95/000,595. + 95/001499 + 95/001455

PATENT NUMBER 7528782.

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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Novak Druce & Quigg, LLP
1000 Louisiana Street
53rd Floor
Houston, TX 77002

In re Carles Puente Baliarda et al. :
Inter Partes Reexamination Proceeding :
Control No.: 95/000,595 :
Filed: December 14, 2010 :
For: U.S. Patent No. 7,528,782 :
:
In re Carles Puente Baliarda et al. : **DECISION, *SUA SPONTE*,**
Inter Partes Reexamination Proceeding : **TO MERGE**
Control No.: 95/001,499 : **REEXAMINATION**
Filed: December 3, 2010 : **PROCEEDINGS**
For: U.S. Patent No. 7,528,782 :
:
In re Carles Puente Baliarda et al. :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,455 :
Filed: September 30, 2010 :
For: US. Patent No. 7,528,782 :

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. 7,528,782 ("the '782 patent") issued to Carles Puente Baliarda et al. on May 5, 2009, with 29 claims.

2. A request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent was filed on September 30, 2010, by a third party requester, and was assigned control number 95/001,455 ("the '1455 *inter partes* proceeding"). The real party in interest is Samsung Electronics Co. Ltd.

3. On November 19, 2010, *inter partes* reexamination was ordered for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent in the '1455 *inter partes* proceeding based on the examiner's determination that the September 30, 2010 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection Office action.

4. A second request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent was filed on December 3, 2010, by a third party requester, and was assigned control number 95/001,499 ("the '1499 *inter partes* proceeding"). The real party in interest is HTC Corporation and HTC America, Inc.

5. A third request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent was filed on December 14, 2010, by a third party requester, and was assigned control number 95/000,595 ("the 595 *inter partes* proceeding"). The real party in interest is Kyocera Communications, Inc.

6. On January 13, 2011, *inter partes* reexamination was ordered for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent in the '1499 *inter partes* proceeding based on the examiner's determination that the December 3, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1499 proceeding.

7. On January 21, 2011, *inter partes* reexamination was ordered for claims 1-2, 5-6, 11-12, 15-16, and 22-28 of the '782 patent in the '595 *inter partes* proceeding based on the examiner's determination that the December 14, 2010 request raised a substantial new question of patentability affecting these claims.[1] No Office action on the merits has been issued in the '595 proceeding.

8. On April 12, 2011, patent owner submitted a response to the November 19, 2010 non-final rejection action in the '1455 *inter partes* proceeding.[2] The April 12, 2011 patent owner response did not include any amendment to the specification or claims.

---

[1] The January 21, 2011 order stated that the December 14, 2010 request did not raise a substantial new question of patentability as to claims 7-8 and 18.

[2] Patent owner's April 12, 2011 response in the '1455 *inter partes* proceeding was a corrected response filed in response to a March 28, 2011 Notice Re Defective Paper In *Inter Partes* Reexamination. The March 28, 2011 Notice stated that patent owner's original February 22, 2011 response to the November 19, 2010 non-final rejection action was defective.

9. On April 28, 2011, the '1455 requester filed comments to patent owner's April 12, 2011 response.

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 95/001,455, 95/001,499 and 95/000,595 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

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding.*

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 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent in the '1455 and '1499 proceedings, and for claims 1-2, 5-6, 11-12, 15-16, and 22-28 of the '782 patent in the '595 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent.

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 requesters 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. 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, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,455, *inter partes* Reexamination No. 95/001,499 and *inter partes* Reexamination Control No. 95/000,595 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The examiner will issue an Office action for the merged proceeding in due course.

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

/Kenneth M. Schor/

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

May 20, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595 +98/001455 +95/001499	12/14/2010	7528782	3008.003REX1	8977

26111 7590 06/22/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER 95/000,595. + 95/001499 + 95/001455

PATENT NUMBER 7528782.

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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Inter Partes Reexamination Proceeding Control No. 95/000,595 Filed: December 14, 2010 For: U.S. Patent No. 7,528,782	
Inter Partes Reexamination Proceeding Control No. 95/001,499 Filed: December 3, 2010 For: U.S. Patent No. 7,528,782	**DECISION ON PETITIONS UNDER 37 CFR 1.183**
Inter Partes Reexamination Proceeding Control No. 95/001,455 Filed: September 30, 2010 For: U.S. Patent No. 7,528,782	

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 12, 2011 in reexamination proceeding control no. 95/001,455.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on April 28, 2011, in reexamination proceeding control no. 95/001,455.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

BACKGROUND

1. On May 5, 2009, U.S. patent number 7,528,782 (the '782 patent) issued to Baliarda *et al.*

2. On September 30, 2010, a third party requester filed a request for *inter partes* reexamination of the '782 patent, which request was assigned Reexamination Control No. 95/001,455 (the '1455 proceeding).

3. On November 19, 2010, the Office issued an order granting *inter partes* reexamination in the '1455 proceeding. Concurrently with the order, the Office issued a non-final Office action.

4. On February 22, 2011, patent owner filed a response to the November 19, 2010 Office action.[1]

5. On March 24, 2011, third party requester filed comments after the November 19, 2010 Office action and patent owner's February 22, 2011 response.

6. On March 28, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's February 22, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.

7. On April 12, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the November 19, 2010 Office action (patent owner corrected response submission).

8. On April 28, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the November 19, 2010 Office action and patent owner's April 12, 2011 corrected response submission (requester comments submission).

[1] On December 28, 2010, the Office mailed a decision granting patent owner's December 22, 2010 petition for a one-month extension of time.

9. On May 24, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1455 proceeding with *inter partes* reexamination proceeding control no. 95/000,595 (the '595 proceeding) and with *inter partes* reexamination proceeding control no. 95/001,499 (the '1499 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) 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 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. Analysis

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 petitioner deems to be needed for the response.

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 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. 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, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 12, 2011

On April 12, 2011, patent owner filed, in the '1455 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 12, 2011 corrected response submission is 68 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the corrected response submission.[2] Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."[3] Nonetheless, patent owner also requests waiver of the 50-page limit "for any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts."[4]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 12, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.[5] Additionally, patent owner asserts that "the full length of the Corrected Response is needed to fully and adequately respond to the Office Action,"

[2] Patent owner petition under 37 CFR 1.183 at page 2.
[3] Id. at page 4 (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (41 pages)," are filed herewith.)
[4] Id. at page 6.
[5] Id. at pages 4-6.

and that although the Office action "constitutes only 9 pages, it incorporates by reference over 450 pages of arguments and detailed claim charts set forth by the third party requester in its request for reexamination."[6] Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 28, 2011 notice of defective paper, by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[7] As evidence of the reformatting and further editing made to reduce page length, patent owner submitted as "Exhibit 1" a redlined document comparing patent owner's February 22, 2011 original response submission to patent owner's April 12, 2011 corrected response submission. The "Exhibit 1" redlined document has been expunged from the record of the '1455 proceeding by marking the paper "closed" and "not public" in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 28, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[8] and the individual facts and circumstances of this case (such as the length of the November 19, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner's April 12, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the November 19, 2010 Office action, which has been determined to span approximately 388 pages.[9] Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 12, 2011 corrected response submission. This waiver makes patent owner's April 12, 2011 corrected response submission page-length compliant.

IV. Third party requester petition of April 28, 2011

On April 28, 2011, the '1455 requester filed, in the '1455 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1455 requester asserts that the April 28, 2011 comments submission includes "56 pages of double spaced 12 pt font arguments and a 14 page declaration from Dr.

[6] Id. at page 2.
[7] Id. at page 3.
[8] 67 pages of the remarks portion of patent owner's April 12, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 7-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the total number of pages of the patent owner's April 12, 2011 corrected response submission exceeds the 50-page limit.
[9] On its face, the substantive portion of the November 19, 2010 Office action spans only approximately 7 pages, but it incorporates by reference approximately 147 pages, in addition to approximately 234 pages of claim charts, from the '1455 request for *inter partes* reexamination.

Balanis under 37 C.F.R. § 1.132."[10] The '1455 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 56 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue."[11]

In support of its request for waiver of the rule, the '1455 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 135 page response."[12] The '1455 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 70 pages."[13] The '1455 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."[14]

Based on the specific facts set forth in the '1455 requester's petition under 37 CFR 1.183, the '1455 requester'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 comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),[15] 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 to the extent that the '1455 requester's April 28, 2011 comments submission exceeds 50 pages. Accordingly, the '1455 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 necessary to permit entry of the '1455 requester's April 28, 2011 comments submission. This waiver makes the '1455 requester's April 28, 2011 comments submission page-length compliant.

---

[10] Third party requester petition under 37 CFR 1.183 at page 1.

[11] Id. at page 4. The '1455 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1455 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. 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. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

[12] Id. at page 2.

[13] Id.

[14] Id.

[15] 56 pages of the remarks portion of the '1455 requester's April 28, 2011 comments submission count toward the page limit. Thus, the total number of pages of the '1455 requester's April 28, 2011 comments submission exceeds the 50-page limit.

ADDITIONAL DISCUSSION

The 95/000,595 third party requester and the 95/001,499 third party requester have 30 days from the date of this decision, granting patent owner's April 12, 2011 petition under 37 CFR 1.183 and entering patent owner's April 12, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

> The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's May 24, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

> Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.
>
> No *inter partes* requester has a right to comment on any issue raised outside the confines of the 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. [footnote omitted]

Thus, because the patent owner's April 12, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1455 proceeding with the '595 and '1499 proceedings, the entry of patent owner's April 12, 2011 corrected response submission

triggers a right for the 95/000,595 third party requester and the 95/001,499 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 12, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 12, 2011 corrected response submission. This waiver makes patent owner's April 12, 2011 corrected response submission page-length compliant.

2. The '1455 requester's April 28, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1455 requester's April 28, 2011 comments submission. This waiver makes the '1455 requester's April 28, 2011 comments submission page-length compliant.

3. The 95/000,595 third party requester and the 95/001,499 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 12, 2011 petition under 37 CFR 1.183 and entering patent owner's April 12, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.

4. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

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

06-17-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595 +95/001453 +95/001499	12/14/2010	7528782	3008.003REX1	8977

26111 7590 09/08/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Richard C. Kim
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San Diego, CA 92130-2040

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER 95/000,595. + 95/001499 + 95/001455

PATENT NUMBER 7528782.

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.: 95/001,455 + 95/000,595 + 95/001,499

1. THIS IS A DECISION ON THE PETITION FILED on 08/30/2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 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 07/29/2011, which sets a two (2) month period for filing a response thereto, be extended by two (2) months.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☒ Other/comment: Requests for extensions of time for more than one (1) month will not be granted unless extraordinary circumstances are involved; e.g., death or incapacitation of the patent owner.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 3 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/ for Mark Reinhart — SPE, Art Unit 3992

[*Signature*] — (Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595 +95/001,455 +95/001,499	12/14/2010	7528782	3008.003REX1	8977

26111 7590 12/12/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

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Date: 12-12-11

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San Diego, CA 92130-2040

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000595 + 95/001455 + 95/001499
PATENT NO. : 7528782
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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Novak, Druce & Quigg, LLP (For *Inter Partes* '1455 Requester)
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Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,499
Filed: December 03, 2010
For: U.S. Patent No. 7,528,782

Inter Partes Reexamination Proceeding
Control No: 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, 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 95/001,499, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,499 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,499, 95/000,595 and 95/001,455.

Inter partes reexamination proceeding 95/001,499, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,499 (the '1499 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 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1499 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '595 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '782 patent, which is the patent under reexamination in the '1499 proceeding, are listed in the consent judgment as claims 1, 2, 5-8, 11, 12, 15, 16, 18, and 22-28, which are identical to the claims that were requested to be reexamined by HTC in the '1499 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '782 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1499 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,499 , 95/000,595 and 95/001,455.

Inter partes reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1499 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '595 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[3]

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,595 and 95/001,455, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,595 and 95/001,455 will otherwise remain, in general, as outlined by the decision, mailed on May 24, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1499 *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 September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,499 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,499, 95/000,595 and 95/001,455.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue** in the manner set forth in this decision.
- The prosecution of the '1499 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1499 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1499 proceeding, as set forth in this decision.

[3] A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

Kenpet9

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95/000,595	12/14/2010	7528782	3008.003REX1	8977

26111 7590 12/12/2011

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1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455	09/30/2010	7528782	3008.003REX0	7741

26111 7590 12/12/2011
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1000 Louisiana St., 53rd Floor
Houston, TX 77002

Date: **MAILED**

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001455
PATENT NO. : 7528782
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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Date:

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DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000595
PATENT NO. : 7528782
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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Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

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

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

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

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

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

[1] In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate Inter Partes Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,499, was granted. *Inter partes* reexamination proceeding 95/001,499 was severed from the merger of *inter partes* reexamination proceedings 95/001,499, 95/000,595 and 95/001,455, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,595 and 95/001,455.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,595, filed on September 30, 2011, is **dismissed**.

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

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,595 (the '595 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '595 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '782 patent's claims 1, 2, 5-8, 11, 12, 15, 16, 18, 22-28 all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

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

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

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 2, 5, 6, 11, 12, 15, 16 and 22-28 of the '782 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

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

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

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

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '595 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '595 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

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

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

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

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

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

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

The September 30, 2011 Petition to Expunge

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

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), " . . . entered a Final Consent Judgment against Kyocera [the requester of the '595 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '595 proceeding, has consented to a waiver of any protective order by the court,

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

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

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

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

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

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

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

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,595 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

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

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

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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.
95/000,595 +95/001455	12/14/2010	7528782	3008.003REX1	8977

26111 7590 01/04/2012

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-4-12

MORRISON & FOERSTER LLP
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000595 + 95/001455
PATENT NO. : 7528782
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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Inter Partes Reexamination Proceeding Control No. 95/000,595 Filed: December 14, 2010 For: U.S. Patent No. 7,528,782	**DECISION GRANTING PETITION UNDER 37 CFR 1.183**
Inter Partes Reexamination Proceeding Control No. 95/001,455 Filed: September 30, 2010 For: U.S. Patent No. 7,528,782	

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,595, 95/001,455 and 95/001,499.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

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

RELEVANT BACKGROUND

1. On May 5, 2009, U.S. patent number 7,528,782 (the '782 patent) issued to Carles Puente Baliarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '782 patent were filed, which requests were assigned Reexamination Control Nos. 95/001,455, 95/001,499, and 95/000,595, and for each of which reexamination was instituted by the Office.

3. On May 24, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1455 proceeding with the '1499 and '595 proceedings (the merged proceeding).

4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.

5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (petition under 37 CFR 1.183).[1]

6. On December 12, 2011, the Office issued a "DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER," terminating the 95/001,499 proceeding and severing the 95/001,499 proceeding from the merged proceeding.[2]

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.

[1] On September 8, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 29, 2011 Office Action.
[2] The merged proceeding continues as to the '595 and '1455 proceedings.

II. Analysis

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 petitioner deems to be needed for the response.

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 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. 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, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.[3] Patent owner asserts that the argument portion of the October 31, 2011 response submission is 86 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.[4] Patent owner states

[3] Because the '1499 proceeding has been terminated, this decision does not address the instant petition with respect to the '1499 proceeding.
[4] Patent owner petition under 37 CFR 1.183 at page 2.

that it concurrently filed "a number of 132 Declarations" but asserts that the declarations are "drawn to fact, not argument, and thus does not count towards the 50-page limit."[5] Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit...."[6]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.[7] Additionally, patent owner asserts that "the full length of the Response is needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 43 pages, it incorporates by reference almost 900 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination."[8] Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[9]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[10] and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),[11] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's October 31, 2011 response submission. This waiver makes patent owner's October 31, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,455 third party requester and the 95/000,595 third party requester have 30 days from the date of this decision, granting patent owner's October 31, 2011 petition under 37 CFR 1.183

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[5] Id. at page 4 (identifying a copy of the declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), filed on October 3, 2011 in the '1390 proceeding, a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), and a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (11 pages), which references and includes a copy of the declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (41 pages), previously entered in the '1455 proceeding).

[6] Id. at page 2.

[7] Id. at pages 4-6.

[8] Id. at page 2-3.

[9] Id. at page 3.

[10] 86 pages of the remarks portion of patent owner's October 31, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 7-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner's October 31, 2011 response submission exceeds the 50-page limit by at least 36 pages.

[11] On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 43 pages, some of which pertain to rejections that have been withdrawn and not adopted, but in setting forth the rejections that have been adopted, it incorporates by reference over 100 pages from the '1455, '1499 and '595 requests for *inter partes* reexamination.

and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

> The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's October 31, 2011 response submission. This waiver makes patent owner's October 31, 2011 response submission page-length compliant.

2. The 95/001,455 third party requester and the 95/000,595 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 31, 2011 petition under 37 CFR 1.183 and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

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

01-03-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595	12/14/2010	7528782	3008.003REX1	8977

26111 7590 02/27/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Richard C. KIm
MORRISON & FOERSTER LLP
12531 High Bluff Dr., Suite 100
San Diego, CA 92130-2040

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000595 + 95001455
PATENT NO. : 7528782
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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Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)
1100 New York Avenue, N.W.
Washington, D.C. 20005

Morrison & Foerster, LLP (For *Inter Partes* '595 Requester)
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Novak, Druce & Quigg, LLP (For *Inter Partes* '1455 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

DECISION DISMISSING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).[1]

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,455 (the '1455 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1455 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

[1] On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,499. *Inter partes* reexamination proceeding 95/001,499 was severed from the merger of *inter partes* reexamination proceedings 95/001,499, 95/000,595 and 95/001,455, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,595 and 95/001,455.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,595 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,595 (the '595 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '595 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.[2] The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '595 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '595 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,595 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

[2] For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

- 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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,598	12/03/2010	7148850	3008.009REX2	8625

26111 7590 06/08/2011

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JUN 08 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000598
PATENT NO. : 7148850
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.

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Baker Botts LLP (For *Inter Partes* '598 Requester)
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Dallas, TX 75201

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No. 7,148,850 B2

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850 B2

Inter Partes Reexamination Proceeding
Control No. 95/000,598
Filed: December 3, 2010
For: U.S. Patent No. 7,148,850 B2

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 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,148,850 B2 (the '850 patent) issued to Carles Puente Baliarda *et al.* on December 12, 2006.

2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/001,413 (the '1413 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. A first Office action on the merits was issued in this proceeding on the same date, rejecting all pending claims under reexamination. Patent owner filed a response on April 11, 2011;[1] the response did not include any proposed amendment to the claims. Third party requester filed comments on May 2, 2011.

3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,593 (the '593 *inter partes* proceeding), and a filing date of December 22, 2010, the date which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on February 3, 2011. No action on the merits has been issued in this proceeding.

4. On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,598 (the '598 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 4, 2011. No action on the merits has been issued in this proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 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.

[1] An earlier-filed patent owner response was refused entry, and additional time was given for a proper response.

As evidenced by the above review of facts, the '1413, '593, and '598 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent have been mailed in each of the reexamination proceedings, and a decision under 37 C.F.R. § 1.989(a) is timely. The '593, and '598 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued. The '1413 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to the reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple 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 each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1413, '593, and '598 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1413, '593, and '598 reexamination proceedings <u>are hereby merged</u>. 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 two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[2] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters'

[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.

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

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

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

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

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

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

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

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for 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 triplicate**, each bearing a signature and identifying data for <u>all</u> 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 C.F.R. § 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 C.F.R. § 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
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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, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 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 specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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.

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 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 C.F.R. § 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,413, *inter partes* Reexamination Control No.95/000,598, and *inter partes* Reexamination Control No. 95/000,593 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

June 7, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,598	12/03/2010	7148850	3008.009REX2	8625

26111 7590 06/21/2011

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WASHINGTON, DC 20005

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PTO-90C (Rev. 10/09)

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Date:

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JUN 21 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000598
PATENT NO. : 7148850
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PTOL-2070(Rev.07-04)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593

26111 7590 06/21/2011

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SAN DIEGO, CA 92130-2040

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000593
PATENT NO. : 7148850
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.

PTOL-2070(Rev.07-04)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117

26111 7590 06/21/2011

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

ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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

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JUN 2 1 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001413
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JUN 21 2011

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Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/000,598
Filed: December 3, 2010
For: U.S. Patent No. 7,148,850

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,413.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,413.

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The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

BACKGROUND

1. On December 12, 2006, U.S. patent number 7,148,850 (the '850 patent) issued to Baliarda *et al.*

2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '850 patent, which request was assigned Reexamination Control No. 95/001,413 (the '1413 proceeding).

3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1413 proceeding. Concurrently with the order, the Office issued a non-final Office action.

4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.[1]

5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.

7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).

9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the

[1] On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.

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October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

10. On June 8, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1413 proceeding with *inter partes* reexamination proceeding control no. 95/000,593 (the '593 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) 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 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. Analysis

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

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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 petitioner deems to be needed for the response.

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 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. 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, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 50 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).[2] Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."[3] Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."[4]

---

[2] Patent owner petition under 37 CFR 1.183 at page 2.

[3] Id. (stating that "[i]n addition to the Corrected Response, a number of Rule 132 declarations are filed herewith: Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages); and, Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages)," and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

[4] Id.

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In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.[5] Additionally, patent owner asserts that "the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 7 pages, it incorporates by reference almost 500 pages of arguments and detailed claim charts."[6] Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[7] As evidence of the reformatting and further editing made to reduce page length, patent owner submitted as "Exhibit 1" a redlined document comparing patent owner's January 10, 2011 original response submission to patent owner's April 11, 2011 corrected response submission. "Exhibit 1" has been expunged from the record of the '1413 proceeding by marking the paper "closed" and "not public" in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[8] and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner's April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span approximately 475 pages.[9] Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.

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[5] Id. at pages 2-4.
[6] Id. at page 5.
[7] Id.
[8] 49 pages of the remarks portion of patent owner's April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 14-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 45-page "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132" are subject to the regulatory page limit count, such that the total number of pages of the patent owner's April 11, 2011 corrected response submission exceeds the 50-page limit.
[9] On its face, the substantive portion of the October 8, 2010 Office action spans only 5 pages, but it incorporates by reference more than 200 pages, in addition to approximately 270 pages of claim charts, from the '1413 request for *inter partes* reexamination.

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IV. Third party requester petition of May 2, 2011

On May 2, 2011, the '1413 requester filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1413 requester asserts that the May 2, 2011 comments submission includes "49 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best's expert report."[10] The '1413 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 49 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best's [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language" such that no waiver would be needed.[11]

In support of its request for waiver of the rule, the '1413 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 132 page response."[12] The '1413 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 83 pages."[13] The '1413 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."[14]

Based on the specific facts set forth in the '1413 requester's petition under 37 CFR 1.183, the '1413 requester'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 comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),[15] and the

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[10] Third party requester petition under 37 CFR 1.183 at page 1.

[11] Id. at page 4. The '1413 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1413 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. 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. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

[12] Id. at page 2.

[13] Id.

[14] Id.

[15] Upon brief review, it appears that 49 pages of the remarks portion of the '1413 requester's May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, portions of the

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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 to the extent that the '1413 requester's May 2, 2011 comments submission exceeds 50 pages. Accordingly, the '1413 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 necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

> The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 8, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

> Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

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submitted declarations are deemed to include legal argument and are subject to the regulatory page limit count, such that the total number of pages of the '1413 requester's May 2, 2011 comments submission exceeds the 50-page limit.

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> Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.
>
> No *inter partes* requester has a right to comment on any issue raised outside the confines of the 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. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1413 proceeding with the '593 and '598 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,593 third party requester and the 95/000,598 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.

2. The '1413 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.

3. The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

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

06-17-2011

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Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No.: 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/000,598
Filed: December 03, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No: 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, 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 95/000,598, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/000,598 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,598, 95/000,593 and 95/001,413.

Inter partes reexamination proceeding 95/000,598, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,598 (the '598 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 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '598 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '593 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 29, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '850 patent, which is the patent under reexamination in the '598 proceeding, are listed in the consent judgment as claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, 68, 69, and 70, which are, with the exception of claim 68, identical to the claims that were requested to be reexamined by HTC in the '598 proceeding,[2] and are identical (i.e., including claim 68) to the claims under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '850 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '598 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598 , 95/000,593 and 95/001,413.

Inter partes reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue**.[3] Any rejection proposed by HTC (the requester of the '598 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

[2] Claim 68 was not specifically requested to be reexamined in the request of the '598 proceeding, but is currently under reexamination in the merged proceeding.

[3] As pointed out above, this decision does not address the September 29, 2011 petition to terminate the '593 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[4]

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,593 and 95/001,413, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,593 and 95/001,413 will otherwise remain, in general, as outlined by the decision, mailed on June 8, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '598 *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 September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,598 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598, 95/000,593 and 95/001,413.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.
- The prosecution of the '598 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '598 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '598 proceeding, as set forth in this decision.

[4] A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

Kenpet9

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593

26111 7590 02/27/2012

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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

Copied from 95000593 on 03/30/2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

Date:

MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000593 + 95001413
PATENT NO. : 7148850
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.

PTOL-2070(Rev.07-04)

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United States Patent and Trademark Office

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)
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Morrison & Foerster, LLP (For *Inter Partes* '593 Requester)
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Novak, Druce & Quigg, LLP (For *Inter Partes* '1413 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No.: 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 04, 2010
For: U.S. Patent No. 7,148,850

DECISION DISMISSING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).[1]

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,413 (the '1413 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1413 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

[1] On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,598. *Inter partes* reexamination proceeding 95/000,598 was severed from the merger of *inter partes* reexamination proceedings 95/000,598, 95/000,593 and 95/001,413, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,593 and 95/001,413.

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SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,593 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,593 (the '593 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '593 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 29, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

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original). As discussed in the December 12, 2011 decision dismissing patent owner's September 29, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.[2] The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '593 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '593 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

[2] For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

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CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,593 is **dismissed**.

- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

- 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

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JUN 01 2011

CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For patent owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

NOVAK, DRUCE & QUIGG, LLP (For the '1461 requester)
(NDQ REEXAMINATION GROUP)
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HOUSTON, TX 77002

BAKER BOTTS, LLP (For the '599 requester)
2001 ROSS AVENUE
DALLAS, TX 75201

MORRISON & FOERSTER LLP (For the '587 requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,461
Filed: October 1, 2010
For: U.S. Patent No. 7,312,762

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/000,599
Filed: December 3, 2010
For: U.S. Patent No. 7,312,762

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No. 7,312,762

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 FACTS

1. On December 25, 2007, the Office issued U.S. Patent No. 7,312,762 (the '762 patent) to Carles Puente Baliarda *et al.* with 21 claims.

2. On October 1, 2010, a request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, was filed by a third party requester and assigned control No. 95/001,461 ("the '1461 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1461 requester") as the real party in interest.

3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, assigned control No. 95/000,587 ("the '587 proceeding"), was filed by a third party requester. The request identified Kyocera Communications, Inc. ("the '587 requester") as the real party in interest.

4. On November 19, 2010, *inter partes* reexamination of the '762 patent was granted-in-part in the '1461 proceeding. Reexamination was granted for claims 12, 14-15, and 17 of the '762 patent, and was denied for claims 1, 7-8, 11, and 21 of the '762 patent. An Office action was not concurrently issued. The order stated that an Office action would issue in due course.

5. On December 3, 2010, a third request for *inter partes* reexamination of claims 1, 8, 11 and 21 of the '762 patent, assigned control No. 95/000,599 ("the '599 proceeding"), was filed by a third party requester. The request identified HTC Corp. and HTC America, Inc. ("the '599 requester") as the real party in interest.

6. On December 20, 2010, the '1461 requester petitioned for supervisory review of the November 19, 2010 Order with regard to the denial of reexamination for claims 1, 7-8, 11 and 21 of the '762 patent in the '1461 proceeding. The petition requested that reexamination of claims 1, 7-8, 11 and 21 be ordered in the '1461 proceeding.

7. On January 21, 2011, the Office issued a decision granting the December 20, 2010 '1461 requester petition and ordering reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '1461 proceeding.

8. On February 10, 2011, *inter partes* reexamination was ordered on claims 1, 8, 11, and 21 of the '762 patent in the '599 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

9. On February 11, 2011, *inter partes* reexamination was ordered on claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '587 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

10. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '762 patent.

DECISION

I. MERGER OF PROCEEDINGS

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

The 95/001,461, 95/000,599 and 95/000,587 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the

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

statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

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

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

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

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

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

It is to be noted that, because the '599 *inter partes* third party requester did not propose any rejections of claims 7, 12, 14-15, and 17 in their request for reexamination, the '599 requester has no appeal rights as to those claims as they appear in the '762 patent.

C. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

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

D. Amendments:

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

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.
Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged

multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,461, 95/000,599 and 95/000,587 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. 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

May 31, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,599	12/03/2010	7312762	3008.004REX2	1788

26111 7590 07/07/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2011

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

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Date: JUL 07 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000599
PATENT NO. : 7312762
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.: 95/000,587 & 95/000,599 & 95/001,461

1. THIS IS A DECISION ON THE PETITION FILED 05 July 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 07 June 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the large number of related reexamination proceedings prosecuted at the same time as the instant proceedings as well as the length and complexity of the Office action. It is agreed that patent owner needs to be given opportunity to fully explore all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management with respect to workload resulting from related proceedings. Resource management takes into consideration the time required to respond to other Office actions.

While the additional workload from other proceedings is noted, it is the length and complexity of the office action that weighs most heavily in consideration of whether the patent owner has met the burden of providing "sufficient cause" for supporting the granting of an extension of time.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added.)

On balance, the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part

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DEC 12 2011

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)
1100 New York Avenue, N.W.
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Morrison & Foerster, LLP (For *Inter Partes* '587 Requester)
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Baker Botts, LLP (For *Inter Partes*'599 Requester)
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Suite 600
Dallas, TX 75201-2980

Novak, Druce & Quigg, LLP (For *Inter Partes* '1461 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No.: 7,312,762

Inter Partes Reexamination Proceeding
Control No. 95/000,599
Filed: December 03, 2010
For: U.S. Patent No. 7,312,762

Inter Partes Reexamination Proceeding
Control No: 95/001,461
Filed: October 01, 2010
For: U.S. Patent No. 7,312,762

DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, 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 95/000,599, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/000,599 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,599, 95/000,587 and 95/001,461.

Inter partes reexamination proceeding 95/000,599, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,599 (the '599 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 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '599 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '587 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '762 patent, which is the patent under reexamination in the '599 proceeding, are listed in the consent judgment as claims 1, 7, 8, 11, 12, 14, 15, 17, and 21, which include all of the claims that were determined to be subject to reexamination in the '599 proceeding (i.e., claims 1, 8, 11 and 21), and all of which are under reexamination in the merged proceeding.[2] The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '762 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '599 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.

Inter partes reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue**.[3] Any rejection proposed by HTC (the requester of the '599 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

[2] Claims 1, 8, 11, 12 and 21 were requested by HTC to be reexamined in the '599 proceeding. The Office determined, however, that no SNQ was raised by the request as to claim 12. For this reason, the claims that are subject to reexamination in the '599 proceeding are claims 1, 8, 11, and 21.

[3] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '587 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[4]

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,587 and 95/001,461, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,587 and 95/001,461 will otherwise remain, in general, as outlined by the decision, mailed on June 01, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '599 *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 September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,599 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.
- The prosecution of the '599 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '599 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '599 proceeding, as set forth in this decision.

[4] A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

Kenpet9

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841

26111 7590 12/12/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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

PTO-90C (Rev. 10/03)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170

26111 7590 12/12/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
53rd FLOOR
HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001461
PATENT NO. : 7312762
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.

PTOL-2070(Rev.07-04)

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

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000587
PATENT NO. : 7312762
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.

PTOL-2070(Rev.07-04)

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

MAILED

Morrison & Foerster, LLP (For *Inter Partes* '587 Requester) DEC 12 2011
12531 High Bluff Drive
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CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP (For *Inter Partes* '1461 Requester)
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1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding :
Control No. 95/000,587 :
Filed: December 15, 2010 :
For: U.S. Patent No.: 7,312,762 :

Inter Partes Reexamination Proceeding :
Control No. 95/001,461 :
Filed: October 01, 2010 :
For: U.S. Patent No. 7,312,762 :

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

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

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

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

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

[1] In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate Inter Partes Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,599, was granted. *Inter partes* reexamination proceeding 95/000,599 was severed from the merger of *inter partes* reexamination proceedings 95/000,599, 95/000,587 and 95/001,461, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,587 and 95/001,461.

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SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,587, filed on September 30, 2011, is **dismissed**.

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

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,587 (the '587 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '587 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '762 patent's claims 1, 7, 8, 11, 12, 14, 15, 17 and 21, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

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

Copied from 95000587 on 01/18/2012

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

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the '762 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

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

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

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

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '587 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '587 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

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

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

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

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

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

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

The September 30, 2011 Petition to Expunge

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

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), " . . . entered a Final Consent Judgment against Kyocera [the requester of the '587 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '587 proceeding, has consented to a waiver of any protective order by the court,

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

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

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

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

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

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

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

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,587 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

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

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,603	01/27/2011	7,366,919	17089-112002.R3	4276

69417 7590 03/29/2012

WILMERHALE/SYMANTEC CORPORATION
Wilmer Cutler Pickering Hale and Dorr LLP
1875 Pennsylvania Avenue, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/29/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

Date:

MAILED

MAR 29 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000603
PATENT NO. : 7366919
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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WILMERHALE/SYMANTEC Corporation
Wilmer Cutler Pickering Hale and Dorr LLP
1875 Pennsylvania Avenue, NW
Washington, DC 20006

(For Patent Owner)

MAILED

MAR 29 2012

CENTRAL REEXAMINATION UNIT

Mike H. Lee
King & Spalding, LLP
P.O. Box 889
Belmont, California 94002

(For *Inter Partes* Requester)

In re Sobel *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/000,603
Filed: January 27, 2011
For: U.S. Patent No. 7,366,919

DECISION DISMISSING PETITION

This is a decision on *inter partes* third party requester's February 10, 2012 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT OPPOSITION".

The petition is dismissed as moot. Requester's opposition petition has a right of entry.

REVIEW OF THE RELEVANT FACTS

1. On April 29, 2008, the Office issued United States Patent Number 7,366,919 (the '919 patent) to Sobel *et al.*

2. On January 27, 2011, a request for *inter partes* reexamination of the '919 patent was filed by a third party requester and assigned Reexamination Control No. 95/000,603 (the '603 proceeding).[1]

3. On March 17, 2011, the Office issued an order granting *inter partes* reexamination in the '603 proceeding. A first Office action on the merits concurrently issued with the order.

[1] On December 3, 2010, requester filed an initial request which was incomplete and therefore not given a filing date by the Office until completed on January 27, 2011.

4. On May 17, 2011, patent owner timely filed a response to the Office action.

5. On June 16, 2011, third party requester timely filed comments.

6. On September 28, 2011, the Office issued and Action Closing Prosecution (ACP).

7. On October 28, 2011, patent owner timely filed a response to the ACP.

8. On November 28, 2011, third party requester timely filed comments after ACP, which included an affidavit by Dr. Medvidovic and arguments based upon the content of the affidavit.
9. On January 30, 2012, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182," requesting that the November 28, 2011 Medvidovic affidavit and arguments based upon the affidavit be expunged from the record.

10. On February 10, 2012, third party requester filed the instant petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT OPPOSIITON," requesting entry of a concurrently filed opposition under 37 C.F.R. 1.182.

DISCUSSION

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).

On January 30, 2012, patent owner filed a petition under 37 CFR 1.182, alleging that part of requester's November 28, 2011 comments were improper and those portions should be expunged. On February 10, 2012, the requester filed an opposition to patent owner's January 30, 2012 petition under 37 CFR 1.182. Concurrently, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the opposition under 37 CFR 1.182. In this instance, requester is opposing the allegations of patent owner regarding the propriety of the November 28, 2011 requester comments. The issues raised by patent owner are not a matter of discretionary relief; the issues raised are whether or not the submission is in compliance with the relevant law, regulations and procedures regarding the conduct of *inter partes* reexamination. The patent owner petition, if granted, would affect the reexamination participation rights of the requester. Therefore, requester is entitled to rebut patent owner's challenge to Office's consideration of information the requester submitted. Accordingly, the petition is <u>dismissed as moot.</u>

CONCLUSION

1. Third party requester's February 10, 2012 petition is dismissed as moot.

2. Telephone inquiries with regard to this decision should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

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

March 28, 2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,604	02/02/2011	6,794,634	CRAN01-00524	1534

42624 7590 04/14/2011

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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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. : 95000604
PATENT NO. : 6794634
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 14 2011

CENTRAL REEXAMINATION UNIT

Daniel E. Venglarik
DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

(For Third Party Requester)

In re Hair, III et al.
Reexamination Proceeding
Control No. 95/000,604
Request Deposited: February 2, 2011
For: U.S. Patent No. 6,794,634

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181(a)**
: **REQUESTING VACATUR**
: **OF THE PROCEEDINGS**

Patent owner filed a petition under 37 CFR 1.181(a) on April 4, 2011. The petition states that the reexamination proceeding should be vacated because the U.S. Patent No. 6,794,634 is not eligible for *inter partes* reexamination since it fails to meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999." This petition is being treated as a petition under 37 CFR 1.181(a)(3) asserting the order granting reexamination is an *ultra vires* action, and is before the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 6,794,634 (hereinafter, the '634 patent) was issued to Hair, III et al. on September 21, 2004. The '634 patent issued from application number 09/729,853, filed December 6, 2000, which is identified as a divisional of application number 09/261,221, filed on March 3, 1999[1] and issued as U.S. Patent No. 6,384,402, which claims priority to a provisional application filed on April 29, 1998.

2. On December 10, 2010, a third party deposited a request for *inter partes* reexamination of the '634 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,604 (hereinafter, the '604 proceeding).

3. On January 3, 2011, a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed in the '604 proceeding. The notice stated that the request for reexamination did not receive a filing date because of failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, failure to provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested, and failure to provide a certification that a copy of the request had been served in its entirety on the patent owner at the address provided for in 37 CFR 1.33(c).

4. On February 2, 2011, the third party deposited a replacement request for *inter partes* reexamination of the '634 patent.

5. On February 16, 2011, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '604 proceeding. The notice assigned the filing date of February 2, 2011, to the request for reexamination.

6. On March 18, 2011, the Office mailed an order granting reexamination and a non-final Office action.

7. On April 4, 2011, the third party requester filed a petition under 37 CFR 1.181(a) requesting vacatur of the reexamination proceeding.

DECISION

Patent owner filed a petition under 37 CFR 1.181 requesting that the order and the reexamination proceedings, as a whole, be vacated. Patent owner contends that the '634 patent is not eligible for *inter partes* reexamination because it was issued from an "original" application filed prior to November 29, 1999. Specifically, patent owner points out that the '634 patent is a divisional of application number 09/261,221, which was filed on March 3, 1999, and argues, based upon this benefit claim, that the '634 patent issued from an "original" application that was filed prior to

[1] A Continued Prosecution Application (CPA) was filed on December 8, 2000.

November 29, 1999. Therefore, patent owner asserts that the '634 patent does not meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

Upon review of the proceeding record, the '634 patent is eligible for *inter partes* reexamination because the '634 patent was issued from the "original" application number 09/729,853, filed December 6, 2000. Therefore, for the reasons expressed in more detail below, the '634 patent issued from an original application that was filed after November 29, 1999, and is eligible for *inter partes* reexamination.

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application that was filed on or after November 29, 1999. Specifically, the AIPA (1999 American Inventors Protection Act), Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," provides that:

> "(a) In General. — ... this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date [November 29, 1999]." [emphasis added]

As pointed out above, the '634 patent issued from application number 09/729,853. The filing date of application number 09/729,853 is December 6, 2000. Application number 09/729,853, from which the '634 patent issued, is an original application within the meaning of section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999. See MPEP 2611 and 201.04(a). Specifically, MPEP 201.04(a) states that "[a]n original application may be a first filing or a continuing[2] application." This language in MPEP 201.04(a) is consistent with policies set forth in the final rule package, entitled "Rules to Implement Optional *Inter Partes* Reexamination Proceeding; Final Rule," 65 Fed. Reg. 76756 (December 7, 2000) and in an Official Gazette notice, entitled "Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54 (April 11, 2000). Furthermore, the Office's statutory interpretation of the term "original application" was upheld by the Court of Appeals for the Federal Circuit (CAFC) in *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 87 USPQ2d 1705 (Fed. Cir. 2008). Similar to the patent owner's arguments in this proceeding, the patent owner in *Cooper Technologies* asserted that "original application" only refers to the first application in a chain of applications from which priority is claimed. See 87 USPQ2d at 1706, 1708. The CAFC specifically addressed the patent owner's arguments, which were also based on the language of 35 U.S.C. 120, and found such arguments unpersuasive. See 87 USPQ2d at 1714. The CAFC found that Congress had not directly spoken to the meaning of the term "original application" and that the term does not have a well-defined,

[2] "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part." See MPEP 201.11, subsection II.B.

singular meaning in regard to patent prosecution. Specifically, "... the phrase 'original application' [has not been] used consistently to either include or to exclude continuation applications." See 87 USPQ2d at 1712. In other words, the CAFC acknowledged that the term "original application" has been used to convey various meanings depending on its context. See 87 USPQ2d at 1712-1713. The fact that 35 U.S.C. 121 uses the term "original application" for distinguishing any earlier-filed applications from the divisional application with respect to receiving the benefit of the earlier filing date is another example of where the meaning of the phrase "original application" depends on its context. The wording in 35 U.S.C. 121 does not alter the CAFC's analysis and holding in *Cooper Technologies*. The CAFC held that the Office's definition of the term "original application," as set forth in MPEP 201.04(a), is permissible because Congress has not spoken directly to the issue and the Office provided sufficient notice of its interpretation of the term "original application." Consistent with the analysis of the *Cooper Technologies* decision, the fact that application number 09/729,853 is labeled a divisional[3] of application number 09/261,221 is not dispositive. The controlling fact is that the '634 patent issued from an original application (09/729,853) filed on December 6, 2000. For these reasons, the '634 patent is eligible for *inter partes* reexamination.

Accordingly, the April 4, 2011 petition is **denied**. For the reasons stated above, the '634 patent is eligible for *inter partes* reexamination because it was issued from an original application (09/729,853) filed on December 6, 2000.

CONCLUSION

1. The April 4, 2001 petition is **denied**.

2. A response to the non-final Office action is due by May 18, 2011.

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

Irem Yücel, Director
Technology Center 1600

[3] The petition and U.S. Patent No. 6,794,643 states that application no. 09/729,853 is a divisional of application no. 09/261,221, but the restriction in application no. 09/261,221 resulted in the system claims being elected over method of detecting claims (see page 2 of the August 28, 2000 Office action). The claims in U.S. Patent No. 6,794,643 are drawn to a system or machine and not the nonelected method.

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CENTRAL REEXAMINATION UNIT

Daniel E. Venglarik
DOCKET CLERK
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(For Third Party Requester)

In re Hair, III et al.	: DECISION UNDER
Reexamination Proceeding	: 37 CFR 1.181(a)
Control No. 95/000,605	: WITHDRAWING
Request Filed: February 2, 2011	: DECISION VACATING
For: U.S. Patent No. 6,384,402	: THE PROCEEDINGS

This is a decision addressing the March 11, 2011 third party requester petition under 37 CFR 1.181(a) requesting reconsideration of the March 3, 2011 decision.

The *inter partes* reexamination request papers deposited on December 10, 2010, and February 2, 2011, are before the Office of Patent Legal Administration for **reconsideration** of whether to the patent is eligible for *inter partes* reexamination in response to the March 11, 2011 petition under 37 CFR 1.181(a) .

This decision constitutes notice that the March 2, 2011 decision is withdrawn, and **the filing date** of February 2, 2011, which was assigned to the request papers for the above-captioned *inter partes* reexamination proceeding, is hereby **reinstated**, because the patent (for the reasons set forth below) meets the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999." For this reason, the **proceeding as a whole is hereby reinstated**.

REVIEW OF FACTS

1. U.S. Patent No. 6,384,402 (hereinafter, the '402 patent) was issued to Hair, III et al. on May 7, 2002. The '402 patent issued from application number 09/261,221, which was a Continued Prosecution Application (CPA) filed on December 8, 2000, which claimed priority to an application filed on March 3, 1999.

2. On December 10, 2010, a third party deposited a request for *inter partes* reexamination of claims 1-9, 15, 22-25, 28, 33-38, 40-46, and 48-50 of the '402 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,605 (hereinafter, the '605 proceeding).

3. On January 3, 2011, a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed in the '605 proceeding. The notice stated that the request for reexamination did not receive a filing date because of failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, failure to provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested, and failure to provide a certification that a copy of the request had been served in its entirety on the patent owner at the address provided for in 37 CFR 1.33(c).

4. On February 2, 2011, the third party deposited a replacement request for *inter partes* reexamination of claims 1-9, 15, 22-25, 28, 33-38, 40-46, and 48-50 of the '402 patent.

5. On February 24, 2011, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '605 proceeding. The notice assigned the filing date of February 2, 2011, to the request for reexamination.

6. On March 3, 2011, the Office mailed a decision *sua sponte* vacating the *inter partes* reexamination filing date and the '605 proceeding as a whole.

7. On March 11, 2011, the third party requester filed a petition under 37 CFR 1.181(a) requesting reconsideration of the March 3, 2011 decision.

DECISION

Upon further review of the proceeding papers, the '402 patent is found to be eligible for *inter partes* reexamination because a Continued Prosecution Application (CPA) was filed on December 8, 2000, which resulted in issuance of the '402 patent. This fact was not appreciated in the prior March 3, 2011 decision. Therefore, for the reasons expressed in the March 11, 2011 petition, the '402 patent issued from an original application that was filed on December 8, 2000.

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application <u>that was filed on or after November 29, 1999</u>. Specifically, the AIPA (1999 American Inventors Protection Act),

Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," provides that:

> "(a) In General. — ... this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date [November 29, 1999]." [emphasis added]

Further, MPEP 2611 provides that:

> The phrase "original application" is interpreted to encompass utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications. [emphasis added]

As pointed out above, the '402 patent issued from application number 09/261,221. The filing date for the original application number 09/261,221, for purposes of the interpretation of the statutory "original application," is December 8, 2000, which is the filing date of the CPA. The CPA claimed domestic priority to an application filed on March 3, 1999. Thus, the '402 patent, which is the basis for this reexamination, issued from an original application which was filed after November 29, 1999 (the date of enactment of the AIPA), and therefore, is eligible for *inter partes* reexamination.

Accordingly, the March 11, 2011 petition is **granted** to the extent that the March 2, 2011 decision is hereby withdrawn. The **filing date of February 2, 2011** that was granted for the '605 proceeding is hereby **reinstated**. Furthermore, all papers of the record previously issued by the Office and those filed for the proceeding, and **the proceeding, as a whole, are hereby reinstated**.

CONCLUSION

1. The March 11, 2001 petition is granted to the extent that the February 2, 2011 filing date assigned to the proceeding, all papers of the record previously issued by the Office and those filed for the proceeding thus far, and *inter partes* reexamination proceeding Control No. 95/000,605, as a whole, are hereby reinstated.

2. The *inter partes* reexamination proceeding is hereby referred to the Central Reexamination Unit, where the proceeding will be assigned to an examiner for a determination on the request for reexamination.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or Jeanne Clark, at (571) 272-7714, or in their absence to the undersigned at (571) 272-7710.

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.
95/000,605	02/02/2011	6384402	CRAN01-00523	1448

42624 7590 06/28/2011

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/28/2011

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Date: 6-28-11

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Daniel E. Venglarik
DOCKET CLERK
P.O. DRAWER 800889
Dallas, TX 75380

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000605
PATENT NO. : 6384402
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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Davidson Berquist Jackson & Gowdey, LLP (For Patent Owner)
4300 Wilson Blvd., 7th Floor
Arlington, VA 22203

MAILED
JUN 28 2011
CENTRAL REEXAMINATION UNIT

Docket Clerk (For *Inter Partes* Requester)
P.O. Drawer 800889
Dallas, TX 75380

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/000,605 : **DISMISSING**
Filed: February 2, 2011 : **PETITION**
For: U.S. Patent No. 6,384,402 :

This is a decision on the patent owner paper entitled "§1.181 PETITION TO THE DIRECTOR," filed on June 6, 2011, requesting "expansion of the page limitation in an inter partes reexamination response."[1]

The patent owner paper is being treated as a petition under 37 CFR 1.183 for waiver of the regulatory page limit set forth in 37 CFR 1.943(b). The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition is dismissed for the reasons set forth herein.

FEES

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's Deposit Account No. 501860 on June 10, 2011, as authorized on page 2 of the petition.

BACKGROUND

1. On May 7, 2002, United States Patent No. 6,384,402 ("the '402 patent") issued to Hair, III *et al.*

2. On December 10, 2010, a request for *inter partes* reexamination of the '402 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,605 ("the '605 proceeding").

[1] Petition at page 1.

3. On February 2, 2011, a corrected request for *inter partes* reexamination of the '402 patent was filed by the third party requester (the request for reexamination), and the '605 proceeding was assigned a filing date of February 2, 2011.

4. On April 23, 2011, the Office mailed an order granting *inter partes* reexamination in the '402 proceeding, accompanied by a non-final Office action on the merits.

5. On June 6, 2011, patent owner filed the instant petition entitled, "§1.181 PETITION TO THE DIRECTOR," requesting waiver of the regulatory 50-page limit for patent owner's response to the April 23, 2011 Office action (the petition under 37 CFR 1.183).

6. On June 20, 2011, patent owner filed a request for extension of time to file patent owner's response to the April 23, 2011 Office action.

7. On June 23, 2011, the Office mailed a decision granting patent owner's June 20, 2011 request for extension of time, extending the time period for patent owner's response by four weeks to Monday, July 25, 2011.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent Owner's Petition under 37 CFR 1.183

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. In particular, patent owner requests that "the 50 page limit be expanded to 100 pages".[2] In support of its request for waiver of the rule, patent owner asserts that "[t]he Office Action itself being 39 pages long contains 15

[2] *See* Petition at page 1.

separate rejections," that "[t]he first nine rejections amount to the Examiner's adoption of rejection arguments proposed by the Requestor, with reference by the Examiner to the wholesale adoption of Requestor's allegations contained within the Requestor's own 250 page submission," and that "[a]dditionally, the Examiner has made another six rejections".[3] Patent owner further asserts that "[t]he Patent Owner should not be forced to limit its defense to . . . . 50 pages when the Examiner's 39 page Office Action references hundreds of pages and makes far more rejections than a normal Office Action".[4]

Analysis and Findings

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. General requests, unsubstantiated by specific facts which justify an increase in the number of pages available for patent owner to respond to an Office action, are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b).

As indicated above, patent owner seeks waiver of 37 CFR 1.943(b) to increase the page limit for patent owner's response to 100 pages. The patent owner has provided arguments in support of why more pages are deemed necessary to complete the response, including, for example, the argument that, in the April 23, 2011 Office action, the examiner relies on "wholesale adoption" of the requester's reasoning from the request for reexamination to advance the first nine grounds of rejection and makes another six grounds of rejections. However, a review of the April 23, 2011 Office action shows that, in adopting nine proposed grounds of rejection (either in whole or in-part) that were advanced by the requester, the examiner has not relied on incorporation by reference of the requester's reasoning as set forth in the request for reexamination but, rather, has set forth the examiner's own reasoning for adopting the rejections, merely making reference to where the adopted rejection is found in the request for reexamination. Further, the examiner used only approximately nine pages to advance the six new grounds of rejections proposed by the examiner.

To the extent that addressing the fifteen grounds of rejections set forth in the Office action, covering various combinations of claims 1-9, 15, 22-25, 28, 33-38, 40-46, and 48-50 of the '402 patent, may cause patent owner's response to exceed the regulatory 50-page limit, patent owner has failed to provide a concrete basis for an accurate determination of how many additional pages over 50 pages are needed to complete the response. A concrete showing which petitioner patent owner could have made in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) would be an attempt to draft a response in compliance with the 50-page limit followed by submission of the resulting drafted 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). Such a submission can be evaluated for <u>economizing, extraneous material, and arrangement, without repetition of information already of record</u>. In this way, petitioner could have relied on the proposed response

[3] *See id.*
[4] *See id.* at pages 1-2.

for justification that more pages (than are permitted by rule) are needed to complete the response and to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

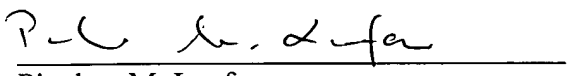
Patent owner may file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), accompanied by a drafted response, as described immediately above. No further fee would be required for the renewed petition. If the Office does not grant such renewed petition under 37 CFR 1.183 to the full extent of the suggested proposed response, patent owner would be given a period of 15 days within which to submit a compliant response in accordance with the page limit set forth in the decision on that petition. The third party requester would then have 30 days from the date of service of any patent owner's rule-compliant response that is filed, to file a comments paper pursuant to 37 CFR 1.947.[5] If the Office does grant such renewed petition under 37 CFR 1.183, the third party requester would have 30 days from the mailing date of a decision granting patent owner's petition under 37 CFR 1.183 and accepting the proposed response as page-length compliant, in which to file a comments paper pursuant to 37 CFR 1.947. *See* MPEP 2667(I)(A)(2).

For all of the reasons set forth above, patent owner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.943(b), and the June 6, 2011 petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. The patent owner June 6, 2011 petition entitled, "§1.181 PETITION TO THE DIRECTOR," requesting waiver of the regulatory 50-page limit for patent owner's response to the April 23, 2011 Office action, is **dismissed**.

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

06-27-2011

[5] *See* MPEP 2667(I)(A)(2), which provides, in-part: "Where the length of the patent owner submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, pursuant to 37 CFR 1.957(d), a Notice will be mailed to the patent owner. The Notice will be issued by the examiner and will permit the patent owner to exercise one of the following two options: (A) Submit a re-drafted response that does not exceed the page limit set by 37 CFR 1.943; or (B) File a copy of the supplemental response with pages redacted to satisfy the 37 CFR 1.943 page limit requirement. ... If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice."

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,605	02/02/2011	6384402	CRAN01-00523	1448

42624 7590 02/28/2012

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
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EXAMINER

ART UNIT	PAPER NUMBER

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Dallas, TX 75380

Date: **MAILED**

FEB 28 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000605
PATENT NO. : 6384402
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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DAVIDSON BERQUIST JACKSON & GOWDEY, LLP
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ARLINGTON, VA 22203

(For Patent Owner)

DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/000,605	:	**DENYING**
Filed: February 2, 2011	:	**PETITION**
For: U.S. Patent No. 6,384,402 B1	:	

This is a decision on the April 15, 2011 patent owner petition under 37 CFR 1.181(a). The petition requests that the April 11, 2011 Office decision be reversed and that U.S. Patent No. 6,384,402 B1 be found not eligible for an *inter partes* reexamination.

The patent owner petition under 37 CFR 1.181(a) is before the Office of Patent Legal Administration for consideration.

The patent owner's April 15, 2011 petition under 37 CFR 1.181(a) is **denied**. The April 11, 2011 Office decision properly determined that U.S. Patent No. 6,384,402 B1 meets the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

This decision is designated as a final agency action under 5 U.S.C. § 704.

DECISION

I. Patent Owner's Petition Under 37 CFR 1.181(a)

In the present petition, the patent owner requests the Office (1) to change its interpretation of "original application" as it applies to *inter partes* reexamination and (2) to reverse its April 11, 2011 decision, in which the Office determined that U.S. Patent No. 6,384,402 B1 (hereinafter "the '402 patent") meets the eligibility requirement for an *inter partes* reexamination.[1] The

[1] Petition at pages 1, 12, and 13.

patent owner argues that the '402 patent did not issue from an original application filed on December 8, 2000, but rather from an original application, filed on March 3, 1999.[2] The patent owner takes the position that the Continued Prosecution Application (CPA) filed on December 8, 2000 is not the original application from which the '402 patent issued, but rather the original application is Application No. 09/261,221 filed on March 3, 1999.[3] The patent owner argues that 35 U.S.C. § 121 defines an "original application" as the first-filed case in a family.[4] Furthermore, the patent owner contends that the Office's interpretation of the phrase "original application" as used by Congress in the America Inventors Protection Act (AIPA) of 1999 effectively changed the law as set forth in 35 U.S.C. §§ 120 and 121 by reading the phrase "original application" out of §121 and by denying the effect of § 120 to the '402 patent.[5] The patent owner admits that it is "aware of *Cooper Technologies Company v. Dudas*, 537 F.3d 1330, (Fed. Cir. 2008) which specifically reviewed the USPTO's rule making authority and found, on the particular facts and arguments of that case, that the USPTO's interpretation of 'original application' was not impermissible."[6] Nevertheless, patent owner asserts "that to the extent that the decision in *Cooper* is inconsistent with this argument then that decision is in error."[7]

II. Findings and Analysis

The patent owner's arguments that the Office did not properly interpret the statutory language "original application" as it applies to *inter partes* reexamination are found to be unpersuasive. In 2008, the Federal Circuit in *Cooper* found the Office's longstanding interpretation of the phrase "original application," for the purposes of determining which patents are subject to *inter partes* reexamination pursuant to section 4608 of the AIPA, as being permissible and entitled to deference. In *Cooper*, the court affirmed the Office's interpretation of the phrase "original application" in section 4608 of the AIPA to encompass utility, plant, and design applications, including first filed applications, continuations, divisionals, continuations-in-part, **continued prosecution applications (CPAs)** and national stage phase of international applications. *Cooper*, 536 F.3d at 1331 and 1343. The *Cooper* decision affirming the Office's interpretation of "original application" as used in *inter partes* reexamination is binding precedent that the Office must follow. Under the Office's interpretation, the CPA filed on December 8, 2000 is an original application from which the '402 patent issued. Accordingly, the '402 patent is eligible for *inter partes* reexamination.

Furthermore, contrary to the patent owner's argument, the Office's interpretation of "original application" in *inter partes* reexamination proceedings does not deny an application any domestic benefit properly claimed under 35 U.S.C. § 120. The court held that the Office's interpretation of "original application" to be "interpretive," rather than "substantive," and that this interpretation did not effect any change in existing law and policy. *Cooper*, 536 F.3d at 1336. As explained by the Federal Circuit in *Cooper*, the phrase "original application" does not necessarily mean the first application in a chain - the phrase does not have a single definitive

[2] *Id.* at page 5.
[3] *Id.*
[4] *Id.* at page 11.
[5] *Id.*
[6] *Id.* at page 8.
[7] *Id.* at page 12.

meaning but depends on the context. *Cooper*, 536 F.3d at 1338. The phrase "original application" as used in the *inter partes* reexamination context does not necessarily mean the first filed nonprovisional application in the chain.

For all of the reasons set forth above, the Office properly determined that the '402 patent issued from an "original application" filed on December 8, 2000, and therefore meets the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

Accordingly, the patent owner's April 15, 2011 petition under 37 CFR 1.181(a) is **denied**.

This decision constitutes the Office's final decision concerning whether the '402 patent meets the eligibility requirement for an *inter partes* reexamination proceeding.

CONCLUSION

1. The patent owner's April 15, 2011 petition under 37 CFR 1.181(a) is **denied**.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

3. Any inquiry concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711 or, in her absence, to Pinchus M. Laufer, Senior Legal Advisor at (571) 272-7726.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

2-21-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,606	02/04/2011	7343220	CRAN01-00526	7023

42624 7590 04/14/2011

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ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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

REEXAMINATION CONTROL NUMBER *95/000,606*.

PATENT NUMBER *7,343,220*.

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)

Daniel E. Venglarik
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DALLAS, TX 75380

(For Third Party Requester)

In re Hair, III et al.
Reexamination Proceeding
Control No. 95/000,606
Request Deposited: February 4, 2011
For: U.S. Patent No. 7,343,220

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181(a)**
: **REQUESTING VACATUR**
: **OF THE PROCEEDINGS**

Patent owner filed a petition under 37 CFR 1.181(a) on April 5, 2011. The petition states that the reexamination proceeding should be vacated because the U.S. Patent No. 7,343,220 is not eligible for *inter partes* reexamination since it fails to meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999." This petition is being treated as a petition under 37 CFR 1.181(a)(3) asserting the order granting reexamination is an *ultra vires* action, and is before the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,343,220 (hereinafter, the '220 patent) was issued to Hair, III et al. on March 11, 2008. The '220 patent issued from application number 11/639,231, filed December 15, 2006, which is a continuation of application number 10/838,222, filed on May 5, 2004, which is a continuation of application number 09/729,853, filed on December 6, 2000, which is a continuation[1] of application number 09/261,221, filed on March 3, 1999[2] and issued as U.S. Patent No. 6,384,402, which claims priority to a provisional application filed on April 29, 1998.

2. On December 10, 2010, a third party deposited a request for *inter partes* reexamination of the '220 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,606 (hereinafter, the '606 proceeding).

3. On January 12, 2011, a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed in the '606 proceeding. The notice stated that the request for reexamination did not receive a filing date because of failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, failure to provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested, and failure to provide a certification that a copy of the request had been served in its entirety on the patent owner at the address provided for in 37 CFR 1.33(c).

4. On February 4, 2011, the third party deposited a replacement request for *inter partes* reexamination of the '220 patent.

5. On February 28, 2011, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '606 proceeding. The notice assigned the filing date of February 4, 2011, to the request for reexamination.

6. On March 24, 2011, the Office mailed an order granting reexamination and a non-final Office action.

7. On April 5, 2011, the third party requester filed a petition under 37 CFR 1.181(a) requesting vacatur of the reexamination proceeding.

---

[1] The front page and the specification of the '220 patent states that application no. 09/729,853 is a continuation of application no. 09/261,221. The petition and U.S. Patent No. 6,794,643 states that application no. 09/729,853 is a divisional of application no. 09/261,221, but the restriction in application no. 09/261,221 resulted in the system claims being elected over method of detecting claims (see page 2 of the August 28, 2000 Office action). The claims in U.S. Patent No. 6,794,643, however, are drawn to a system or machine and not the nonelected method.
[2] A Continued Prosecution Application (CPA) was filed on December 8, 2000.

DECISION

Patent owner filed a petition under 37 CFR 1.181 requesting that the order and the reexamination proceedings, as a whole, be vacated. Patent owner contends that the '220 patent is not eligible for *inter partes* reexamination because it was issued from an "original" application filed prior to November 29, 1999. Specifically, patent owner points out that the '220 patent is a divisional of application number 09/261,221, which was filed on March 3, 1999, and argues, based upon this benefit claim, that the '220 patent issued from an "original" application that was filed prior to November 29, 1999. Therefore, patent owner asserts that the '220 patent does not meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

Upon review of the proceeding record, the '220 patent is eligible for *inter partes* reexamination because the '220 patent was issued from the "original" application number 11/639,231, filed December 15, 2006. Therefore, for the reasons expressed in more detail below, the '220 patent issued from an original application that was filed after November 29, 1999, and is eligible for *inter partes* reexamination.

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application <u>that was filed on or after November 29, 1999</u>. Specifically, the AIPA (1999 American Inventors Protection Act), Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," provides that:

> "(a) In General. — ... this <u>subtitle and the amendments</u> made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and <u>shall apply to any patent that issues from an original application filed in the United States on or after that date</u> [November 29, 1999]." [emphasis added]

As pointed out above, the '220 patent issued from application number 11/639,231. The filing date of application number 11/639,231 is December 15, 2006. Application number 11/639,231, from which the '220 patent issued, is an original application within the meaning of section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999. See MPEP 2611 and 201.04(a). Specifically, MPEP 201.04(a) states that "[a]n original application may be a first filing or a continuing[3] application." This language in MPEP 201.04(a) is consistent with policies set forth in the final rule package, entitled "Rules to Implement Optional *Inter Partes* Reexamination Proceeding; Final Rule," 65 Fed. Reg. 76756 (December 7, 2000) and in an Official Gazette notice, entitled "Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54 (April 11, 2000). Furthermore, the Office's statutory interpretation of the term "original application" was upheld

[3] "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part." See MPEP 201.11, subsection II.B.

by the Court of Appeals for the Federal Circuit (CAFC) in *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 87 USPQ2d 1705 (Fed. Cir. 2008). Similar to the patent owner's arguments in this proceeding, the patent owner in *Cooper Technologies* asserted that "original application" only refers to the first application in a chain of applications from which priority is claimed. See 87 USPQ2d at 1706, 1708. The CAFC specifically addressed the patent owner's arguments, which were also based on the language of 35 U.S.C. 120, and found such arguments unpersuasive. See 87 USPQ2d at 1714. The CAFC found that Congress had not directly spoken to the meaning of the term "original application" and that the term does not have a well-defined, singular meaning in regard to patent prosecution. Specifically, "... the phrase 'original application' [has not been] used consistently to either include or to exclude continuation applications." See 87 USPQ2d at 1712. In other words, the CAFC acknowledged that the term "original application" has been used to convey various meanings depending on its context. See 87 USPQ2d at 1712-1713. The fact that 35 U.S.C. 121 uses the term "original application" for distinguishing any earlier-filed applications from the divisional application with respect to receiving the benefit of the earlier filing date is another example of where the meaning of the phrase "original application" depends on its context. The wording in 35 U.S.C. 121 does not alter the CAFC's analysis and holding in *Cooper Technologies*. The CAFC held that the Office's definition of the term "original application," as set forth in MPEP 201.04(a), is permissible because Congress has not spoken directly to the issue and the Office provided sufficient notice of its interpretation of the term "original application." As in the *Cooper Technologies* decision, the fact that application number 11/639,231 is a continuation[4] of application number 09/261,221 is not dispositive. The controlling fact is that the '220 patent issued from an original application (11/639,231) filed on December 15, 2006. For these reasons, the '220 patent is eligible for *inter partes* reexamination.

Accordingly, the April 5, 2011 petition is **denied**. For the reasons stated above, the '220 patent is eligible for *inter partes* reexamination because it was issued from an original application (11/639,231) filed on December 15, 2006.

CONCLUSION

1. The April 5, 2001 petition is **denied**.

2. A response to the non-final Office action is due by May 24, 2011.

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

Irem Yucel, Director
Technology Center 1600

[4] or a divisional as argued in the petition.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,607	01/31/2011	7191915	CRAN01-00525	2902

42624 7590 04/14/2011
DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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

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Date:
MAILED
APR 14 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000607
PATENT NO. : 7191915
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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DAVIDSON BERQUIST JACKSON
& GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

(For Patent Owner)

MAILED

APR 14 2011

CENTRAL REEXAMINATION UNIT

Daniel E. Venglarik
DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

(For Third Party Requester)

In re Hair, III et al.
Reexamination Proceeding
Control No. 95/000,607
Request Deposited: January 31, 2011
For: U.S. Patent No. 7,191,915

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181(a)**
: **REQUESTING VACATUR**
: **OF THE PROCEEDINGS**

Patent owner filed a petition under 37 CFR 1.181(a) on April 5, 2011. The petition states that the reexamination proceeding should be vacated because the U.S. Patent No. 7,191,915 is not eligible for *inter partes* reexamination since it fails to meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999." This petition is being treated as a petition under 37 CFR 1.181(a)(3) asserting the order granting reexamination is an *ultra vires* action, and is before the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,191,915 (hereinafter, the '915 patent) was issued to Hair, III et al. on March 20, 2007. The '915 patent issued from application number 10/838,222, filed May 5, 2004, which is a continuation of application number 09/729,853, filed on December 6, 2000, which is a continuation[1] of application number 09/261,221, filed on March 3, 1999[2] and issued as U.S. Patent No. 6,384,402, which claims priority to a provisional application filed on April 29, 1998.

2. On December 10, 2010, a third party deposited a request for *inter partes* reexamination of the '915 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,607 (hereinafter, the '607 proceeding).

3. On December 30, 2010, a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed in the '607 proceeding. The notice stated that the request for reexamination did not receive a filing date because of failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, failure to provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested, and failure to provide a certification that a copy of the request had been served in its entirety on the patent owner at the address provided for in 37 CFR 1.33(c).

4. On January 31, 2011, the third party deposited a replacement request for *inter partes* reexamination of the '915 patent.

5. On February 10, 2011, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '607 proceeding. The notice assigned the filing date of January 31, 2011, to the request for reexamination.

6. On March 18, 2011, the Office mailed an order granting reexamination and a non-final Office action.

7. On April 5, 2011, the third party requester filed a petition under 37 CFR 1.181(a) requesting vacatur of the reexamination proceeding.

---

[1] The front page and the specification of the '915 patent states that application no. 09/729,853 is a continuation of application no. 09/261,221. The petition and U.S. Patent No. 6,794,643 states that application no. 09/729,853 is a divisional of application no. 09/261,221, but the restriction in application no. 09/261,221 resulted in the system claims being elected over method of detecting claims (see page 2 of the August 28, 2000 Office action). The claims in U.S. Patent No. 6,794,643, however, are drawn to a system or machine and not the nonelected method.
[2] A Continued Prosecution Application (CPA) was filed on December 8, 2000.

DECISION

Patent owner filed a petition under 37 CFR 1.181 requesting that the order and the reexamination proceedings, as a whole, be vacated. Patent owner contends that the '915 patent is not eligible for *inter partes* reexamination because it was issued from an "original" application filed prior to November 29, 1999. Specifically, patent owner points out that the '915 patent is a divisional of application number 09/261,221, which was filed on March 3, 1999, and argues, based upon this benefit claim, that the '915 patent issued from an "original" application that was filed prior to November 29, 1999. Therefore, patent owner asserts that the '915 patent does not meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

Upon review of the proceeding record, the '915 patent is eligible for *inter partes* reexamination because the '915 patent was issued from the "original" application number 10/838,222, filed May 5, 2004. Therefore, for the reasons expressed in more detail below, the '915 patent issued from an original application that was filed after November 29, 1999, and is eligible for *inter partes* reexamination.

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application <u>that was filed on or after November 29, 1999</u>. Specifically, the AIPA (1999 American Inventors Protection Act), Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," provides that:

> "(a) In General. — ... this <u>subtitle and the amendments</u> made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and <u>shall apply to any patent that issues from an original application filed in the United States on or after that date</u> [November 29, 1999]." [emphasis added]

As pointed out above, the '915 patent issued from application number 10/838,222. The filing date of application number 10/838,222 is May 5, 2004. Application number 10/838,222, from which the '915 patent issued, is an original application within the meaning of section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999. See MPEP 2611 and 201.04(a). Specifically, MPEP 201.04(a) states that "[a]n original application may be a first filing or a continuing[3] application." This language in MPEP 201.04(a) is consistent with policies set forth in the final rule package, entitled "Rules to Implement Optional *Inter Partes* Reexamination Proceeding; Final Rule," 65 Fed. Reg. 76756 (December 7, 2000) and in an Official Gazette notice, entitled "Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54 (April 11, 2000).

---

[3] "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part." See MPEP 201.11, subsection II.B.

Furthermore, the Office's statutory interpretation of the term "original application" was upheld by the Court of Appeals for the Federal Circuit (CAFC) in *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 87 USPQ2d 1705 (Fed. Cir. 2008). Similar to the patent owner's arguments in this proceeding, the patent owner in *Cooper Technologies* asserted that "original application" only refers to the first application in a chain of applications from which priority is claimed. See 87 USPQ2d at 1706, 1708. The CAFC specifically addressed the patent owner's arguments, which were also based on the language of 35 U.S.C. 120, and found such arguments unpersuasive. See 87 USPQ2d at 1714. The CAFC found that Congress had not directly spoken to the meaning of the term "original application" and that the term does not have a well-defined, singular meaning in regard to patent prosecution. Specifically, "... the phrase 'original application' [has not been] used consistently to either include or to exclude continuation applications." See 87 USPQ2d at 1712. In other words, the CAFC acknowledged that the term "original application" has been used to convey various meanings depending on its context. See 87 USPQ2d at 1712-1713. The fact that 35 U.S.C. 121 uses the term "original application" for distinguishing any earlier-filed applications from the divisional application with respect to receiving the benefit of the earlier filing date is another example of where the meaning of the phrase "original application" depends on its context. The wording in 35 U.S.C. 121 does not alter the CAFC's analysis and holding in *Cooper Technologies*. The CAFC held that the Office's definition of the term "original application," as set forth in MPEP 201.04(a), is permissible because Congress has not spoken directly to the issue and the Office provided sufficient notice of its interpretation of the term "original application." As in the *Cooper Technologies* decision, the fact that application number 10/838,222 is a continuation[4] of application number 09/261,221 is not dispositive. The controlling fact is that the '915 patent issued from an original application (10/838,222) filed on May 5, 2004. For these reasons, the '915 patent is eligible for *inter partes* reexamination.

Accordingly, the April 5, 2011 petition is **denied**. For the reasons stated above, the '915 patent is eligible for *inter partes* reexamination because it was issued from an original application (10/838,222) filed on May 5, 2004.

CONCLUSION

1. The April 5, 2001 petition is **denied**.

2. A response to the non-final Office action is due by May 18, 2011.

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

Irem Yücel, Director
Technology Center 1600

[4] or a divisional as argued in the petition.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,608	02/04/2011	7742837	CRAN01-00527	5823

42624 7590 04/25/2011

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/25/2011

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000608
PATENT NO. : 7742837
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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ARLINGTON, VA 22203

(For Patent Owner)

Daniel E. Venglarik
DOCKET CLERK
P.O. DRAWER 800889
DALLAS, TX 75380

(For Third Party Requester)

In re Hair, III et al.
Reexamination Proceeding
Control No. 95/000,608
Request Deposited: February 4, 2011
For: U.S. Patent No. 7,742,837

: **DECISION ON**
: **PETITION UNDER**
: **37 CFR 1.181(a)**
: **REQUESTING VACATUR**
: **THE PROCEEDINGS**

Patent owner filed a petition under 37 CFR 1.181(a) on April 5, 2011. The petition states that the reexamination proceeding should be vacated because the U.S. Patent No. 7,742,837 is not eligible for *inter partes* reexamination since it fails to meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999." This petition is being treated as a petition under 37 CFR 1.181(a)(3) asserting the order granting reexamination is an *ultra vires* action, and is before the Central Reexamination Unit for decision.

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

REVIEW OF FACTS

1. U.S. Patent No. 7,742,837 (hereinafter, the '837 patent) was issued to Hair, III et al. on June 22, 2010. The '837 patent issued from application number 12/010,126, filed on January 22, 2008, which is a continuation of application number 11/639,231, filed on December 15, 2006, which is a continuation of application number 10/838,222, filed May 5, 2004, which is a continuation of application number 09/729,853, filed on December 6, 2000 and issued as U.S. Patent No. 6,794,634, which is a continuation[1] of application number 09/261,221, filed on March 3, 1999[2] and issued as U.S. Patent No. 6,384,402, which claims priority to a provisional application filed on April 29, 1998.

2. On December 10, 2010, a third party deposited a request for *inter partes* reexamination of the '837 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,608 (hereinafter, the '608 proceeding).

3. On January 5, 2011, a "Notice of Failure to Comply with *Inter Partes* Reexamination Request Filing Requirements (37 CFR 1.915(d))" was mailed in the '608 proceeding. The notice stated that the request for reexamination did not receive a filing date because of failure to provide a statement pointing out each substantial new question of patentability based on the cited patents and printed publications, failure to provide a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested, and failure to provide a certification that a copy of the request had been served in its entirety on the patent owner at the address provided for in 37 CFR 1.33(c).

4. On February 4, 2011, the third party deposited a replacement request for *inter partes* reexamination of the '837 patent.

5. On February 10, 2011, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '608 proceeding. The notice assigned the filing date of February 4, 2011, to the request for reexamination.

6. On March 29, 2011, the Office mailed an order granting reexamination and a non-final Office action.

7. On April 5, 2011, the third party requester filed a petition under 37 CFR 1.181(a) requesting vacatur of the reexamination proceeding.

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[1] The front page and the specification of the '837 patent states that application no. 09/729,853 is a continuation of application no. 09/261,221. The petition and U.S. Patent No. 6,794,643 states that application no. 09/729,853 is a divisional of application no. 09/261,221, but the restriction in application no. 09/261,221 resulted in the system claims being elected over method of detecting claims (see page 2 of the August 28, 2000 Office action). The claims in U.S. Patent No. 6,794,643, however, are drawn to a system or machine and not the nonelected method.
[2] A Continued Prosecution Application (CPA) was filed on December 8, 2000.

DECISION

Patent owner filed a petition under 37 CFR 1.181 requesting that the order and the reexamination proceedings, as a whole, be vacated. Patent owner contends that the '837 patent is not eligible for *inter partes* reexamination because it was issued from an "original" application filed prior to November 29, 1999. Specifically, patent owner points out that the '837 patent is a divisional of application number 09/261,221, which was filed on March 3, 1999, and argues, based upon this benefit claim, that the '837 patent issued from an "original" application that was filed prior to November 29, 1999. Therefore, patent owner asserts that the '837 patent does not meet the eligibility requirement for an *inter partes* reexamination proceeding that is set forth in Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999."

Upon review of the proceeding record, the '837 patent is eligible for *inter partes* reexamination because the '837 patent was issued from the "original" application number 12/010,126, filed January 22, 2008. Therefore, for the reasons expressed in more detail below, the '837 patent issued from an original application that was filed after November 29, 1999, and is eligible for *inter partes* reexamination.

The *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application <u>that was filed on or after November 29, 1999</u>. Specifically, the AIPA (1999 American Inventors Protection Act), Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," provides that:

> "(a) In General. — ... this <u>subtitle and the amendments</u> made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and <u>shall apply to any patent that issues from an original application filed in the United States on or after that date</u> [November 29, 1999]." [emphasis added]

As pointed out above, the '837 patent issued from application number 12/010,126. The filing date of application number 12/010,126 is January 22, 2008. Application number 12/010,126, from which the '837 patent issued, is an original application within the meaning of section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999. See MPEP 2611 and 201.04(a). Specifically, MPEP 201.04(a) states that "[a]n original application may be a first filing or a continuing[3] application." This language in MPEP 201.04(a) is consistent with policies set forth in the final rule package, entitled "Rules to Implement Optional *Inter Partes* Reexamination Proceeding; Final Rule," 65 Fed. Reg. 76756 (December 7, 2000) and in an Official Gazette notice, entitled "Guidelines Concerning the Implementation of Changes to 35 U.S.C. 102(g) and 103(c) and the Interpretation of the Term 'Original Application' in the American Inventors Protection Act of 1999," 1233 O.G. 54 (April 11, 2000).

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[3] "Continuing applications include those applications which are called divisions, continuations, and continuations-in-part." See MPEP 201.11, subsection II.B.

Furthermore, the Office's statutory interpretation of the term "original application" was upheld by the Court of Appeals for the Federal Circuit (CAFC) in *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 87 USPQ2d 1705 (Fed. Cir. 2008). Similar to the patent owner's arguments in this proceeding, the patent owner in *Cooper Technologies* asserted that "original application" only refers to the first application in a chain of applications from which priority is claimed. See 87 USPQ2d at 1706, 1708. The CAFC specifically addressed the patent owner's arguments, which were also based on the language of 35 U.S.C. 120, and found such arguments unpersuasive. See 87 USPQ2d at 1714. The CAFC found that Congress had not directly spoken to the meaning of the term "original application" and that the term does not have a well-defined, singular meaning in regard to patent prosecution. Specifically, "... the phrase 'original application' [has not been] used consistently to either include or to exclude continuation applications." See 87 USPQ2d at 1712. In other words, the CAFC acknowledged that the term "original application" has been used to convey various meanings depending on its context. See 87 USPQ2d at 1712-1713. The fact that 35 U.S.C. 121 uses the term "original application" for distinguishing any earlier-filed applications from the divisional application with respect to receiving the benefit of the earlier filing date is another example of where the meaning of the phrase "original application" depends on its context. The wording in 35 U.S.C. 121 does not alter the CAFC's analysis and holding in *Cooper Technologies*. The CAFC held that the Office's definition of the term "original application," as set forth in MPEP 201.04(a), is permissible because Congress has not spoken directly to the issue and the Office provided sufficient notice of its interpretation of the term "original application." As in the *Cooper Technologies* decision, the fact that application number 12/010,126 is a continuation[4] of application number 09/261,221 is not dispositive. The controlling fact is that the '837 patent issued from an original application (12/010,126) filed on January 22, 2008. For these reasons, the '837 patent is eligible for *inter partes* reexamination.

Accordingly, the April 5, 2011 petition is **denied**. For the reasons stated above, the '837 patent is eligible for *inter partes* reexamination because it was issued from an original application (12/010,126) filed on January 22, 2008.

CONCLUSION

1. The April 5, 2001 petition is **denied**.

2. A response to the non-final Office action is due by May 29, 2011.

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

Irem Yucel, Director
Technology Center 1600

[4] or a divisional as argued in the petition.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,609	12/16/2010	7326210	SYNT-3052	3785

53443 7590 08/05/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1100 NEW YORK AVENUE, N.W.
WASHINGTON, D.C. 20005

Date: MAILED
AUG 05 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000609
PATENT NO. : 7326210
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
AUG 05 2011
CENTRAL REEXAMINATION

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, DC 20005-3934

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,609
Filed: December 16, 2010
For: U.S. Patent No. 7,326,210

DECISION
DISMISSING
PETITION

This is a decision on the patent owner's May 13, 2011 petition paper entitled "PETITION TO REQUEST ARTIFACT FOLDER FOR COLOR VERSION OF PATENT OWNER'S RESPONSE UNDER 37 C.F.R. §1.182".

The patent owner's petition under 37 CFR 1.182 is dismissed, for the reasons set forth herein.

BACKGROUND

1. On February 5, 2008, United States Patent No. 7,326,210 (the '210 patent) issued to Jahng et al.

2. On December 16, 2010, a request for *inter partes* reexamination of the '210 patent was filed by a third party requester. The request was assigned Reexamination Control No. 90/000,609 (the '609 proceeding).

3. On February 1, 2011, the Office issued an order granting *inter partes* reexamination in the '609 proceeding, concurrently with a non-final action.

4. On May 13, 2011, the patent owner filed a response which included a "DECLARATION OF STEVEN L. GRIFFITH, Ph.D." and concurrently filed a petition paper entitled "PETITION TO REQUEST ARTIFACT FOLDER FOR COLOR VERSION OF PATENT OWNER'S RESPONSE UNDER 37 C.F.R. §1.182" (petition under 37 CFR 1.182).

5. On June 13, 2011, the third party requester filed comments after the patent owner's May 13, 2011 response and the February 1, 2011 Office action.

DECISION

I. Relevant Authority

37 CFR 1.91(a) provides:

> A model or exhibit will not be admitted as part of the record of an application unless it:
> (1) Substantially conforms to the requirements of § 1.52 or § 1.84;
> (2) Is specifically required by the Office; or
> (3) Is filed with a petition under this section including:
> (i) The fee set forth in § 1.17(h); and
> (ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

37 CFR 1.84 provides in-part (emphasis added):

> (a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.
>
> ****
>
> (2) *Color*. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a <u>petition filed under this paragraph explaining why the color drawings are necessary</u>. Any such petition must include the following:
> (i) The fee set forth in § 1.17(h);
> (ii) Three (3) sets of color drawings;
> (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings: The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.
>
> (b) *Photographs*.—
>
> ****
>
> (2) <u>*Color photographs*. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.</u>

II. Patent owner's petition under 37 CFR 1.182

In the instant petition under 37 CFR 1.182, patent owner states that the "[r]esponse and the accompanying declaration of Steven Griffith, Ph.D. contain various illustrations and photographs in color."[1] Patent owner requests "that the color versions of these materials be made available to the Examiner," "that an Artifact Folder be created in the IFW system for the above referenced matter to contain the attached original documents after they are scanned," and that "[c]onsideration of these documents is to be on the basis of the original documents containing the color illustrations."[2]

While there is no regulatory provision for entry of a response or declaration containing color illustrations and photographs in a reexamination proceeding, 37 CFR 1.91 provides an analytical framework for such entry in that it provides for entry of exhibits that substantially conform to the requirements of 37 CFR 1.84 in applications. Under § 1.84, the Office will accept color drawings in applications only after granting a petition explaining why color is necessary that includes (1) the petition fee, (2) three sets of color drawings/photographs, and (3) an amendment to the specification indicating that at least one drawing is in color.[3] The requirement for three sets of color drawings under 37 CFR 1.84(a)(2)(ii), however, is not applicable to color drawings submitted via EFS-Web and only one set of such color drawings is necessary when filing color submissions via EFS-Web.[4] Color submissions filed via EFS-Web in PDF format are maintained in SCORE and a black and white copy will be stored in the image file wrapper (IFW) along with a SCORE placeholder sheet.[5] In this instance, because the color submission was not filed via EFS-Web, an artifact folder containing the color submission has been created.[6]

In the instant case, the patent owner has filed the instant petition under 37 CFR 1.182, requesting entry of the color submission, with the requisite petition fee.[7] However, the patent owner has neither filed three sets of the color submission nor was the color submission filed by EFS-Web. Further, the instant petition fails to state any reason why the color submission is necessary (*i.e.*, why a black and white version would not suffice).[8] In view of the above facts and circumstances the instant petition under 37 CFR 1.182 <u>is dismissed</u>.

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[1] *See* petition under 37 CFR 1.182 at page 1.
[2] *Id.*
[3] *See* 37 CFR § 1.84(b)(2); 37 CFR § 1.84(a)(2); MPEP 608.02 (VIII); *see also* 502.05(VIII)(C) (stating "[f]or color drawings, a petition filed under 37 CFR 1.84(a)(2) explaining why the color drawings are necessary is *required*").
[4] *See* MPEP 502.05(VIII)(C).
[5] See *Legal Framework for Electronic Filing System-Web (EFS-Web)*, 74 FR 55200, 55202 and 55208 (October 27, 2009).
[6] *See* MPEP 608.02 (VIII). *See also* May 27, 2011 artifact sheet indicating receipt of color documents that have not been scanned and creation of an artifact folder containing the color documents (95000609CA).
[7] *See* Petition at page 2.
[8] No amendment to the specification is required in this instance because the color photographs will not be reproduced as a part of the patent or reexamination certificate (*i.e.*, due the color photographs being part of patent owner's response, and not the patent itself).

The patent owner is given 15 days from the mailing of this decision to file a supplemental response limited to: (1) a renewed petition under 37 CFR 1.182 which states a reason why the color version of the response and accompanying declaration is necessary, and (2) either three sets of the color submission, as filed on may 13, 2011, or an EFS-Web submission of a PDF version of the color submission, as filed on May 13, 2011. No fee would be required for any such renewed petition. If the supplemental response is limited solely to these issues and the renewed petition is grantable, the Office will enter the response as a supplemental response under 37 CFR 1.945(b). If the patent owner fails to provide such supplemental response, within 15 days of the mailing date of this decision, the Office will enter a scanned black and white version of the response and accompanying declaration, as filed on May 13, 2011, and the color version will be removed from the artifact folder, and only the black and white version of the response will be considered.

CONCLUSION

1. Patent owner's May 13, 2011 petition under 37 CFR 1.182 is dismissed.

2. The patent owner is given 15 days from the mailing of this decision to file a supplemental response limited to: (1) a renewed petition under 37 CFR 1.182 which explains why the color version of the response and accompanying declaration is needed, and (2) either three sets of the color submission, as filed on may 13, 2011, or an EFS-Web submission of a PDF version of the color submission, as filed on May 13, 2011. No fee would be required for the renewed petition.

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

08-04-2011
Kenpet8/IP

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,609	12/16/2010	7326210	SYNT-3052	3785

53443 7590 09/28/2011
WOODCOCK WASHBURN LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2011

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(For Patent Owner)

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SEP 28 2011

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, DC 20005-3934

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,609
Filed: December 16, 2010
For: U.S. Patent No. 7,326,210

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

This is a decision on the patent owner's August 17, 2011 petition paper entitled "RENEWED PETITION UNDER 37 CFR § 1.182 TO REQUEST ENTRY OF COLOR VERSION OF PATENT OWNER'S RESPONSE".

The patent owner's petition under 37 CFR 1.182 is granted, for the reasons set forth herein.

DECISION

On August 5, 2011, the Office mailed a decision dismissing the patent owner's May 13, 2011 petition paper entitled "PETITION TO REQUEST ARTIFACT FOLDER FOR COLOR VERSION OF PATENT OWNER'S RESPONSE UNDER 37 C.F.R. §1.182" (the May 13, 2011 decision). In the May 13, 2011 decision, the patent owner was given 15 days from the mailing of the decision to file a supplemental response limited to: (1) a renewed petition under 37 CFR 1.182 which states a reason why the color version of the response and accompanying declaration is necessary (*i.e.*, why a black and white version would not suffice), and (2) either three sets of the color submission, as filed on May 13, 2011, or an EFS-Web submission of a PDF version of the color submission, as filed on May 13, 2011.

On August 17, 2011, the patent owner filed the instant renewed petition under 37 CFR 1.182 which states several reasons why a black and white version of the color version of the May 13, 2011 submission would not suffice. For example, patent owner states:

> The color assists the examiner in understanding how these devices function and the examiner would not fully appreciate the illustrations and photographs without the color (see, e.g., page 5 where color permits examiner to fully appreciate the toggling motion as seen by compressed parts where color assists in understanding

> the compression). Also, at page 12 of the response, color (yellow) is used to highlight the gap between the neck (red) and the pedicle screw assembly. Similarly, at page 16 of the response, color (red) is used to highlight the core element within the rigid section (yellow). And at page 22, color (red/yellow) is used to show how Requester has identified parts of the lower end portion of the part and also color (green) has been similarly used at the top end portion of the part. The same analysis can be used for the Griffith declaration (see pages 6, 7, 8, 12, 15) where color is used in the same manner just discussed for the response.[1]

Further, the patent owner has concurrently filed three sets of the color submissions.[2] Since, the patent owner has complied with the requirements identified in the May 13, 2011 decision the instant renewed petition under 37 CFR 1.182 is granted.

CONCLUSION

1. Patent owner's August 17, 2011 renewed petition under 37 CFR 1.182 is granted.

2. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

/Kenneth M. Schor/

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

09-27-2011
Kenpet9/IP/

[1] *See* Renewed Petition at page 3.
[2] *See* Artifact folder 95000609CB.

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CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein, & Fox, PLLC (For Patent Owner)
1100 New York Avenue, NW
Washington, DC 20005

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12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Novak, Druce, & Quigg LLP (For *Inter Partes* '1414 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

Baker Botts LLP (For *Inter Partes* '610 Requester)
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Dallas, TX 75201

Inter Partes Reexamination Proceeding :
Control No. 95/000,592 :
Filed: December 16, 2010 :
For: U.S. Patent No. 7,202,822 :
:
:
Inter Partes Reexamination Proceeding : **DECISION, *SUA SPONTE,***
Control No. 95/000,610 : **MERGING**
Filed: December 16, 2010 : ***INTER PARTES***
For: U.S. Patent No. 7,202,822 : **PROCEEDINGS**
:
:
Inter Partes Reexamination Proceeding :
Control No. 95/0001,414 :
Filed: August 4, 2010 :
For: U.S. Patent No. 7,202,822 :

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 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,202,822 (the '822 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.

2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/001,414 (the '1414 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. An action on the merits was issued on that same date, rejecting all of the claims under reexamination. Patent owner responded on April 11, 2011;[1] no amendments to the claims were proposed in that response. Third party requester submitted comments on May 2, 2011.

3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,592 (the '592 *inter partes* proceeding), and a filing date of December 16, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on January 31, 2011. No action on the merits has been issued in this proceeding.

4. On December 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,610 (the '610 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 1, 2011. No action on the merits has been issued in this proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 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.

[1] An earlier patent owner response was refused entry, and additional time given for a proper response.

As evidenced by the above review of facts, the '1414, '592, and '610 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent have been mailed in both the '592 and '610 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was mailed in the '1414 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '592 and '610 proceedings are at the same stage, in which no Office action on the merits has been issued. The '1414 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple 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 each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1414, '610, and '592 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1414, '610, and '592 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 two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C.

314(b)(2).[2] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

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

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

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

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

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

It is to be noted that, because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent.

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

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for 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 triplicate**, each bearing a signature and identifying data for all 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 C.F.R. § 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 C.F.R. § 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, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 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 specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 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.

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester

intends to contest. (37 C.F.R. § 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 C.F.R. § 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,414, *inter partes* Reexamination Control No.95/000,610, and *inter partes* Reexamination Control No. 95/000,592 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

June 7, 2011

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JUN 21 2011

CENTRAL REEXAMINATION UNIT

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

Inter Partes Reexamination Proceeding
Control No. 95/000,610
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

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

DECISION ON PETITIONS UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,414.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,414.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

BACKGROUND

1. On April 10, 2007, U.S. patent number 7,202,822 (the '822 patent) issued to Baliarda *et al.*

2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '822 patent, which request was assigned Reexamination Control No. 95/001,414 (the '1414 proceeding).

3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1414 proceeding. Concurrently with the order, the Office issued a non-final Office action.

4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.[1]

5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.

7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).

9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

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[1] On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.

10. On June 7, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1414 proceeding with *inter partes* reexamination proceeding control no. 95/000,592 (the '592 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) 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 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. Analysis

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 petitioner deems to be needed for the response.

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 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. 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, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 62 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the corrected response submission.[2] Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."[3] Nonetheless, patent owner also requests waiver of the 50-page limit "for any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts."[4]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.[5] Additionally, patent owner asserts that "the full

[2] Patent owner petition under 37 CFR 1.183 at page 2.
[3] Id. at page 4 (stating that the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)" and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (45 pages)," are filed herewith and noting in FN 3 that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")
[4] Id. at page 6.
[5] Id. at pages 4-6.

length of the Corrected Response is needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 9 pages, it incorporates by reference over 450 pages of arguments and detailed claim charts set forth by the third party requester in its request for reexamination."[6] Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[7] As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner's January 10, 2011 original response submission to patent owner's April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the '1414 proceeding by marking the paper "closed" and "not public" in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[8] and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner's April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span more than 400 pages.[9] Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.

IV. Third party requester petition of May 2, 2011

On May 2, 2011, the '1414 requester filed, in the '1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1414 requester asserts that the May 2, 2011 comments submission

[6] Id. at page 2.
[7] Id. at page 3.
[8] 69 pages of the remarks portion of patent owner's April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 17-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the total number of pages of the patent owner's April 11, 2011 corrected response submission exceeds the 50-page limit.
[9] On its face, the substantive portion of the October 8, 2010 Office action spans only approximately 7 pages, but it incorporates by reference approximately 178 pages, in addition to approximately 220 pages of claim charts, from the '1414 request for *inter partes* reexamination.

includes "61 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best's expert report."[10] The '1414 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 61 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best's [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language."[11]

In support of its request for waiver of the rule, the '1414 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 144 page response."[12] The '1414 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 95 pages."[13] The '1414 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."[14]

Based on the specific facts set forth in the '1414 requester's petition under 37 CFR 1.183, the '1414 requester'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 comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),[15] 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 to the extent that the '1414 requester's May 2, 2011 comments submission exceeds 50 pages. Accordingly, the '1414 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 necessary to permit entry of

[10] Third party requester petition under 37 CFR 1.183 at page 1.

[11] Id. at page 4. The '1414 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1414 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. 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. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

[12] Id. at page 2.

[13] Id.

[14] Id.

[15] 62 pages of the remarks portion of the '1414 requester's May 2, 2011 comments submission count toward the page limit. Thus, the total number of pages of the '1414 requester's May 2, 2011 comments submission exceeds the 50-page limit.

the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

> The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 7, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

> Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.
>
> No *inter partes* requester has a right to comment on any issue raised outside the confines of the 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. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1414 proceeding with the '592 and '610 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,592 third party requester and the 95/000,610 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.

2. The '1414 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.

3. The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.

4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

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

06-17-2011

United States Patent and Trademark Office

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

Inter Partes Reexamination Proceeding
Control No. 95/000,610
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

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

DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, 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 95/000,610, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/000,610 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,610, 95/000,592 and 95/001,414.

Inter partes reexamination proceeding 95/000,610, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,610 (the '610 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 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '610 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '592 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '822 patent, which is the patent under reexamination in the '610 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53, which are identical to the claims that were requested to be reexamined by HTC in the '610 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '822 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '610 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610 , 95/000,592 and 95/001,414.

Inter partes reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue**.[2] Any rejection proposed by HTC (the requester of the '610 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '592 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[3]

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,592 and 95/001,414, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,592 and 95/001,414 will otherwise remain, in general, as outlined by the decision, mailed on June 7, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".[4]

The '610 *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 September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,610 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610, 95/000,592 and 95/001,414.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.
- The prosecution of the '610 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '610 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '610 proceeding, as set forth in this decision.

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[3] A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

[4] The statement at the bottom of page 4 of the June 7, 2011 decision, that "because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent", was made in error. The requester of the '1414 proceeding did propose rejections of claim 8 in the request filed in that proceeding, and does have appeal rights as to claim 8 as it appears in the '822 patent.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

Kenpet9

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,611	12/17/2010	6,663,738	HZC020	2698

EXAMINER

ART UNIT	PAPER NUMBER

27885 7590 05/09/2011

FAY SHARPE LLP
1228 Euclid Avenue, 5th Floor
The Halle Building
Cleveland, OH 44115

DATE MAILED: 05/09/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEVEN J. GROSSMAN , PH. D.
GROSSMAN,TUCKER,PERREAYLT & PFLEGER, PLLC
55 SOUTH COMMERICAL STREET
MANCHESTER, NH 03101

Date:
MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000611
PATENT NO. : 6663738
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.:95/000,611

1. THIS IS A DECISION ON THE PETITION FILED April 29. 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on April 1, 2011, which sets a two-month period for filing a response thereto, be extended by one month.

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

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

5. CONCLUSION **Response is due on July 1, 2011**

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

   Deborah Jones 5/6/2011 (Title) DEBORAH D. JONES
   [Signature] CRU SPEC. ANL 6981

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,617	01/25/2011	7843508	169AA-000700US	7253

83275 7590 10/28/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

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

Date:
MAILED
OCT 28 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000617
PATENT NO. : 7843508
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 2011

CENTRAL REEXAMINATION UNIT

AMPACC Law Group, PLLC (For Patent Owner)
6100 219th Street SW
Suite 580
Mountlake Terrace, Washington 98043

Novak Druce & Quigg, LLP (For 95/001,521 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, Texas 77002

Woodcock Washburn LLP (Microsoft Corporation) (For 95/000,617 Requester)
CIRA Centre
12th Floor
2929 Arch Street
Philadelphia, Pennsylvania 19104-2891

Kenyon & Kenyon LLP (For 95/001,534 Requester)
One Broadway
New York, New York 10004

In re Qiang Huang *Inter Partes* Reexamination Proceeding Control No.: 95/001,521 Filed: January 7, 2011 For: U.S. Patent No. 7,843,508	:
In re Qiang Huang *Inter Partes* Reexamination Proceeding Control No.: 95/000,617 Filed: January 25, 2011 For: U.S. Patent No. 7,843,508	: **DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS**
In re Qiang Huang *Inter Partes* Reexamination Proceeding Control No.: 95/001,534 Filed: January 31, 2011 For: US. Patent No. 7,843,508	:

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. 7,843,508 ("the '508 patent") issued to Qiang Huang on November 30, 2010, with 46 claims.

2. A request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 7, 2011, by a third party requester, and was assigned control number 95/001,521 ("the '1521 *inter partes* proceeding"). The request identified Apple Inc.as the real party in interest.

3. A second request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 25, 2011, by a third party requester, and was assigned control number 95/000,617 ("the '617 *inter partes* proceeding"). The request identified Microsoft Corporation as the real party in interest.

4. A third request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 31, 2011, by a third party requester, and was assigned control number 95/001,534 ("the '1534 *inter partes* proceeding"). The request identified Sony Corporation and Sony Electronics Inc. as real party in interest.

5. On February 14, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1521 *inter partes* proceeding based on the examiner's determination that the January 7, 2011 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection Office action.

6. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '617 *inter partes* proceeding based on the examiner's determination that the January 25, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '617 proceeding.

7. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1534 *inter partes* proceeding based on the examiner's determination that the January 31, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1534 proceeding.

8. On April 15, 2011, patent owner submitted a response to the February 14, 2011 non-final rejection action in the '1521 *inter partes* proceeding. The April 15, 2011 patent owner response did not include any amendment to the specification or claims.

9. On May 16, 2011, the '1521 requester filed comments to patent owner's April 15, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same 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 95/001,521, 95/000,617 and 95/001,534 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

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding*.

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 each of claims 1-46 of the '508 patent in each of the '1521, '617, and '1534 proceedings. Accordingly, the examiner will conduct reexamination in the merged proceeding for claims 1-46 of the '508 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings, all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683. As pointed out in MPEP 2674:

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

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

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

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

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all 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

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

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 requesters 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.

D. 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.

E. 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.

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by* <u>*that*</u> *third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,521, *inter partes* Reexamination No. 95/000,617 and *inter partes* Reexamination Control No. 95/001,534 <u>are merged into a single proceeding</u>, to be conducted in accordance with the procedure set forth above.

2. The examiner will issue an Office action for the merged proceeding in due course.

3. 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
Senior Legal Advisor
Office of Patent Legal Administration

October 27, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,617	01/25/2011	7843508	169AA-000700US	7253

83275 7590 11/29/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/29/2011

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2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

Date:
MAILED
NOV 29 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000617
PATENT NO. : 7843508
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.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,521; 95/000,617 & 95/001,534

MAILED
NOV 29 2011
CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 21 November 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 04 November 2011 which sets a two(2)month period for filing a response to the Office action, be extended by two (2) months.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☐ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot, _____.
      vi. ☐ Other/comment: see attached.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his absence, calls may be directed to Sudhanshu C Pathak at 571-272-5509 in the Central Reexamination Unit.

/Mark Reinhart/ [*Signature*]	SPRS, AU 3992 Central Reexamination Unit (Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time.

Pursuant to MPEP § 2665 (in part) Extension of Time

First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

On balance, there is "sufficient cause" for granting of one (1) month extension of time. Requests for more than one month will only be granted in extraordinary situations.

The petition for extension of time is hereby granted-in-part.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,617 95/001521 95/001534	01/25/2011	7843508	169AA-000700US	7253

83275 7590 02/24/2012

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-24-12

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

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000617 + 95/001521 + 95/001534
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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FEB 24 2012

CENTRAL REEXAMINATION UNIT

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Philadelphia, Pennsylvania 19104-2891 (For 95/000,617 Requester)

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One Broadway
New York, New York 1004 (For 95/001,534 Requester)

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,521
Filed: January 7, 2011
For: U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No. 95/000,617
Filed: January 25, 2011
U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,534
Filed: January 31, 2011
For: U.S. Patent No.: 7,843,508

: DECISION ON § 1.181,
: §1.182, AND § 1.183
: PETITIONS

This is a decision on February 23, 2011 patent owner petitions under 37 CFR 1.181, 1.182 and/or 37 CFR 1.183 seeking to vacate or suspend *inter partes* reexamination control number 95/000,617 (the '617 reexamination), filed January 25, 2001 and reexamination control number 95/001,534 (the '1534 reexamination), filed January 31, 2011 based on the assertion

that the requesters of the instant reexaminations are real party in interests or privies with the requester in *inter partes* reexamination control number 95/001,521 (the '1521 reexamination), filed January 7, 2011. This decision also takes into consideration a March 9, 2011 third party requester (Requester) Opposition, filed in the '1,534 reexamination, and a March 12, 2011 Opposition, filed in the '617 reexamination, the two oppositions being filed to address the respective petitions for vacatur; the Oppositions are supported by Petitions under 37 CFR 1.181, 1.182 and/or 1.183, requesting entry of the Oppositions.

The Petitions and Oppositions are before the Office of Patent Legal Administration for consideration.

The Patent Owner Petitions for vacatur under 37 CFR 1.181, 1.182 and/or 1.183 are Dismissed.

The Requester Petitions under 37 CFR 1.181, 1.182 and/or 1.183 are Granted and the Oppositions have been entered.

I. FEES

Notwithstanding the reliance on alternative petition rules by both the Patent Owner and the Requesters, only one petition fee from each party will be required to consider the matter raised. A review of Office PALM records reveals that:

- in the '1,534 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page7), but not the Requester's $400 petition fee, which fee was authorized in the petition (at page 6) and will be so charged, and

- in the '617 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page 7), and the Requester's similar $400 fee was charged on March 14, 2011 as authorized in the petition (at page 10).

II. BACKGROUND

1. U.S. Patent No. 7,843,508 (the '508 patent) was issued on November 30, 2010.

2. On January 7, 2011, a first request for reexamination of the '508 patent was filed on behalf of Apple, Inc (Apple)[1] and was given a reexamination control number 95/001,521 (the '1,521 reexamination):
   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer Inc. et al.*, Case No. 3:10-cv-05762 (N.D. Cal. December 17, 2010).[2]
   b. Reexamination was ordered on February 14, 2011.

3. On January 25, 2011, a second request for *inter partes* reexamination of the '508 patent

[1] Request transmittal form, at page 1, paragraph 2a.
[2] *Id.*, at page 2, paragraph 16d.

was filed on behalf of Microsoft Corporation[3] (Microsoft) and was given a reexamination control number 95/000,617 (the '617 reexamination):

a The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, Civil Action No. 3:10-CV-05762 (EMC), December 17, 2010.[4]

b. Reexamination was ordered on March 25, 2011.

4. On January 31, 2011, a third request for *inter partes* reexamination of the '508 patent was filed on behalf of Sony Corporation and Sony Electonics Inc[5] (Sony) and was given a reexamination control number 95/001,534 (the '1,534 reexamination):

   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, 3:10-cv-05762-RS (N.D. Cal.),[6]

   b. Reexamination was ordered on March 25, 2011.

5. On February 23, 2011, Patent Owner filed petitions under 1.181, § 1.182 and/or § 1.183 in reexaminations '617 and '1,534 to vacate or suspend the reexaminations in that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed.

6. On March 9, 2011, and March 12, 2011, the requesters submitted Oppositions in reexaminations '617 and '1,534 to the February 23, 2011 petitions by the Patent Owner supported by petitions under 37 CFR 1.181, 1.182 and/or 1.183.

7. On October 28, 2011, the Office mailed a Decision, Sua Sponte, to Merge Reexamination Proceedings for the following reexaminations:

   a. '1,521,

   b. '617, and

   c. '1,534.

III. Patent Owner Petition Under 37 CFR 1.182 and/or 1.183 for Vacatur

Petitioner (Patent Owner) notes that a reexamination order of the '508 patent on behalf of Apple (the '1521 reexamination) has been issued, and that, therefore, the '617 and '1,534 subsequent requests for reexamination of that patent are precluded for all real parties in interest to the first reexamination request, and for all privies, until a reexamination certificate has issued on the first reexamination.[7]

Petitioner does not attempt to factually distinguish between Microsoft and Sony in terms of their being alleged real parties in interest or privies with Apple.

The Supreme Court decision in *Taylor v. Sturgell*[8] (*Taylor*) is relied upon for its holdings that[9]:

1. a non-party may be bound by a judgement, because he/she was adequately represented

[3] Request transmittal from, at page 1, paragraph 2a.
[4] Id., at page 2, paragraph 16d.
[5] Request transmittal form, at page 1, paragraph 2a.
[6] Request transmittal form, paragraph 16d.
[7] Petition, bridge of pages 1 and 2, citing 35 U.S.C. 317(a).
[8] *Taylor v. Sturgell*, 128 S. Ct. 2161 (2008).
[9] Petition, bridge of pages 2 and 3.

by someone with the same interests who was a party to a suit, and
2. a party may not avoid a preclusive effect by relitigating through a proxy.

As to being adequately represented, it is asserted that Apple's representation of Microsoft and Sony (joint defendants in concurrent litigation) is adequate for preclusion purposes because[10]:

1. the interests of the joint defendants are aligned,
2. the Office as the administrative body adjudicating an *inter partes* reexamination has taken the necessary care to assert any additional prior art or arguments required to protect the interests of the other joint defendants, and
3. all joint defendants had notice of the reexamination filed by Apple.

As to relitigating through a proxy, it is asserted that a joint agency relationship has been admitted in the underlying litigation, and that may not now be renounced in the reexamination in that[11]:

1. there is in place a joint defense agreement thereby making all the joint defendants privies to the reexamination filed by Apple, and
2. the joint defendants have asserted an attorney privilege and joint defense privilege in the underlying litigation.

The instant patent being reexamined is part of a family of patents, including U.S. patents 7,009,655 and 7,282,172.[12] A discussion is provided in regard to litigation of these two other patents to establish a relationship between Apple and Microsoft and Sony, including the absence of additional reexamination requests by Microsoft and Sony for those patents.[13] Additionally, it is noted by petitioner that in regard the reexamination of the other two patents, the examiner did not merely adopt the invalidity arguments made by Apple, but instead added other arguments not found in Apple's briefs.

It is also asserted and argued that the joint defendants have exchanged prior art and are aware of all the *inter partes* reexaminations requested by Apple.

IV. Petition under 37 CFR 1.183 for entry of Opposition and Decision Thereon

Third party petitioners (Requesters) seek entry of their Oppositions to the Patent Owner petitions for vacatur of the reexamination filing dates, such as by waiver of § 1.939(a) (or (b)).

Section 1.939(a) provides:

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

Because the Oppositions shed light on the proper identification of the real party in interest, as noted below, and in addition the Requesters have a right to defend against vacating their requests, the petitions for waiver are granted.

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[10] Petition, at page 3.
[11] *Id.*
[12] *Id.*
[13] Petition, at page 5.

V. Requesters' Oppositions to Patent Owner Petition for Vacatur

Oppositions have been filed by each of the Requesters in reexaminations '1,521 and '1,534.

Microsoft:[14] The Opposition by the Requester of the '617 reexamination (Microsoft) explicitly states:

> Microsoft properly certified under 37 CFR § 1.917(b)(7) that the estoppel provisions do not apply to it.[15]

The Opposition also addresses the lack of privity between Microsoft and Apple by pointing out that petitioner's reliance on the mere existence of a joint defense agreement is not, as a matter of law, sufficient to establish privity or a joint agency agreement.[16] The Opposition by Microsoft, as does the Opposition by Sony, notes that, in *Taylor*, the Supreme Court rejected the D.C. Circuit's expansive use of the doctrine of virtual representation to preclude a claim brought by a non-party. It is added that Petitioner seeks to expand the limited exception in precisely the manner that *Taylor* forbade.[17] The D.C. Circuit held incorrectly that preclusion based on virtual representation can exist where there was both an identity of interest and adequate representation together with a third factor, such as a close relationship or substantial participation. It is asserted by requester that the admitted joint defense agreement in the underlying litigation is not the same as a class action suit or suit brought by fiduciaries, and guardians that are the basis of the exception to the general rule of non-preclusion.

Requester provides that, while Petitioner would have the Office believe that the Office is well-suited to protect Microsoft's interests in the Apple reexamination, Microsoft notes that it has presented its own substantial new questions of patentability which are different from those raised by Apple, and they would not be considered if the petition was granted. It is asserted that if the Office were fully able to protect the interest of third parties in a reexamination proceeding, then there would be no need for the statute to allow the filing of any subsequent *inter partes* reexamination request, including those of third parties.[18]

Sony: The Opposition by the Requester of the '1,534 reexamination (Sony) explicitly states that:

> Sony is not a 'real party in interest' to the '521 reexamination and is not in privity with Apple in the '521 reexamination.[19]

It is stated that Sony has:

> certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this

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[14] The Opposition has raised what requester believes to be legal defects in the petition for Vacatur in that: (a) the instant petitions were filed before reexamination was ordered (based on the requests by Microsoft and Sony), so there is no action of the Office that could be suspended or vacated, Opposition, page 4, and (b) without a first order for reexamination (based on the Apple request), there can be no preclusion of a second request for reexamination - the February 14, 2011 order for reexamination on the Apple request in the first request for reexamination was after the January 25, 2011 Microsoft and January 31, 2011 Sony (second) requests for reexamination, Opposition, pages 4 and 5.

[15] Opposition, page 9.

[16] Opposition, pages 6 and 7.

[17] *Id.*

[18] *Id.*, page 8.

[19] Opposition, page 2.

reexamination.[20]

It is also stated that the Patent Owner has failed to establish that Sony's certification is in any way ambiguous or facially inaccurate, nor has the Patent Owner attempted to even allege any such ambiguity or inaccuracy.[21]

While it is recognized that Sony is a co-defendant with Apple in concurrent litigation and Sony admits that it has cooperated with Apple in the litigation, such actions are asserted to not to amount to control over, or privity, in the present reexamination.

It is pointed out that *Taylor* actually supports denial of the Patent Owner's petition based on the Court's recognition, in reversing the lower court's finding of a virtual representation, that everyone should have his own day in court.[22]

VI. Decision on the Patent Owner Petitions for Vacatur

The petitions by patent owner seeking vacatur of the subsequent *inter partes* reexaminations requested by Microsoft and Sony are dismissed.

At page 2, the petitions assert:

> Once a third party requester has filed a request for *inter partes* reexamination and the request has been granted by the PTO, neither the third party requester nor its privies may file a subsequent request for *inter partes* reexamination on the same patent until a reexamination certificate has issued. *See* 35 U.S.C. § 317(a).

The petitions go on to state:

> The limitation provided in section 317(a) of the patent statute takes effect as soon as reexamination is ordered by the PTO, See 35 U.S.C. § 317(a) (requiring that an order for *inter partes* reexamination be issued). The limitation applies for the entire patent, regardless of the claims for which the *inter partes* reexamination was requested, and regardless of whether all claims are actually examined. See 35 U.S.C. § 317(a) ("...neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent ....

Petitioner misreads 35 U.S.C. 317(a). The pertinent part of section 317(a) provides that:

> ...<u>once an order for inter partes reexamination of a patent has been issued</u> under section 313, <u>neither the third-party requester nor its privies may file</u> a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director. [Emphasis added.]

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[20] *Id.*
[21] Opposition, bridge of pages 2 and 3.
[22] Opposition, page 5.

In this instance, the '1521 reexamination was filed January 7, 2011, the '617 reexamination was filed January 25, 2001, and the '1534 reexamination was filed January 31, 2011. The '1521 reexamination was ordered February 14, 2011, and the '617 and '1534 reexaminations were ordered March 25, 2011. Thus, all three reexaminations were requested before any of the three were ordered. Accordingly, all three of the reexaminations may continue, regardless of whether filed by the same party, a real party in interest, or a privy.

It is also pointed out that *inter partes* reexamination is a "creature of the statute," and the estoppels stated in the statute are the only estoppels that apply; preclusion based on virtual representation does not apply unless it fits within one of the statutory estoppels, and it does not fit here.

The following discussion is provided only to address the extent that the Patent Owner petition could be interpreted to request vacatur or suspension of reexaminations '617 and '1,534 because of the assertion that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed, yet, Microsoft and Sony were not identified as such, and thus, the filing date requirement of 37 CFR 1.515(b)(8) to identify the real parties in interest was not satisfied.

The MPEP[23] makes it clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the identified copending litigation does not translate *ipso facto* into each defendant being a real party in interest in any request for reexamination filed by one of the defendants. This is not to say that concurrent litigation defendants cannot be real parties in interest in requests for reexaminations of the patent in litigation, but such result must be shown and not merely speculated on or theorized about. To be required to be named as a real party in interest, a party must participate, contribute, or direct that action be taken in some concrete manner in the request for reexamination. If, in fact, it could be evidenced that a party not identified as a real party in interest participated, contributed or directed action to be taken in some concrete manner in the Apple request for reexamination, than an issue could be raised as to whether Microsoft or Sony is a real party in interest in the filing of the Apple reexamination request, and as to whether Microsoft or Sony are in privy with Apple.

Preliminarily, it is noted that the allegations regarding a joint defense are not even directed towards the particular patent that is the subject of the reexaminations, but other patents alleged to be in a family of patents for which the instant patent is a member. Nonetheless, even if the joint defense involved litigation of the instant patent being reexamined, preparation of an invalidity defense, based on found and evaluated prior art to support a concurrent litigation defense, does not amount to participation, contribution, or directing that action be taken by all the defendants in a request for reexamination by one of the defendants based on such joint activity, where the joint activity was conducted with only an intent to defend the concurrent litigation suit. Evidence that the joint activity was also conducted with

[23] MPEP § 2612.

an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other concurrent litigation defendants are real parties in interest or privy with the concurrent litigation defendant filing the reexamination request.

Notwithstanding any actual benefit that would result to the concurrent litigation defendants from a favorable result in the reexamination, or their ability to request a litigation stay based on the reexamination request, the question of whether a defendant in the litigation is a real party in interest or privy in the reexamination must be determined on a case-by-case basis focusing on **the showing** of a party's participation, contribution, or directing that action be taken in regard to the filing of a request for reexamination, and not ancillary matters, such as the defendants taking advantage of the reexamination request, or taking advantage of arguments in the subsequent reexamination request that were previously drafted by others for the concurrent litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation and ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by the unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative – that it was not supported by the litigation defendants. Similarly, here, the Office will not require the Requester to prove a negative – that the concurrent litigation defendants did not participate, contribute or direct the action to be taken in the reexamination. The fact that a first party defended itself in litigation, and another party defendant later filed a request for reexamination related to the patent in litigation utilizing in-part that defense, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed utilizing part of that defense. Rather, the burden is on the challenging Patent Owner to provide evidence of participation contribution, or directing that action be taken as to the reexamination request.

It may be that a particular defendant in a litigation has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation. To embrace each defendant as a real party in interest to a first reexamination request, would result in estoppel against parties who had no control over the initial request for reexamination. None-the-less, using petitioner's theory that the defendants in the litigation must be deemed to be real parties in interest in any initial reexamination request of the patent in litigation, the litigation defendants would then be barred (under 35 U.S.C. § 317(a)) from raising other substantial new questions of patentability that they may feel is better in a subsequent request for reexamination after the first request has been ordered, which at least Microsoft has alleged in its Opposition (at page 8).

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation, contribution or direction of action to be taken in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that the concurrent litigation defendants may be impacted and even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated contributed or directed action to be taken in the request for reexamination, or in the reexamination proceeding after the request was filed. Similarly, it is incumbent upon Patent Owner to present objective evidence that a subsequent reexamination requester is in privity with a prior reexamination requester for which reexamination has been ordered.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the petitions for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in the *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, contains on its face, an unambiguous identification of the identity of the real party in interest.[24]

Patent Owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. at 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest or privy (by way of having participated contributed or directed that action be taken in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which such instance a third party requester which is before the Office can be queried by the Office, because the instant record is not clear (*i.e.*, the ambiguity causes an issue that is ripe for consideration due to a required request statement being ambiguous). Since the present record in the instant reexamination

[24] The Requesters have in fact confirmed that they have identified the only real party in interest.

proceeding is not ambiguous as to the identification of the real party in interest (and Patent Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Moreover, the third party requesters, Microsoft and Sony in their Oppositions have responded based on facts wholly within their knowledge and possession. Both third party requesters have clearly stated that their certifications are correct that they are not barred from filing their requests for reexamination. No facts have been presented by Petitioner that would cause the Office to believe any issue regarding real party in interest or privity is raised that would need further clarification by the requesters. It is noted that Petitioner has not challenged the identification of the real party in interest in the initial reexamination 95/000,617, although Petitioner herein argues that that Microsoft and Sony are true real parties in interest along with Apple or privies thereof.[25]

Where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[26] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[27] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Once a court has determined that a party is a "real party in interest," the Office can make use of that determination to bar the filing of a subsequent *inter partes* reexamination request by that party. Of course at that point, the party could file an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[28]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why Patent Owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner Patent Owner

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[25] Petition, page 1.
[26] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).
[27] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).
[28] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[29] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[30] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[31] Requester Apple has clearly stated it is the real party in interest, and that is an identification to a sufficient extent that a party, such as a concurrent litigation defendant, filing the subsequent *inter partes* reexamination request can look into its interaction with the identified real party in interest to "determine whether the subsequent requester is a privy" with Apple who filed the initial reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the subsequent *inter partes* reexamination proceedings, the real party in interest is unambiguously identified in the records. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant subsequent reexamination proceedings, because there is no legal reason to do so.

B. Synopsis

[29] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[30] 35 U.S.C. § 311(b)(1).
[31] 37 CFR 1.915(b)(8).

Rather than having presented clear and undisputed evidence establishing that Microsoft and Sony are either real parties in interest along with Apple or privies thereof, the petition is supported only by supposition and conjecture on Patent Owner's part based on a joint defense agreement in concurrent litigation, which basis is insufficient to support the allegations.. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceedings or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

VII. CONCLUSION

1. The February 23, 2011 Patent Owner petitions under 37 CFR 1.181, 1.182 and 1.183, seeking vacatur of the reexamination, are dismissed.

2. The March 9 and March 12, 2011 third party Requester §§ 1.181, 1.182 and 1.183 petitions for entry of a concomitant Oppositions to the Patent Owner petition have been granted and the Oppositions entered.

3. The $400 Requester petition fee for the '1,534 reexamination will be charged to Deposit Account 11-0600.

4. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7707.

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration

1-17-12

APPENDIX OF GENERALLY RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) 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.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. 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. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(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.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(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.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

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 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(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.

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,620	03/25/2011	6708864	059410-0140	3271

64956 7590 10/20/2011
HAHN LOESER / LINCOLN
ONE GOJO PLAZA
SUITE 300
AKRON, OH 44311-1076

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/20/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LINCOLN ELECTRIC COMPANY/PERKINS COIE LLP
700 THIRTEENTH STREET, N.W.
SUITE 600
WASHINGTON, D.C. 20005-3960

Date:

MAILED

OCT 20 2011

CENTRAL REEXAMINATION U

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000620
PATENT NO. : 6708864
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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Hahn Loeser/Lincoln One Gojo Plaza Suite 300 Akron, OH 44311-1076	: : : :	(For Patent Owner)

MAILED

OCT 20 2011

CENTRAL REEXAMINATION UNIT

McDermott Will & Emery LLP 600 13th Street, N.W. Washington, D.C. 20005-3096	: : :	(For Third Party Requester)

In re Ferguson, III et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,620 Filed: March 25, 2011 For: U.S. Patent No. 6,708,864	: : : : :	DECISION ON PETITION UNDER 37 CFR 1.181 & 1.927

The paper filed by requester on July 8, 2011, entitled "Petition Under 37 C.F.R. § 1.927 Seeking Review of the Denial of the Request for *Inter Partes* Reexamination," is being treated as a petition Under 37 CFR 1.181 and 1.927 (hereinafter the Petition). The Petition is before the Group Director overseeing the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed June 8, 2011.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,708,864 (hereinafter, the '864 patent) issued on March 23, 2004.

2. A complete request for *inter partes* reexamination was deemed to have been filed by a third party requester on March 25, 2011. The resulting reexamination proceeding was assigned Control No. 95/000,620 (hereinafter, the '620 proceeding).

3. Reexamination was requested for claims 1-8 and 11-15 of the '864 patent.

4. A Notice of Reexamination Request Filing Date was issued on March 31, 2011.

5. An order denying the request for reexamination for claims 1-8 and 11-15 was mailed on June 8, 2011.

6. On July 8, 2011, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the teachings of U.S. Patent No. 6,301,944 to Offer (hereinafter "Offer") does not raise a substantial new question of patentability (SNQ). The petitioner also advances the examiner incorrectly concluded that the teachings of French Patent 2,055,181 (hereinafter "FR") do not raise a SNQ. The examiner determined that Offer did not raise a SNQ because Offer does not show 1) a wire having a substantially linear cast in the form of an undulating curve, where the undulating curve is at least partially retained after being unwound from a spool, and 2) a linear cast having a radius of curvature of about 15-40 inches. The examiner determined that FR did not raise a SNQ because the teachings of FR relied upon to raise the SNQ were also present in the previous examination of the application which issued as the '864 patent and were not presented in a new light.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo.* Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-8 and 11-15 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-8 and 11-15 of the '864 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be

based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

On September 4, 2008, the Court of Appeals for the Federal Circuit issued a decision that discussed the meaning of a substantial new question of patentability. See *In re Melvin J. Swanson and Patrick E. Guire* (CAFC 2007-1534). In this decision, the court found that the Office did not err in determining that Deutsch, which was applied in a rejection under 35 U.S.C. § 103 as a secondary teaching reference in the previous examination, raised a substantial new question of patentability based on anticipation. Specially, the court stated that "[i]n light of the extremely limited purpose for which the examiner considered Deutsch in the initial examination, the Board is correct that the issue of whether Deutsch anticipates the method disclosed in claims 22, 23, and 25 was a

[1] Public Law 96-517, enacted on December 12, 1980.

substantial new question of patentability, never before addressed by the PTO." The court also stated that:

> As the legislative history clarifies, to decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose. See H.R. Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."); see also 147 Cong. Rec. H5359 (statement of Rep. Berman) ("Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider . . . .").
>
> Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.

III. Analysis of the Request for Reexamination

The Request sets forth multiple proposed SNQ, which all have either Offer or FR as the primary reference applied (see, e.g., page 3 of the denial mailed June 8, 2011).

The Request was denied in the June 8, 2011Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. The examiner determined that the teachings of Offer, although not previously considered or addressed in the prior examination of the patent, did not teach the features of the independent claims (e.g., a wire having a substantially linear cast in the form of an undulating curve, where the undulating curve is at least partially retained after being unwound from a spool, and a linear cast having a radius of curvature of about 15-40 inches) (see pages 4-12 of the denial mailed June 8, 2011). The examiner also determined that FR, as a previously considered reference, was not proposed to be considered in a "new light" or in a different way that escaped review during the earlier examination and that petitioner did not properly propose an SNQ, but instead relied upon rejection proposals set forth in claim charts (see pages 13-14 of the denial mailed June 8, 2011).

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The Group Director overseeing the CRU reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the request, regarding the Offer reference, the request states that Offer teaches a wire having a substantially linear cast in the form of an undulating curve (see page 16 of the request). The petition further points out that Offer's disclosed apparatus

and method produce a linear cast in the form of an undulating curve in the weld wire (see page 4-5 of the petition). The request and petition are further supplemented by the Declaration of Peter Savoy (hereinafter "the Savoy declaration"), at paragraphs 9-18. Furthermore, both the request and the petition state that Offer teaches a wire that retains the undulating curve after casting and unwinding (see page 17 of the request and pages 5-6 of the petition). The Savoy declaration further supports this argument at paragraph 18. Finally, the request and petition state that Offer teaches a linear cast having a radius of curvature of about 15-40 inches (see page 17 of the request and pages 6-7 of the petition). This is further supported by the Savoy declaration at paragraph 23). The Director has reviewed the entire record, and has determined that there is a substantial new question of patentability presented by the teachings of Offer for these reasons.

Regarding the FR reference, review of the specification and prosecution history of the '864 patent clearly indicates that the invention of the '864 patent was allowed because of the claim limitations pertaining to the cast having a generally fixed radius of curvature in the range of at least about 5-60 inches or the limitation of said shape memory being in a shape of a waveform with maximum amplitude for each half cycle. As noted at page 14 of the petition, in the previous prosecution, FR did not teach specific dimensions of the radius of curvature. The newly cited references of GasTech, PROSTAR, Weldpoint, C.I.F.E., Rushforth, Corbin, Asano, JP and Offer teach these specific dimensions and are proposed by the requester to be considered in combination with FR. More specifically, at pages 15-19 of the request, petitioner clearly sets forth the SNQ with relation to each cited reference and the claim charts further describe the combination of those references with FR. Therefore, the record does not reflect that this issue of patentability was fully considered and decided by the examiner in the previous examination. In other words, the requester has proposed FR in combination with GasTech, PROSTAR, Weldpoint, C.I.F.E., Rushforth, Corbin, Asano, JP and Offer and, because GasTech, PROSTAR, Weldpoint, C.I.F.E., Rushforth, Corbin, Asano, JP and Offer are newly cited references, this combination was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Accordingly, the requester has presented the teachings of FR in "a new light" that was not considered by the examiner in the previous examination.

Accordingly, a reasonable examiner would consider evaluation of Offer and FR as important in determining the patentability of claims 1-8 and 11-15. As such, it is agreed with petitioner that Offer and FR raise a SNQ with respect to claims 1-8 and 11-15 of the '864 patent.

Because it is agreed that Offer and FR raise a SNQ with respect to claims 1-8 and 11-15 of the '864 patent, the Petition is GRANTED.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *inter partes* reexamination of claims 1-8 and 11-15 of the '864 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. An Office action on the merits will follow in due course.

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

Irem Yucel
Director
Central Reexamination Unit

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CENTRAL REEXAMINATION UNI

McDermott Will & Emery LLP 600 13th Street, N.W. Washington, D.C. 20005-3096	: : :	(For Third Party Requester)

In re Ferguson, III et al. *Inter Partes* Reexamination Proceeding Control No. 95/000,622 Filed: April 15, 2011 For: U.S. Patent No. 6,820,454	: : : : :	DECISION ON PETITION UNDER 37 CFR 1.181 & 1.927

The paper filed by requester on July 13, 2011, entitled "Petition Under 37 C.F.R. § 1.927 Seeking Review of the Denial of the Request for *Inter Partes* Reexamination," is being treated as a petition Under 37 CFR 1.181 and 1.927 (hereinafter the Petition). The Petition is before the Group Director overseeing the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination mailed June 13, 2011.

The Petition is **GRANTED**.

REVIEW OF FACTS

1. U.S. Patent No. 6,802,454 (hereinafter, the '454 patent) issued on November 23, 2004.

2. A complete request for *inter partes* reexamination was deemed to have been filed by a third party requester on April 15, 2011. The resulting reexamination proceeding was assigned Control No. 95/000,622 (hereinafter, the '622 proceeding).

3. Reexamination was requested for claims 1-25 of the '454 patent.

4. A Notice of Reexamination Request Filing Date was issued on April 20, 2011.

5. An order denying the request for reexamination for claims 1-25 was mailed on June 13, 2011.

6. On July 13, 2011, the third party requester filed the present Petition under 37 CFR §§ 1.181 and 1.927.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the teachings of U.S. Patent No. 6,301,944 to Offer (hereinafter "Offer") does not raise a substantial new question of patentability (SNQ). The petitioner also advances the examiner incorrectly concluded that the teachings of French Patent 2,055,181 (hereinafter "FR") do not raise a SNQ. The examiner determined that Offer did not raise a SNQ because Offer does not show 1) imparting a desired shape memory in generally a wave form and 2) a cast of a radius of curvature of at least about 15 inches. The examiner determined that FR did not raise a SNQ because application of the claims' radius of curvature dimensions to the teachings of FR would result in unreasonably large diameters of the weld wire and thus the results would not meet the "at least three undulation peaks" teaching of FR.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-25 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-25 of the '864 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents

or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

On September 4, 2008, the Court of Appeals for the Federal Circuit issued a decision that discussed the meaning of a substantial new question of patentability. See *In re Melvin J. Swanson and Patrick E. Guire* (CAFC 2007-1534). In this decision, the court found that the Office did not err in determining that Deutsch, which was applied in a rejection under 35 U.S.C. § 103 as a secondary teaching reference in the previous examination, raised a substantial new question of patentability based on anticipation. Specially, the court stated that "[i]n light of the extremely limited purpose for which the examiner considered Deutsch in the initial examination, the Board is correct that the issue of whether Deutsch anticipates the method disclosed in claims 22, 23, and 25 was a substantial new question of patentability, never before addressed by the PTO." The court also stated that:

> As the legislative history clarifies, to decide whether a reference that was previously considered by the PTO creates a substantial new question of

[1] Public Law 96-517, enacted on December 12, 1980.

> patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose. See H.R. Rep. No. 107-120, at 3 ("The appropriate test to determine whether a 'substantial new question of patentability' exists should not merely look at the number of references or whether they were previously considered or cited but their combination in the appropriate context of a new light as it bears on the question of the validity of the patent."); see also 147 Cong. Rec. H5359 (statement of Rep. Berman) ("Ideally, a reexamination could be requested based on prior art cited by an applicant that the examiner failed to adequately consider . . . .").
>
> Determining the scope of an examiner's previous consideration of a reference will generally require an analysis of the record of the prior proceedings to determine if and how the examiner used the reference in making his initial decisions.

III. Analysis of the Request for Reexamination

The Request sets forth multiple proposed SNQ, which all have either Offer or FR as a reference applied (see, e.g., pages 3-5 of the denial mailed June 13, 2011).

The Request was denied in the June 13, 2011Order Denying Request for *Inter Partes* Reexamination, wherein the examiner maintained that a SNQ was not raised by the references cited in the Request. The examiner determined that the teachings of Offer did not teach the features of the independent claims (e.g., imparting a desired shape memory in generally a wave form and a cast of a radius of curvature of at least about 15 inches) (see pages 5-22 of the denial mailed June 13, 2011). The examiner also determined that application of the claims' radius of curvature dimensions to the teachings of FR would result in unreasonably large diameters of the weld wire and thus the results would not meet the "at least three undulation peaks" teaching of FR (see pages 22-33 of the denial mailed June 13, 2011).

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The Group Director overseeing the CRU reviews the request *de novo* in response to the Petition, and such a review of the record, as a whole, has been made in this case.

Turning to the request, regarding the Offer reference, the request states that Offer teaches a wire having a shape memory generally in a waveform (see page 15 of the request). The petition further points out that Offer's disclosed apparatus and method produce a wire "W" having a linear cast in the form of generally a wave form (see pages 6-7 of the petition). The request and petition are further supplemented by the Declaration of Peter Savoy (hereinafter "the Savoy declaration"), at paragraphs 9-16. Furthermore, both the request and the petition state that Offer teaches a wire that retains the undulating curve after casting and unwinding (see page 17 of the request and pages 6-7 and 9 of the petition). The Savoy declaration further supports this argument at paragraph 18. Finally, the request and petition state that Offer teaches a linear cast having a radius of curvature of at least about 15 inches (see page 17 of the

request and page 8 of the petition). This is further supported by the Savoy declaration at paragraph 23). The Director has reviewed the entire record, and has determined that there is a substantial new question of patentability presented by the teachings of Offer for these reasons.

Regarding the FR reference, the request states that FR is proposed to teach all of the claim limitations except the radius of curvature dimensions. As noted at page 17 of the petition, the newly cited references of C.I.F.E, GasTech, PROSTAR and Weldpoint teach these specific dimensions and are proposed by the requester to be considered in combination with FR. More specifically, at pages 15-19 of the request, petitioner clearly sets forth the SNQ with relation to each cited reference and the claim charts further describe the combination of those references with FR. A review of the request indicates that the examiner's application of the radius of curvature dimensions of the claims and subsequent conclusions were in error (see also pages 17-18 of the petition for a further explanation. Therefore, the Director concluses that there is a substantial new question of patentability presented by the teachings of FR for these reasons.

Because it is agreed that Offer and FR raise a SNQ with respect to claims 1-25 of the '454 patent, the Petition is GRANTED.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is GRANTED.

2. Accordingly, the request for *inter partes* reexamination of claims 1-25 of the '454 patent is GRANTED, and reexamination is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. An Office action on the merits will follow in due course.

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

Irem Yucel
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,624	04/06/2011	6,947,456	12000233-001-067	7270

57299 7590 11/15/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/15/2011

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

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

Date: MAILED
NOV 15 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000624
PATENT NO. : 6947456
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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FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007	: : : :	(For Patent Owner)
SNR DENTON US LLP P.O. BOX 061080 CHICAGO, IL 60606-1080	: : :	(For Third Party Requester)
In re: Chin et al. *Inter Partes* Reexamination Proceeding Control No.: 95/000,624 Deposited: April 8, 2011 For: U.S. Patent No.: 6,947,456	: : : : :	DECISION ON PETITION UNDER 37 CFR §§ 1.927 & 1.181

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CENTRAL REEXAMINATION UNIT

This is a decision on the petition filed by the third party requester on June 30, 2011, entitled "PETITION UNDER 37 CFR §§ 1.927 AND 1.181 FOR SUPERVISORY REVIEW OF REFUSAL TO ORDER REEXAMINATION FOR CLAIMS 1-20" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order mailed June 6, 2011, which denied the request for reexamination.

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

The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,947,456 issued on September 20, 2005.
- A request for *ex parte* reexamination was filed March 1, 2011 and assigned control no. 90/011,519. Reexamination was requested of claims 1-20, and the request was granted in an Order mailed April 15, 2011.
- A request for *inter partes* reexamination was filed April 6, 2011 and assigned control no. 95/000,624. Reexamination was requested of claims 1-20.
- In an Order mailed June 6, 2011, the *inter partes* request was denied.
- On June 30, 2011, the third party requester timely filed the instant petition requesting reconsideration of the denial of the request.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial

likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Additionally, the MPEP states:

> If a second or subsequent request for reexamination is filed (by any party permitted to do so) while a first reexamination is pending, the presence of a substantial new question of patentability depends on the art (patents and printed publications) cited by the second or subsequent request . . . . [I]f the subsequent request includes the art which raised a substantial new question in the earlier pending reexamination, then reexamination should be ordered only if the art cited raises a substantial new question of patentability which is different from that raised in the earlier pending reexamination. If the art cited in the subsequent request raises the same substantial new question of patentability as that raised in the earlier pending reexamination, the subsequent request should be denied. Where the request raises a different substantial new question of patentability as to some patent claims, but not as to others, the request would be granted in part . . . . If the subsequent request does not include the art which raised the substantial new question of patentability in the earlier pending reexamination, reexamination may or may not be ordered, depending on whether the different art cited raises a substantial new question of patentability.

MPEP § 2640.

Furthermore:

> If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided . . . (B) by the Office in a previous examination or <u>pending</u> reexamination of the patent. A "previous examination" of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in

> a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

MPEP § 2642(I) (emphasis added).

Thus, even if the references raise a substantial question of patentability, there is no substantial new question if the same question of patentability was already decided in a pending reexamination of the patent. The requester must therefore demonstrate that the patents and printed publications relied upon present a new question of patentability not considered in the earlier pending reexamination.

Summary of the Prior Prosecution with Respect to the '456 Patent

The '456 patent contains claims 1-20. After a long bout of prosecution the claims were ultimately allowed in a Notice of Allowability mailed March 29, 2005. The examiner stated as reasons for allowance that the prior art failed to disclose the claimed invention of the independent claims, particularly:

As to claim 1: "having in particular a memory storing a plurality of drive waveforms including at least one parameter for affecting the negative peaking portion of the drive waveform;"

As to claim 8: "having in particular a digital controller, which provides negative peaking adjustments to a waveform shaping circuit for driving a semiconductor laser;" and

As to claim 15: "having in particular the steps of employing a digital controller to access from the storage a first and second set of drive waveform parameters, which include at least one parameter for affecting the negative peaking portion of the drive waveform."

Furthermore, in reexamination proceeding 90/011,519 a substantial new question of patentability was raised as to claims 1-20 by various references. In that proceeding, a reference to Bruensteiner was relied on to teach the above noted limitations. Additionally, the references to Heilman and Wang were relied upon to teach the alleged known benefits of the known technique of employing digital control of negative peaking. *See, e.g.*, '11519 Request p. 358.

Decision on the Request for Reexamination

The Request proposes that a substantial new question of patentability is raised as to claims 1-20 based on prior art applied in numerous different proposed rejections. Claims 1-20, however, have already been rejected in pending reexamination 90/011,519 as being anticipated and

obvious over various prior art, including Bruensteiner, which allegedly teaches what was missing during the original prosecution. The examiner has therefore already decided the question of whether claims 1-20 are patentable over art that teaches what was missing during the original prosecution. The proposals in the instant Request are likewise asking the Office to decide that claims 1-20 are unpatentable over art including the same new technical teaching—art that allegedly includes the "negative peaking" limitations. The proposals are therefore asking the Office to decide the same thing that it already decided—the question of the patentability of claims 1-20, in favor of the claims being unpatentable and in view of art that shows the features missing during the original examination. This is not a new question of patentability, it is the same question that is already at issue in the pending proceeding.

Additional explanation of whether there is a substantial question of patentability is given in the MPEP: "A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable." MPEP § 2642(I). A reasonable examiner is less likely to deem a reference important in deciding patentability of a claim when there are already other references (for example, here, Bruensteiner) that render the claim unpatentable. MPEP § 706.02(I). instructs the examiner to confine her rejections to the best available art, unless certain exceptions apply. Absent an exception, once art is found that supports a rejection, the examiner will give much less importance to additional art that may also support a rejection. As there is already art in the pending reexamination that supports a rejection, a reasonable examiner will give much less importance to other art, such as that presented in the instant proceeding, that may also support a rejection. There is no indication that the art in the pending reexamination falls under any of the exceptions of MPEP § 706.02(I). This weighs against there being a "substantial likelihood that a reasonable examiner would consider the [art] important in deciding whether the claim is patentable," further weighing against a finding that there is a substantial question of patentability.

Accordingly, the Director finds that the question of the patentability of claims 1-20 of the '456 patent has already been decided in a pending reexamination in favor of claims 1-20 being unpatentable. The proposals suggesting that claims 1-20 are unpatentable are therefore not a new question of patentability different than that already decided. Reexamination is therefore <u>denied</u>.

<u>Response to the Petition</u>

Even with the Director's *de novo* review set forth above, petitioner sets forth arguments why reexamination should be granted. Petitioner argues that the teachings of Siegel, Stronczer, Shang, Heilman and Wang are different than those of Bruensteiner, therefore the teachings presented in the Request are different and non-cumulative to those presented in the '11519

proceeding. More particularly, petitioner argues that these references differ because they provide parameters which affect the negative peak portion of a drive waveform without affecting the positive peak portion. While the underlined is not a part of the claims, petitioner argues the patent owner may argue that the claim construction requires the underlined, that Bruensteiner's parameter does affect the positive peak portion, therefore the present references are different from and not cumulative to Bruensteiner.

This argument is not persuasive. As just stated, the underlined part above is not present in the claims, and was not a part of the original examiner's reasons for allowance. Such a difference in the references would therefore not have been important to a reasonable examiner in determining the patentability of the claims in any way different than Bruensteiner, because there was no indication that such features would matter to patentability. That is, there is no indication that the underlined and unclaimed portion had any bearing on patentability, so the fact that new references provide such teaching is not a new technical teaching relevant to the claimed invention or to patentability.[1] Accordingly, each of Bruensteiner and the new references provides the same new technical teaching with respect to the original examination.

Petitioner's citation to a petition decision from 95/001,461 does not change the result. In that decision the undersigned determined that two combinations of references differed from the implicit combination in the original prosecution including the Sonada reference. Sonada was silent as to a particular limitation, and the original examiner found the feature to be obvious in Sonada, but declined (without explanation) to combine the reference with another reference, WO525. The two new references explicitly taught the limitation as well as a motivation to use it, and it was determined that combining those reference with WO525 raised a new question of patentability in light of the new explicit teachings and clear motivation to combine. Petitioner argues that in the same way the alleged new teachings of the underlined portion mentioned above means the newly cited reference are not cumulative.

Even if unrelated petition decisions were controlling, this one is not as the facts are distinguishable. In '1461, the new references taught claimed material that was not explicitly present in the original reference, along with reasons to combine with another reference. Here, the new references are alleged to teach new unclaimed material in addition to the claimed material that was already present in the original reference. It is apparent that this is simply a different situation than '1461.

---

[1] If it is determined in the '11519 proceeding that the underlined portion is required in the claims, and they are allowed over Bruensteiner for that reason, then such new references *might* then raise an SNQ. References teaching the underlined feature might then be a new technical teaching making the reference important to a reasonable examiner when considering the patentability of the claims viewed in light of the findings of the '11519 proceeding. Of course, none of that has happened yet and is therefore not relevant at present.

Accordingly, because the proposals do not raise a substantial new question of patentability, the request for reexamination of claims 1-20 of the '456 patent is denied. Petitioner's additional arguments for ordering *inter partes* reexamination are not persuasive, and the petition filed June 30, 2011 is denied.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is denied. Accordingly, the request for *inter partes* reexamination of claims 1-20 of the '456 patent is denied.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. This decision has no impact on reexamination proceeding 90/011,519, which remains pending.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,634	05/20/2011	7,461,353	18157.0045.353	8853

29000 7590 12/13/2011

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA ST., FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

DEC 1 3 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000634
PATENT NO. : 7461353
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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DEC 1 3 2011

CENTRAL REEXAMINATION UNIT

IRELL & MANELLA LLP : (For Patent Owner)
1800 AVENUE OF THE STARS :
SUITE 900 :
LOS ANGELES, CA 90067 :

NOVAK DRUCE & QUIGG : (For Third-Party Requester)
(NDQ REEXAMINATION GROUP) :
1000 LOUISIANA ST., FIFTY-THIRD FLOOR :
HOUSTON, TX 77002 :

In re ROHRABAUGH : DECISION ON
Reexamination Proceeding : PETITION ON ORDER
Control No. 95/000634 : DENYING *EX PARTE*
Request Deposited: May 20, 2011 : REEXAMINATION
For: U.S. Patent No.7,461,353 :

This is a decision on the petition filed on September 08, 2011 by which Third Party Requester requests review of the Examiner's determination refusing ex parte reexamination of claims 5, 23-27, 33, 43, 58-61, 84, 122, 137-141, 147, 156, 174-177, 183, 220, 238-242, 248, 259, 274-277 and 283 of US Patent No 7,461,353 under 37 CFR 1.927. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 7,461,353 was ordered in the Order mailed August 08, 2011.

2. The Order determined that a substantial new question (SNQ) of patentability existed with respect to claims 1-4, 6-22, 28-32, 34-42, 44-57, 62-83, 85-121, 123-136, 142-146, 148-155, 157-173, 178-182, 184-219, 221-237, 243-247, 249-258, 260-273, 278-282 and 284-319 and did not exist with respect to claims 5, 23-27, 33, 43, 58-61, 84, 122, 137-141, 147, 156, 174-177, 183, 220, 238-242, 248, 259, 274-277 and 283.

3. A non-final action was mailed on September 30, 2011. On page 2 of this action, the examiner notes that after reconsideration all claims requested for re-examination have been brought into the proceeding.

DECISION

37 CFR 1.927 states:

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

In view of the relevant facts above, the examiner has entered all requested claims into the reexamination proceeding.

Accordingly, the request for review of refusal to order inter partes reexamination is moot.

CONCLUSION

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

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered

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

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for

reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,633	05/24/2011	7,629,705	1299600.00197US1	2639

23483 7590 08/12/2011

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/12/2011

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

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United States Patents and Trademark Office
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Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, LLP
1940 DUKE STREET
ALEXANDRIA, VA 22314

Date:

MAILED

AUG 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000633
PATENT NO. : 7629705
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.: 95/000,633 –Clarification of Decision

1. THIS IS A DECISION ON THE PETITION FILED 04 August 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 27 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by one (1) month.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☐ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,635	05/23/2011	7831926	8157.045.IP926	4626

29000 7590 12/13/2011

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date: 12-13-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000635
PATENT NO. : 7831926
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

IRELL & MANELLA LLP	: (For Patent Owner)
1800 AVENUE OF THE STARS	:
SUITE 900	:
LOS ANGELES, CA 90067	:
NOVAK DRUCE & QUIGG	: (For Third-Party Requester)
(NDQ REEXAMINATION GROUP)	:
1000 LOUISIANA ST., FIFTY-THIRD FLOOR	:
HOUSTON, TX 77002	:

In re ROHRABAUGH	: DECISION ON
Reexamination Proceeding	: PETITION ON ORDER
Control No. 95/000635	: DENYING *EX PARTE*
Request Deposited: May 23, 2011	: REEXAMINATION
For: U.S. Patent No.7,831,926	:

This is a decision on the petition filed on September 08, 2011 by which Third Party Requester requests review of the Examiner's determination refusing ex parte reexamination of claims 1-51, 59, 69 and 72 of US Patent No 7,831,926 under 37 CFR 1.927. The petition is considered pursuant to 37 CFR 1.181; No fee is required.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

1. Reexamination of U.S. Patent No. 7,831,926 was ordered in the Order mailed August 08, 2011.

2. The Order determined that a substantial new question (SNQ) of patentability existed with respect to claims 52-58, 60-68, 70-71 and 73-88 and did not exist with respect to claims 1-51, 59, 69 and 72.

3. A non-final action was mailed on October 1, 2011. On page 2 of this action, the examiner notes that after reconsideration all claims requested for re-examination have been brought into the proceeding.

DECISION

37 CFR 1.927 states:

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

In view of the relevant facts above, the examiner has entered all requested claims into the reexamination proceeding.

Accordingly, the request for review of refusal to order inter partes reexamination is moot.

CONCLUSION

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

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered

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

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

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

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

for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director, Central Reexamination Unit

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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,636	06/29/2011	7014012	5594-110342	8794

23589 7590 04/19/2012

Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
Overland Park, KS 66210

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Paul M. Reznick
THE WEBB LAW FIRM, PC., One Gateway Center
420 Ft. Duquesne Blvd., Suite 1200
Pittsburgh, PA 15222

Date: MAILED

APR 19 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000636
PATENT NO. : 7014012
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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Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
Overland Park KS 66210

(For Patent Owner)

MAILED

APR 19 2012

CENTRAL REEXAMINATION UNIT

The Webb Law Firm
One Gateway Center
420 Fort Duquesne Blvd.
Suite 1200
Pittsburgh, PA 15222

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/000,636
Filed: June 29, 2011
For: U.S. Patent No. 7,014,012

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

This is a decision on patent owner's paper entitled, "PATENT OWNER'S PETITION FOR WAIVER OF 37 C.F.R. § 1.955 FOR AN INTERVIEW," filed on December 22, 2011.

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

The petition is dismissed.

Third party requester's counsel is called upon to clarify the record with regard to the authority of the signatory on the September 7, 2011 letter to represent and bind the requester in the '636 proceeding with respect to withdrawal from further participation in the present proceeding.

BACKGROUND

1. On March 21, 2006, U.S. Patent No. 7,014,012 ("the '012 patent") issued to Baker.

2. On June 29, 2011, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/000,636 ("the '636 proceeding").

3. On August 11, 2011, reexamination was ordered in the '636 proceeding. Concurrently the Office issued a first non-final Office action on the merits in the '636 proceeding.

4. On September 7, 2011, third party requester filed a paper advising the Office that requester will not further participate in the '636 proceeding.

5. On October 11, 2011, patent owner timely filed a response to the August 11, 2011 Office action.

6. On December 8, 2011, the Office issued an Action Closing Prosecution (ACP) in the '636 proceeding.

7. On December 22, 2011, patent owner filed the instant petition paper entitled "PATENT OWNER'S PETITION FOR WAIVER OF 37 C.F.R. § 1.955 FOR AN INTERVIEW."

8. On February 7, 2012, patent owner filed a paper entitled "RESPONSE BY PATENT OWNER PURSUANT TO 37 C.F.R. §1.951," responsive to the December 8, 2012 ACP.

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 December 22, 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 September 7, 2011 withdrawal from participation in the '636 proceeding.[1]

[1] Patent Owner petition filed December 22, 2011 at page 3.

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 advancing prosecution because (1) the December 8, 2011 Office action is non-final; (2) petitioner can submit evidence during the interview; (3) petitioner would be able to discuss the December 8, 2011 Office action rejection clarifications.[5] Finally patent owner asserts that by allowing patent owner to discuss the merits of the proceeding in an interview, patent owner will have a declarant render a presentation with regard to their previously submitted declaration.[6] Accordingly, patent owner requests waiver of 37 CFR 1.955 and an interview with the examiner.

No specific and relevant technical features are identified as being at issue in the proceeding for discussion in the interview. Nor are any specific rejection(s), claim language or prior art of record are cited by patent owner, which will be discussed in the interview. Further, an interview does not serve as a mechanism for the submission into the record of evidence in circumvention of the rules that govern the timing of evidence submissions. The record reflects that an ACP has issued in the '636 proceeding, therefore while non-final, the entry of evidence is not a matter of right and must be in accordance with 37 CFR 1.116(e).[7]

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, a paper purported to be a statement by third party requester that it is withdrawing from the '636 *inter partes* reexamination proceeding was submitted by counsel for third party

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[2] Patent Owner petition filed December 22, 2011.
[3] Id.
[4] Id. at pages 3-4. See 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.
[5] See petition, section B at pages 4-5.
[6] Id. at page 5.
[7] In extraordinary circumstances where justice requires, patent owner may petition for waiver of any rule that prevents the entry of evidence into the record.

requester.[8] Thus, only a single party (patent owner) will now participate in the '636 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 it is permissible to permit the conduct of an interview rather than closing prosecution.[9]

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 as the present proceeding in *inter partes* reexamination control 95/000,274 (the '274 proceeding). Patent owner, cites to the proceeding in general and includes an excerpt of the Office decision to support the contention that an interview should be granted in the present proceeding.[10] Patent owner does not provide any of the facts and circumstances regarding the '274 proceeding incident with the granted decision, and makes no correlation of the facts between the present proceeding with the cited proceeding. The Office is not bound by prior decisions, as all matters are addressed and resolved on a case-by-case basis. 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 on the record and would not be prejudiced by the conduct of an interview. The present proceeding's record does not contain an express waiver of all rights by the third party requester. Due to the absence of an express waiver of all rights and because the authority to the signatory of the September 7, 2011 third party requester paper to discharge the rights of the third party is unknown, patent owner has not demonstrated that the requester would not be prejudiced by the conduct of the interview.

Furthermore, patent owner has not focused the matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner has not identified (1) the specific and relevant technical features that are at issue for discussion in the interview; (2) specific rejections, claim language or prior art of record for discussion in the interview; and (3) the specific declaration that is already of record, and the additional evidence the December 22, 2011 petition alludes to if entry is obtained,[11] and how the evidence supports whatever patent owner's position(s) of patentability are that will be discussed during an interview. Accordingly, patent owner has not sufficiently focused the issues to be addressed at the interview, and instead has expressed merely a general intent to discuss any random issue of patentability at the time of the interview.

---

[8] *See* September 7, 2011, counsel for third party requester filed a letter stating only that Requester ". . . wishes to advise the U.S. Patent Office that it will not be participating in any Inter Partes Reexamination that might be ordered in the above references Inter partes proceeding request." The September 7, 2011 third party requester withdrawal paper is not signed by a registered practitioner and the signature on the submission includes only the name of the signatory, with no title information or relationship to the third party requester. The third party requester letter does include the registered trademark and business contact information of the third party requester. Papers that were concurrently filed with the September 7, 2011 withdrawal paper do include the signature of registered counsel for third party requester. Neither party has provided any documentation of the alleged settlement agreement 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. However, both parties have alluded to the existence of a settlement agreement that requires requester to withdraw from the '636 proceeding, but a copy of the pertinent part of the settlement agreement has not been provided. Patent owner has provided a joint stipulation for dismissal with prejudice and the Court's responsive Order dismissing the related litigation with prejudice.

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

[10] Petition at pages 3-4.

[11] In accordance with 37 CFR 1.116(e).

Should patent owner correct the matters identified immediately above, it may be found that permitting a single interview to be conducted at this point in the '636 *inter partes* proceeding may well 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, given the Office's statutory requirement (35 U.S.C. § 314(c)) to conduct 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.

2. Any renewed petition must be filed within two (2) months of this decision, to assure that an Office action is not issued without the requested interview after ACP.

3. Third party requester's counsel is given one (1) month to submit a response to clarify the status of the requester and inform the Office regarding the requester's continued participation in the proceeding.

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

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

April 18, 2012

[12] The '636 proceeding appears ready for examiner action following patent owner's August 24, 2011 response to the June 24, 2011 ACP.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,647	10/07/2011	757064	SIRF-169REX	6409

29989 7590 02/15/2012

HICKMAN PALERMO TRUONG & BECKER, LLP
ONE ALMADEN BOULEVARD
FLOOR TWELVE
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/15/2012

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RATNER/PRESTIA
P O BOX 980
VALLEY FORGE, PA 19482

Date: MAILED
FEB 15 2012
CENTRAL REEXAMINATIO

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000647
PATENT NO. : 7570614
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.: 95/000,647

MAILED

FEB 15 2012

CENTRAL REEXAMINATION

1. THIS IS A DECISION ON THE PETITION FILED: 10 February 2012.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Notice of Appeal dated 05 January 2012 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☒ Other/comment: see attachment.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Sudhanshu Pathak at 571-272-5509, Supervisory Patent Reexamination Specialists in the Central Reexamination Unit.

/Mark Reinhart/ [*Signature*]	SPRS, AU 3992 Central Reexamination Unit (Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with "special dispatch" the Office must fully consider the facts presented in any petition for extension of time. The petition speaks to the considerations of other concurrent proceedings before counsel, the extensive length and complexity of the Office action.

Pursuant to MPEP § 2665 (in part) Extension of Time (in-part)

> "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added)

On balance there is "sufficient cause" to grant-in-part the extension of time for one (1) month. When balanced between the need for "special dispatch" and the opportunity for a patent owner to fully respond to the issues outstanding the breadth and complexity of the Office actions does support "sufficient cause" for granting-in-part the petition for extension of time.

The petition for extension of time is hereby granted-in-part for one (1) month.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,648	10/27/2011	7027418	SIRF-170REX	7148

29989 7590 02/15/2012

HICKMAN PALERMO TRUONG & BECKER, LLP
ONE ALMADEN BOULEVARD
FLOOR TWELVE
SAN JOSE, CA 95113

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/15/2012

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Date: MAILED
FEB 15 2012
CENTRAL REEXAMINATION

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000648
PATENT NO. : 7027418
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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Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,648
	FEB 15 2012

CENTRAL REEXAMINATION

1. THIS IS A DECISION ON THE PETITION FILED: 10 February 2012.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Notice of Appeal dated 12 January 2012 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

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

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☒ Other/comment: see attachment.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Sudhanshu Pathak at 571-272-5509, Supervisory Patent Reexamination Specialists in the Central Reexamination Unit.

/Mark Reinhart/	SPRS, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with "special dispatch" the Office must fully consider the facts presented in any petition for extension of time. The petition speaks to the considerations of other concurrent proceedings before counsel, the extensive length and complexity of the Office action.

Pursuant to MPEP § 2665 (in part) Extension of Time (in-part)

> "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added)

On balance there is "sufficient cause" to grant-in-part the extension of time for one (1) month. When balanced between the need for "special dispatch" and the opportunity for a patent owner to fully respond to the issues outstanding the breadth and complexity of the Office actions does support "sufficient cause" for granting-in-part the petition for extension of time.

The petition for extension of time is hereby granted-in-part for one (1) month.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,652	11/29/2011	7448100	R018-7000-REX	7907

69638 7590 04/02/2012

KAMRATH IP Lawfirm, P.A.
4825 OLSON MEMORIAL HIGHWAY
SUITE 245
GOLDEN VALLEY, MN 55422

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/02/2012

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Date: 4-2-12

Edmund J. Walsh
WOLF GREENFIELD & SACKS, P.C
600 Atlantic Avenue
Boston, MA 02210-2206

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000652
PATENT NO. : 7448100
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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KAMRATH IP Lawfirm, P.A. (For Patent Owner)
4825 OLSON MEMORIAL HIGHWAY
SUITE 245
GOLDEN VALLEY, MN 55422

WOLF GREENFIELD & SACKS, P.C. (For Third Party Requester)
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Inter Partes Reexamination Proceeding
Control No. 95/000,652
Filed: November 29, 2011
For: U.S. Patent No. 7,448,100

DECISION
DISMISSING
PETITION

This is a decision on the requester's November 29, 2011 petition paper entitled "PETITION UNDER 1.182 FOR ENTRY OF AN EXHIBIT WITH COLOR SHADING".

The petition under 37 CFR 1.182 is dismissed, for the reasons set forth herein.

BACKGROUND

1. On November 11, 2008, United States Patent No. 7,448,100 (the '100 patent) issued to Lung-Tan Shih.

2. On November 29, 2011, a request for *inter partes* reexamination of the '100 patent was filed by a third party requester, concurrently with a petition paper entitled "PETITION UNDER 1.182 FOR ENTRY OF AN EXHIBIT WITH COLOR SHADING" (petition under 37 CFR 1.182). The request was assigned Reexamination Control No. 95/000,652 (the '652 proceeding).

3. On January 7, 2012, the Office issued an order granting *inter partes* reexamination in the '652 proceeding, concurrently with a non-final Office action.

DECISION

I. Relevant Authority

37 CFR 1.91(a) provides:

> A model or exhibit will not be admitted as part of the record of an application unless it:
> (1) Substantially conforms to the requirements of § 1.52 or § 1.84;
> (2) Is specifically required by the Office; or
> (3) Is filed with a petition under this section including:
> (i) The fee set forth in § 1.17(h); and
> (ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

37 CFR 1.84 provides in-part (emphasis added):

> (a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.
>
> ****
>
> (2) *Color*. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:
> (i) The fee set forth in § 1.17(h);
> (ii) Three (3) sets of color drawings;
> (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings: The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.
>
> (b) *Photographs*.—
>
> ****
>
> (2) *Color photographs*. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

II. Requester's petition under 37 CFR 1.182

In the instant petition under 37 CFR 1.182, requester requests that "Optional Exhibit A, containing drawings with color shading, be accepted as part of the file of this reexamination."[1] Requester states that "[t]he drawings are shaded in color to show correspondence between structural features of the '100 patent and the prior art," and that "having such drawings available to the Examiner should enhance the Examiner's understanding of the grounds of rejection presented in the Request and expedite review of the Request."[2] Finally, the requester states that "granting this petition would promote the Office's ability to comply with its obligation to conduct reexamination proceedings with special dispatch."[3]

While there is no regulatory provision for entry of a exhibit containing color shading in a reexamination proceeding, 37 CFR 1.91 provides an analytical framework for such entry in that it provides for entry of exhibits that substantially conform to the requirements of 37 CFR 1.84 in applications. Under § 1.84, the Office will accept color drawings in applications only after granting a petition that explains why color is necessary,[4] and that includes the petition fee and three sets of color drawings/photographs.[5] The requirement for three sets of color drawings under 37 CFR 1.84(a)(2)(ii), however, is not applicable to color drawings submitted via EFS-Web and only one set of such color drawings is necessary when filing color submissions via EFS-Web.[6] Color submissions filed via EFS-Web in PDF format are maintained in SCORE and a black and white copy will be stored in the image file wrapper (IFW) along with a SCORE placeholder sheet.[7] In this instance, because the color submission was not filed via EFS-Web, an artifact folder containing the color submission has been created.[8]

In this instance, the requester has filed the instant petition under 37 CFR 1.182, requesting entry of the color submission, including the petition fee and three sets of the color drawings; however, the requester does not state that color is necessary in this instance. Rather, the requester merely states that the color drawings should enhance the examiner's understanding of the proposed grounds of rejection set forth in the request. Further, the request for *inter partes* reexamination filed on November 29, 2011 does not rely on the color submission, as the color submission was filed only as an "optional exhibit" to supplement to the request. Thus, based on the facts and circumstances in this instance, the requester has not demonstrated "why color is necessary" pursuant to 37 CFR 1.84. Accordingly, the instant petition under 37 CFR 1.182 <u>is dismissed</u>.

---

[1] *See* petition under 37 CFR 1.182 at page 1.
[2] *Id.*
[3] *Id.*
[4] *See* 37 CFR § 1.84(b)(2); 37 CFR § 1.84(a)(2); MPEP 608.02 (VIII); *see also* 502.05(VIII)(C) (stating "[f]or color drawings, a petition filed under 37 CFR 1.84(a)(2) explaining why the color drawings are necessary is *required*").
[5] When color drawings are filed in applications, 37 CFR 1.84 also requires an amendment to the specification indicating that at least one drawing is in color. The requirement to amend the specification is not applicable to a color submission filed as part of an exhibit because the color drawings will not become part of the patent.
[6] *See* MPEP 502.05(VIII)(C).
[7] See *Legal Framework for Electronic Filing System-Web (EFS-Web)*, 74 FR 55200, 55202 and 55208 (October 27, 2009).
[8] *See* MPEP 608.02 (VIII). *See also* November 29, 2011 artifact sheet indicating receipt of color documents that have not been scanned and creation of an artifact folder containing the color documents (95000652CA).

PATENT OWNER'S ADDRESS

Different patent owner addresses are of record for the patent and the reexamination proceeding. On February 21, 2012, patent owner filed a "Revocation of Power Of Attorney with a New Power Of Attorney and Change of Correspondence Address" in the '652 proceeding. The paper requested that the address associated with Customer No. 54604 be recognized as the correspondence address for the '652 reexamination proceeding. On February 22, 2012, the Office mailed a "notice of Acceptance of Power of Attorney."

Patent owner's February 21, 2012 paper was not effective to change the correspondence address of record for the '652 proceeding. See *Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*, 72 Fed. Reg. 18892 (April 16, 2007) (final rule) (stating, "The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to § 1.33(c), automatically changed to that of the patent file..."). The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Kamrath IP Lawfirm, P.A., 4825 Olson Memorial Highway, Suite 245, Golden Valley, MN 55422.

Accordingly, all future correspondence will be directed to, and service on patent owner should also be directed to, Kamrath IP Lawfirm, P.A., 4825 Olson Memorial Highway, Suite 245, Golden Valley, MN 55422. A courtesy copy of the instant decision is being provided to the address specified in patent owner's February 21, 2012 paper.

CONCLUSION

1. Requester's November 29, 2011 petition under 37 CFR 1.182 is dismissed.

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

03-30-2012

Cc: Kamrath & Associates P.A.
4825 Olson Memorial Highway
Suite 245
Golden Valley, MN 55422

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,657	01/19/2012	6366130	19968-0006RX1	8472

74642 7590 04/13/2012

CLIFFORD H. KRAFT
320 ROBIN HILL DR.
NAPERVILLE, IL 60540

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2012

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MINNEAPOLIS, MN 55440-1022

Date: APR 13 2012

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000657
PATENT NO. : 6366130
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	95/000,657

MAILED

APR 13 2012

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED: 06 April 2012.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

   Patent owner requests that the period for responding to the Office action dated 02 March 2012 which sets a two (2) month period for filing a response to the Office action, be extended by one (1) month.

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

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

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his absence, calls may be directed to Sudhanshu C Pathak at 571-272-5509 in the Central Reexamination Unit.

/Mark Reinhart/ [*Signature*]	SPRS, AU 3992 Central Reexamination Unit (Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. The petition seeks reconsideration of an earlier petition for extension of time.

The patent owner states that the action was not timely forwarded by the "correspondence" attorney. The action was mailed to the address of record. Further, all reexamination proceedings are available via Public Pair and could have been accessed at any time.

On balance there is not "sufficient cause" for granting an extension of time.

The petition for extension of time is hereby dismissed.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,008	10/01/2007	6715020	38512.13	5604

22852 7590 10/15/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/15/2010

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.
95/001,008	10/01/07	6715020	3851213

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

DATE MAILED:

OCT 15 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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Naveen Modi
Finnegan, Henderson et al., LLP
901 New York Avenue, NW
Washington, DC 20001-4413

(For Patent Owner)

MAILED

OCT 15 2010

CENTRAL REEXAMINATION UNIT

David L. McCombs, Esq.
Hayes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Requester)

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,008
Filed: October 1, 2007
For: U.S. Patent No. 6,715,020

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "SECOND RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on July 30, 2010.

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

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

REVIEW OF THE RELEVANT FACTS

1. On March 30, 2004, U. S. Patent No. 6,715,020 (the '020 patent) issued to Farmwald *et al.*

2. On October 1, 2007, a request for *inter partes* reexamination of the '020 patent, assigned Reexamination Control No. 95/001,008 (the '1008 proceeding), was filed by a third party requester.

3. On December 19, 2007, the Office issued an order granting *inter partes* reexamination in the '1008 proceeding, stating that an Office action on the merits would be issued in due course.

4. On February 25, 2008, the Office issued a non-final Office action on the merits in the '1008 proceeding.

5. The proceeding progressed until, on December 11, 2009, the Office issued an Action Closing Prosecution (ACP).

6. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1008 proceeding.

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a petition under 37 CFR 1.183).

8. On April 20, 2010, the Office mailed a decision dismissing patent owner's February 25, 2010 petition under 37 CFR 1.183.

9. On May 3, 2010, patent owner filed a renewed petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a renewed petition under 37 CFR 1.183).

10. On July 8, 2010, the Office mailed a decision dismissing patent owner's May 3, 2010 renewed petition under 37 CFR 1.183.

11. On July 30, 2010, patent owner filed the present second renewed petition paper entitled "SECOND RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a renewed petition under 37 CFR 1.183).

12. On August 8, 2010, the Office issued a Right of Appeal Notice (RAN), withdrawing all outstanding rejections and confirming the patentability of all the claims being reexamined.

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.

In the July 30, 2010 second renewed 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 February 11, 2010 withdrawal from participation in the '1008 proceeding.[1] In the second renewed petition patent owner has responded to the July 8, 2010 Office decision by providing a summary of the current state of the proceedings, a list of issues to be addressed in any granted interview and supporting arguments to show that given the nature of the issues an interview would enhance an understanding of the issues and advance prosecution. 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.

Since the filing of the second renewed petition, the Office has issued a RAN confirming patentability of all the claims. Therefore the issues to be discussed justifying waiver of the rule and granting an interview no longer exist. In view of this fact the '1008 proceeding can no longer present an extraordinary situation that justifies waiver of 37 CFR 1.955 to further the interest's justice. Thus, patent owner's second renewed petition under 37 CFR 1.183 is dismissed as moot.

CONCLUSION

1. Patent owner's July 30, 2010 renewed petition is dismissed as moot.

2. Any questions concerning this communication 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

10-14-10

[1] Petition under 37 CFR 1.183 at page 3.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,009	10/11/2007	6939052	3744/1	6268

7590 08/06/2010

JAMES M. HARRINGTON
THE HARRINGTON PRACTICE PLLC
10130 MALLARD CREEK ROAD,
SUITE 110
CHARLOTTE, NC 28262-6001

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
W. THAD ADAMS, III ADAMS EVANS P.A.
2350 CHARLOTTE PLAZA,
201 SOUTH COLLEGE STREET
CHARLOTTE, NC 28244

Date:
MAILED
AUG 0 6 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001009
PATENT NO. : 6939052
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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

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AUG 06 2010
CENTRAL REEXAMINATION UNIT

THE HARRINGTON PRACTICE PLLC
10130 MALLARD CREEK ROAD
SUITE 110
CHARLOTTE NC 28262-6001

(For Patent Owner)

W. THAD ADAMS, III
ADAMS INTELLECTUAL PROPERTY LAW, P.A.
201 SOUTH COLLEGE STREET, SUITE 2350
CHARLOTTE, NC 28244

(For Third Party Requester)

In re Hull	:	
Inter Partes Reexamination Proceeding	:	**DECISION DISMISSING**
Control No: 95/001,009	:	**PETITION TO TERMINATE**
Filing Date: October 11, 2007	:	***INTER PARTES* PROCEEDING**
For: U.S. Patent No.: 6,939,052	:	

This is a decision on the patent owner petition filed on May 17, 2010, entitled "Petition For Termination of *Inter Partes* Reexamination Proceeding Control No. 95/000,477," filed as a petition under 37 C.F.R. § 1.182.

In addition, *inter partes* third party requester filed a paper on June 10, 2010 entitled "Third Party Comments in Response to Patent Owner's Petition for Termination of *Inter Partes* Reexamination Proceeding."

The patent owner petition and requester opposition paper are before the Office of Patent Legal Administration.

The patent owner's petition is **dismissed**, and the opposition paper **not considered** for the reasons below; reexamination will continue with special dispatch.

BACKGROUND

1. Patent number 6,939,052 B1 (the '052 patent) issued on September 6, 2005, with claims 1-17.

2. In June 2006, the '052 patent became the subject of a concurrent proceeding styled *Precision Components v. CW Bearing USA*, Western District of North Carolina, docketed as 3:06cv259, filed on June 22, 2006.

3. On October 11, 2007, a third party, C.W. Bearing USA, filed a complete request for *inter partes* reexamination of all claims (1-17) in the '052 patent, which was assigned control no. 95/001,009 (the '1009 proceeding).

4. On December 4, 2007, reexamination was ordered in the '1009 proceeding for claims 1-17 of the '052 patent. On the same date, a non-final Office action was issued, rejecting claims 1, 2, 4-10, and 12-14, and confirming claims 3, 11, and 15-17.

5. On February 4, 2008, patent owner filed a response to the December 4, 2007 Office action.

6. On March 3, 2008, third party requester filed comments after the patent owner response of February 4, 2008.

7. On June 5, 2008, a second non-final Office action was issued, rejecting claims 1, 2, 4-10, and 12-14, and confirming claims 3, 11, and 15-17.

8. On August 13, 2008, patent owner filed a response to the June 5, 2008 Office action.

9. On September 5, 2008, third party requester filed comments after the patent owner response of August 13, 2008.

10. On March 13, 2009, patent owner filed a paper entitled "Request for Termination of Proceedings Following Final Decision In Pending Litigation Under 35 U.S.C. § 317(b)," treated as a Notice of Concurrent Proceedings per 37 C.F.R. § 1.985. This paper included a document entitled "Stipulation of Voluntary Dismissal With Prejudice," filed by CW Bearing USA in the civil proceeding 3:06cv00259 in the Western District of North Carolina.

11. On March 26, 2009, third party requester filed a paper entitled "Third Party Requester's Objection to Patent Owner's Request for Termination of Proceedings Following Final Decision In Pending Litigation Under 35 U.S.C. § 317(b)," treated as a Notice of Concurrent Proceedings per 37 C.F.R. § 1.985. This paper included a document entitled "Memorandum of Decision and Order," entered by the court in the civil proceeding 3:06cv00259 in the Western District of North Carolina.

12. Also on March 26, 2009, the Office issued an Action Closing Prosecution ("ACP"), rejecting claims 1, 2, 4-10, and 12-14, and confirming claims 3, 11, and 15-17; the ACP stated that the March 13 request "will be addressed in due course."

13. On April 27, 2009, patent owner filed a response to the March 26, 2009 ACP, which additionally presented arguments in support of patent owner's request for termination of proceedings, and addressing earlier third party remarks opposing that request.

14. On May 18, 2009, third party requester filed comments directed towards patent owner's April 27, 2009 response.

15. On May 17, 2010, patent owner filed the instant petition under 37 C.F.R. § 1.182 to terminate the '1009 proceeding.

16. On June 10, 2010, third party requester filed the instant opposition to patent owner's May 17, 2010 petition.

DECISION

I. Pertinent Regulations

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).

35 U.S.C. § 317 *states:*

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(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. (Emphasis added)

37 C.F.R. § 1.907 *states:*

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(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.

(c) If a final **decision** in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding. (Emphasis added)

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. (Emphasis added)

MPEP 2267(III) states, in pertinent part:

In those limited instances where there is a right to file an opposition to a petition, any such opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party, to ensure consideration. Any such opposition which is filed after the two-week period will remain in the record, even though it is not considered.

II. Findings and Analysis

Petitioner patent owner requests that this *inter partes* reexamination proceeding be terminated following the conclusion of the proceedings between the patent owner and the real party in interest in the '1009 reexamination in the civil proceeding 3:06cv00259 in the Western District of North Carolina.[1] This proceeding was concluded with the issuance of a Judgment on April 14, 2009.[2] This Judgment was entered in favor of Defendant C.W. Bearing USA and against Plaintiff Precision Components in connection with Precision Component's claims for

[1] *Precision Components v. C.W. Bearing USA, Western District of North Carolina, docketed as 3:06cv259, filed on June 22, 2006.*
[2] *Id.*

conversion, unfair and deceptive trade practices, and civil conspiracy. The Judgment acknowledged that all other claims in the case have been disposed by a "Stipulation of Dismissal" filed by the parties.

Patent owner's rationale for termination of the '1009 proceeding is grounded in 35 U.S.C. § 317, which states that once a "final decision has been entered against a party in a civil action . . . that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . 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." Patent owner alleges that there has been such a final decision in the aforementioned civil proceeding such that termination of the proceeding is required.

The court materials submitted by the parties have been carefully reviewed.[3] In none of these papers is there a final decision entered against a party that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, as would be required under § 317(b) for termination of the reexamination proceedings. The March 9, 2009 "Stipulation of Voluntary Dismissal With Prejudice" is not "a final decision entered against a party." The December 16, 2008 "Memorandum of Decision and Order" is a decision on motions that is not a final decision; the Memorandum states that Judgment will be entered "at the conclusion of the case." Furthermore, the Memorandum is adverse to patent owner Precision Components and not to the third party requester C.W. Bearing USA; neither does the Memorandum address any issues of validity or invalidity of the patent claims at issue. There is therefore no support, based upon the information submitted to the Office, for the contention that there has been a final decision entered against a party that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, such that termination of the proceedings under § 317(b) is appropriate.

It is further noted that an investigation of the current status of the litigation reveals that the court proceedings were concluded on April 14, 2009, in a final judgment. However, neither party has submitted to the Office any notice of this conclusion; i.e., the results of this proceeding. Patent owner is reminded of the requirement for a patent owner to "call the attention of the Office to any . . . concurrent proceedings in which the patent is or was involved, including . . . litigation and the results of such proceedings," as per the language of 37 C.F.R. § 1.985. It is clear from the April 14, 2009 Judgment, that the court has entered final judgment only against Plantiff patent owner, and only on the claims for conversion, unfair and deceptive trade practices, and civil conspiracy.[4] Although the Judgment states that "[i]n light of [the March 9, 2009] Stipulation of Dismissal, all of the [other] claims have been disposed of," this shows only that the claims are no longer before the court. This statement is not a showing that there has been a final decision entered against a party that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, and therefore termination of the proceedings under § 317(b) is not appropriate.

In view of the above, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

---

[3] In the papers treated as Notices of Concurrent Proceedings by the parties, filed on March 13, 2009 and March 26, 2009.

[4] April 14, 2009 Judgment at 2.

With respect to the June 17, 2010 third party requester opposition paper, this paper is not being considered as it was untimely filed. Pursuant to MPEP 2667(II.3), "in instances where there is a right to file an opposition to a petition, any such opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party, to ensure consideration. Any such opposition which is filed after the two-week period will remain in the record, even though it is not considered." The date upon which a copy of the original petition was served was certified by the patent owner's representative to be May 13, 2010. Therefore the two week period expired on May 27, 2010. The third party requester opposition paper, filed on June 17, was therefore outside the two week period and was untimely. Note that the opposition paper may not be considered comments under 37 C.F.R. § 1.947 to patent owner's response to an Office action because the latest Office action of March 26, 2009 was addressed with the patent owner response of April 27, 2009 and the third party requester comments of May 18, 2009. The opposition paper will therefore remain in the record, but it is not considered.

CONCLUSION

1. The patent owner petition for termination filed on May 17, 2010 is dismissed.

2. The third party requester opposition paper filed on June 17, 2010 remains in the record, but has not been considered.

3. Jurisdiction over the proceeding is returned to the Central Reexamination Unit to take appropriate action on the proceeding.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

Kenneth M. Schor

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

August 5, 2010
Kenpet8

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,013	10/11/2007	6697295	38512.14	5575

22852 7590 10/15/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/15/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVID L. MCCOMBS, ESQ.
HAYES AND BOONE, LLP (IP SECTION)
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:

MAILED

OCT 15 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001013
PATENT NO. : 6697295
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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

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

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

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(For Patent Owner)

MAILED

OCT 15 2010

David L. McCombs, Esq.
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IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Requester) CENTRAL REEXAMINATION UNIT

In re: Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,013
Filed: October 11, 2007
For: U.S. Patent No. 6,697,295

DECISION DISMISSING PETITION

This is a decision on patent owner's petition paper entitled "SECOND RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," filed on July 30, 2010.

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

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

REVIEW OF THE RELEVANT FACTS

1. On February 24, 2004, U. S. Patent No. 6,697,295 (the '295 patent) issued to Farmwald *et al.*

2. On October 11, 2007, a request for *inter partes* reexamination of the '295 patent, assigned Reexamination Control No. 95/001,013 (the '1013 proceeding), was filed by a third party requester.

3. On January 9, 2008, the Office issued an order granting *inter partes* reexamination in the '1013 proceeding, stating that an Office action on the merits would be issued in due course.

4. On August 25, 2008, the Office issued a non-final Office action on the merits in the '1013 proceeding.

5. On February 11, 2010, third party requester filed a paper entitled "NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION," notifying the Office of third party requester's withdrawal from participation in the '1013 proceeding.

6. The proceeding progressed until, on February 19, 2010, the Office issued an Action Closing Prosecution (ACP).

7. On February 25, 2010, patent owner filed a petition paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.955," (a petition under 37 CFR 1.183).

8. On April 20, 2010, the Office mailed a decision dismissing patent owner's February 25, 2010 petition under 37 CFR 1.183.

9. On May 3, 2010, patent owner filed a renewed petition paper entitled "EXPEDITED RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a renewed petition under 37 CFR 1.183).

10. On July 8, 2010, the Office mailed a decision dismissing patent owner's May 3, 2010 renewed petition under 37 CFR 1.183.

11. On July 30, 2010, patent owner filed the present second renewed petition paper entitled "SECOND RENEWED PETITION SEEKING WAIVER OF 37 C.F.R § 1.955," (a renewed petition under 37 CFR 1.183).

12. On August 8, 2010, the Office issued a Right of Appeal Notice (RAN), withdrawing all outstanding rejections and confirming the patentability of all the claims being reexamined.

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.

In the July 30, 2010 second renewed 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 February 11, 2010 withdrawal from participation in the '1013 proceeding.[1] In the second renewed petition patent owner has responded to the July 8, 2010 Office decision by providing a summary of the current state of the proceedings, a list of issues to be addressed in any granted interview and supporting arguments to show that given the nature of the issues an interview would enhance an understanding of the issues and advance prosecution. 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.

Since the filing of the second renewed petition, the Office has issued a RAN confirming patentability of all the claims. Therefore the issues to be discussed justifying waiver of the rule and granting an interview no longer exist. In view of this fact the '1013 proceeding can no longer present an extraordinary situation that justifies waiver of 37 CFR 1.955 to further the interest's justice. Thus, patent owner's second renewed petition under 37 CFR 1.183 is dismissed as moot.

CONCLUSION

1. Patent owner's July 30, 2010 renewed petition is dismissed as moot.

2. Any questions concerning this communication 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

10-14-10

[1] Petition under 37 CFR 1.183 at page 3.

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.
95/001,018	12/07/2007	6,928,479	79123-00006	1015

30734 7590 09/30/2010

BAKER & HOSTETLER LLP
WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,018	12/07/07	6928479	79123-00006

EXAMINER
LEE, CHRISTOPHER E.

ART UNIT	PAPER
3992	

ROBERT S. BLASI, ESQ.
GOODWIN PROCTOR LLP
EXCHANGE PLACE
53 STATE STREET
BOSTON, MA 02109

DATE MAILED: MAILED

SEP 30 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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SEP 30 2010

CENTRAL REEXAMINATION UNIT

Baker & Hostetler LLP
Washington Square, Suite 1100
1050 Connecticut Ave., N.W.
Washington, DC 20036-5304

(For Patent Owner)

Goodwin Proctor LLP
Exchange Place
53 State Street
Boston, MA 02109

(For Third Party Requester)

In re: Meyer et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,018
Request Deposited: December 7, 2007
For: U.S. Patent No. 6,928,479

: DECISION ON PETITION
: TO REOPEN PROSECUTION
: UNDER 37 CFR 1.181 AND
: 1.182
:

This is a decision on the September 7, 2010 petition entitled "3RD PARTY REQUESTER'S PETITIONS UNDER 37 CFR 1.181 and 1.182 TO REOPEN PROSECUTION AND FOR CONTINUED PROSECUTION AND FOR ADMISSION OF EVIDENCE UNDER 37 CFR 1.116" and patent owner's September 21, 2010 opposition thereto.

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

For the reasons set forth below, the third-party requester's petition is **DISMISSED**.

BACKGROUND

1. On August 19, 2009, an Action Closing Prosecution (ACP) was mailed in the present proceeding.

2. On September 19, 2009, Patent Owner filed a response to the ACP which included a second declaration of Gregory Ganger.

3. On October 19, 2009, Third Party Requester filed comments on the Patent Owner response.

4. At page 23 of Third Party Requester's comments of October 19, 2009, the declaration of Mr. Ganger is addressed. This petition takes no position on the merits of the Ganger declaration or the response thereto.

5. On July 7, 2010, a Right of Appeal Notice was mailed which indicated that certain rejections were overcome by the Ganger declaration (RAN, page numbered 6).

6. On July 29, 2010, Third Party Requester filed a Notice of Appeal.

7. The present petitions, together with evidence proffered by the Third Party Requester, were filed September 7 and September 21, respectively.

DECISION

Initially, it is noted that the petition of September 7, 2010 seeks review in the alternative.

37 CFR 1.4(c) states:

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

The petition has been treated under 37 CFR 1.181 as a petition to reopen prosecution, i.e. essentially to replace the RAN with an ACP.

To the extent that Patent Owner "alternatively petitions" for continued reexamination under 37 CFR 1.182, said request is **dismissed** under 37 CFR 1.4(c) since that different matter is considered by a different branch or section of the office.

35 USC 314(b) reads as follows:

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

37 CFR 1.947 reads as follows:

> Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be

considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 CFR 1.951 reads as follows:

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

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

MPEP 2673.01 reads as follows:

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).

In the present situation, Patent Owner submitted a second declaration of Mr. Ganger following the ACP, apparently in response to the examiner's discussion of the first declaration of Mr. Ganger at page 7 of the ACP. In the Third Party Requester comments of October 19, 2009, the second declaration was acknowledged and arguments made against it.

Any response to the Patent Owner paper of September 19, 2009, including evidence rebutting assertions made by Patent Owner, was due 30 days from that paper and not in a subsequent petition. The 30-day period is set by statute and is not extendable.

With regard to the propriety of issuing a RAN that makes a new finding of patentability, that situation is squarely addressed in MPEP 2673.01. Such a finding is not an abuse of discretion.

In view of the above, the petition is **DISMISSED**.

CONCLUSION

1. Third party Requester's petition of September 7, 2010 is **dismissed**; accordingly, Patent Owner's opposition petition of September 21, 2010 is **dismissed as moot**.

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

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

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

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

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

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

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

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

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

Gregory Morse
Director, Center Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,018	12/07/2007	6,928,479	79123-00006	1015

30734 7590 05/04/2011

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WASHINGTON SQUARE, SUITE 1100
1050 CONNECTICUT AVE. N.W.
WASHINGTON, DC 20036-5304

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

---

01 Communique Laboratory, Inc.
Patent Owner

Citrix Systems. Inc.
Third Party Requester

Inter partes Reexamination Control 95/001,018
Patent 6,928,479

DECISION ON PETITIONS

This is a decision on Third Party Requestor Citrix's "Petition in Opposition to Patent Owner's Reply Brief," ("Petition in Opposition"), and on Third Party Requestor Citrix's "Petition to Strike Sections of Respondent's Brief," ("Petition to Strike"), both filed December 29, 2010.

FINDINGS

1. Patent 6,298,479 ("'479 patent") issued on August 9, 2005, with 14 claims. The '479 patent is currently assigned to 01 Communique Laboratory, Inc. ("01").

2. Third Party Requester Citrix Systems, Inc. ("Citrix") filed a request for *inter partes* reexamination of the '479 patent on December 7, 2007.

3. The Office issued an Order granting *inter partes* reexamination of claims 1-11, 20-33, and 42-46 of the '479 patent on March 4, 2008, after finding a substantial new question of patentability affecting these claims.

4. After a non-final Office Action and subsequent amendment, the Examiner entered an Action Closing Prosecution on August 19, 2009, finding claims 7 and 31-33 patentable and rejecting claims 1-6, 8-11, 20-30, and 42-100.

5. 01 entered an Amendment on September 19, 2009, amending claims 7, 8, and 31 and cancelling claims 47-100. 01 relied on the Second Declaration of Gregory P. Ganger under 37 C.F.R. § 1.132 ("Second Granger Declaration"), provided as an appendix.

6. Citrix entered Third Party Requestor's Comments to Patent Owner's Amendment Under 37 C.F.R. § 1.951 on October 19, 2009, arguing, in part, that the Second Granger Declaration should be given no weight for lack of citation to the '479 patent or to other third-party references (p. 23).

7. The Examiner entered a Right of Appeal Notice on July 6, 2010, confirming claims 1-6, 20-30, and 42-45, finding claims 7-11, 31-33, and 46 patentable, in light of the amendments of claims 7, 8, and 31, and noting reliance on the Second Granger Declaration (pp. 6-7).

8. Third Party Requestor Citrix filed "3rd Party Requester's Petition Under 37 C.F.R. § 1.181 and 1.182 to Reopen Prosecution and for Continued Prosecution and for Admission of Evidence Under 37 C.F.R. § 1.116" ("Original Petition") on September 7, 2010, arguing that the Office had improperly allowed Patent Owner 01 to rely on the Second Ganger Declaration because no showing of good and sufficient reason why the

declaration was necessary had been made and because, according to Citrix, it had no chance to present impeachment/rebuttal evidence against asserted misrepresentations made in the Declaration.

9. Patent Owner 01 filed an Opposition to Citrix's petition to reopen prosecution, for continued prosecution, and for admission of evidence on September 21, 2010.

10. The Director of the Central Reexamination Unit entered a Decision on Petition to Reopen Prosecution under 37 CFR 1.181 and 1.182 ("Decision") on September 30, 2010, dismissing Citrix's Petition because the time for submitting a response to the Patent Owner 01's paper or the Second Ganger Declaration had passed (being due 30 days from when Patent Owner 01's paper was filed) and a response was not proper in a subsequent petition (p. 3.)

11. Citrix appealed the decision of the Examiner, filing a Third Party Requester's Brief on Appeal ("Appeal Brief") on September 29, 2010.

12. In its Appeal Brief, Citrix argued that the Second Granger Declaration was improper and misleading. According to Citrix, the Second Granger Declaration conflicts with testimony that Mr. Granger gave during litigation (pp. 10-13.)

13. 01 filed a Respondent Brief Pursuant to 37 C.F.R. § 41.68 ("Respondent Brief") on October 29, 2010.

14. In its Respondent Brief, 01 argues that much of the argument in Citrix's Appellant's Brief lacks support because the litigation testimony of Mr. Ganger referenced in the Appeal Brief is not of record in the reexamination (p.1). 01 requests that the arguments relying on the portions

of the litigation testimony not of record in this reexamination not be considered by the Board. (Respondent Brief, pp. 1-2, section IA.)

15. In its Respondent Brief, 01 also argues that Citrix improperly argued for unpatentability under 35 U.S.C. § 112 and that this argument should not be considered and because, in part, it is not proper for consideration in reexamination under 37 C.F.R. § 1.906(a) (providing for examination of claims in a reexamination on the basis of patents and printed publications and on the basis of 35 U.S.C. § 112 with respect to matter added or deleted during the reexamination) (pp. 2-3).

16. Citrix filed the Petition in Opposition on December 29, 2010.

17. 01 filed an Opposition to Petition in Opposition to Patent Owner's Reply Brief ("Opposition to Petition in Opposition") on January 25, 2001.

18. Citrix filed the Petition to Strike on December 29, 2010,

19. 01 filed an Opposition to Petition to Strike Sections of Respondent's Brief ("Opposition to Petition to Strike") on January 25, 2011.

ANALYSIS

Petition in Opposition

Citrix's Petition in Opposition requests that Respondent 01's arguments in its Respondent Brief that the Board not consider portions of Citrix's Appeal Brief be denied. (Petition in Opposition, p. 1.) Citrix argues that there is no basis under either 37 C.F.R. § 41.67(c)(1)(vi) or § 41.67(c)(1)(vii) for striking portions of Citrix's Appeal Brief.

As initial matters, Respondent 01 notes that it did not base its arguments on 37 C.F.R. § 41.67(c)(1)(vi), but mistakenly omitted an "i" in its Respondent Brief. (Opposition to Petition in Opposition, p. 2, n.2.) Thus, only Citrix's argument against 01's request that the Board not consider portions of Citrix's Appeal Brief under 37 C.F.R. § 41.67(c)(1)(vii) is considered here. In addition, 01 notes that it only requested that portions of Citrix's Appeal Brief be refused consideration, not be "struck," as Citrix asserts. (Opposition to Petition in Opposition, p. 3, n. 3.) On review of 01's Respondent Brief, it is appropriate to review only whether this decision should deny Respondent 01's request that the Board *not consider* certain of Citrix's Appeal Brief arguments.

In pertinent part, 37 C.F.R. § 41.67(c)(1)(vii) provides:

> *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.

In its Respondent Brief, 01 argues that portions of Citrix's Appeal Brief should not be considered because the arguments have no support in the record. According to Citrix, though, § 41.67 (c)(1)(vii) allows the Board to refuse consideration only if arguments or authorities are not included in the brief. (Petition in Opposition, p. 5.) Citrix argues that because its arguments were properly provided in its Appeal Brief, there is no basis for 01 to ask that they be refused consideration.

The Rule requires citation to the basis for contentions and arguments in an Appeal Brief. Citrix does not deny that there is a question of whether

citation to litigation testimony is sufficient in its Appeal Brief. Thus, it is appropriate for this issue to be decided by the Board. Accordingly, this portion of Citrix's Petition in Opposition is dismissed.

Citrix also argues in its Petition in Opposition that 01's arguments regarding Citrix's arguments relating to 35 U.S.C. §112 be denied. Whether the merits of Citrix's arguments or 01's arguments are more persuasive is not a petitionable matter, but is to be determined by a panel of the Administrative Patent Judges. *See* 35 U.S.C. § 6(b) ("The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents . . . . Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director.") Accordingly, this portion of Citrix's Petition in Opposition is also dismissed.

Petition to Strike

Citrix's Petition to Strike requests that portions of 01's Respondent Brief be stricken, asserting that these sections are not responsive to issues raised in Citrix's Appeal Brief in violation of 37 C.F.R. § 41.68(a)(3). (Petition to Strike, p. 1.)

37 C.F.R. § 41.68(a)(3) provides:

> The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

First, Citrix argues that section I(B) of 01's Respondent Brief raises the issue of whether 01's claims are invalid under 35 U.S.C. § 112, but that this issue was not raised in Citrix's Appeal Brief. Citrix argues that it only

addressed whether the *claim construction* proposed by 01 is supported by sufficient written description, not invalidity. (Petition to Strike, p. 5.)

01 contends that Citrix did raise the issue of invalidity under 35 U.S.C. § 112, citing to Citrix's Appeal Brief as follows:

> the Examiner accepted Dr. Granger's construction in his Second Reexamination Declaration with was clear error because . . . under 01's and Dr. Ganger's new September 19, 2009, construction, the limitation "the location facility creates a communication channel between the remote computer and the person computer" indisputably lacks any written description in the specification of the application as filed, contrary to the patentability requirements of 35 U.S.C. § 112.

(Appeal Brief, p. 15 (emphasis added); *see* Opposition to Petition to Strike, p. 2.) Because Citrix discussed patentability requirements under § 112, Citrix's argument that invalidity under that section was not raised is unpersuasive. Accordingly, 01's arguments regarding patentability under § 112 were properly presented under 37 C.F.R. § 41.68(a)(3) and the request to strike them from 01's Respondent Brief is denied.

Citrix also argues that sections VIII(C)(2) and VIII(D)(2) should be stricken from 01's Respondent Brief because they concern issues, specifically the disclosure of certain claim limitations in the prior art, which the Examiner has already resolved in Citrix's favor and thus were not raised in Citrix's Appeal Brief. (Petition to Strike, pp. 6-7.) Because Citrix's Appeal Brief lists "Issues to be Reviewed on Appeal," including the withdrawal of rejections in light of the prior art references discussed by 01 in its Respondent Brief, issues involving these prior art references were appropriately addressed by 01 in its Respondent Brief. Accordingly, Citrix's request to strike these sections is denied.

DECISION

Because Citrix has failed to present persuasive argument and evidence that Respondent 01's requests that the Board not consider certain of Citrix's Appeal Brief arguments be denied under 37 C.F.R. § 41.67(c)(1)(vii), Citrix's Petition in Opposition is DISMISSED.

Because Citrix has failed to present persuasive argument and evidence that 01 violated 37 C.F.R. § 41.68(a)(3) by addressing issues in its Respondent Brief not raised in Citrix's Appeal Brief, Citrix's Petition to Strike is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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Boston, MA 02109

UNITED STATES PATENT AND TRADEMARK OFFICE

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Patent Owner

Citrix Systems. Inc.
Third Party Requester

Inter partes Reexamination Control 95/001,018
Patent 6,928,479

DECISION ON PETITIONS

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FINDINGS

1. Patent 6,298,479 ("'479 patent") issued on August 9, 2005, with 14 claims. The '479 patent is currently assigned to 01 Communique Laboratory, Inc. ("01").

2. Third Party Requester Citrix Systems, Inc. ("Citrix") filed a request for *inter partes* reexamination of the '479 patent on December 7, 2007.

3. The Office issued an Order granting *inter partes* reexamination of claims 1-11, 20-33, and 42-46 of the '479 patent on March 4, 2008, after finding a substantial new question of patentability affecting these claims.

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6. Citrix entered Third Party Requestor's Comments to Patent Owner's Amendment Under 37 C.F.R. § 1.951 on October 19, 2009, arguing, in part, that the Second Granger Declaration should be given no weight for lack of citation to the '479 patent or to other third-party references (p. 23).

7. The Examiner entered a Right of Appeal Notice on July 6, 2010, confirming claims 1-6, 20-30, and 42-45, finding claims 7-11, 31-33, and 46 patentable, in light of the amendments of claims 7, 8, and 31, and noting reliance on the Second Granger Declaration (pp. 6-7).

8. Third Party Requestor Citrix filed "3rd Party Requester's Petition Under 37 C.F.R. § 1.181 and 1.182 to Reopen Prosecution and for Continued Prosecution and for Admission of Evidence Under 37 C.F.R. § 1.116" ("Original Petition") on September 7, 2010, arguing that the Office had improperly allowed Patent Owner 01 to rely on the Second Ganger Declaration because no showing of good and sufficient reason why the

declaration was necessary had been made and because, according to Citrix, it had no chance to present impeachment/rebuttal evidence against asserted misrepresentations made in the Declaration.

9. Patent Owner 01 filed an Opposition to Citrix's petition to reopen prosecution, for continued prosecution, and for admission of evidence on September 21, 2010.

10. The Director of the Central Reexamination Unit entered a Decision on Petition to Reopen Prosecution under 37 CFR 1.181 and 1.182 ("Decision") on September 30, 2010, dismissing Citrix's Petition because the time for submitting a response to the Patent Owner 01's paper or the Second Ganger Declaration had passed (being due 30 days from when Patent Owner 01's paper was filed) and a response was not proper in a subsequent petition (p. 3.)

11. Citrix appealed the decision of the Examiner, filing a Third Party Requester's Brief on Appeal ("Appeal Brief") on September 29, 2010.

12. In its Appeal Brief, Citrix argued that the Second Granger Declaration was improper and misleading. According to Citrix, the Second Granger Declaration conflicts with testimony that Mr. Granger gave during litigation (pp. 10-13.)

13. 01 filed a Respondent Brief Pursuant to 37 C.F.R. § 41.68 ("Respondent Brief") on October 29, 2010.

14. In its Respondent Brief, 01 argues that much of the argument in Citrix's Appellant's Brief lacks support because the litigation testimony of Mr. Ganger referenced in the Appeal Brief is not of record in the reexamination (p.1). 01 requests that the arguments relying on the portions

of the litigation testimony not of record in this reexamination not be considered by the Board. (Respondent Brief, pp. 1-2, section IA.)

15. In its Respondent Brief, 01 also argues that Citrix improperly argued for unpatentability under 35 U.S.C. § 112 and that this argument should not be considered and because, in part, it is not proper for consideration in reexamination under 37 C.F.R. § 1.906(a) (providing for examination of claims in a reexamination on the basis of patents and printed publications and on the basis of 35 U.S.C. § 112 with respect to matter added or deleted during the reexamination) (pp. 2-3).

16. Citrix filed the Petition in Opposition on December 29, 2010.

17. 01 filed an Opposition to Petition in Opposition to Patent Owner's Reply Brief ("Opposition to Petition in Opposition") on January 25, 2001.

18. Citrix filed the Petition to Strike on December 29, 2010,

19. 01 filed an Opposition to Petition to Strike Sections of Respondent's Brief ("Opposition to Petition to Strike") on January 25, 2011.

ANALYSIS

Petition in Opposition

Citrix's Petition in Opposition requests that Respondent 01's arguments in its Respondent Brief that the Board not consider portions of Citrix's Appeal Brief be denied. (Petition in Opposition, p. 1.) Citrix argues that there is no basis under either 37 C.F.R. § 41.67(c)(1)(vi) or § 41.67(c)(1)(vii) for striking portions of Citrix's Appeal Brief.

As initial matters, Respondent 01 notes that it did not base its arguments on 37 C.F.R. § 41.67(c)(1)(vi), but mistakenly omitted an "i" in its Respondent Brief. (Opposition to Petition in Opposition, p. 2, n.2.) Thus, only Citrix's argument against 01's request that the Board not consider portions of Citrix's Appeal Brief under 37 C.F.R. § 41.67(c)(1)(vii) is considered here. In addition, 01 notes that it only requested that portions of Citrix's Appeal Brief be refused consideration, not be "struck," as Citrix asserts. (Opposition to Petition in Opposition, p. 3, n. 3.) On review of 01's Respondent Brief, it is appropriate to review only whether this decision should deny Respondent 01's request that the Board *not consider* certain of Citrix's Appeal Brief arguments.

In pertinent part, 37 C.F.R. § 41.67(c)(1)(vii) provides:

> *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.

In its Respondent Brief, 01 argues that portions of Citrix's Appeal Brief should not be considered because the arguments have no support in the record. According to Citrix, though, § 41.67 (c)(1)(vii) allows the Board to refuse consideration only if arguments or authorities are not included in the brief. (Petition in Opposition, p. 5.) Citrix argues that because its arguments were properly provided in its Appeal Brief, there is no basis for 01 to ask that they be refused consideration.

The Rule requires citation to the basis for contentions and arguments in an Appeal Brief. Citrix does not deny that there is a question of whether

citation to litigation testimony is sufficient in its Appeal Brief. Thus, it is appropriate for this issue to be decided by the Board. Accordingly, this portion of Citrix's Petition in Opposition is dismissed.

Citrix also argues in its Petition in Opposition that 01's arguments regarding Citrix's arguments relating to 35 U.S.C. §112 be denied. Whether the merits of Citrix's arguments or 01's arguments are more persuasive is not a petitionable matter, but is to be determined by a panel of the Administrative Patent Judges. *See* 35 U.S.C. § 6(b) ("The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents . . . . Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director.") Accordingly, this portion of Citrix's Petition in Opposition is also dismissed.

Petition to Strike

Citrix's Petition to Strike requests that portions of 01's Respondent Brief be stricken, asserting that these sections are not responsive to issues raised in Citrix's Appeal Brief in violation of 37 C.F.R. § 41.68(a)(3). (Petition to Strike, p. 1.)

37 C.F.R. § 41.68(a)(3) provides:

> The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

First, Citrix argues that section I(B) of 01's Respondent Brief raises the issue of whether 01's claims are invalid under 35 U.S.C. § 112, but that this issue was not raised in Citrix's Appeal Brief. Citrix argues that it only

addressed whether the *claim construction* proposed by 01 is supported by sufficient written description, not invalidity. (Petition to Strike, p. 5.)

01 contends that Citrix did raise the issue of invalidity under 35 U.S.C. § 112, citing to Citrix's Appeal Brief as follows:

> the Examiner accepted Dr. Granger's construction in his Second Reexamination Declaration with was clear error because . . . under 01's and Dr. Ganger's new September 19, 2009, construction, the limitation "the location facility creates a communication channel between the remote computer and the person computer" indisputably lacks any written description in the specification of the application as filed, contrary to the patentability requirements of 35 U.S.C. § 112.

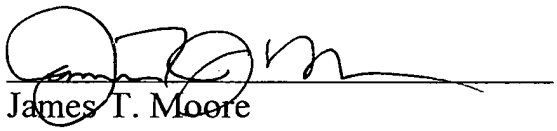
(Appeal Brief, p. 15 (emphasis added); *see* Opposition to Petition to Strike, p. 2.) Because Citrix discussed patentability requirements under § 112, Citrix's argument that invalidity under that section was not raised is unpersuasive. Accordingly, 01's arguments regarding patentability under § 112 were properly presented under 37 C.F.R. § 41.68(a)(3) and the request to strike them from 01's Respondent Brief is denied.

Citrix also argues that sections VIII(C)(2) and VIII(D)(2) should be stricken from 01's Respondent Brief because they concern issues, specifically the disclosure of certain claim limitations in the prior art, which the Examiner has already resolved in Citrix's favor and thus were not raised in Citrix's Appeal Brief. (Petition to Strike, pp. 6-7.) Because Citrix's Appeal Brief lists "Issues to be Reviewed on Appeal," including the withdrawal of rejections in light of the prior art references discussed by 01 in its Respondent Brief, issues involving these prior art references were appropriately addressed by 01 in its Respondent Brief. Accordingly, Citrix's request to strike these sections is denied.

DECISION

Because Citrix has failed to present persuasive argument and evidence that Respondent 01's requests that the Board not consider certain of Citrix's Appeal Brief arguments be denied under 37 C.F.R. § 41.67(c)(1)(vii), Citrix's Petition in Opposition is DISMISSED.

Because Citrix has failed to present persuasive argument and evidence that 01 violated 37 C.F.R. § 41.68(a)(3) by addressing issues in its Respondent Brief not raised in Citrix's Appeal Brief, Citrix's Petition to Strike is DENIED.



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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.
95/001,018	12/07/2007	6,928,479	79123-00006	1015

33797 7590 05/25/2011

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CANADA

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/25/2011

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
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BOSTON, MA 02109-2881

Date:
MAILED
MAY 25 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001018
PATENT NO. : 6928479
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,018	12/07/2007	6,928,479	79123-00006

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

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05/25/11

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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,018	12/07/2007	6,928,479	79123-00006

EXAMINER
LEE, CHRISTOPHER

ART UNIT	PAPER
3992	

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MAY 25 2011

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(Courtesy Copy)

In re Meyer et al
Inter Partes Reexamination Proceeding
Control No. 95/001,018
Filed: December 7, 2007
For: U.S. Patent No. 6,928,479

: **DECISION**
: **DENYING**
: **PETITION**

This decision is in response to the November 12, 2010 combined requester petition, entitled "Petition Requesting Final Agency Determination", taken as a petition under 37 CFR 1.181(a)(3) requesting supervisory review of the September 30, 2010 decision, a renewed petition under 37 CFR 1.181 to enter evidence and/or reopen prosecution, and a renewed alternative petition under 37 CFR 1.182 for continued reexamination (the November 12, 2010 combined requester petition).

The November 12, 2010 combined requester petition, and the record as a whole, are before the Acting Associate Commissioner for Patent Examination Policy.

SUMMARY

The petition is granted only to the extent that the decision of the CRU Director of September 30, 2010 has been reconsidered, but is denied with respect to making any change therein. **The petition is denied as to the relief requested**. The Newman declaration proffered September 7, 2010 will not be entered, and prosecution will not be reopened.

The September 30, 2010 decision **properly dismissed** requester's September 7, 2010 combined petition under 37 CFR §§ 1.181 and 1.182.

BACKGROUND

- On August 9, 2005, U.S. Patent 6,928,479 (the '479 patent) issued to Meyer et al.

- On December 7, 2007, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001,018 (the '1018 proceeding).

- On March 4, 2008, the United States Patent and Trademark Office ("the Office") mailed an order granting *inter partes* reexamination.

- On June 16, 2008, the Office mailed a nonfinal Office action.

- On June 30, 2008, the patent owner filed a request for a two-month extension of time.

- On July 2, 2008, the Office mailed a decision granting-in-part patent owner's request for an extension of time, extending the time period for response by one month.

- On July 25, 2008, the patent owner filed a change of power of attorney and correspondence address.

- On September 3, 2008, the patent owner filed a response to the June 16, 2008 nonfinal Office action, including a first declaration under 37 CFR 1.132 of Gregory R. Ganger.

- Also on September 3, 2008, the patent owner filed a petition entitled "Petition Under 37 C.F.R. §§ 1.183, 1.182 or 1.137(b)", treated as a petition under 37 CFR 1.183 to waive the page length requirements of 37 CFR 1.943(b) (the September 3, 2008 patent owner petition).

- On November 12, 2008, the Office mailed a decision granting-in-part patent owner's September 3, 2008 petition, to the extent that patent owner's September 3, 2008 response, including the first declaration of Gregory R. Ganger, was accepted for entry. The decision refused entry of, and expunged as improper, patent owner's original July 25, 2008 response, patent owner's supplemental responses filed on August 20, 2008 and August 21, 2008, and requester's comments filed on August 22, 2008. The decision gave the requester 30 days from the mail date of the decision to submit comments on patent owner's September 3, 2008 response.

- Also on November 12, 2008, the Office mailed a decision refusing entry of, and expunging as improper, an opposition paper filed by the requester on September 26, 2008, entitled "Third Party Requester's Petition Under 37 CFR §§ 1.181 and 1.182 in Opposition to Patent Owner's Petition Under 37 C.F.R. §§ 1.183, 1.182 or 1.137(b)".

- On November 24, 2008, the requester filed a petition under 37 CFR 1.183 for waiver of the page limit requirements of 37 CFR 1.943(b).

- On November 26, 2008, the patent owner filed a petition to strike an exhibit filed by the requester with its November 24, 2008 petition.

- On December 12, 2008, the requester filed revised comments pursuant to 37 CFR 1.947.
- On March 2, 2009, the Office mailed a decision granting requester's November 24, 2008 petition under 37 CFR 1.183.
- Also on March 2, 2009, the Office mailed a decision dismissing patent owner's November 26, 2008 petition.
- On August 19, 2009, the Office mailed an action closing prosecution (ACP), which included a detailed response to the first declaration under 37 CFR 1.132 of Gregory R. Ganger.
- On September 19, 2009, the patent owner filed comments after ACP, accompanied by a second declaration under 37 CFR 1.132 of Gregory R. Ganger.
- On October 19, 2009, the third party requester filed comments after ACP.
- On July 6, 2010, the Office mailed a right of appeal notice (RAN), in which the examiner determined that the second declaration under 37 CFR 1.132 of Gregory R. Ganger provided evidence sufficient to overcome the rejections listed on page 6 of the RAN (see, generally, pages 6-7 of the RAN).
- On July 29, 2010, the requester filed a notice of appeal.
- On September 7, 2010, the requester filed a combined petition, entitled "3rd Party Requester's Petitions under 37 C.F.R. § 1.181 and 1.182 to Reopen Prosecution and for Continued Prosecution and for Admission of Evidence under 37 C.F.R. § 1.116" (the September 7, 2010 combined requester petition). The September 7, 2010 combined requester petition is accompanied by a newly submitted declaration under 37 CFR 1.132 of Dr. Richard E. Newman, and associated exhibits (designated on page 1 of the Newman declaration as "Exhibit A").
- On September 21, 2010, the patent owner filed an opposition to the September 7, 2010 combined requester petition (the September 21, 2010 patent owner opposition). The September 21, 2010 opposition is entitled "Opposition to 3rd Party Requester's Petitions under 37 C.F.R. § 1.181 and 1.182 to Reopen Prosecution and for Continued Prosecution and for Admission of Evidence under 37 C.F.R. § 1.116".
- On October 27, 2009, the requester filed a notice of appeal.
- On September 29, 2010, the requester filed an appellant's brief.
- On September 30, 2010, the Office mailed a decision dismissing requester's September 7, 2010 combined petition, and addressing patent owner's September 21, 2010 opposition.

- On October 29, 2010, the patent owner filed a respondent's brief.
- On November 12, 2010, the requester filed the present petition, entitled "Petition Requesting Final Agency Determination" (the November 12, 2010 requester petition).
- On December 29, 2010, the requester filed a petition entitled "Petition to Strike Sections of Respondent's Brief" (the first December 29, 2010 requester petition).
- Also on December 29, 2010, the requester filed a petition entitled "Petition In Opposition to Patent Owner's Reply Brief" (the second December 29, 2010 requester petition).
- On January 25, 2011, the patent owner filed a paper in opposition to the first December 29, 2010 requester petition. The opposition paper is entitled "Opposition to Petition to Strike Sections of Respondent's Brief" (the first January 25, 2011 patent owner opposition).
- Also on January 25, 2011, the patent owner filed a paper in opposition to the second December 29, 2010 requester petition. The opposition paper is entitled "Opposition to Petition in Opposition to Patent Owner's Reply Brief" (the second January 25, 2011 patent owner opposition).
- On May 4, 2011, the Office mailed a decision by the Board of Patent Appeals and Interferences (Board), denying the first December 29, 2010 requester petition and dismissing the second December 29, 2010 requester petition. The Board's decision also addressed patent owner's first and second January 25, 2011 oppositions.

DECISION

The requester urges that the following points be reviewed:

A. Whether the September 30, 2010 decision properly dismissed requester's September 7, 2010 petition;

B. Whether the examiner properly entered the second declaration under 37 CFR 1.132 of Gregory R. Ganger in the July 6, 2010 right of appeal notice (RAN); and

C. Whether the Office will grant relief by i) admitting the Newman declaration, or ii) in addition to admitting the Newman declaration, reopening prosecution.

A. The September 30, 2010 Decision Properly Dismissed Requester's September 7, 2010 Combined Petition under 37 CFR §§ 1.181 and 1.182

On September 7, 2010, the requester filed a combined petition, in which the requester sought "reopened prosecution under 37 CFR §§ 1.181 and 1.182 and/or admission of the attached Newman Declaration under 37 CFR § 1.116".[1] The September 7, 2010 combined petition was treated as a petition under 37 CFR 1.181 to reopen prosecution and/or to enter the Newman declaration, and as an alternative petition under 37 CFR 1.182 for continued reexamination.

On September 30, 2010, the Office mailed a decision dismissing requester's September 7, 2010 combined petition as to all forms of relief requested.

The requester argues that the September 30, 2010 decision "wrongly dismissed as untimely" requester's September 7, 2010 petition. The requester points out that the September 7, 2010 petition requested relief from the July 6, 2010 RAN, and was timely filed within two months of the mail date of the RAN, in accordance with 37 CFR 1.181(f).

The September 30, 2010 decision, however, did not dismiss requester's September 7, 2010 petition for the reason that the *petition* was untimely under 37 CFR 1.181(f).[2] Rather, the September 30, 2010 decision dismissed requester's petition under 37 CFR 1.181 to enter the Newman declaration because *the filing of the Newman declaration* was untimely under 35 U.S.C. 314(b)(2). As stated in the September 30, 2010 decision:

> Any response to the Patent Owner paper [i.e., patent owner's comments after ACP] of September 19, 2009, including evidence rebutting assertions made by Patent Owner, was due 30 days from that paper and not in a subsequent petition. The 30-day period is set by statute and is not extendable.

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**.

After the 30-day statutory period has expired, the entry of any comments or evidence addressing issues raised by the Office action or patent owner's response thereto is prohibited by the statute (35 U.S.C. 314(b)(2)). The requester urges that the Newman declaration "fully address[es]",[3] i.e, is in rebuttal to, the issues raised by the patent owner's second Ganger declaration, which was filed with patent owner's September 19, 2009 responsive comments under 37 CFR 1.951(a). The Newman declaration, however, was not filed by the requester until September 7, 2010,

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[1] See page 11 of the September 7, 2010 petition.
[2] In fact, there is no mention of 37 CFR 1.181(f) anywhere in the September 30, 2010 decision.
[3] See the last full paragraph of page 4 of the present petition.

nearly one year after the filing of patent owner's September 19, 2009 § 1.951(a) comments. Thus, the filing of the Newman declaration was not timely based upon the statute.

Aside from the above-discussed statutory bar to the entry of the declaration, there is another statutory bar. 35 U.S.C. 314(b)(2) only permits the requester **one opportunity** to file any comments addressing issues raised by the Office action or patent owner's response thereto. On October 19, 2009, the requester timely filed its comments under 37 CFR 1.951(b) addressing issues raised by the previous Office action and by patent owner's September 19, 2009 § 1.951(a) comments. No mention, however, is specifically made in requester's comments of the second declaration under 37 CFR 1.132 of Gregory R. Ganger, which was included in patent owner's September 19, 2009 § 1.951(a) comments submission. The requester only makes a brief reference to an unidentified declaration filed by the patent owner on page 23 of requester's § 1.951(b) comments, where the requester presents a bald argument that "the bulk of this declaration appears to constitute paid opinion that is uncorroborated by any impartial third party authority, and it should be given no weight by the Office in these proceedings". The requester had the opportunity to "fully address" the second Ganger declaration when the requester timely filed its comments on October 19, 2009, but chose not to do so. The Office cannot grant the requester an additional opportunity to address issues raised by patent owner's September 19, 2009 comments, because the filing of a supplemental comments paper after an Office action (and patent owner response) is prohibited by statute. 35 U.S.C. 314(b)(2).

For the reasons given above, the September 30, 2010 decision properly dismissed requester's September 7, 2010 petition under 37 CFR 1.181 to enter the Newman declaration, and there is no reason to grant that relief via the present petition for reconsideration. Thus, the underlying requested relief to enter the Newman declaration is **denied**.

The requester also argues, in the September 7, 2010 petition, that the Office should reopen prosecution in order to provide requester with the opportunity to provide evidence to rebut the second Ganger declaration and "positions taken by the USPTO in reliance thereupon".[4] Specifically, the requester points out that the Office "reversed several critical positions . . . in favor of positions articulated in the Ganger declaration", and requests the Office to reopen prosecution so that the requester may file rebuttal evidence, including the Newman declaration.

As correctly stated in the September 30, 2010 decision, however, the MPEP expressly states that it is not necessary to reopen prosecution when the Office reverses its position, i.e., withdraws a ground of rejection and makes a new finding of patentability in the RAN. See MPEP 2673.01, which is entitled "Reopening Prosecution After ACP", and which provides, in pertinent part (emphasis added):

> 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

[4] See page 4 of requester's September 7, 2010 petition.

> (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 . . .

Furthermore, if prosecution is reopened, there is no assurance that the patent owner would respond to the Office's allowance of the claims, and the Office cannot permit the entry of the Newman declaration, or of any other arguments or evidence unless patent owner responds. See 35 U.S.C. 314(b)(2).

In addition, the requester has not provided a sufficient showing as to why it is appropriate to reopen prosecution. The requester had an opportunity to file comments specifically addressing issues raised by the second Ganger declaration, and chose not to do so, despite the possibility that the Office might enter second Ganger declaration (see part B below). The Office is required to conduct *inter partes* reexamination proceedings with special dispatch, pursuant to 35 USC 314(c), and requester's choice not to file the second Ganger declaration (nor even hint that one was actively in the process of being sought) clearly does not facilitate special dispatch on the part of the Office. Prudent action on the part of requester to facilitate special dispatch should have motivated requester to provide a rebuttal declaration as soon as possible, in the event the second Ganger declaration was entered. Then, the Office would have had all the information on the issue prior to issuing a right of appeal notice. The present case is at the appeal stage, and a respondent's brief has already been filed by patent owner. To reopen prosecution at this stage would cause extensive rework and substantial delay, and in the present circumstances, is deemed to be contrary to the Office's mandate for special dispatch.

For the reasons given above, the September 30, 2010 decision properly dismissed requester's petition under 37 CFR 1.181 to reopen prosecution, and there is no reason to grant that relief via the present petition for reconsideration. Thus, the underlying requested relief to reopen prosecution is **denied.**

Regarding requester's alternative petition under 37 CFR 1.182 for continued prosecution, i.e, for continued reexamination, the September 30, 2010 decision correctly informed the requester that such a petition must be filed as a separate paper pursuant to 37 CFR 1.4(c). 37 CFR 1.4(c) provides (emphasis added):

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

The original petition under 37 CFR 1.181 was addressed by the Central Reexamination Unit, while an original petition under 37 CFR 1.182 for continued prosecution is addressed by the Office of Patent Legal Administration, and not by the Central Reexamination Unit. Requester's alternative petition under 37 CFR 1.182 was not filed as a separate paper for treatment by the Office of Patent Legal Administration, contrary to the rule. Thus, the September 30, 2010

decision properly dismissed requester's September 7, 2010 alternative petition under 37 CFR 1.182 for continued reexamination.

In view of the above discussion, the September 30, 2010 decision **properly dismissed** requester's September 7, 2010 combined petition, including a petition under 37 CFR 1.181 to reopen prosecution and/or to enter the Newman declaration, and an alternative petition under 37 CFR 1.182 for continued reexamination.

B. The Examiner Properly Entered the Second Ganger Declaration in the July 6, 2010 RAN

The requester repeatedly argues that the examiner, in the RAN, could not properly enter the second Ganger declaration filed by the patent owner after ACP, absent a finding that the patent owner had provided a showing of good and sufficient reasons pursuant to 37 CFR 1.116(e). The requester further points out that the RAN does not include such a finding, and "does not even address or acknowledge this requirement".

37 CFR 1.116(e) provides, in pertinent part (emphasis added):

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

The language of the rule, however, is permissive rather than mandatory, and is used by the Office as a tool to limit prosecution after ACP (or after a final action in an application or in an *ex parte* reexamination proceeding).[5] There is, however, nothing in the rule that *prohibits* the examiner from *sua sponte* entering evidence after ACP[6] that is not accompanied by a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented. Furthermore, there is no requirement that the examiner must explain why evidence admitted *sua sponte* by the examiner was entered without such a showing.

For the reasons given above, the examiner properly entered, in the July 6, 2010 RAN, the second Ganger declaration submitted by the patent owner with its comments after ACP.

---

[5] In both *ex parte* and *inter partes* reexamination proceedings, the Office is required to conduct prosecution with special dispatch. See 35 USC 305 and 314(c). In applications, the Office has the responsibility to protect the interests of the public. It is in the interests of the public to bring prosecution to a close as quickly as practicable, and to avoid extended prosecution.

[6] Or after a final action in an application or an *ex parte* reexamination proceeding.

C. The Office Will Not Grant Relief by Entering the Newman Declaration And/Or by Reopening Prosecution

The Office will not grant the underlying relief requested for the reasons give *supra.*

In addition, the requester admits that the requester did not begin working with Dr. Newman to assemble the Newman declaration and accompanying exhibits until after July 6, 2010, the mail date of the RAN.[7] The requester argues that "[e]ntry and consideration of the second Ganger declaration was . . . entirely unforeseeable", because the examiner newly entered the Ganger declaration in the RAN. The requester, however, should have foreseen the possibility that the examiner would find patent owner's proffered evidence to be persuasive, and should have filed rebuttal evidence during the time period provided to the requester by the statute. Furthermore, the requester, by its own admission, intentionally waited until after a subsequent Office action had been mailed before beginning to draft its rebuttal evidence. The Office cannot, as a matter of policy, permit a procedural delay caused by requester's deliberate decision to wait until the RAN to draft its rebuttal evidence, due to the Office's mandate for special dispatch.[8]

The July 25, 2008 Change of Correspondence Address is Ineffective

The change of correspondence address, filed by the patent owner on July 25, 2008, is **ineffective**. The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2222 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 09/595,533, is shown in the caption of this decision.

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Robert S. Blasi. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/595,533, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The petition is granted only to the extent that the decision of the CRU Director of September 30, 2010 has been reconsidered, but **is denied as to the underlying relief requested**.
- The Newman declaration proffered September 7, 2010 will not be entered, and prosecution will not be reopened.

---

[7] See page 4 of the September 7, 2010 petition.

[8] It is also for this reason that any later-filed petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and 37 CFR 1.116(f), and to enter the Newman declaration, may not be grantable. 37 CFR 1.183 permits waiver of the rules in extraordinary circumstances. Requester's decision to wait until the mail date of the RAN before beginning to draft its rebuttal evidence, as well as the other circumstances presented to date by the requester, are not extraordinary, such that justice requires waiver of the rule.

- The September 30, 2010 decision **properly dismissed** requester's September 7, 2010 combined petition under 37 CFR §§ 1.181 and 1.182.

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

- The July 25, 2008 change of correspondence address of the patent owner is **ineffective**. A courtesy copy of this decision will be mailed to the practitioner who submitted the present petition, Mr. Robert S. Blasi. Absent the filing of a proper change of correspondence address in the patent file, application no. 09/595,533, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Any further correspondence with respect to this matter should be addressed as follows:

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

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

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

- Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her 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

5-23-11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,021	02/26/2008	7,110,562	Q105787	1634

29053 7590 08/24/2011

FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
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DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

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(For Patent Owner)

MAILED

AUG 24 2011

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

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

In re Feeley *et alia*
Reexamination Proceeding
Control No. 95/001,021
For: U.S. Patent No. 7,110,562

DECISION DISMSSING PETITIONS

The *inter partes* reexamination is before the Central Reexamination Unit for consideration of the following papers:

1. Patent Owner petition requesting that a new office action be issued filed April 3, 2009.

2. Requester's comments filed June 12, 2009.

3. Patent Owner petition filed June 23, 2009 requesting the office return the requester's comments of June 12, 2009.

4. Revised requester comments filed September 18, 2009.

5. Patent Owner petition requesting the office return the requester's revised comments filed September 22, 2009.

6. Patent Owner petition filed December 23, 2009 to expunge the requester's comments of June 12, 2009.

7. Requester's petition filed May 14, 2010 from refusal to enter comments filed September 18, 2009.

8. Patent Owner's petition of May 21, 2010 in opposition to requester's petition of May 14, 2010.

9. Patent Owner's petition of May 5, 2011.

Decision

In response to the non-final office action mailed March 18, 2009, Patent Owner petitioned for a new, non-final office action. In view of the non-final office action mailed on March 31, 2010, the Patent Owner petition filed April 3, 2009 petition is **dismissed as moot**.

The requester's comments filed June 12, 2009 were found **improper** as noted in the office letter mailed September 3, 2009. In accordance with MPEP 2666.05, the requester's comments filed June 12, 2009 are **expunged** from the record. Since this proceeding is not a paper file and the papers of June 12, 2009 were electronically filed, the papers are being **closed** from public view.

In view of the finding that the requester's submission of June 12, 2009 was improper and expunged from the file, the Patent Owner petitions filed June 23, 2009 and December 23, 2009 are **dismissed as moot**.

The revised requester's comments filed September 18, 2009 are found **improper**.

The revised requester's comments present modified rejections from than those set forth in the request for reexamination. These proposed rejections are improper as such comments are not in compliance with 37 CFR 1.947 and 1.948. Rules 1.947 and 1.948 limit the comments of the third party requester to those issues raised by the Office action or the patent owner's response. In the request for *inter partes* reexamination, the third party requester did not propose any rejections with the newly presented rationales for combining references. The patent owner has not amended the claims, and therefore, there is no basis for proposing new rationales for combining references. Instead of limiting the discussion to a rebuttal of the examiner's or patent owner's finding of fact as to the cited references, the requester has sought to introduce new rationales for combining the references (see for example pages 7 and 8 of the September 18, 2009 comments that present a new rationale for combining references associated with 10 of the 21 proposed rejections).

These new variations of proposed rejections presented in the revised requester's comments are improper as such comments are not in compliance with MPEP § 2666.05. Office policies require that where a newly proposed rejection is presented, 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. However, the requester has sought to introduce new proposed rejections without the detailed explanation for how the references apply to the claim limitations. For example, the comments purport to alter 10 of the rejections, but lump together the explanation of the new rationale for combining references without separate detailed explanations in accordance with the guidelines set forth in MPEP § 2617. Therefore, the proposals of new rejections are improper as such comments are not in compliance with Office policies.

Since the revised requester's comments are found **improper** as noted above, in accordance with MPEP 2666.05, the revised requester's comments are **expunged** from the record. Since this proceeding is not a paper file and the papers of September 18, 2009 were electronically filed, the papers are being **closed** from public view.

In view of the finding that the revised requester's comments of September 18, 2009 was improper and expunged from the file, the Patent Owner petition filed September 22, 2009 is **dismissed as moot**.

The May 14, 2010 and May 21, 2010 petitions are **dismissed as moot** in view of subsequent submissions being addressed in the Action Closing Prosecution mailed September 26, 2010.

The May 5, 2011 petition is **dismissed as moot** in view of the Right of Appeal Notice mailed May 10, 2011.

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

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

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

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

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

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

This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,021	02/26/2008	7,110,562	Q105787	1634

29053 7590 11/08/2011

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DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/08/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes K/S Hearing Instruments Manufacturers Patent Partnership
v.
Hear-Wear Technologies, L.L.C.

Reexamination Control No. 95/001,021
Patent No. 7,110,562
Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner's "Petition Under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Appeal Brief," filed on September 23, 2011 (petition). Petitioner requests that the Office determine that requester's appellant brief is not compliant with 37 C.F.R. § 41.67. Petition 1. The petition fee of $400 was charged to petitioner's credit card on September 26, 2011, as authorized on the last page of the petition.

This is also a decision on the "Third Party Requester's Opposition to Maintain Appeal Brief against Patent Owner's Petition under 37 C.F.R. § 1.182 to Remove Requester's Appeal Brief," filed on October 14, 2011 (opposition). The opposition asserts that the requester's appellant brief is entirely in compliance with

37 C.F.R. § 41.67, and requests that the requester's appellant brief remain on the record. Opposition 1. The petition fee of $400 was charged to petitioner's credit card on October 17, 2011, as authorized on the last page of the opposition.

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. 7,110,562 was filed on February 26, 2008, and was assigned control no. 95/001,021.
2. On April 14, 2008, reexamination was ordered, and on March 18, 2009, a non-final Office action was mailed.
3. Prosecution was conducted and on March 31, 2010, the previous non-final Office action was withdrawn and a new non-final action was mailed that withdrew all previously adopted rejections, set forth new rejections, and confirmed some claims.
4. Patent owner filed a response to the non-final action on May 27, 2010, and requester filed comments on June 28, 2010.
5. On September 26, 2010, an Action Closing Prosecution (ACP) was mailed that maintained the rejections and confirmation of patentability.
6. On May 10, 2011, a Right of Appeal Notice (RAN) was mailed.
7. Patent owner and requester each separately filed Notices of Appeal on June 9, 2011.
8. Requester filed an appellant brief on August 4, 2011.
9. Patent owner filed an appellant brief on August 9, 2011.
10. A Notice of Non-compliant Brief was mailed with regard to requester's appellant brief on August 25, 2011.
11. Requester filed a corrected appellant brief on September 8, 2011.

12. The Notice of Non-compliant Brief was vacated in a decision mailed on September 13, 2011.
13. Patent owner filed the instant petition on September 23, 2011.
14. Patent owner filed a respondent brief on October 12, 2011.
15. Requester filed the instant opposition on October 14, 2011.

DISCUSSION

Petitioner requests that the requester's appellant brief of August 4, 2011, be returned and expunged from the record because the brief includes new grounds of rejections. Petition 3. Patent owner asserts that the new grounds of rejection are the same as the new grounds that the Office has thrice found to be improper. *Id.* Patent owner asserts that in the appellant brief, the requester attempted to modify the rejections from that of the originally proposed claim chart. Petition 4. Patent owner points out that no rule in reexamination allows the requester to assert new grounds of rejection, absent an amendment by patent owner, over the grounds of the original request. *Id.*

Requester's opposition asserts that the brief is entirely in compliance with 37 C.F.R. § 41.67, and requests that the brief remain on the record. Opposition 1. Requester asserts that every effort was made to ensure that the appellant brief did not incorporate the subject matter of any previously filed comments that were held to be improper, *e.g.*, miniaturization of components. *Id.* Requester argues that relying on the same references and the same basis does not constitute new grounds of rejection in view of the MPEP and *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). Opposition 3. Requester asserts that their brief is responsive to each examiner determination of patentability (determination of inapplicability of a proposed rejection) which the third party requester appellant contests.

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).

37 C.F.R. § 41.61(a)(2) states:

> Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

37 C.F.R. § 41.61(d) states:

> An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

37 C.F.R. § 41.67(c)(1)(vi) states:

> Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

37 C.F.R. § 41.67(d) states:

> If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

ANALYSIS

The petition has been considered fully. A petition under 37 C.F.R. § 1.182 to strike another party's submission is appropriate if a submission is improper. Petitioner asserts that requester's appellant brief includes new grounds of rejections and that the requester has attempted to modify the rejections from that of the originally proposed claim chart. Petitioner provides one example, where requester originally proposed deeply inserting component 2 of Toht so as to be completely in the user's ear canal, but asserts that requester now in its' brief, shifted the grounds of rejection to instead proposed modifying the BTE-RITE type hearing aid of Toht to utilize the CIC component as in Reiter. Petition 3-4. Patent owner states that this reasoning was explicitly cited as an improper attempt to create a new rejection before and was consequently expunged from the record. Petition 4. In the opposition, requester argues that relying on the same references and the same basis does not constitute new grounds of rejection in view of the MPEP and *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). Opposition 2. Requester asserts that their brief is responsive to each examiner determination of patentability (determination of inapplicability of a proposed rejection) which the third party requester appellant contests. Opposition 2-3.

A review of the record reveals that the requester's comments submission of June 28, 2010, was entered. A comparison of the requester's appellant brief of August 4, 2011, with the earlier filed comments submission shows that the proposed grounds of rejection that the examiner refused to adopt are based on the same proposed combinations of references. However, there do appear to be a number of differences in the explanation of the proposed combination of the teachings of Toht and Reiter, taken with Shennib:

"Thus, combining the two would be no more than substituting known elements for other known elements to obtain predictable results, which is a proper rationale for obviousness under KSR. For example, this combination is obvious because it merely requires replacing the in-canal module of Toht with the CIC component of Reiter, which would reduce the occlusion effect, as disclosed by Reiter."

Requester's appellant brief of August 4, 2011, at 16.

The examiner withdrew these grounds of rejection in the Office action of March 31, 2010, which states in pertinent part:

> ***Withdrawal of Rejections***
>
> Upon further consideration the examiner withdraws the rejections set forth in the prior Office action and vacates the prior Office action. The rejections set forth by third party requester in the request for reexamination are not adopted because the requester's position set forth in the request alleging a detailed explanation of applying the prior art to the claims fails to set forth a complete and adoptable case of obviousness. New rejections based on the prior art provided by third party requester in the request follow: . . .

Non-final Action of March 31, 2010, at 3-4. The reasons for allowance in the Office action of March 31, 2010, states:

> ***Allowable Subject Matter***
>
> Claims 13, 14 and 32-37 are confirmed. The following is the examiner's statement of reasons for confirmation.

Claims 13 and 32 require an ear mold that is a custom fit ear mold. Shennib teaches away from the use of a custom fit ear mold stating on page 3 in the second and third full paragraphs:

> Unfortunately, even with custom earpieces or canal devices, small gaps between the ear piece and the wall of the ear canal frequently occur. These gaps, which are a significant source of acoustic feedback, occur because ear impressions are unable to mimic the geometry of the ear canal identically. Furthermore, gaps can also occur during canal deformations associated with jaw movements.
>
> Proving a tight fit to minimize gaps and improve sealing is usually accompanied by discomfort, irritation, or even pain particularly in the bony portion of the canal which is sensitive and more prone to discomfort and irritation.

Accordingly, modifying the completely-in-canal component disclosed by Shennib to use a custom fit ear mold would not have been obvious to one of ordinary skill in the art at the time of the invention. Claims 14 and 33-37 depend from claims 13 and 32, respectively and likewise are confirmed.

Non-final Office Action of March 31, 2010, at 34.

The ACP of September 26, 2010 states:

Allowable Subject Matter

Claims 13, 14 and 32-37 are confirmed. The examiner's statement of reasons for confirmation was set forth in the prior Office action.

. . .

Response to Third Party's Comments

The examiner has reviewed the arguments set forth in section III of Third Party's Comments, but they are not persuasive. As discussed in the prior Office action, the rejections set forth in the request for reexamination of the '562 patent are not adoptable because they do not provide the required detailed explanation of how the prior art is applied to the claims.

> Third Party's argument that claims 13, 14 and 32-37 should be rejected is not persuasive. As discussed in the reasons for confirmance set forth in the prior Office action, Shennib clearly teaches away from the limitations set forth in these claims.

ACP of September 26, 2010, at 29.

The RAN of May 10, 2011, is the final Office action from which appeal is taken. The RAN includes an indication of patentability:

> Allowable Subject Matter
>
> Claims 13, 14 and 32-37 are confirmed. The examiner's statement of reasons for confirmation was set forth in the prior Office action.
>
> Response to Arguments
>
> As no arguments have been filed in response to the action closing prosecution, no response from the examiner is needed.

RAN of May 10, 2011, at 30.

The requester is in the interesting position of having presented comments in a submission of June 28, 2010, that apparently were not persuasive enough to convince the examiner to reinstate the proposed grounds of rejection previously adopted, and subsequently withdrawn in the Office action of March 31, 2010. Upon mailing of the ACP, the patent owner did not file a response, which means that the requester did not have a right to file any comments subsequent to the ACP. Therefore, the appellant's brief is the first opportunity for requester to provide any further arguments with regard to the proposed grounds of rejection not adopted. In an attempt to do so, it appears that the requester has provided an explanation that not only differs from previous explanations for combining the proposed combination of references, but appears may include new rationale. Such new rationale may be considered a new grounds of rejection, which is not permitted by rule, as pointed out by petitioner. It is noted that the patent owner filed a

respondent brief on October 12, 2011, which responds to the requester's appellant brief.

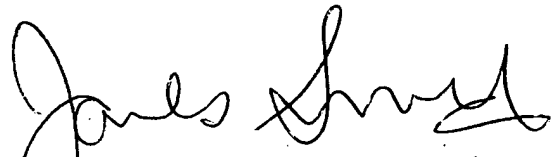
Because the examiner's supervisor expunged the previous improper comments by the requester from the record, the examiner is in the best position to determine whether or not the requester's appellant brief includes reasoning that was cited explicitly as an improper attempt to create a new rejection before and was consequently expunged from the record, as asserted by petitioner. The examiner is also in the best position to determine whether or not any differences in the requester's explanation for combining the references constitute further argument, or rise to the level of new grounds of rejection. Because both the appellant brief and the respondent brief have been received, the instant *inter partes* reexamination is now ripe for consideration by the examiner and preparation of the next appropriate Office action.

In considering the facts in this *inter partes* reexamination and the Office's need for special dispatch pursuant to 35 U.S.C. 314(c), patent owner's petition is **dismissed.** Requester's opposition is **dismissed as moot.**

CONCLUSION

In view of the foregoing, the petition is DISMISSED.

Jurisdiction of the instant *inter partes* reexamination is returned to the Central Reexamination Unit (CRU) for consideration by the examiner and preparation of the next appropriate Office action.



James Donald Smith
Chief Administrative Judge

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COUNSEL FOR THIRD PARTY REQUESTER:
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1100 New York Avenue, NW, Suite 800
Washington, DC 20005-3934

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,021	02/26/2008	7,110,562	Q105787	1634

29053 7590 12/08/2011

FULBRIGHT & JAWORSKI L.L.P
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DALLAS, TX 75201-2784

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ART UNIT	PAPER NUMBER

DATE MAILED: 12/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-8-11

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

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001021
PATENT NO. : 7110562
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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CENTRAL REEXAMINATION UNIT

FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS TX 75201-2784

(For Patent Owner)

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

(For Third Party Requester)

In re Feeley *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,021
Filed: December 26, 2007
For: U.S. Patent No. 7,110,562

In re Feeley *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/011,729
Filed: June 3, 2011
For: U.S. Patent No. 7,110,562

: DECISION ON PETITION TO PREVENT MERGER OF REEXAMINATION PROCEEDINGS

This is a decision on patent owner's September 14, 2011 petition entitled "PETITION UNDER 37 C.F.R. § 1.182 PRESENTING FACTS TO SUPPORT A DECISION AGAINST MERGER OF THE PRESENT CASE WITH A SUBSEQUENTLY FILED REEXAMINATION PROCEEDING." On October 14, 2011, third party requester filed an opposition entitled, "THIRD PARTY REQUESTER'S OPPOSITION IN SUPPORT OF MERGER AGAINST PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.182 FOR NO MERGER," to patent owner's September 14, 2011 petition.

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

Patent Owner's petition is granted, and the above captioned proceedings are NOT merged for the reasons set forth below.

REVIEW OF FACTS

1. On September 19, 2006, the Office issued U.S. Patent No. 7,110,562 (the '562 patent) to Feeley *et al.*

2. The '562 patent is subject to litigation in the United States District Court for the Northern District of Oklahoma, in *Hear-Wear Technologies, LLC v. Oticon Inc. et al.,* {Civil Action No. 07:CV-212-CVE-FHM}. The initial complaint was filed April 16, 2007.

3. On December 26, 2007, a request for *inter partes* reexamination of claims 1-9, 11-27 and 30-45 of the '562 patent was filed by third party requester (requester) K/S Hearing Instrument Manufactures Patent Partnership (HIMPP). The request was assigned Control No. 95/001,021 (the '1021 proceeding).

4. On April 14, 2008, the Office issued an order granting the '1021 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 1-9, 11-27 and 30-45 of the '562 patent would be subject to reexamination.

5. On March 6, 2009, the Office issued a non-final Office action in the '1021 proceeding.

6. On March 18, 2009, the Office *sua sponte* issued a new non-final Office action in the '1021 proceeding.

7. On May 13, 2009, patent owner timely filed a response to the March 18, 2009 non-final Office action.

8. On June 12, 2009, third party requester filed comments after patent owner's response.

9. On June 23, 2009, patent owner filed a petition requesting expungement of third party requester's June 11, 2009 comments as improper.

10. On September 3, 2009, the Office issued a decision expunging, as improper, third party requester's June 12, 2009 comments and giving third party requester 15-days to submit proper comments.

11. On September 18, 2009, third party requester submitted corrected comments.

12. On September 22, 2009, patent owner filed a petition requesting expungement of third party requester's September 18, 2009 comments as improper.

13. On March 31, 2010, the Office issued a non-final Office action confirming claims 13-14 and 32-37 and rejecting as unpatentable claims 1-9, 11-12, 15-27, 30-31 and 38-41. The action also noted that claims 42-45 were canceled.

14. On April 2, 2010, the Office issued a decision expunging as improper third party requester's September 18, 2009 corrected comments submission. Third party requester was not given another opportunity to file third party comments.

15. On May 27, 2010, patent owner timely filed a response to the March 31, 2010 non-final Office action.

16. On June 28, 2010, third party requester timely filed comments after patent owner's response.

17. On September 27, 2010, the Office issued an Action Closing Prosecution (ACP) confirming claims 13-14 and 32-37 and rejecting as unpatentable claims 1-9, 11-12, 15-27, 30-31, and 38-41. The action also noted that claims 42-45 were canceled.

18. On May 10, 2011, the Office issued a Right of Appeal Notice (RAN) confirming claims 13-14 and 32-37 and rejecting as unpatentable claims 1-9, 11-12, 15-27, 30-31 and 38-41. The action also noted that claims 42-45 were canceled.

19. On June 3, 2011, a request for *ex parte* reexamination of claims 1, 13-14, 22 and 32-37 of the '562 patent was filed by Robert Sterne of the Sterne Kessler Goldstein and Fox law firm. The request was assigned Control No. 90/011,729 (the '11729 proceeding).

20. On June 9, 2011, patent owner and third party requester both filed a notice of appeal in the '1021 proceeding.

21. On June 10, 2011, the '1021 third party requester filed a revocation of power of attorney, with a new power of attorney and change of correspondence address designating the Sterne Kessler Goldstein and Fox law firm for the '1021 proceeding.

22. On June 21, 2011, the Office issued an *Ex Parte* Reexamination Interview Summary – Pilot Program for Waiver of Patent Owner's Statement form reflecting that during a telephone interview held on June 20, 2011 patent owner did not agree to waive the right to submit a Patent Owner's Statement under 35 U.S.C. 304 in the '11729 proceeding.

23. On July 13, 2011, the Office issued an order granting the '11729 request for *ex parte* reexamination. The order stated that claims 1, 13-14, 22 and 32-37 of the '562 patent, would be subject to reexamination.

24. On August 4, 2011, third party requester timely filed an appellant's brief in the '1021 proceeding.

25. On August 9, 2011, patent owner timely filed an appellant's brief in the '1021 proceeding.

26. On August 25, 2011, the Office issued a Notice of non-compliant brief, indicating that third party requester's August 4, 2011 brief was non-compliant and giving requester one month to file a corrected brief in the '1021 proceeding.

27. On September 13, 2011, the Office issued a notice vacating the August 25, 2011 notice of non-compliant brief in the '1021 proceeding.

28. On September 8, 2011, third party requester filed a respondent's brief in response to patent owner's August 9, 2011 appellant's brief in the '1021 proceeding.

29. On September 14, 2011, patent owner filed the present petition in the '1021 proceeding to prevent merger of the '1021 proceeding with the '11729 proceeding.

30. On October 14, 2011, third party requester filed an opposition to patent owner's September 14, 2011 petition to prevent merger.

31. This decision addresses patent owner's September 14, 2011 petition to prevent merger and third party requester's October 14, 2011 opposition to patent owner's request to prevent merger.

RELEVANT AUTHORITY

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter *partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.182 states:

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

37 CFR 1.937(a) states:

> (a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.989 states:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

MPEP 2686.01 states (in part):

> Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.
>
> Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:
>
> (1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.
>
> (1)(b) The subsequent request is an *ex parte* reexamination request. Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.
>
> . . . .
>
> In order for the second or subsequent request to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. See MPEP § 2640 regarding whether a substantial new question of patentability is raised by the art cited in a second or subsequent request filed while a first reexamination proceeding is pending.
>
> If the second or subsequent request is granted, the decision on whether or not to merge the proceedings will be made by the Office of Patent Legal Administration. (OPLA). No decision on merging the reexaminations should be made until such time as reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply (if an *ex parte* reexamination is one of the proceedings).

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged *where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings.* However, **a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate**

of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch." [Emphasis Added]

MPEP 2686.01 IV states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, *if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting.* The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. [Emphasis Added]

MPEP 2686.01 VI states:

> No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the order to reexamine the second request, it will not be considered but will be returned to the party submitting the same by the OPLA. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2667.
>
> The patent owner can file a petition to merge the proceedings at any time after the order to reexamine the second request. A requester of any of the multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request. A petition to merge the multiple

proceedings which is filed by a party other than the patent owner or one of the third party requesters of the reexaminations will not be considered but will be returned to that party by the OPLA. Note that the acceptance of a petition to merge the multiple proceedings at any time after the order to reexamine the second request is contrary to 37 CFR 1.939 since such acceptance can be prior to the issuance of the first Office action. Accordingly, the requirement of 37 CFR 1.939 is hereby waived to the extent that a petition for merger of a reexamination proceeding with a reexamination proceeding or with a reissue (see MPEP § 2686.03) can be submitted after the order to reexamine has been issued in all the reexamination proceedings to be merged. This waiver is made to assure merger at the earliest possible stage.

All decisions on the merits of petitions to merge multiple reexamination proceedings, where at least one of the proceedings is an *inter partes* reexamination will be made by the OPLA.

Decisions on the merits of petitions to merge multiple reexamination proceedings, where none of the proceedings is an inter partes reexamination, will be made by the CRU Director (or by the CRU SPE, if the CRU Director delegates such to the CRU SPE); see MPEP § 2283.

DECISION

I. Issues Raised and Relief Requested

Patent owner requests the '1021 and '11729 proceedings not be merged, asserting the following: (1) The merger of the '1021 *inter partes* proceeding with the '11729 *ex parte* proceeding will only further delay the '1021 proceeding, which has been pending for over three years, contrary to the statutory mandate of special dispatch; and (2) Merger of the '1021 *inter partes* proceeding with the later filed '11729 *ex parte* circumvents 35 U.S.C. § 317(a) and 37 C.F.R. §§ 1.907, 1.989, 1.535 to undermine the integrity of *ex parte* and *inter partes* reexamination proceedings. Patent owner requests the remedy of non-merger of the two proceedings.

II. Findings and Analysis

Reexamination of the '562 patent has been ordered in the '11729 *ex parte* proceeding and '1021 *inter partes* proceeding. Thus far, the Office has made no decision to merge the above-captioned *ex parte* and *inter partes* reexamination proceedings. In view of the patent owner's petition, a discussion will be presented (a) as to the Office's discretion with respect to whether proceedings are to be merged and (b) as to why the Office does not intend to merge the above-captioned proceedings at present.

There is no legal requirement for the Office to merge, or not to merge, two pending reexamination proceedings. The determination whether to merge two reexamination proceedings is an act reserved to the sole discretion of the Office. See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I.,[1] MPEP 2686.01 IV,[2] 2283,[3] MPEP 2286.[4] In connection with this, the following is pointed out:

First, the statute is silent as to the administrative consolidation of co-pending reexamination proceedings on the same patent. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[5] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of proceedings eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[6] Therefore, while the Office retains the authority to merge, the Office also retains the authority to not merge proceedings, where special dispatch can be better served absent merger. Given the complexities and/or particularities that would arise as a result of merger in the present instance, as well as the delay of one proceeding that has already arrived at the advanced stage of being fully briefed, requester's position that merger would be in accord with special dispatch is not persuasive. Merger/non-merger determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding, and in this case the Office has decided that the statutory mandate for special dispatch is best served by not merging.[7,8]

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[1] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'" (Emphasis added).

[2] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[3] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[4] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[5] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[6] Id.

[7] See "*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of

III. Response to Opposition Petition Arguments

A. Propriety of Merger under the Present Circumstances. Requester is in error that the Office can only achieve prosecution efficiency by merging the '1021 proceeding and the '11729 proceeding and that non-merger runs contrary to special dispatch. All determinations of merger are made on a case-by-case basis. The Office is in the best position to determine what will facilitate the Office's discharge of its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), because the Office is in the best position to evaluate the complications and results of merger and balance them against the benefits of merger. It is appropriate that the Office has sole discretion in this matter, because it is the Office that is charged by statute with the duty of special dispatch – not the parties. In the present proceedings, as noted in section II, the Office has determined the most efficient manner to address the issues raised in each request is to not merge. Requester's concerns regarding non-merger of the proceedings are unfounded. The '11729 proceeding is at a very early stage of prosecution, while the '1021 proceeding has advanced to the appeal stage, with appellant's and respondent's briefs submitted. Withdrawing the '1021 proceeding from this advanced point of the appeal stage to reopen prosecution therefore is contrary to special dispatch.

B. Requester Activity. Third party requester did nothing to minimize the consumption of Office resources in this instance. Requester did not file the '11729 request until after the May 10, 2011 RAN was issued, knowing that an initial determination regarding the existence of a substantial new question of patentability would not be made for up to three months[9] and that the proceeding would not be ripe for merger consideration for at least two more months.[10] Requester could have filed a petition (in the '1021 proceeding) for extension of time to file its briefs, concurrently with a notice of concurrent proceedings, to obtain the results of the decision to merge, explaining why the requester believed merger was in order. If requester could have made a sufficient showing, that would have avoided the Office's having to process requester's and patent owner's initial and responsive briefs. If requester could not have made a sufficient showing, then, at that point the issue of merger would have been resolved in the negative. Either way, the matter could have been resolved before the present stage of the proceeding. Instead, requester's actions were to file a notice of appeal, appeal brief and file a respondent's brief, actions which are contrary to requester's arguments. Thus, requester's actions and inactions

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proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by-case basis."

[8] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

[9] See 35 USC 303(a)

[10] See 35 USC 304 and MPEP 2686.01

have resulted in a circumstance that if the merger were now to be granted, resources on the part of the parties and the Office will be wasted.

C. Merger does not "Undermine the Integrity" of Reexamination. Patent owner's sweeping allegation that merger undermines the integrity of reexamination is not persuasive. The administrative act of consolidation of reexamination proceedings that is "merger'" cannot and does not undermine the integrity of reexamination proceedings. A consolidation of proceedings, depending upon the individual facts and circumstances, serves to avoid unnecessary delay and resolve issues having common questions of fact and/or law. Consolidation does not alter the statutory rights of the parties, *e.g.* grant participation rights to an *ex parte* requester, as to do so would constitute an *ultra vires* act. Merger, pursuant to 35 U.S.C. §§ 305 and 314(c), and in accordance with 37 CFR 1.989, is used to support the Office's statutory mandate of special dispatch, where certain proceedings are facilitated by merger. Accordingly, patent owner's sweeping allegation that merger undermines the integrity of reexamination is not persuasive.

D. Parallel or Serial Proceedings are Viable. Office policy, practice and procedure as set forth in the MPEP provides a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office reexamination proceedings on the same patent when a reexamination certificate issues.[11] Further, the issues of each proceeding can be addressed separately without complicating and delaying the other proceeding. When one proceeding matures into a certificate, the other proceeding can be adjusted accordingly. MPEP 2686.01 IV is on point as to not merging in the present circumstance to minimize the consumption of Office resources, promote special dispatch, and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger.

Non-merger is in accord with, and not contrary to, public policy for the reasons stated above in the previous sections. Further, a decision to not merge best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), permitting the resolution of the substantial new questions raised in each proceeding, without deterring either proceeding. The 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 timely as possible. Accordingly, the decision is not contrary to the relevant issues of public policy identified by requester.

---

[11] See 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.

CONCLUSION

1. The September 14, 2011 patent owner petition is granted.

2. The October 14, 2011 third party requester opposition has been considered.

3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

Pinchus M. Laufer
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.
95/001,021	02/26/2008	7,110,562	Q105787	1634

29053 7590 12/20/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/20/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes K/S Hearing Instruments Manufacturers Patent Partnership
v.
Hear-Wear Technologies, L.L.C.

Reexamination Control No. 95/001,021
Patent No. 7,110,562
Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner's "Request for Reconsideration of USPTO Decision Dismissing Patent Owner's Petition Under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Appeal Brief," filed on November 16, 2011 (renewed petition). Petitioner requests reconsideration of the decision dismissing the previous petition and that the Office determine that requester's appellant brief is not compliant with 37 C.F.R. § 41.67. Petition 1. The petition fee of $400 was charged to petitioner's credit card on November 17, 2011, as authorized on the last page of the petition.

This is also a decision on the "Third Party Requester's Opposition Against Patent Owner's Request for Reconsideration" of November 30, 2011 (renewed

opposition). The opposition asserts that the Office's decision dismissing patent owner's petition should be maintained. Opposition 1. The petition fee of $400 was charged to petitioner's credit card on December 1, 2011, as authorized on the last page of the opposition.

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. 7,110,562 was filed on February 26, 2008, and was assigned control no. 95/001,021.
2. On April 14, 2008, reexamination was ordered, and on March 18, 2009, a non-final Office action was mailed.
3. Prosecution was conducted and on March 31, 2010, the previous non-final Office action was withdrawn and a new non-final action was mailed that withdrew all previously adopted rejections, set forth new rejections, and confirmed some claims.
4. Patent owner filed a response to the non-final action on May 27, 2010, and requester filed comments on June 28, 2010.
5. On September 26, 2010, an Action Closing Prosecution (ACP) was mailed that maintained the rejections and confirmation of patentability.
6. On May 10, 2011, a Right of Appeal Notice (RAN) was mailed.
7. Patent owner and requester each separately filed Notices of Appeal on June 9, 2011.
8. Requester filed an appellant brief on August 4, 2011.
9. Patent owner filed an appellant brief on August 9, 2011.
10. A Notice of Non-compliant Brief was mailed with regard to requester's appellant brief on August 25, 2011.
11. Requester filed a respondent brief on September 8, 2011.

12. The Notice of Non-compliant Brief was vacated in a decision mailed on September 13, 2011.
13. Patent owner filed the previous petition on September 23, 2011.
14. Patent owner filed a respondent brief on October 12, 2011.
15. Requester filed the previous opposition on October 14, 2011.
16. On November 8, 2011, a decision dismissing the previous petition was mailed.
17. Patent owner filed the renewed petition on November 16, 2011.
18. Requester filed an opposition to the renewed petition on November 30, 2011.

DISCUSSION

Petitioner requests that the Board of Patent Appeals and Interferences (BPAI) reconsider and vacate the petition decision of November 8, 2011. Petition 4. Patent owner asserts that the BPAI erred in referring the merits of the petition to the examiner and dismissing the petition. Petitioner contends that the decision envisions a resolution to the issues that is not allowed by the applicable rules, and petitioner cites 75 Fed. Reg. 158 (Aug. 17, 2010) to support such contention. *Id.* Patent owner urges that the petition should be granted because the facts before the BPAI show that the requester's appellant brief does not comply with 37 C.F.R. § 41.67(c)(1)(vi) because the brief includes at least one new ground of rejection. Petition 5. Patent owner asserts that the requester has modified one of the rejections in the brief from that of the originally proposed claim chart:

> In the original request for reexamination, Requester provided Appendix CC-A which set forth the reasoning for the asserted substantial new question of patentability corresponding to SNQ 1. This assertion reasoned that "it would have been obvious to deeply insert <u>component 2</u> [of Toht] so as to be completely in the user's ear canal to isolate the receiver 2 from the microphone and to reduce the occlusion effect as disclosed by Reiter." Appendix CC-A at 2 (emphasis added). Requester now proposes, in the Appeal Brief, that

> the rejection of SNQ 1 should be based on the assertion that "it would have been obvious to enhance the in-canal module of Toht with the CIC component of Reiter." Appeal Brief at 16, second paragraph (emphasis added). Here, the Requester proposes modifying the art using the CIC of Reiter instead of the originally proposed "deep[] insertion of component 2" of Toht. This change in the proposed rejection with respect to SNQ 1 is a proposal for a new ground of rejection.

Petition 5.

Requester's opposition counters that the Board performed a full analysis of both patent owner's and requester's arguments concerning the requester appellant brief, and the Board could not conclude that patent owners' petition was persuasive. Opposition 2. Requester argues that the Board made a full and proper decision in dismissing the petition and forwarding the *inter partes* reexamination to the Central Reexamination Unit for consideration of the briefs and preparation of the next appropriate Office action. *Id.* at 3. Requester urges that the petition decision should not be vacated. *Id.*

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).

37 C.F.R. § 41.61(a)(2) states:

> Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original,

> proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

37 C.F.R. § 41.61(d) states:

> An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

37 C.F.R. § 41.67(c)(1)(vi) states:

> Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

37 C.F.R. § 41.67(d) states:

> If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

ANALYSIS

The renewed petition and opposition have been considered fully. Petitioner asserts that requester's appellant brief includes at least one new ground of rejection and focuses on a single example, where requester originally proposed in the request deeply inserting component 2 of Toht so as to be completely in the user's

ear canal. Petitioner asserts that requester now in its brief, shifted the grounds of rejection to propose instead modifying the BTE-RITE type hearing aid of Toht to utilize the CIC component as in Reiter. Petition 5. A review of the requester's appellant brief reveals that on page 16, requester states;

> It would have been obvious to enhance the in-canal module of Toht with the CIC component of Reiter, as both are directed to in-the-canal hearing devices. Thus, combining the two would be no more than substituting known elements for other known elements to obtain predictable results, which is a proper rationale for obviousness under *KSR*. For example, this combination is obvious because it merely requires replacing the in-canal module of Toht with the CIC component of Reiter, which would reduce the occlusion effect, as disclosed by Reiter. (Reiter, 2:24-32).

Requester's appellant brief of August 4, 2011, at 16.

It is agreed that the explanation of the proposed rejection in the requester's appellant brief is different from the explanation of the proposed rejection in the claim chart CC-A of the request. The request does not propose "enhancing the in-canal module of Toht with the CIC component of Reiter," as discussed in the brief.

In its renewed opposition, requester does not specifically address this difference, nor explain why it is not a new ground of rejection. Requester incorporates by reference the statements contained in the earlier opposition filed in reply to the previous petition. Renewed Opposition 4. In the earlier opposition, requester replied to patent owner's argument by asserting that the statements in Appendix CC-A, page 2 of the request are "the same as or analogous to the statements made in the Appeal Brief." Opposition 2. Requester asserted that the "statements in its Appeal Brief simply reword without changing the scope or context for the support of the proposed rejection disclosed in Appendix CC-A and do not amount to proposing a modified rejection under the law." *Id.* at 2-3.

Such arguments are not persuasive. The request does not propose "enhancing the in-canal module of Toht with the CIC component of Reiter," as discussed in the brief, and it does not suggest "replacing the in-canal module of Toht with the CIC component of Reiter," as proposed in the brief. It is agreed that the brief contains a new ground of rejection.

The patent owner's renewed petition is **granted.** Requester's opposition is **denied.**

CONCLUSION

In view of the foregoing, the petition is GRANTED.

Requester hereby is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 41.67, 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 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.
95/001,022	02/26/2008	7,016,512	Q105784	1648

29053 7590 08/22/2011

FULBRIGHT & JAWORSKI L.L.P
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SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date:

MAILED

AUG 22 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001022
PATENT NO. : 7016512
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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(For Patent Owner) MAILED

AUG 22 2011

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

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

In re Feeley *et alia*
Reexamination Proceeding
Control No. 95/001,022
For: U.S. Patent No. 7,016,512

DECISION DISMSSING PETITION

The *inter partes* reexamination is before the Central Reexamination Unit for consideration of a paper filed January 12, 2011 requesting "that a Right of Appeal Notice be issued in the present case".

A review of the file indicates that a Right of Appeal Notice was mailed on March 16, 2011.

Accordingly, the petition is **dismissed as moot**.

This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Third Party Requester)

MAILED

OCT 3 1 2011

CENTRAL REEXAMINATION UNIT

In re Feeley *et al.*
Inter partes Reexamination Proceeding
Control No.: 95/001,022
Filed: February 26, 2008
For: U.S. Patent No. 7,016,512

In re Feeley *et al.*
Ex Parte Reexamination Proceeding
Control No.: 90/011,599
Filed: March 25, 2011
For: U.S. Patent No. 7,016,512

: DECISION ON
: PETITION TO
: PREVENT
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

This is a decision on patent owner's June 10, 2011 petition entitled "PETITION UNDER 37 C.F.R. § 1.182 PRESENTING FACTS TO SUPPORT A DECISION AGAINST MERGER OF THE PRESENT CASE WITH A SUBSEQUENTLY FILED REEXAMINATION PROCEEDING" filed in *inter partes* reexamination proceeding 95/001,022. On July 8, 2011, third party requester filed an opposition entitled "REQUESTER OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.182" to patent owner's June 10, 2011 petition.

FEE

The Third Party Requester opposition is a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 will be charged to Requester's deposit account no. 19-0036 pursuant to the oral authorization in a voice mail message from requester's representative, Jason Eisenberg, on September 8, 2011.

The Patent Owner petition and Requester opposition are before the Office of Patent Legal Administration for consideration.

Patent Owner's petition is granted, and the above captioned proceedings are NOT merged for the reasons set forth below.

Third party requester's opposition petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On March 21, 2006, the Office issued U.S. Patent No. 7,016,512 (the '512 patent) to Feeley *et al.*

2. The '512 patent is subject to litigation in the United States District Court for the Northern District of Oklahoma, in *Hear-Wear Technologies, LLC v. Oticon Inc. et al.,* {Civil Action No. 07:CV-212-CVE-FHM}. The initial complaint was filed April 16, 2007.

3. On February 26, 2008, a request for *inter partes* reexamination of all the claims (claims 1-12) of the '512 patent was filed by third party requester (requester) K/S Hearing Instrument Manufactures Patent Partnership (HIMPP). The request was assigned Control No. 95/001,022 (the '1022 proceeding).

4. On April 22, 2008, the Office issued an order granting the '1022 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '512 patent, claims 1-12, would be subject to reexamination.

5. On March 4, 2009, the Office issued a non-final Office action in the '1022 proceeding.

6. On March 18, 2009, the Office *sua sponte* issued a new non-final Office action in the '1022 proceeding.

7. On May 12, 2009, patent owner timely filed a response to the March 18, 2009 non-final Office action.

8. On June 11, 2009, third party requester timely filed comments after patent owner's response.

9. On June 23, 2009, patent owner filed a petition requesting expungement of third party requester's June 11, 2009 comments as improper.

10. On December 1, 2009, the Office issued a decision expunging, as improper, third party requester's June 11, 2009 comments and giving third party requester 15-days to submit proper comments.

11. On December 16, 2009, third party requester submitted corrected comments.

12. On December 23, 2009, patent owner filed a petition requesting expungement of third party requester's December 16, 2009 comments as improper.

13. On June 23, 2010, the Office issued a decision expunging as improper third party requester's December 16, 2009 corrected comments submission. Third party requester was not given another opportunity to file third party comments.

14. Also on June 23, 2010, the Office issued an Action Closing Prosecution (ACP) confirming claims 3 and 9 and rejecting as unpatentable claims 1-2, 4-8, and 10-12.

15. On March 16, 2011, the Office issued a Right of Appeal Notice (RAN) confirming claims 3 and 9 and rejecting as unpatentable claims 1-2, 4-8, and 10-12.

16. On March 25, 2011, a request for *ex parte* reexamination of claims 3 and 9 of the '512 patent was filed by Robert Sterne of the Sterne Kessler Goldstein and Fox law firm. The request was assigned Control No. 90/011,599 (the '11599 proceeding).

17. On April 14, 2011, patent owner filed a notice of appeal in the '1022 proceeding.

18. On April 15, 2011, third party requester filed a notice of appeal in the '1022 proceeding.

19. On April 18, 2011, patent owner was contacted (via counsel) and did not agree to waive the right to submit a Patent Owner's Statement under 35 U.S.C. 304 in the '11599 proceeding.

20. On May 12, 2011, the Office issued an order granting the '11599 request for *ex parte* reexamination. The order stated that claims 3 and 9 of the '512 patent, would be subject to reexamination.

21. On May 20, 2011, the Office *sua sponte* issued a new order granting the '11599 request for *ex parte* reexamination. The order stated that patent owner waived the right to submit a Patent Owner's Statement under 37 CFR 1.530. The order stated that claims 3 and 9 of the '512 patent, would be subject to reexamination.

22. On June 10, 2011, the '1022 third party requester filed a revocation of power of attorney, with a new power of attorney and change of correspondence address designating the Sterne Kessler Goldstein and Fox law firm for the '1022 proceeding.

23. Also on June 10, 2011, patent owner timely filed an appellant's brief in the '1022 proceeding. Patent owner concurrently filed the present petition to prevent merger in the '1022 proceeding.

24. On June 14, 2011, third party requester timely filed an appellant's brief in the '1022 proceeding.

25. Also on June 14, 2011, the Office issued a Notice of non-compliant brief, indicating that

patent owner's June 10, 2011 brief was non-complaint and giving patent owner one month to file a corrected brief in the '1022 proceeding.

26. On July 8, 2011, third party requester filed the present opposition petition to patent owner's June 10, 2011 petition to prevent merger, and requesting that patent owner's June 10, 2011 petition be expunged as an improper paper in the '1022 proceeding.

27. Also on July 8, 2011, patent owner filed an amended appellant's brief in the '1022 proceeding in response to the June 14, 2011 Office notice of non-compliant brief.

28. On July 14, 2011, patent owner filed a respondent's brief in response to third party requester's June 14, 2011 appellant's brief in the '1022 proceeding.

29. On August 4, 2011, third party requester filed a respondent's brief in response to patent owner's July 8, 2011 amended appellant's brief in the '1022 proceeding.

30. On August 18, 2011, the Office issued a first Office action on the merits in the '11599 proceeding rejecting claims 3 and 9 of the '512 patent.

31. On August 19, 2011, the Office issued an Examiner's Answer in the '1022 proceeding incorporating by reference all the grounds of rejection, determinations of patentability and explanations set forth in the March 16, 2011 RAN.

32. On September 16, 2011, patent owner and third party requester both filed rebuttal briefs.

33. This decision addresses patent owner's June 10, 2011 petition to prevent merger and third party requester's July 8, 2011 opposition to patent owner's request to prevent merger.

RELEVANT AUTHORITY

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 305 states:

> After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new

claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

35 U.S.C. 311(a) states:

IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(a) states:

(a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.4(c) states:

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

37 CFR 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition

seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.937(a) states:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.989 states:

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

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

MPEP 2686.01 states (in part):

Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. Any party

(including the patent owner) can file the subsequent *ex parte* reexamination request.

. . . .

In order for the second or subsequent request to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. See MPEP § 2640 regarding whether a substantial new question of patentability is raised by the art cited in a second or subsequent request filed while a first reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to merge the proceedings will be made by the Office of Patent Legal Administration. (OPLA). No decision on merging the reexaminations should be made until such time as reexamination has been ordered for both proceedings, and there is no longer an opportunity for filing a patent owner's statement and/or requester's reply (if an *ex parte* reexamination is one of the proceedings).

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged *where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings.* However, **a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate** of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch." [Emphasis Added]

MPEP 2686.01 IV states:

Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, *if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the*

> *second proceeding, with no delay resulting.* The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. [Emphasis Added]

MPEP 2686.01 VI states:

> No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the order to reexamine the second request, it will not be considered but will be returned to the party submitting the same by the OPLA. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See MPEP § 2667.
>
> The patent owner can file a petition to merge the proceedings at any time after the order to reexamine the second request. A requester of any of the multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the third party requesters of the reexaminations will not be considered but will be returned to that party by the OPLA. Note that the acceptance of a petition to merge the multiple proceedings at any time after the order to reexamine the second request is contrary to 37 CFR 1.939 since such acceptance can be prior to the issuance of the first Office action. Accordingly, the requirement of 37 CFR 1.939 is hereby waived to the extent that a petition for merger of a reexamination proceeding with a reexamination proceeding or with a reissue (see MPEP § 2686.03) can be submitted after the order to reexamine has been issued in all the reexamination proceedings to be merged. This waiver is made to assure merger at the earliest possible stage.
>
> All decisions on the merits of petitions to merge multiple reexamination proceedings, where at least one of the proceedings is an *inter partes* reexamination will be made by the OPLA.
>
> Decisions on the merits of petitions to merge multiple reexamination proceedings, where none of the proceedings is an inter partes reexamination, will be made by

the CRU Director (or by the CRU SPE, if the CRU Director delegates such to the CRU SPE); see MPEP § 2283.

PRELIMINARY MATTER

The July 8, 2011 opposition submission is an improper submission, as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. As to the submission of an opposition to the June 10, 2011 patent owner petition and also a petition for the relief of expungement of the June 10, 2011 patent owner petition within a single paper, such is precluded by 37 CFR 1.4(c). The handling of these two matters is delegated to different braches of the Office (the Office of Patent Legal Administration and the Central Reexamination Unit). Therefore, the July 8, 2011 "opposition petition" in regards to the petition to expunge is subject to dismissal as improper. However, in the interest of special dispatch the Office *sua sponte* waives the requirements of 37 CFR 1.4(c) in this specific instance and the Office of Patent Legal Administration is addressing both matters. This waiver does not apply to any further submissions.

DECISION

I. Issues Raised and Relief Requested

A. Patent Owner's June 10, 2011 Petition: Patent owner requests the '1022 and '11599 proceedings not be merged, asserting the following: (1) The merger of the '1022 *inter partes* proceeding with the '11599 *ex parte* proceeding will only further delay the '1022 proceeding, which has been pending for over three years, contrary to the statutory mandate of special dispatch; and (2) Merger of the '1022 *inter partes* proceeding with the later filed '11599 *ex parte* circumvents 35 U.S.C. § 317(a) and 37 C.F.R. §§ 1.907, 1.989, 1.535 to undermine the integrity of *ex parte* and *inter partes* reexamination proceedings. Patent owner requests the remedy of non-merger of the two proceedings.

B. Third Party Requester's July 8, 2011 Opposition Petition: Third party requester opposes patent owner's petition against merger, asserting the following: (1) Patent owner is more of a source of delay relative to third party requester; and (2) Merger is appropriate pursuant to the rules and MPEP. Third party requester further requests that patent owner's June 10, 2011 petition be expunged from the record.

II. Findings and Analysis

Reexamination of the '512 patent has been ordered in the '11599 *ex parte* proceeding and '1022 *inter partes* proceeding. Thus far, the Office has made no decision to merge the above-captioned *ex parte* and *inter partes* reexamination proceedings. In view of the patent owner's petition, a discussion will be presented (a) as to the Office's discretion with respect to whether proceedings are to be merged and (b) as to why the Office does not intend to merge the above-captioned proceedings at present.

There is no legal requirement for the Office to merge, or not to merge, pending reexamination proceedings. The determination whether to merge reexamination proceedings is an act reserved to the sole discretion of the Office. See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I.,[1] MPEP 2686.01 IV,[2] 2283,[3] MPEP 2286.[4] In connection with this, the following is pointed out:

First, the statute is silent as to the administrative consolidation of co-pending reexamination proceedings on the same patent. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[5] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of proceedings eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[6] Therefore, while the Office retains the authority to merge, the Office also retains the authority to not merge proceedings, where special dispatch can be better served absent merger. Given the complexities and/or particularities that would arise as a result of merger in the present instance, as well as the delay and regression of one proceeding that has already arrived at the advanced stage of being fully briefed, requester's position that merger would be in accord with special dispatch is not persuasive. Merger/non-merger

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[1] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'" (Emphasis added).

[2] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[3] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[4] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[5] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[6] Id.

determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding, and in this case the Office has decided that the statutory mandate for special dispatch is best served by not merging.[7,8]

III. Response to Opposition Petition Arguments

A. Propriety of Merger under the Present Circumstances. Requester is in error that the Office can only achieve prosecution efficiency by merging the '1022 proceeding and the '11599 proceeding and that non-merger runs contrary to special dispatch. All determinations of merger are made on a case-by-case basis. The Office is in the best position to determine what will facilitate the Office's discharge of its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), because the Office is in the best position to evaluate the complications and results of merger and balance them against the benefits of merger. It is appropriate that the Office has sole discretion in this matter, because it is the Office that is charged by statute with the duty of special dispatch – not the parties. In the present proceedings, as noted in section II, the Office has determined the most efficient manner to address the issues raised in each request is to not merge. Requester's concerns regarding non-merger of the proceedings are unfounded. The '11599 proceeding is at a relatively early stage of prosecution, while the '1022 proceeding has advanced to the appeal stage, an Examiner's Answer has issued and the proceeding has been briefed. Withdrawing the '1022 proceeding from this advanced point of the appeal stage to reopen prosecution therefore is contrary to special dispatch.

B. Party Activity. Third party requester did nothing to minimize the consumption of Office resources in this instance. Requester did not file that request until after the April 14, 201 RAN was issued, knowing that an initial determination regarding the existence of a substantial new question of patentability would not be made for up to three months[9] and that the proceeding would not be ripe for merger consideration for at least two more months.[10] Given the advanced stage of the'1022 *inter partes* reexamination proceeding, advancement of the '1022 proceeding for an additional five months does not tend toward merger. At that stage, requester could have filed a petition for extension of time to file papers, concurrently with a notice of concurrent proceedings, to obtain the results of the decision to merge, explaining why the requester believed merger was in order. If requester could have made a sufficient showing for waiting until the

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[7] See "*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by-case basis."
[8] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.
[9] See 35 USC 303(a)
[10] See 35 USC 304 and MPEP 2686.01

after the RAN was issued, that would have avoided the Office's having to process requester and patent owner initial, responsive and rebuttal briefs along with issuance of an examiner's answer. If requester could not have made a sufficient showing, then, at that point, the issue of merger would have been resolved in the negative. Either way, the matter could have been resolved before the present stage of the proceeding. Instead, requester's actions were to file a notice of appeal and appeal brief and advance the proceeding through the entire briefing phase of appeal, actions which are contrary to requester's arguments. Thus, requester's actions and inactions have resulted in a circumstance that if the merger were now to be granted, resources on the part of the parties and the Office will be wasted.

C. Merger does not "Undermine the Integrity" of Reexamination. Patent owner's sweeping allegation that merger undermines the integrity of reexamination is not persuasive. The administrative act of consolidation of reexamination proceedings that is "merger," cannot and does not undermine the integrity of reexamination proceedings. A consolidation of proceedings, depending on individual situations, serves to avoid unnecessary delay and resolve issues having common questions of fact and/or law. Consolidation does not alter the statutory rights of the parties, e.g. grant participation rights to an *ex parte* requester, as to do so would constitute an *ultra vires* act. Merger, pursuant to 35 U.S.C. §§ 305 and 314(c), and in accordance with 37 CFR 1.989, is used to support the Office's statutory mandate of special dispatch, where a given situation is facilitated by merger. Accordingly, patent owner sweeping allegation that merger undermines the integrity of reexamination is not persuasive.

D. Expungement of Patent Owner's June 10, 2011 Petition. Requester's assertion that patent owner's June 10, 2011 is improper and must be expunged is not found to be persuasive. Requester provides only a generalized allegation that patent owner's June 10, 2011 petition is an improper paper.[11] Requester does not provide any specific basis as to why patent owner's June 10, 2011 petition constitutes an improper paper. Patent owner's June 10, 2011 petition constitutes a legitimate exercise of a party's petition rights in the present proceeding and therefore, patent owner's June 10, 2011 petition is not an improper paper. Accordingly, third party requester's petition to expunge patent owner's June 10, 2011 opposition petition is dismissed.

Further, it is noted that if the patent owner paper were to be expunged, then requester's opposition paper would likewise be expunged as an answer to a non-existent paper. In that event, no papers on the merger would exist, and the Office's prior *sua sponte* choice not to

[11] Page 2 of the July 8, 2011 Requester Opposition Petition states, "Patent Owner's rationale is not only incorrect, but Patent Owner presents reasons that are adverse to the clear language of the statutes, rules, and procedures allowing for merger as discussed above. Thus, not only does Requester believe merger of the 022 Reexam and the 599 Reexam proceedings is appropriate, but the Patent Owner's Petition should be expunged from the record of the 022 Reexam proceeding as being inappropriate."

merge would remain in place without comment from parties. Non-merger, in appropriate circumstances, is in accord with and not contrary to public policy for the reasons stated above in the previous sections. In the present instance, a decision to not merge best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), permitting the resolution of the substantial new questions raised in each proceeding, without deterring either proceeding. The discretionary Office decision that the instant proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as efficiently as possible. Accordingly, the decision is not contrary to the relevant issues of public policy identified by requester.

CONCLUSION

1. The June 10, 2011 patent owner petition is granted.

2. The July 8, 2011 third party requester opposition petition has been considered, and the expungement aspect is dismissed.

3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

/ Kenneth M. Schor/

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

10-28-11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed October 25, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 23 pages and 12,553 words in length." Petition, p. 1.

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

FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33. The length of the ACP was 104 pages.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41. The length of the RAN was 89 pages.

10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 9, 2010, Rambus filed an Appeal Brief.

13. On September 23, 2010, Micron filed a Cross-Appeal Brief..

14. On October 25, 2010, Rambus filed a Respondent Brief along with the present Petition.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of

contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

ANALYSIS

As an initial matter, Rambus argues that "Micron's 33-page appeal brief addresses sixteen proposed rejections and a priority issue. . . . Micron devotes over half of its appeal brief to issues raised by Samsung." Petition, pp. 1-2.

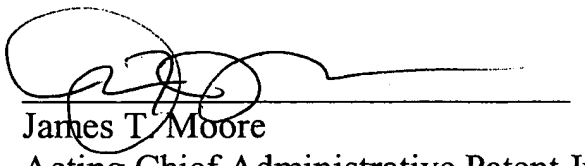
Further, Rambus contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." *Id.* at 2-3.

Rambus also states that it "has made every effort to pare down the arguments in its respondent appeal brief, but a respondent appeal brief limited to 15 pages or 7,000 words in length is inadequate to fully address and comprehensively respond to Micron's arguments." Petition, p. 3.

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

DECISION

For the forgoing reason, the Petition is GRANTED.



James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed October 25, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Director waive the requirement of 37 C.F.R. §1.943(c) limiting respondent appeal briefs to fifteen pages or 7,000 words in length . . . and accept its respondent appeal brief, which is 23 pages and 12,553 words in length." The petition fee of $400 in accordance with 37 C.F.R. § 41.20(a) was paid by check on October 25, 2010, along with the respondent brief fee.

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FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

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10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 9, 2010, Rambus filed an Appellant Brief.

13. On September 23, 2010, Micron filed a Cross-Appellant Brief.

14. On October 25, 2010, Rambus filed a petition to expunge Micron's Cross-Appellant Brief.

15. Also on October 25, 2010, Rambus filed a Respondent Brief accompanied by the present Petition.

DECISION

In the present Petition, Rambus requests waiver of 37 CFR § 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 23 pages and 12,553 words, which count toward the limit of 15 pages and 7,000 words.

Since Rambus' petition to expunge Micron's Cross-Appellant Brief has been granted in a decision mailed simultaneously herewith, patent owner's petition requesting waiver of 37 CFR § 1.943(c) is moot.

Micron has been given one opportunity to file a corrected appellant brief within 30 days/one month (whichever is longer) of the petition decision. Rambus will then have one opportunity to file a respondent brief

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within 30 days/one month (whichever is longer) from the certificate of service of the corrected appellant brief.

In view of the forgoing, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
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RAMBUS, INC.
Patent Owner

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Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed October 25, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office expunge Micron's appeal brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,128 ...)." Petition, p. 1.

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

FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 9, 2010, Rambus filed an Appeal Brief.

13. On September 23, 2010, Micron filed a Cross-Appeal Brief.

14. On October 25, 2010, Rambus filed a Respondent Brief along with the present Petition.

RELEVANT AUTHORITY

Concerning the contents of appellant briefs, 37 C.F.R. §§ 41.67(c)(1)(vi) and (vii) provide:

> (vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. . . .
>
> (vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on.

In respect to the issues that can be raised by a requester on cross appeal, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

More restrictively, MPEP § 2674(B) provides:

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

(emphasis in original).

ANALYSIS

Rambus argues that because Micron's Cross-Appeal Brief is in part directed to rejections originally proposed by Samsung and not Micron, the brief should be expunged. Specifically, Rambus identifies sections VII.C, VII.G, VII.H and VII.I of Micron's Cross-Appeal Brief as presenting rejections and a priority issue that initially were raised by Samsung and that were not adopted by the Examiner. Petition, pp. 2-3. Micron did not present any of these issues in its Request for Reexamination.

In support of its argument, Rambus cites, *inter alia*, MPEP § 2674(B), and *Meadwestvaco Packaging Systems, LLC v. Patent of C. Brown Lingamfelter*, Appeal 2009-002578 (BPAI Jan. 12, 2010).

As quoted above, the seemingly inconsistent provisions of MPEP §§ 2674(B) and 2674.01 with respect to the rejections that can be raised on appeal by a requester are not inconsistent when considering the context of these sections. MPEP § 2674.01, following 37 C.F.R. § 41.61(b)(2), describes the timing and general subject matter of a requester's notice of cross-appeal in an *inter partes* reexamination proceeding. MPEP § 2674(B), on the other hand, describes with particularity the subject matter that can be raised by a specific requester in a notice of appeal or cross appeal.

It is significant here that the brief in issue is Micron's appellant brief and not a respondent brief. As indicated above, in a notice of appeal (or cross appeal), a requester is limited to presenting rejections *previously proposed by that third party requester.* MPEP § 2674(B). Whereas, in respect to a respondent brief:

> After an appellant brief has been properly filed, a party opposing the appellant may file a respondent brief in support of the claim determination(s) made in the Right of Appeal Notice (RAN) which are in favor of the opposing party. The respondent brief must, however, be limited to issues raised in the appellant brief to which the respondent brief is directed.

MPEP § 2675.01. Thus, a requester's respondent brief may address issues raised in the patent owner's appellant brief irrespective of where those issues originated.

In *Meadwestvaco,* where a first requester attempted to raise in an appellant brief a rejection initially proposed by a second requester, the Board held that only the second requester could raise that rejection on appeal. *Meadwestvaco* at 81.

DECISION

In view of the forgoing, the Petition is GRANTED. Micron's Cross-Appeal Brief (appellant brief) will be expunged and Micron is granted one month from the mailing date hereof to file a replacement appellant brief.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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22852 7590 02/16/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

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Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Respondent Brief," filed December 27, 2010 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Respondent Brief," filed January 14, 2011 ("Opposition"). In the Petition, Patent Owner "requests that [Requester Micron's] respondent brief filed on October 25, 2010, addressing rejections proposed by Requester Samsung . . . in a separate proceeding, be expunged from the record." Petition, p. 1.

FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 23, 2010, Rambus filed an Appeal Brief.

13. Also on September 23, 2010, Micron filed a Cross-Appeal Brief.

14. On October 25, 2010, Rambus filed a Respondent Brief.

15. Also on October 25, 2010, Micron filed a Respondent Brief.

16. The present Petition was filed on December 27, 2010.

17. The present Opposition was filed on January 14, 2011.

RELEVANT AUTHORITY

In respect to the issues that properly may be addressed in a respondent's brief, 37 C.F.R. § 41.68(a)(3) provides:

> (3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

Similarly, MPEP § 2675.01 provides:

> After an appellant brief has been properly filed, a party opposing the appellant may file a respondent brief in support of the claim determination(s) made in the Right of Appeal Notice (RAN) which are in favor of the opposing party. The respondent brief must, however, be limited to issues raised in the appellant brief to which the respondent brief is directed. 37 CFR 41.68(a)(3).

ANALYSIS

Rambus argues that –

> Under the statutory scheme and the Office's rules and procedures, Micron has no basis to appeal and address issues that it did not raise and that another third party requester [Samsung] raised.

Petition, p. 3.

Rambus does not contest that the issues addressed in Micron's Respondent Brief are issues that are addressed in Rambus's Appeal Brief. Further, Rambus does not contest that all such issues were addressed by the Examiner during prosecution and that the Office has considered and taken a position on these issues.

Rambus has cited no authority, statutory, regulatory, procedural or judicial, that limits the respondent brief of a party in a merged reexamination proceeding to only those issues originally proposed by that party.

As indicated by the foregoing authorities, the key consideration for determining the propriety of a respondent brief is whether it addresses issues that are raised in the appellant brief to which it responds.

DECISION

In view of the forgoing, the Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,026	01/31/2008	6378020	38512.9	1090

22852 7590 02/16/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition for Reconsideration of the Office's Decision to Expunge Third-Party Requester's Cross-Appeal Brief," filed January 3, 2011 ("Petition"); and "Patent Owner's Opposition to Third Party Requester's Petition for Reconsideration of the Office's Decision to Expunge Third Party Requester's Cross-Appeal Brief," filed January 21, 2011 ("Opposition"). In the Petition, Requester "requests that the Office reconsider its Decision on Petition of December 12, 2010 . . . expunging Third Party Requester's Cross-Appeal Brief." Petition, p. 1.

FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 23, 2010, Rambus filed an Appeal Brief.

13. On September 23, 2010, Micron filed a Cross-Appeal Brief.

14. On October 25, 2010, Rambus filed a Respondent Brief and a Petition to Expunge Third-Party Requester's Appeal Brief.

15. On December 9, 2010, the Office issued a Decision on Petition granting Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief.

16. The present Petition was filed on January 3, 2010.

17. The present Opposition was filed on January 21, 2011.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision*

> *favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

Also relevant is MPEP § 2674(B):

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

(emphasis in original).

ANALYSIS

In the Decision on Petition issued by the Board on December 9, 2010, the Board relied on MPEP § 2674(B) in granting Rambus's Petition to Expunge Micron's Cross-Appeal Brief because Micron's Cross-Appeal Brief presented patentability issues that initially were raised by Third-Party Requester Samsung. After further review and consideration of this matter, the Board finds that the relevant statutes, rules and MPEP sections quoted above are intended to include all proposed rejections presented by the Examiner, patent owner or requester(s) during prosecution of a single

unmerged reexamination proceeding or plural merged reexamination proceedings.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the language:

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

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

DECISION

In view of the forgoing, the Petition is GRANTED. Micron's Cross-Appeal Brief (appellant brief), filed September 23, 2010, is hereby restored to the record.

Patent Owner Rambus is granted a period of one month or 30 days, whichever is longer, to file a respondent brief.

James T. Moore
Acting Chief Administrative Patent Judge

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed October 25, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office expunge Micron's appeal brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,128 ...)." Petition, p. 1.

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

Copied from 95001128 on 03/01/2011

FINDINGS

1. Patent 6,378,020 issued on April 23, 2002 with 41 claims. The '020 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008. Reexamination Control 95/001,026 was assigned to this request.

3. On April 9, 2008, the Office issued an Order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent in the '026 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008. Reexamination Control 95/001,128 was assigned to this request.

5. On February 6, 2009, the Office issued an Order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent in the '128 proceeding.

6. On July 21, 2009, the '026 and '128 proceedings were merged.

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 30, 35-36 and 38-41, and confirming claims 31-33.

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

9. On June 11, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

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10. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

11. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

12. On September 9, 2010, Rambus filed an Appeal Brief.

13. On September 23, 2010, Micron filed a Cross-Appeal Brief.

14. On October 25, 2010, Rambus filed a Respondent Brief along with the present Petition.

RELEVANT AUTHORITY

Concerning the contents of appellant briefs, 37 C.F.R. §§ 41.67(c)(1)(vi) and (vii) provide:

> (vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. . . .
>
> (vii) *Argument.* The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on.

In respect to the issues that can be raised by a requester on cross appeal, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

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Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

More restrictively, MPEP § 2674(B) provides:

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

(emphasis in original).

ANALYSIS

Rambus argues that because Micron's Cross-Appeal Brief is in part directed to rejections originally proposed by Samsung and not Micron, the brief should be expunged. Specifically, Rambus identifies sections VII.C, VII.G, VII.H and VII.I of Micron's Cross-Appeal Brief as presenting rejections and a priority issue that initially were raised by Samsung and that were not adopted by the Examiner. Petition, pp. 2-3. Micron did not present any of these issues in its Request for Reexamination.

In support of its argument, Rambus cites, *inter alia*, MPEP § 2674(B), and *Meadwestvaco Packaging Systems, LLC v. Patent of C. Brown Lingamfelter*, Appeal 2009-002578 (BPAI Jan. 12, 2010).

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As quoted above, the seemingly inconsistent provisions of MPEP §§ 2674(B) and 2674.01 with respect to the rejections that can be raised on appeal by a requester are not inconsistent when considering the context of these sections. MPEP § 2674.01, following 37 C.F.R. § 41.61(b)(2), describes the timing and general subject matter of a requester's notice of cross-appeal in an *inter partes* reexamination proceeding. MPEP § 2674(B), on the other hand, describes with particularity the subject matter that can be raised by a specific requester in a notice of appeal or cross appeal.

It is significant here that the brief in issue is Micron's appellant brief and not a respondent brief. As indicated above, in a notice of appeal (or cross appeal), a requester is limited to presenting rejections *previously proposed by that third party requester.* MPEP § 2674(B). Whereas, in respect to a respondent brief:

> After an appellant brief has been properly filed, a party opposing the appellant may file a respondent brief in support of the claim determination(s) made in the Right of Appeal Notice (RAN) which are in favor of the opposing party. The respondent brief must, however, be limited to issues raised in the appellant brief to which the respondent brief is directed.

MPEP § 2675.01. Thus, a requester's respondent brief may address issues raised in the patent owner's appellant brief irrespective of where those issues originated.

In *Meadwestvaco,* where a first requester attempted to raise in an appellant brief a rejection initially proposed by a second requester, the Board held that only the second requester could raise that rejection on appeal. *Meadwestvaco* at 81.

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DECISION

In view of the forgoing, the Petition is GRANTED. Micron's Cross-Appeal Brief (appellant brief) will be expunged and Micron is granted one month from the mailing date hereof to file a replacement appellant brief.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,026	01/31/2008	6378020	38512.9	1090

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/09/2011

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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITIONS

This is a decision on patent owner's "Petition Seeking Review of Decision Granting Third Party Requester's Request for Reconsideration of the Office's Decision to Expunge Third-Party Requester's Cross-Appeal Brief," filed March 16, 2011 ("Petition #1"). In the petition, patent owner requests that the previous petition decision of February 16, 2011, be overturned and that the Office expunge Micron's cross-appeal brief from the record. The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to patent owner's deposit account, as authorized on page 1 of the petition.

This is also a decision on requester's opposition of April 15, 2011, to the patent owner's petition of March 16, 2011, seeking reconsideration of the Office's

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

decision not to expunge requester's appellant brief ("Petition #2"). The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to requester's deposit account, as authorized on page 2 of the petition.

This is further a decision on patent owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Replacement Respondent Brief" of February 10, 2011("Petition #3"). The petition requests waiver of the page limit to accept the respondent brief, including the Murphy declaration. The petition fee pursuant to 37 C.F.R. § 1.17(f) has been paid by check.

FINDINGS

1. U.S. Patent No. 6,378,020 issued on April 23, 2002, with 41 claims. The '020 patent is assigned to patent owner Rambus, Inc. ("Rambus").
2. Third party requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008, which was assigned reexamination control no. 95/001,026.
3. On April 9, 2008, an order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent was mailed in the '1026 proceeding.
4. Third party requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008, which was assigned reexamination control no. 95/001,128.
5. On February 6, 2009, an order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent was mailed in the '1128 proceeding.
6. On July 21, 2009, the '1026 and '1128 proceedings were merged.
7. Prosecution was conducted and on June 11, 2010, a Right of Appeal Notice ("RAN") was mailed, rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

8. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

9. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

10. Rambus filed an appellant brief on September 23, 2010.

11. Micron filed an appellant brief on September 23, 2010.

12. Rambus filed a respondent brief, accompanied by a petition seeking waiver of the page limit on October 25, 2010. On the same date, Rambus also filed a petition seeking expungement of Micron's appellant brief of September 23, 2010.

13. Micron filed a respondent brief on October 25, 2010.

14. A decision granting the expungement of Micron's appellant brief and a decision denying the waiver petition for Rambus' respondent brief were mailed on December 9, 2010. A decision granting the waiver petition for Rambus' respondent brief was also mailed on December 9, 2010.

15. Rambus filed a petition on December 27, 2010, seeking expungement of Micron's respondent brief of October 25, 2010.

16. On January 3, 2011, Micron filed a petition for reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

17. On January 10, 2011, Micron filed a replacement appellant brief in accordance with the petition decision of December 9, 2010.

18. Micron filed an opposition on January 14, 2011, to Rambus' petition to expunge Micron's respondent brief.

19. Rambus filed an opposition on January 21, 2011, to Micron's January 3, 2011, petition requesting reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

20. On February 10, 2011, Rambus filed a replacement respondent brief in reply to Micron's replacement appellant brief of January 10, 2011, which was accompanied by Petition #3.

21. On February 16, 2011, a decision granting Micron's request for reconsideration of the decision to expunge Micron's appellant brief was mailed, which restored Micron's appellant brief of September 23, 2010, to the record. On the same date, a decision denying Rambus' December 27, 2010, petition to expunge Micron's respondent brief was mailed.

22. Rambus filed Petition #1 on March 16, 2011, which includes a request to enter Rambus' respondent brief of October 25, 2010, in view of the entry of Micron's appellant brief of September 23, 2010.

23. On March 16, 2011, Rambus also filed a petition seeking review of the decision denying Rambus' petition to expunge Micron's respondent brief.

24. Micron filed Petition #2 on April 15, 2011, in opposition to Rambus' March 16, 2011, Petition #1.

25. Micron also filed an opposition on April 18, 2011, to Rambus' March 16, 2011, petition seeking review of the decision denying Rambus' petition to expunge Micron's respondent brief.

RELEVANT AUTHORITY

With respect to the issues that can be raised by a requester on appeal, **35 U.S.C. 315(b)(1) provides**:

> A third party requester –
> may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to **any final decision favorable to the patentability of any original or proposed amended or new claim of the patent** (emphasis added).

37 C.F.R. § 41.61(a)(2) provides:

> (2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to **any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent** by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1) (emphasis added).

ANALYSIS

The exact same issue posed by Rambus' Petition #1 has been addressed recently by the Board in deciding several similar petitions filed by Rambus. Rambus seeks expungement of Micron's cross-appeal brief because it presents arguments premised on rejections proposed initially by Samsung and not by Micron. Clearly, the Board has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed rejections that were before the Office at the time of the RAN[1]. In view of the detailed analysis that the Board has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

Petition #1 is **denied**.

Petition #2 is **granted**.

Since Micron's appellant brief of September 23, 2010, is restored to the record, Rambus' respondent brief of October 25, 2010, now has an entry right. Rambus' respondent brief of October 25, 2010, is entered and the petition to waive

[1] See Merged Proceedings 95/000,183 and 95/001,112, April 15,2011; 95/000,250 and 95/001,124, April 27, 2011; 95/000,166 and 95/001,122, May 31, 2011; 95/000,178 and 95/001,152, June 7, 2011.

the page limit accompanying the respondent brief has been granted for the reasons given in the previous petition decision granting the waiver of December 9, 2010.

Petition #3 is **dismissed as moot** in view of the entry of Rambus' respondent brief of October 25, 2010.

DECISION

In view of the forgoing, Petition #1 is DENIED; Petition #2 is GRANTED; and Petition #3 is DISMISSED AS MOOT.

This Decision constitutes Final Agency Action on this matter.

James Donald Smith
Chief Administrative Patent Judge

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Washington, DC 20001-4413

Inter partes Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,026	01/31/2008	6378020	38512.9	1090

22852 7590 06/10/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/10/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITIONS

This is a decision on patent owner's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Respondent Brief," filed March 16, 2011 ("Petition #1"). In the petition, patent owner requests "that the Office expunge Micron's respondent brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,128 ...)." The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to patent owner's deposit account, as authorized on page 2 of the petition.

This is also a decision on requester's opposition of April 18, 2011, to the patent owner's petition of March 16, 2011, seeking to expunge requester's

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

respondent brief ("Petition #2"). The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to requester's deposit account, as authorized on page 8 of the petition.

FINDINGS

1. U.S. Patent No. 6,378,020 issued on April 23, 2002, with 41 claims. The '020 patent is assigned to patent owner Rambus, Inc. ("Rambus").

2. Third party requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008, which was assigned reexamination control no. 95/001,026.

3. On April 9, 2008, an order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent was mailed in the '1026 proceeding.

4. Third party requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008, which was assigned reexamination control no. 95/001,128.

5. On February 6, 2009, an order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent was mailed in the '1128 proceeding.

6. On July 21, 2009, the '1026 and '1128 proceedings were merged.

7. Prosecution was conducted and on June 11, 2010, a Right of Appeal Notice ("RAN") was mailed, rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

8. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

9. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

10. Rambus filed an appellant brief on September 23, 2010.

11. Micron filed an appellant brief on September 23, 2010.

12. Rambus filed a respondent brief, accompanied by a petition seeking waiver of the page limit on October 25, 2010. On the same date, Rambus also filed a petition seeking expungement of Micron's appellant brief of September 23, 2010.

13. Micron filed a respondent brief on October 25, 2010.

14. A decision granting the expungement of Micron's appellant brief and a decision denying the waiver petition for Rambus' respondent brief were mailed on December 9, 2010.

15. Rambus filed a petition on December 27, 2010, seeking expungement of Micron's respondent brief of October 25, 2010.

16. On January 3, 2011, Micron filed a petition for reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

17. On January 10, 2011, Micron filed a replacement appellant brief in accordance with the petition decision of December 9, 2010.

18. Micron filed an opposition on January 14, 2011, to Rambus' petition to expunge Micron's respondent brief.

19. Rambus filed an opposition on January 21, 2011, to Micron's January 3, 2011, petition requesting reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

20. On February 10, 2011, Rambus filed a replacement respondent brief in reply to Micron's replacement appellant brief of January 10, 2011, which was accompanied by a petition to waive the page limit and accept the respondent brief, including the Murphy declaration.

21. On February 16, 2011, a decision granting Micron's request for reconsideration of the decision to expunge Micron's appellant brief was mailed, which restored Micron's appellant brief of September 23, 2010, to the record. On

the same date, a decision denying Rambus' December 27, 2010, petition to expunge Micron's respondent brief was mailed.

22. Rambus filed a petition on March 16, 2011, seeking review of the decision granting Micron's request for reconsideration of the Office's decision to expunge Micron's appellant brief.

23. On March 16, 2011, Rambus filed Petition #1.

24. Micron filed an opposition on April 15, 2011, to Rambus' March 16, 2011, petition seeking review of the decision granting Micron's request for reconsideration of the Office's decision to expunge Micron's appellant brief.

25. Micron filed Petition #2 on April 18, 2011.

RELEVANT AUTHORITY

With respect to the contents of respondent briefs,

37 C.F.R. § 41.68(a)(3) provides:

> The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

MPEP 2675.01 provides in pertinent part:

> After an appellant brief has been properly filed, a party opposing the appellant may file a respondent brief in support of the claim determination(s) made in the Right of Appeal Notice (RAN) which are in favor of the opposing party. The respondent brief must, however, be limited to issues raised in the appellant brief to which the respondent brief is directed. 37 CFR 41.68(a)(3).
>
> . . .
>
> It should be noted that where a party fails to file a timely notice of appeal or notice of cross appeal, that party may no longer file an appellant brief to appeal a claim determination adverse to that party; however, that party is permitted to file a respondent brief in accordance with 37 CFR 41.66(b).
>
> . . .

> A statement of what in the appellant brief is accepted and what is disputed must be provided in the respondent brief. Respondent must set forth the authorities and arguments upon which he/she will rely to dispute the contentions of the appellant with respect to the issues.
>
> . . .

ANALYSIS

Rambus argues that because Micron's respondent brief is directed to rejections originally proposed by Samsung and not Micron, the brief should be expunged. The exact same issue posed by Rambus' Petition #1 has been addressed recently by the Board in deciding several similar petitions filed by Rambus. Rambus seeks expungement of Micron's respondent brief because it responds to Rambus' arguments premised on rejections proposed initially by Samsung and not by Micron. Clearly, the Board has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed rejections that were before the Office at the time of the RAN[1]. In view of the detailed analysis that the Board has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

Petition #1 is **denied**.

Petition #2 is **granted**.

DECISION

In view of the forgoing, Petition #1 is DENIED; Petition #2 is GRANTED.

This Decision constitutes Final Agency Action on this matter.

[1] See Merged Proceedings 95/000,183 and 95/001,112, April 15,2011; 95/000,250 and 95/001,124, April 27, 2011; 95/000,166 and 95/001,122, May 31, 2011; 95/000,178 and 95/001,152, June 7, 2011.

Jurisdiction of this merged *inter partes* reexamination proceeding is returned to the Central Reexamination Unit (CRU) for preparation of the next appropriate Office action in view of the acceptance of the patent owner and requester appellant briefs of September 23, 2010, and the patent owner and requester respondent briefs of October 25, 2010.

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.
95/001,128	12/15/2008	6378020	8963.002.020	1029

22852 7590 08/30/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,026	01/31/2008	6378020	38512.9	1090

22852 7590 08/30/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128
Patent 6,378,020

DECISION ON PETITION

This is a decision on "Third Party Requester's Petition under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c)," filed July 18, 2011 (present petition). In the petition, requester requests limited waiver of 37 C.F.R. § 1.943(c), so that Micron may submit a rebuttal brief containing up to 7,784 words or 19 pages. The petition fee pursuant to 37 C.F.R. § 1.17(f) has been charged to

requester's deposit account on July 19, 2011, 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. U.S. Patent No. 6,378,020 issued on April 23, 2002, with 41 claims. The '020 patent is assigned to patent owner Rambus, Inc. ("Rambus").

2. Third party requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination on January 31, 2008, which was assigned reexamination control no. 95/001,026.

3. On April 9, 2008, an order granting *inter partes* reexamination of claims 30-33, 35, 36, and 38-41 of the '020 patent was mailed in the '1026 proceeding.

4. Third party requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on December 15, 2008, which was assigned reexamination control no. 95/001,128.

5. On February 6, 2009, an order granting *inter partes* reexamination of claims 30, 35 and 36 of the '020 patent was mailed in the '1128 proceeding.

6. On July 21, 2009, the '1026 and '1128 proceedings were merged.

7. Prosecution was conducted and on June 11, 2010, a Right of Appeal Notice ("RAN") was mailed, rejecting claims 30, 38 and 39 and confirming claims 31-33, 35, 36, 40 and 41.

8. On July 9, 2010, Rambus filed a Notice of Appeal for claims 30, 38 and 39.

9. On July 23, 2010, Micron filed a Notice of Cross Appeal for claims 30, 35 and 36.

10. Rambus filed an appellant brief on September 23, 2010.

11. Micron filed an appellant brief on September 23, 2010.

12. Rambus filed a respondent brief, accompanied by a petition seeking waiver of the page limit on October 25, 2010. On the same date, Rambus also filed a petition seeking expungement of Micron's appellant brief of September 23, 2010.

13. Micron filed a respondent brief on October 25, 2010.

14. A decision granting the expungement of Micron's appellant brief and a decision denying the waiver petition for Rambus' respondent brief were mailed on December 9, 2010.

15. Rambus filed a petition on December 27, 2010, seeking expungement of Micron's respondent brief of October 25, 2010.

16. On January 3, 2011, Micron filed a petition for reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

17. On January 10, 2011, Micron filed a replacement appellant brief in accordance with the petition decision of December 9, 2010.

18. Micron filed an opposition on January 14, 2011, to Rambus' petition to expunge Micron's respondent brief.

19. Rambus filed an opposition on January 21, 2011, to Micron's January 3, 2011, petition requesting reconsideration of the Office's December 9, 2010, decision to expunge Micron's appellant brief.

20. On February 10, 2011, Rambus filed a replacement respondent brief in reply to Micron's replacement appellant brief of January 10, 2011, which was accompanied by a petition to waive the page limit and accept the respondent brief, including the Murphy declaration.

21. On February 16, 2011, a decision granting Micron's request for reconsideration of the decision to expunge Micron's appellant brief was mailed, which restored Micron's appellant brief of September 23, 2010, to the record. On

the same date, a decision denying Rambus' December 27, 2010, petition to expunge Micron's respondent brief was mailed.

22. Rambus filed a petition on March 16, 2011, seeking review of the decision granting Micron's request for reconsideration of the Office's decision to expunge Micron's appellant brief.

23. On March 16, 2011, Rambus filed a petition seeking review of a decision denying patent owner's petition to expunge requester's respondent brief.

24. Micron filed an opposition on April 15, 2011, to Rambus' March 16, 2011, petition for review of the decision granting Micron's request for reconsideration of the Office's decision to expunge Micron's appellant brief.

25. Micron filed an opposition on April 18, 2011, to Rambus' March 16, 2011, petition for review of the decision denying patent owner's petition to expunge requester's respondent brief.

26. On June 9, 2011, a decision was mailed in which Rambus' petition of March 16, 2011, seeking expungement of Micron's appellant brief was denied; Micron's opposition of April 15, 2011, was granted; and Rambus' petition of February 10, 2011, was dismissed as moot; noting that since Micron's appellant brief of October 25, 2010, was entered, that Rambus' respondent brief of October 25, 2010, was entered.

27. On June 10, 2011, a decision was mailed in which Rambus' petition of March 16, 2011, seeking expungement of Micron's respondent brief was denied; and Micron's opposition of April 18, 2011, was granted.

28. Micron filed the present petition on July 18, 2011.

DISCUSSION

In the present petition, Micron requests waiver of the limits of 37 C.F.R. § 1.943(c), which limits requester's rebuttal brief to 15 pages or 7,000 words in length. Micron's rebuttal brief is stated to be 7,784 words or 19 pages. Micron asserts that since Rambus' respondent brief of October 25, 2010, amounted to 12,553 words and 23 pages, that justice requires granting more than the 7,000 words or 15 pages allowed under 37 C.F.R. § 1.943(c) for Micron to reply to all of the arguments raised by Rambus' respondent brief, as well as the examiner's answer of June 17, 2011. Micron contends that an extraordinary situation results since the Office granted Rambus' petition to nearly double the word count for its respondent brief.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.943(c) provides:

> 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. § 41.71 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.

ANALYSIS

Micron's rebuttal brief filed on July 18, 2011, is stated to be 7,784 words or 19 pages, which count toward the limit of 15 pages and 7,000 words. It exceeds the page and word limit.

Petitioner's reasons provided in support of waiving the page/word limits focus on Rambus' respondent brief of October 25, 2010, which amounted to 12,553 words and 23 pages. Petitioner asserts that justice requires granting more than the 7,000 words or 15 pages allowed under 37 C.F.R. § 1.943(c) for Micron to reply to all of the arguments raised by Rambus' respondent brief, as well as the examiner's answer of June 17, 2011. Micron contends that an extraordinary situation results since the Office granted Rambus' petition to nearly double the word count for its respondent brief.

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 Micron's rebuttal brief. The present petition is **granted,** and Micron's rebuttal brief of July 18, 2011, is entered.

DECISION

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

Jurisdiction of this merged *inter partes* reexamination proceeding is returned to the Central Reexamination Unit (CRU) for preparation of the next appropriate Office action in view of the receipt of the patent owner and requester rebuttal briefs of July 18, 2011.

James Donald Smith
Chief Administrative Patent Judge

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(FOR PATENT OWNER)

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NOV 15 2011

CENTRAL REEXAMINATION UNIT

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(FOR THIRD PARTY REQUESTER)

In re Ording et al.
Reexamination Proceeding
Control No. : 95/001,028
Filed: January 30, 2008
Patent No. 6,991,298

: **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 October 10, 2011 patent owner petition, entitled "Petition under 37 CFR § 1.181(a) to Withdraw Holding of Abandonment." The petition is requesting that the non-final Office action of July 15, 2011 be withdrawn and the non-final Office action be mailed again in the proceeding record.

The patent owner's petition is dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,991,298 (the '298 patent) issued on January 31, 2006.

2. A request for reexamination, assigned Control No. 95/001,028 (the '028 proceeding), was filed by a third party requester on January 30, 2008.

3. Reexamination was ordered in the '028 reexamination proceeding on February 27, 2008. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on January 28, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision that contained a new ground of rejection.

5. On February 28, 2011, the patent owner filed a request to reopen prosecution under 37 CFR 41.77(b)(1).

6. On March 24, 2011, the third party requester filed their comments.

7. On July 15, 2011, the Office mailed a non-final Office action.

8. On October 10, 2011, the patent owner filed the instant petition under 37 CFR 1.181 because the July 15, 2011 action was not received by the patent owner's representative.

9. On October 12, 2011, a duplicative copy of the instant petition was entered into the file.

DECISION

As pointed out, the patent owner filed an October 10, 2011 petition under 37 CFR 1.181 requesting withdrawal of the July 15, 2011 non-final Office action and remailing of a non-final Office action in the proceeding record. Patent owner alleges that the July 15, 2011 non-final Office action was not received and provides evidence in accordance with the policies set forth in MPEP 711.03(c).

Upon review of the record by the director, it is determined that the July 15, 2011 non-final Office action was not issued in accordance with 37 CFR 41.77 or the policies set forth in MPEP 2682. Specifically, the action following a request to reopen prosecution under 41.77(b)(1) in an *inter partes* reexamination proceeding should be an action under 37 CFR 41.77(d). Alternatively, under rare circumstances, prosecution may be reopened by the examiner upon written consent of the director. The July 15, 2011 action was not clearly designated as an action under 37 CFR 41.77(d) nor did it contain the director's written consent to reopen prosecution. Therefore, the July 15, 2011 non-final Office action was not issued in accordance with regulations and policies pertaining to limited prosecution after a BPAI decision. Accordingly, for these reasons, the <u>non-final Office action of July 15, 2011 is hereby vacated</u>.

Therefore, the relief requested by the October 10, 2011 petition is given as a result of the vacatur of the July 15, 2011 non-final Office action. Thus, the patent owner's October 10, 2011 petition is moot, and hereby, dismissed.

CONCLUSION

1. The October 10, 2011 patent owner's petition is dismissed as moot.

2. The non-final Office action of July 15, 2011 is hereby vacated for the reasons set forth in this decision.

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

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

Irem Yücel, Director
Technology Center 1600

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(FOR THIRD PARTY REQUESTER)

In re Ording et al.
Reexamination Proceeding
Control No. : 95/001,028
Filed: January 30, 2008
Patent No. 6,991,298

: **DECISION**
: **GRANTING**
: **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 October 10, 2011 patent owner petition, entitled "Petition under 37 CFR § 1.181(a) to Withdraw Holding of Abandonment." The petition is requesting that the non-final Office action of July 15, 2011 be withdrawn and the non-final Office action be mailed again in the proceeding record.

The patent owner's petition is granted to the extent that the July 15, 2001 Office action will be expunged and a new Office action will be issued.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 6,991,298 (the '298 patent) issued on January 31, 2006.

2. A request for reexamination, assigned Control No. 95/001,028 (the '028 proceeding), was filed by a third party requester on January 30, 2008.

3. Reexamination was ordered in the '028 reexamination proceeding on February 27, 2008. On the same day, an Office action on the merits was mailed.

4. Prosecution advanced and on January 28, 2011, the Board of Patent Appeals and Interferences (BPAI) mailed a decision that contained a new ground of rejection.

5. On February 28, 2011, the patent owner filed a request to reopen prosecution under 37 CFR 41.77(b)(1).

6. On March 24, 2011, the third party requester filed their comments.

7. On July 15, 2011, the Office mailed a non-final Office action.

8. On October 10, 2011, the patent owner filed the instant petition under 37 CFR 1.181 because the July 15, 2011 action was not received by the patent owner's representative.

9. On October 12, 2011, a duplicative copy of the instant petition was entered into the file.

DECISION

As pointed out, the patent owner filed an October 10, 2011 petition under 37 CFR 1.181 requesting withdrawal of the July 15, 2011 Non-final Office action and remailing of a non-final Office action in the proceeding record. Patent owner alleges that the July 15, 2011 non-final Office action was not received.

Upon review of the record by the director, it is determined that the October 10, 2011 petition and supporting exhibits provides evidence that the July 15, 2011 Office action was not received at the patent owner's correspondence address of record. Specifically, the petition includes statements describing the system used for recording an Office action received at the patent owner's correspondence address (see paragraphs 4 and 5 in the petition). The petition also states that the Office action was not received at the patent owner's correspondence address of record, and that a search of the practitioner's records, including their file jacket of this proceeding, indicates that the Office action was not received (see paragraph 7 in the petition and Exhibit A). In addition, a copy of the master docket was provided in Exhibit B, which shows no entry for a response due in this proceeding two months from July 15, 2011 Office action. Therefore, the October 10, 2011 petition has provided a showing of failure to receive an Office action in accordance with the policies set forth in MPEP 711.03(c). Accordingly, the petition is granted.

For this reason, the July 15, 2011 non-final Office action will be expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

CONCLUSION

1. The October 10, 2011 patent owner's petition is granted.

2. The non-final Office action of July 15, 2011 will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

3. The proceeding will be forwarded to the examiner issuance of a new Office action in due course.

4. Telephone inquiries related to this decision should be directed Andres 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.
95/001,036	04/02/2008	7139404	Q105786	8422

29053 7590 08/22/2011

FULBRIGHT & JAWORSKI L.L.P
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/22/2011

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Date: 8-22-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Robert Greene Sterne
STERNE KESSLER GOLDSTEIN & FOX P.L.L.C.
1100 New York Avenue, NW
Washington, DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001036
PATENT NO. : 7139404
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 Patent Owner)

(For Third Party Requester)

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

In re Feeley *et alia*
Reexamination Proceeding
Control No. 95/001,036
For: U.S. Patent No. 7,139,404

DECISION DISMSSING PETITION

The *inter partes* reexamination is before the Central Reexamination Unit for consideration of a paper filed February 24, 2011 requesting "that a Right of Appeal Notice be issued in the present case".

A review of the file indicates that a Right of Appeal Notice was mailed on March 16, 2011.

Accordingly, the petition is **dismissed as moot**.

This is not a final agency action. The decision is made without prejudice to a request for reconsideration or higher-level review.

Eric Keasel

Eric Keasel
SPE, AU 3992

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.
95/001,036	04/02/2008	7139404	Q105786	8422

29053 7590 08/30/2011

FULBRIGHT & JAWORSKI L.L.P
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DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes

K/S Hearing Instrument Manufacturers Patent Partnership, Inc.

v.

Hear-Wear Technologies, LLC

Inter Partes Reexamination Control No. 95/001,036

Patent 7,139,404

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Appeal Brief," filed July 14, 2011 (present petition). In the petition, patent owner requests that the Office determine that requester's appellant brief is not compliant with 37 C.F.R. § 41.67. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on July 15, 2011.

This is also a decision on "Requester's Opposition to Patent Owner's Petition under 37 C.F.R. § 1.182," filed August 12, 2011 (opposition petition). In the opposition petition, petitioner requests that the Office determine that requester's appellant brief is proper and compliant with 37 C.F.R. § 41.67. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on August 24, 2011.

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

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,139,404, on April 2, 2008, which was assigned control no. 95/001,036.
2. On June 12, 2008, reexamination was ordered and on February 25, 2009, a non-final Office action was mailed, rejecting claims 1-45.
3. Patent owner filed a petition on March 3, 2009, requesting that a new Office action be mailed, because the 140 grounds of rejection were not set forth with a degree of particularity pursuant to 35 U.S.C. 132(a).
4. On March 11, 2009, a non-final Office action was mailed, rejecting claims 1-45.
5. Patent owner filed a response to the non-final Office action on May 11, 2009, along with a petition requesting waiver of the 50 page limit pursuant to 37 C.F.R. § 1.943(b).

6. Requester filed comments on June 10, 2009, accompanied by a petition to waive the page limit.
7. On June 23, 2009, a decision granting the petition to permit entry of the 66 page response by patent owner was mailed.
8. Patent owner filed a petition requesting that the requester's comments be held non-compliant with 37 C.F.R. § 1.947 and § 1.948 on June 24, 2009, purporting that the comments contain newly proposed grounds of rejection, when patent owner has not filed any amendments to the claims.
9. On September 3, 2009, a decision granting the petition to hold requester's comments as non-compliant was mailed, setting a 15 day time period for requester to file corrected comments.
10. Requester filed corrected comments on September 18, 2009.
11. Patent owner filed a petition on September 22, 2009, requesting that the requester's comments of September 18, 2009, be found non-compliant with 37 C.F.R. § 1.947 and § 1.948.
12. Patent owner filed another petition on December 23, 2009, requesting that the requester's comments of June 10, 2009, be expunged from the record because the comments were deemed defective under 37 C.F.R. § 1.947.
13. On March 31, 2010, a non-final Office action was mailed, rejecting claims 1-30 and confirming patentability of claims 31-45.
14. On April 23, 2010, a decision on petitions was mailed, which found that a corrected non-final Office action had been mailed on March 31, 2010, and therefore dismissed the petitions of March 3, 2009, and March 20, 2009, as moot. The decision also found the requester's

comments of June 10, 2009, to be improper, as well as found the requester's comments of September 18, 2009, to be improper, and therefore dismissed the petitions of June 2,2009, and September 22, 2009, as moot.

15. The requester filed a petition on May 14, 2010, requesting reversal of the decision of April 23, 2010, to expunge the requester's comments.
16. Patent owner filed a petition on May 21, 2010, requesting that the Office dismiss requester's petition of May 14, 2010.
17. On August 6, 2010, an Action Closing Prosecution (ACP) was mailed, withdrawing claims 1-30 from consideration for patent owner's failure to respond to the previous Office action, and confirming patentability of claims 31-45.
18. On March 16, 2011, a Right of Appeal Notice (RAN) was mailed, confirming patentability of claims 31-45.
19. Patent owner filed a petition on March 25, 2011, requesting that the instant *inter partes* reexamination not be merged with *ex parte* reexamination 90/011,480.
20. Requester filed a Notice of Appeal on April 15, 2011, appealing the refusal to adopt 110 proposed rejections of claims 31-45.
21. Requester filed an opposition to the patent owner's petition not to merge on April 21, 2011.
22. Requester filed an appellant brief on June 14, 2011.
23. Patent owner filed a respondent brief on July 14, 2011, accompanied by the present petition.

24. Requester filed an opposition to the present petition on August 12, 2011.
25. On August 22, 2011, a decision dismissing the petition of February 24, 2011, was mailed.

DISCUSSION

In the present petition, patent owner requests that the Office determine that requester's appellant brief is not compliant with 37 C.F.R. § 41.67. Petitioner contends that in the appellant brief, requester impermissibly proposed new grounds of rejections. Petitioner states that requester asserts for the first time references, *e.g.*, Rapps, and other reasons/combinations, that should be used to reject claim 31, which have never been relied on by the requester or the examiner to meet limitations of claim 31 before in the instant *inter partes* reexamination proceeding (appellant brief pp. 16-17).

In the opposition petition, requester asserts that the appellant brief of June 12, 2011, is proper because the original request and claim charts as filed provided proposed rejections of claims 31-34 over Toht in view of Reiter, and further in view of Rapps.

RELEVANT AUTHORITY

37 CFR § 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in

writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 41.67(c)(1)(vi) provides:

Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

ANALYSIS

Patent owner's petition has been considered fully. A review of the prosecution history of this proceeding reveals that the *inter partes* reexamination request and claim charts include a proposed rejection of claim 31 over Toht in view of Reiter, further in view of Shennib, but not further in view of Rapps, as suggested by requester in the opposition petition. The request does include a few proposed rejections of claim 34 over a combination of references including Toht in view of Reiter, and . . ., further in view of Rapps. The requester's appellant brief contains newly presented proposed grounds of rejection and therefore is not in compliance with 37 C.F.R. § 41.67.

The present petition is **granted**. The opposition petition is **denied,** and the appellant brief of June 14, 2011, is not entered.

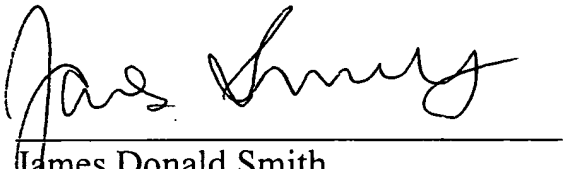
DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time

period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the requester's appeal will be dismissed.

If a corrected appellant brief is timely received, then patent owner's respondent brief will be due pursuant to 37 C.F.R. § 41.66.

In view of the foregoing, the present petition is GRANTED, and the opposition petition is DENIED.



James Donald Smith
Chief Administrative Patent Judge

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EXAMINER

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001036
PATENT NO. : 7139404
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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In re Feeley *et al.* *Inter partes* Reexamination Proceeding Control No.: 95/001,036 Filed: April 2, 2008 For: U.S. Patent No. 7,139,404	DECISION ON PETITION TO PREVENT MERGER OF REEXAMINATION PROCEEDINGS
In re Feeley *et al.* *Ex Parte* Reexamination Proceeding Control No.: 90/011,480 Filed: February 8, 2011 For: U.S. Patent No. 7,139,404	

This is a decision on patent owner's March 25, 2011 petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO SUPPORT A DECISION AGAINST MERGER OF THE PRESENT CASE WITH A SUBSEQUENTLY FILED REEXAMINATION PROCEEDING" filed in *inter partes* reexamination proceeding 95/001,036. On April 21, 2011, third party requester filed an opposition entitled "REQUESTER OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.182 to patent owner's March 25, 2011 petition.

FEE

The Third Party Requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400 will be charged to Requester's deposit account no. 19-0036 pursuant to an oral authorization in a phone conversation with Jon Wright on September 8, 2011.

The patent owner petition and third party requester opposition petition are before the Office of Patent Legal Administration for consideration.

Patent owner's petition is granted, and the above captioned proceedings are NOT merged for the reasons set forth below.

Third party requester's opposition petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On November 21, 2006, the Office issued U.S. Patent No. 7,139,404 (the '404 patent) to Feeley *et al.*

2. The '404 patent is subject to litigation in the United States District Court for the Northern District of Oklahoma, in *Hear-Wear Technologies, LLC v. Oticon Inc. et al.*, {Civil Action No. 07:CV-212-CVE-FHM}. The initial complaint was filed April 16, 2007.

3. On April 2, 2008, a request for *inter partes* reexamination of all the claims (claims 1-45) of the '404 patent was filed by third party requester (requester) K/S Hearing Instrument Manufactures Patent Partnership (HIMPP). The request was assigned Control No. 95/001,036 (the '1036 proceeding).

4. On June 12, 2008, the Office issued an order granting the '1036 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 '404 patent, claims 1-45, would be subject to reexamination.

5. On February 25, 2009, the Office issued a non-final Office action in the '1036 proceeding.

6. On March 11, 2009, the Office *sua sponte* issued a new non-final Office action in the '1036 proceeding.

7. On May 11, 2009, patent owner timely filed a response to the March 11, 2009 non-final Office action.

8. On June 10, 2009, third party requester filed comments after patent owner's response.

9. On September 3, 2009, the Office issued a decision expunging, as improper, third party requester's June 10, 2009 comments and giving third party requester 15-days to submit proper comments.

10. On September 18, 2009, third party requester submitted corrected comments.

11. On March 31, 2010, the Office issued another non-final Office action in the '1036 proceeding rejecting claims 1-30 and confirming claims 31-45.

12. On April 23, 2010, the Office issued a decision expunging as improper third party requester's September 18, 2009 corrected comments submission. Third party requester was not given another opportunity to file third party comments.

13. On May 14, 2010, third party requester filed a petition under 37 CFR 1.181 requesting entry of the September 18, 2009 revised requester comments.

14. On August 6, 2010, the Office issued an Action Closing Prosecution in the '1036 proceeding (a) withdrawing claims 1-30 from further consideration due to patent owner's failure to respond to the March 31, 2010 non-final Office action and (b) confirming claims 31-45.

15. On February 8, 2011, a request for *ex parte* reexamination of claims 31-45 of the '404 patent was filed by Robert Sterne of the Sterne Kessler Goldstein and Fox law firm. The request was assigned Control No. 90/011,480 (the '11480 proceeding).

16. On March 16, 2011, the Office issued an order granting the '11480 request for *ex parte* reexamination. Patent owner waived the right to submit a Patent Owner's Statement under 37 CFR 1.530. The order stated that claims 31-45 of the '404 patent, would be subject to reexamination.

17. Also on March 16, 2011, the Office issued a Right of Appeal Notice (RAN) in the '1036 proceeding, withdrawing claims 1-30 from further consideration due to patent owner's failure to respond and confirming claims 31-45.

18. On March 25, 2011, patent owner filed the present petition to prevent merger.

19. On April 15, 2011, third party requester filed a notice of appeal in the '1036 proceeding.

20. On April 21, 2011, third party requester filed an opposition petition to patent owner's March 25, 2011 petition to prevent merger, requesting that patent owner's petition be expunged.

21. On June 14, 2011, third party requester filed an appellant's brief in the '1036 proceeding.

22. On July 13, 2011, an Office action on the merits issued in the '11480 proceeding, confirming claim 44 and rejecting claims 31-43 and 45.

23. On July 14, 2011, patent owner filed a respondent's brief in the '1036 proceeding.

24. On August 22, 2011, the Office issued a decision dismissing requester's May 14, 2010 petition.

24. This decision addresses the patent owner petition to prevent merger and the Requester's opposition to the request to prevent merger.

RELEVANT AUTHORITY

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 304 states:

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

35 U.S.C. 311(a) states:

> IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 314(c) states:

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

35 U.S.C. 317(a) states:

> (a) ORDER FOR REEXAMINATION.- Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.4(c) states:

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

37 CFR 1.182 states:

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

37 CFR 1.530 (in pertinent part) states:

> (a) Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination, and it will be returned or discarded (at the Office's option).
>
> (b) The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.
>
> (c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the

> reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with § 1.248.

37 CFR 1.907(a) states:

> Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued under § 1.997, unless authorized by the Director.

37 CFR 1.937(a) states:

> (a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 CFR 1.989 states:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.
>
> (b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

MPEP 2640 II states (in part):

> Where reexamination is granted on a second or subsequent request, but the patent owner can clearly show that the second or subsequent request was filed for purposes of harassment, the patent owner can petition under 37 CFR 1.182 that the second or subsequent request should be suspended. If such a petition is granted, prosecution on the second or subsequent reexamination would be suspended until conclusion of proceedings in the first reexamination. In such an

instance, merger of the second (or subsequent) reexamination with the first would unduly prolong the conclusion of the pending reexamination and be inconsistent with the requirement that the reexamination proceeding be conducted with special dispatch.

Where an ordered *inter partes* reexamination is pending, and an inter partes reexamination request is subsequently filed, the prohibition provision of 37 CFR 1.907(a) must be borne in mind. Once an order for *inter partes* reexamination has been issued, neither the third party requester of the *inter partes* reexamination, nor its privies, may file a subsequent request for inter partes reexamination of the same patent until an inter partes reexamination certificate has been issued, unless expressly authorized by the Director of the Office. Note that 37 CFR 1.907(a) tracks the statutory provision of 35 U.S.C. 317(a). A petition for such express authorization is a request for extraordinary relief and will not be granted where there is a more conventional avenue to accomplish the same purpose and provide relief analogous to that requested. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

MPEP 2686.01 states (in part):

Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged *where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings.* However, **a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate** of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch." [Emphasis Added]

MPEP 2686.01 IV. PROCEEDINGS NOT MERGED states:

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, *if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting.* The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. [Emphasis Added]

PRELIMINARY MATTER

The April 21, 2011 opposition submission is an improper submission, as it runs contrary to the strictures of 37 CFR 1.4(c), which requires separate submissions for separately distinct and different matters. As to the submission of an opposition to the March 25, 2011 patent owner petition and also a petition for the relief of expungement of the March 25, 2011 patent owner petition within a single paper, such is precluded by 37 CFR 1.4(c). The handling of these two

matters is delegated to different braches of the Office (the Central Reexamination Unit and the Office of Patent Legal Administration). Therefore, the April 21, 2011 "opposition petition" in regards to the petition to expunge is subject to dismissal as improper. However, in the interest of special dispatch the Office *sua sponte* waives the requirements of 37 CFR 1.4(c) in this specific instance and the Office of Patent Legal Administration is addressing both matters. This waiver does not apply to any further submissions.

DECISION

I. Issues Raised and Relief Requested

A. Patent Owner's March 25, 2011 Petition: Patent owner requests the '1036 and '11480 proceedings not be merged, asserting the following: (1) The merger of the '1036 *inter partes* proceeding with the '11480 *ex parte* proceeding will only further delay the '1036 proceeding, which as been pending for over three years, contrary to the statutory mandate of special dispatch; (2) Merger of the '1036 *inter partes* proceeding with the later filed '11480 *ex parte* proceeding violates 35 U.S.C. § 317(a) and 37 C.F.R. § 1.907, because merger of a subsequently filed *ex parte* proceeding by a requester with a pending *inter partes* reexamination proceeding constitutes a *de facto* second *inter partes* reexamination proceeding; and (3) Requester's filing of the '11480 *ex parte* reexamination request constitutes a harassment of patent owner. Patent owner requests the remedy of non-merger of the two proceedings.

B. Third Party Requester's April 21, 2011 Opposition Petition: Third party requester opposes patent owner's petition against merger, asserting the following: (1) Merger is appropriate pursuant to the rules and MPEP; and (2) Parallel or serial proceedings are untenable under the rules. Third party requester further requests that patent owner's March 25, 2011 petition be expunged from the record. The requester's basis for expungement is that patent owner's petition touches upon the merits of the '11480 proceeding and thus constitutes a *de facto* Patent Owner's statement. Accordingly, it is argued that patent owner's petition circumvents the rules governing responses to orders in *ex parte* reexamination proceedings, and the petition has the effect of not allowing requester to file a response to the *de facto* patent owner's statement.

II. Findings and Analysis

Reexamination of the '404 patent has been ordered in the '11480 *ex parte* proceeding and '1036 *inter partes* proceeding. Thus far, the Office has made no decision to merge the above-captioned *ex parte* and *inter partes* reexamination proceedings. In view of the patent owner's petition, a discussion will be presented (a) as to the Office's discretion with respect to whether proceedings are to be merged and (b) as to why the Office does not intend to merge the above-captioned proceedings at present.

There is no legal requirement for the Office to merge, or not to merge, two pending reexamination proceedings. The determination whether to merge two reexamination proceedings is an act reserved to the sole discretion of the Office. See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I.,[1] MPEP 2686.01 IV,[2] 2283,[3] MPEP 2286.[4] In connection with this, the following is pointed out:

First, the statute is silent as to the administrative consolidation of co-pending reexamination proceedings on the same patent. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[5] Third, while the MPEP does state the Office will "normally" merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of proceedings eligible for merger. Finally, the MPEP also notes that the decision to merge is within the "sole discretion" of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[6] Therefore, while the Office retains the authority to merge, the Office also retains the authority to not merge proceedings, where special dispatch can be better served absent merger. Given the complexities and/or particularities that would arise as a result of merger in the present instance, as well as the delay of one proceeding that has already arrived at the advanced stage of being briefed, requester's position that merger would be in accord with special dispatch is not persuasive. Merger/non-merger determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding, and in this case the Office has decided that the statutory mandate for special dispatch is best served by not merging.[7,8]

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[1] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with 'special dispatch.'" (Emphasis added).

[2] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[3] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[4] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[5] "If any reexamination is ordered while a prior inter partes reexamination proceeding is pending for the same patent and prosecution in the prior inter partes reexamination proceeding has not been terminated, a decision **may** be made to merge the two proceedings or to suspend one of the two proceedings. . . ." (Emphasis added).

[6] Id.

[7] See "*Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination*," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing ex parte reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by-case basis."

III. Response to Opposition Petition Arguments

A. Propriety of Merger under the Present Circumstances. Requester is in error that the Office can only achieve prosecution efficiency by merging the '1036 proceeding and the '11480 proceeding and that non-merger runs contrary to special dispatch. All determinations of merger are made on a case-by-case basis.[9] The Office is in the best position to determine what will facilitate the Office's discharge of its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), because the Office is in the best position to evaluate the complications and results of merger and balance them against the benefits of merger. It is appropriate that the Office has sole discretion in this matter, because it is the Office that is charged by statute with the duty of special dispatch – not the parties. In the present proceedings, as noted in section II, the Office has determined the most efficient manner to address the issues raised in each request is to not merge. Requester's concerns regarding non-merger of the proceedings are unfounded. The '11480 proceeding is at a very early stage of prosecution, while the '1036 proceeding has advanced to the appeal stage and has been briefed. Withdrawing the '1036 proceeding from the appeal stage to reopen prosecution therefore is contrary to special dispatch. Furthermore, requester's concerns can be readily resolved and prevented in accordance with the procedural guidance set forth in the MPEP in accordance 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.[10] The issues of a later request can be resolved after the certificate issues for the first request, and, as will be pointed out in the next section of this decision, any such certificate is to give notice to the public that the later request exists and remains to be resolved. As the '1036 proceeding has advanced to appeal and the '11480 proceeding is at an early stage of prosecution, special dispatch would not be served by merging the proceedings and re-opening prosecution in the '1036 proceeding.

B. Parallel or Serial Proceedings are Viable. Office policy, practice and procedure as set forth in the MPEP provides a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office reexamination proceedings on the same patent when a reexamination certificate issues.[11] Further, the issues of each proceeding can be addressed separately without complicating and delaying the other proceeding. When one proceeding matures into a certificate, the other proceeding can be adjusted accordingly. MPEP 2686.01 IV is on point as to not merging in the present circumstance to minimize the consumption of Office resources, promote special dispatch, and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger.

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[8] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.
[9] See MPEP 2686.01 IV, last sentence.
[10] See MPEP §§ 2295 *et seq.* and 2695 *et seq.*
[11] See 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.

C. Requester Activity. Third party requester did nothing to minimize the consumption of Office resources in this instance. Requester did not file that request until more that a half year after the August 6, 2010 Action Closing Prosecution was issued, and given the advanced stage of the '1036 *inter partes* reexamination proceeding, the considerations do not tend toward merger. Even at that stage, requester could have filed a petition for extension of time to file papers to obtain the results of the decision to merge, explaining why the requester believed merger was in order. If requester could have made a sufficient showing, that would have avoided the Office's having to process requester and patent owner briefs. If requester could not have made a sufficient showing, then, at that point the issue of merger would have been resolved in the negative. Either way, the matter could have been resolved before the present stage of the proceeding. Instead, requester's actions were to file a notice of appeal and appeal brief and advance the proceeding to the appeal phase, actions which are contrary to requester's very arguments.[12] Thus, requester's actions and inactions have resulted in a circumstance that if the requested merger relief were now to be granted, resources on the part of the parties and the Office will be wasted.

D. Expungement of Patent Owner's March 25, 2011 Petition. Requester's assertion that patent owner's March 25, 2011 is improper and must be expunged is not found to be persuasive. Patent owner's arguments are an attempt to establish that the '11480 request combined with merger would constitutes a violation of 35 U.S.C. 317(a) and 37 CFR 1.97(a) and amount to harassment. Patent owner's petition is not a patent owner's statement, as it is filed in an *inter partes* proceeding and not an *ex parte* proceeding, and its statements as to the '11480 request are only directed to the assertion that merger would make the '11480 request a vehicle for harassment of patent owner. In this regard, it is noted that patent owner's March 25, 2011 paper is captioned for entry solely in the '1036 *inter partes* reexamination proceeding and not the '11480 *ex parte* reexamination proceeding. The petition is being filed under 37 CFR 1.182, a petition rule and not 35 U.S.C. 304 and 37 CFR 1.530, the statute and rule that govern patent owner statements in *ex parte* reexamination. Patent owner has not discussed any of the proposed rejections in the '11480 proceeding. Patent owner has not submitted any comments regarding anticipation or obviousness as set forth in 37 CFR 1.530(c), nor has patent owner provided any amendment to the patented claims nor proposed new claims as set forth in 35 U.S.C. 304. Patent owner has only mentioned the Fretz reference in terms of requester awareness, devoid of any discussion of the specific teachings of the Fretz reference, to allege requester holding back an SNQ in order to harass patent owner.

Patent owner cites to requester's admitted participation in the '1036 proceeding and requester's later initiated '11480 as an alleged violation of 37 CFR 1.907 if merged, because merger is argued as converting the *ex parte* reexamination into an *inter partes* reexamination, in terms of

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[12] ". . . [P]rosecution efficiency can only be achieved by merger ***before*** appeal of claims 31-45 in the '036 Reexam is undertaken . . ." requester opposition petition at the top of page 2.

the requester obtaining *inter partes* participation rights regarding the SNQs raised in the later filed, *ex parte* reexamination request.

Requester's arguments that the March 25, 2011 patent owner paper is improper are not persuasive because patent owner's March 25, 2011 petition was only filed in the '1036 *inter partes* reexamination proceeding; only captioned to the '1036 *inter partes* reexamination proceeding; only captioned as a petition under 37 CFR 1.182; not captioned as a patent owner's statement under 35 U.S.C. 304 and 37 C.F.R. 1.530; and only refers to the '11480 proceeding in terms of the prohibition of subsequent *inter partes* reexaminations and harassment if the two proceedings are merged. Therefore, patent owner's March 25, 2011 petition is not an improper paper. Accordingly, third party requester's petition to expunge patent owner's March 25, 2011 opposition petition is dismissed.

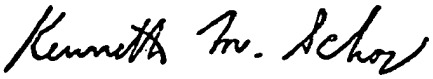
It is to be noted that if the patent owner paper were to be expunged, then requester's opposition paper would likewise be expunged as an answer to a non-existents paper. In that event, no papers on the merger would exist, and the Office's *sua sponte* choice not to merge would remain in place without comment from parties. Non-merger is in accord with and not contrary to public policy for the reasons stated above in the previous sections. Further, a decision to not merge best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), permitting the resolution of the substantial new questions raised in each proceeding, without deterring either proceeding. The 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 timely as possible. Accordingly, the decision is not contrary to the relevant issues of public policy as asserted by requester.

CONCLUSION

1. The March 25, 2011 patent owner petition is granted.

2. The April 21, 2011 third party requester opposition petition has been considered, and the expungement aspect is dismissed.

3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

9-8-11

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(FOR PATENT OWNER)

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CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN
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WASHINGTON, DC 20005

(FOR THIRD PARTY
REQUESTER)

In re Feeley et al.
Reexamination Proceeding
Control No. : 95/001,036
Filed: April 2, 2008
Patent No. 7,139,404

: **DECISION**
: **DISMISSING**
: **PETITION**
: **UNDER 37 CFR 1.181**
:

The above reexamination proceeding is before the Director of the Central Reexamination Unit, after receipt of a May 14, 2010 third party requester petition, entitled "Petition under 37 CFR 1.181 from Refusal to Enter Third Party Requester Comments." The petition is requesting that the replacement requester's comments of September 18, 2009 be entered into the proceeding record. This decision also addresses the patent owner's opposition petition, dated May 21, 2010.

The third party requester's petition is dismissed.

The patent owner's opposition petition is granted to the extent that the requester's petition is dismissed.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. On November 21, 2006, the Office issued U.S. Patent No. 7,139,404 (the '404 patent) to Feeley et al.

2. The '404 patent is subject to litigation in the United States District Court for the Northern District of Oklahoma, in Hear-Wear Technologies, LLC v. Oticon Inc. et al., {Civil Action No. 07:CV-212-CVE-FHM}. The initial complaint was filed April 16, 2007. According to the October 28, 2011 respondent brief filed in the reexamination proceeding, the litigation is stayed pending results of reexamination.

3. On April 2, 2008, a request for inter partes reexamination of all the claims (claims 1-45) of the '404 patent was filed by third party requester (requester) K/S Hearing Instrument Manufactures Patent Partnership (HIMPP). The request was assigned Control No. 95/001,036 (the '1036 proceeding).

4. On June 12, 2008, the Office issued an order granting the '1036 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 '404 patent, claims 1-45, would be subject to reexamination.

5. On February 25, 2009, the Office issued a non-final Office action in the '1036 proceeding.

6. On March 11, 2009, the Office *sua sponte* issued a new non-final Office action in the '1036 proceeding.

7. On May 11, 2009, patent owner timely filed a response to the March 11, 2009 non-final Office action.

8. On June 10, 2009, third party requester filed comments after patent owner's response.

9. On September 3, 2009, the Office issued a decision expunging, as improper, third party requester's June 10, 2009 comments and giving third party requester 15-days to submit proper comments.

10. On September 18, 2009, third party requester submitted replacement comments.

11. On March 31, 2010, the Office issued another non-final Office action in the '1036 proceeding rejecting claims 1-30 and confirming claims 31-45.

12. On April 23, 2010, the Office issued a decision expunging as improper third party requester's September 18, 2009 replacement comments submission.

13. On May 14, 2010, third party requester filed the instant petition under 37 CFR 1.181 requesting entry of the September 18, 2009 revised requester comments.

14. On May 21, 2010, the patent owner filed the instant opposition petition requesting that requester's May 14, 2010 petition be dismissed.

15. On August 6, 2010, the Office issued an Action Closing Prosecution in the '1036 proceeding (a) withdrawing claims 1-30 from further consideration due to patent owner's failure to respond to the March 31, 2010 non-final Office action and (b) confirming claims 31-45.

16. On March 16, 2011, the Office issued a Right of Appeal Notice (RAN) in the '1036 proceeding, withdrawing claims 1-30 from further consideration due to patent owner's failure to respond and confirming claims 31-45.

17. On June 14, 2011, third party requester filed an appellant's brief.

18. On July 14, 2011, patent owner filed a respondent's brief.

19. On August 30, 2011, the Office issued a decision that found the June 14, 2011 appellant brief noncompliant with 37 CFR 41.67 and gave the requester one month to submit a replacement brief.

20. On September 30, 2011, the third party requested filed a replacement brief.

21. On October 28, 2011, the patent owner filed a replacement respondent's brief.

DECISION

Legal Authority Citations:

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.

...

(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 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.

Analysis:

As pointed out, the third party requester filed a May 14, 2010 petition, which is a petition requesting entry of the September 18, 2009 replacement comments into the proceeding record. Specifically, the petition requests that the comments related to nine grounds of proposed rejections, identified on page 3 of the May 14, 2010 petition, for claims 1, 22, and 31 be entered. On May 21, 2010, patent owner filed a petition opposing the grant of the May 14, 2010 petition. For reasons set forth below, the requester's May 14, 2010 petition is dismissed.

Claims 1 and 22:

The relief requested in the May 14, 2010 petition as to claims 1 and 22 is rendered moot due to the withdrawal of these claims from the reexamination proceeding. Specifically, patent owner's failure to respond to the March 31, 2010 Office action resulted in the withdrawal of claims 1-30, which were under rejection in the March 31, 2010 Office action. In accordance with 37 CFR 1.957(c), the Action Closing Prosecution, dated August 6, 2010, indicated that claims 1-30 are withdrawn. Claims 1-30 will be cancelled from the '404 patent when the reexamination certificate is issued. For this reason, the relief requested in the May 14, 2010 petition as to claims 1 and 22 is rendered moot, and is hereby dismissed.

Claim 31:

To the extent that the May 14, 2010 petition is requesting relief from the September 3, 2009 Notice of noncompliance, the petition is untimely. The petition was filed over **two** months from the mailing date of the action (September 3, 2009) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable. Therefore, any relief requested from the September 3, 2009 notice in the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

To the extent that the May 14, 2010 petition is requesting relief from the April 23, 2010 decision regarding claim 31, the Director finds there are not good and sufficient reasons to do so for the reasons set forth below. 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 Office personnel to look at the facts involved in a particular proceeding and to weigh the equities before petition decisions and notices. Second, prosecution has advanced in this proceeding to the point where the patentability of claim 31 is on appeal. During the appeal, the requester has full rights to appeal the finding of

patentability of claim 31 based upon any and all of the proposed rejections for claim 31 as set forth in the request for reexamination. Given that the requester retained the ability to present arguments against the patentability of claim 31, the April 23, 2010 decision that held the September 18, 2009 comments noncompliant and not entered did not prejudiced the requester in framing the issues during appeal. Third, upon review of the record, it is found that the April 23, 2010 decision properly concluded that the September 18, 2009 comments were not submitted in compliance with the requirements of 37 CFR 1.947 and 1.948 in this case. Specifically, based upon the facts in this proceeding, the September 18, 2009 changed the basis for the original proposed rejection, as described in the April 23, 2010 decision, thus resulting in the presentation of new grounds of rejection. MPEP 2666.05 clearly states that "... 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.**" (Emphasis added). The record is clear and undisputed that the patent owner did not amend claims. Therefore, the presentation of new grounds of rejection is not permitted in order to achieve special dispatch required by 35 USC 314(c). For example, in the request, proposed rejection SNQ 1 (Toht in view of Reiter and Shennib '892) used the following rationale: "It would have been obvious to deeply insert component 2 so as to be completely in the user's ear canal to isolate the receiver 2 from the microphone and to reduce the occlusion effect as disclosed by Reiter." See page 2 of Exhibit CC-A in the request for reexamination. Page 7 of the September 18, 2009 comments, however, for the first time asserts that "[a]t the time of the invention, one of ordinary skill in the art certainly would have had at least a reasonable expectation of success modifying the BTE-RITE type hearing aid of Toht to utilize a CIC component (as in Reiter) for positioning the speaker in the user's ear canal," and cites to the Thompson declaration, filed on September 18, 2009, for evidentiary support. In other words, the request sets forth the basis of the rejection as modifying receiver 2 so that it can be inserted into the ear, but the September 18, 2009 comments change the basis to substituting receiver 2 with a CIC component (as taught by Reiter). Such arguments and new evidence go beyond merely rebutting the positions taken by the patent owner, but instead, change the basic thrust of the original bases for the proposed rejections, which results in new grounds of rejection. See, e.g., "Rules of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte* Appeals," 76 FR 722270, 72276 (November 22, 2011), which states that arguments that rely on new evidence and change the basic thrust of the rejection are considered a new grounds of rejection. Although the notice applies to *ex parte* appeal and was published after this issue aroused, the determination of whether a ground of rejection is new in an *inter partes* reexamination would be substantially similar, and the notice clarifies policies that were in effect at the time this issue arose. Therefore, while 37 CFR 1.947 and 1.948(a)(2) may authorize the arguments and evidence to rebut the position taken by the patent owner, MPEP 2666.05 is clear that 37 CFR 1.947 and 1.948(a)(2) do not authorized newly presented proposed rejections because such newly proposed rejections are not necessitated by an amendment to the patent claims. For this reason, the decision to not enter the comments regarding the patentability of claim 31 in the September 18, 2009 comments is maintained.

Moreover, the record in this reexamination proceeding is long and complex with numerous petitions and petition decisions of record. As discussed above, prosecution in this proceeding has advanced to the point of appeal. It would clearly be against the statutory mandate of special dispatch to enter the September 18, 2009 comments and remove the proceeding from appeal. The record shows that issues have been developed and are ready for appeal even without the

entry of the September 18, 2009 comments. In addition, the record shows that litigation is stayed pending the results of reexamination. See page 3 of the October 28, 2011 respondent brief. Given the facts of this proceeding and the fact that the statutory mandate of special dispatch must not be ignored, it is not justifiable to further delaying prosecution to enter the September 18, 2009 comments into the record.

Therefore, for all these reasons, the September 18, 2009 comments will not be entered into the proceeding record and the May 14, 2010 petition is, hereby, dismissed.

CONCLUSION

1. The May 14, 2010 third party requester's petition is dismissed.

2. The May 21, 2010 patent owner's opposition petition is granted to the extent that the requester's petition is dismissed.

3. Telephone inquiries related to this decision should be directed Matthew Brooks, Supervisory Patent Examiner, at (571) 272-8112.

Irem Yucel, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,036	04/02/2008	7139404	Q105786	8422

29053 7590 03/16/2012

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DALLAS, TX 75201-2784

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
K/S Hearing Instrument Manufacturers Patent Partnership, Inc.
v.
Hear-Wear Technologies, LLC

Reexamination Control No. 95/001,036
Patent 7,139,404
Technology Center 3900

DECISION ON PETITIONS

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Appeal Brief," filed October 21, 2011 (petition). In the petition, patent owner requests that the Office determine that requester's corrected appellant brief is not compliant with 37 C.F.R. § 41.67. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), was charged to petitioner's credit card on October 24, 2011.

This is also a decision on "Requester's Opposition to Patent Owner's Petition under 37 C.F.R. § 1.182," filed October 31, 2011 (opposition). In the

opposition, requester asks that the Office determine that the corrected appellant brief is proper and compliant with 37 C.F.R. § 41.67. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to requester's credit card on November 1, 2011.

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

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,139,404, on April 2, 2008, which was assigned control no. 95/001,036.

2. On June 12, 2008, reexamination was ordered and on February 25, 2009, a non-final Office action was mailed, rejecting claims 1-45.

3. Prosecution was conducted and on August 6, 2010, an Action Closing prosecution (ACP) was mailed, withdrawing claims 1-30 from consideration for patent owner's failure to respond to the previous Office action, and confirming patentability of claims 31-45.

4. On March 16, 2011, a Right of Appeal Notice (RAN) was mailed, confirming patentability of claims 31-45.

5. Requester filed a Notice of Appeal on April 15, 2011, appealing the refusal to adopt 110 proposed rejections of claims 31-45.

6. Requester filed an appellant brief on June 14, 2011.

7. Patent owner filed a respondent brief on July 14, 2011, accompanied by a petition to expunge requester's appellant brief.

8. Requester filed an opposition to the petition to expunge on August 12, 2011.

9. On August 30, 2011, a decision granting the petition of July 14, 2011, and denying the opposition of August 12, 2011, was mailed, setting a one month period for requester to file a corrected appellant brief.

10. Requester filed a corrected appellant brief on September 30, 2011.

11. Patent owner filed the present petition on October 21, 2011.

12. Patent owner filed a respondent brief on October 28, 2011.

13. Requester filed the present opposition on October 31, 2011.

14. An Examiner's Answer was mailed on January 25, 2012.

15. Requester filed a rebuttal brief and a request for oral hearing on February 24, 2012.

DISCUSSION

In the petition, patent owner requests that the Office determine that requester's appellant brief is not compliant with 37 C.F.R. § 41.67. Petitioner contends that in the corrected appellant brief, requester impermissibly proposed a new ground of rejection by relying upon Rapps to meet the limitation "providing a plurality of behind-the-ear components" of the claim. Petitioner points out that, in the request, Toht is relied upon for teaching "providing a plurality of behind-the-ear components," while Rapps is used to modify the components of Toht to have "different dimensions" in the proposed rejection of dependent claim 34.

In the opposition, requester asserts that the corrected appellant brief of August 30, 2011, is proper because the original request and claim charts, as filed, provided proposed rejections of claim 34 over Toht in view of Reiter, and further in view of Rapps. Requester asserts that the corrected brief does not include a change in the rationale in support of the rejection because the basic thrust of the rejection remains the same, and patent owner has been given a fair opportunity to

react to the rejection. Requester states that the concept that Rapps discloses a "plurality of said behind–the-ear components" in the context of the limitations of claim 34 was introduced explicitly in the original request, as requester alleged that Rapps disclosed "at least two behind-the-ear components of different dimensions" as recited in claim 34.

RELEVANT AUTHORITY

37 CFR § 1.182 provides:

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

37 CFR § 41.67(e)(1)(vi) provides:

> Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

ANALYSIS

Patent owner's petition has been considered fully. A review of the prosecution history of this proceeding reveals that in the request for *inter partes* reexamination, the dependent claims are addressed in Appendix CC-C, which includes a claim chart that indicates:

34. The method of claim 32 wherein said plurality of said behind-the-ear components includes at least two behind-the-ear components of different dimensions.	"[T]he combination of Toht in view of Reiter does not expressly disclose said plurality of said BTE components includes at least two behind-the-ear components of different dimensions. However, the combination of Toht in view of Reiter does not limit the BTE construction and multi-dimensional BTE housings are well known in the art and Rapps teaches a BTE component of various dimensions (See Fig. 2 and col. 1, lines 45-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a BTE devices with different dimensions to select the device which most comfortably fit a wide variety of users (See abstract)."

It is clear from the request that requester relied upon Rapps for teaching "a BTE component of various dimensions (See Fig. 2 and col. 1, lines 45-67)," and not for teaching "at least two behind-the-ear components of different dimensions." Furthermore, a review of the corrected appellant brief reveals that Rapps is not included in any of the "Issues to be Reviewed on Appeal" listed on page 10. That is, Rapps is not affirmatively stated there to be support for either of the discussed elements existing in the patent. Having not even mentioned Rapps in stating the issues, Rapps then is discussed in the "Arguments" section on pages 16-17 of the brief.

Requester in the "Arguments" asserts that Rapps teaches "providing a plurality of behind-the-ear components" to support requester's arguments against the confirmation of claims 31-45. A review of the appellant brief of June 14, 2011, reveals that requester asserts on page 17 that Rapps teaches "providing a plurality of behind-the-ear components" to support requester's arguments against the confirmation of claim 31. The brief of June 14, 2011, was found non-compliant under 37 C.F.R. § 41.67 because it contained newly presented proposed grounds of rejection of claim 31. Requester, having been non-compliant in that use of Rapps

in arguing claim 31, now has expanded such argument to include claims 31-45. The corrected appellant brief continues to include new grounds of rejection of claims 31-45, *albeit included as arguments*, and therefore still is not in compliance with 37 C.F.R. § 41.67.

The petition is **granted**. The opposition is **denied**, and the corrected appellant brief of August 30, 2011, is **not entered**. Appellant was given previously **one** opportunity to file a corrected appellant brief. Because the corrected appellant brief is still not in compliance with 37 C.F.R. §41.67, the requester's appeal is **dismissed**.

DECISION

In view of the foregoing, the petition is GRANTED, and the opposition is DENIED.

The requester's appeal is DISMISSED.

The *inter partes* reexamination is returned to the Central Reexamination Unit (CRU) for preparation of the next appropriate Office action in view of the dismissal of the appeal.

James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
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Inter Partes Reexamination Control No. 95/001,036
Patent No. 7,139,404

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,036	04/02/2008	7139404	Q105786	8422

29053 7590 04/04/2012

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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
K/S Hearing Instrument Manufacturers Patent Partnership, Inc.
v.
Hear-Wear Technologies, LLC

Reexamination Control No. 95/001,036
Patent 7,139,404
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Rebuttal Brief," filed March 7, 2012 (petition). In the petition, patent owner requests that the Office determine that requester's rebuttal brief is not compliant with 37 C.F.R. § 41.71. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), was charged to petitioner's credit card on March 8, 2012.

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

Inter Partes Reexamination Control No. 95/001,036
Patent No. 7,139,404

DECISION

On March 16, 2012, a decision on petition was mailed in which the petition to strike the corrected appellant brief was GRANTED, the opposition was DENIED, and the requester's appeal was DISMISSED. In view of the foregoing, the petition is DISMISSED as moot.

The *inter partes* reexamination is returned to the Central Reexamination Unit (CRU) for preparation of the next appropriate Office action in view of the dismissal of the appeal.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,037	04/10/2008	7162458	8332.001.458	7186

7590 08/04/2010

Maureen L. Stretch
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,037	04/10/08	7162458	8332.001.458

EXAMINER
GRAHAM, MATTHEW

ART UNIT	PAPER
3993	

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AUG 04 2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,037	04/10/08	7162458	8332.001.458

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HOUSTON, TX 77002

(For Requester)

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

In re Flanagan et al.	:	
Reexamination Proceeding	:	DECISION
Control No.: 95/001,037	:	DISMSSING
Filing Date: April 10, 2008	:	
For: U.S. Patent No.: 7,162,458	:	

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a July 8, 2010 third party requester petition, which is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the patent owner's appeal brief, dated June 8, 2010.

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

BACKGROUND

1. U.S. Patent No. 7,162,458, (hereinafter, the '458 patent) issued on January 9, 2007.

2. A request for inter partes reexamination of the '458 patent was filed by a third party requester on April 10, 2008, which request was assigned control no. 95/001,037 ("the '037
proceeding").

3. Reexamination was ordered in the '037 proceeding on June 20, 2008.

4. The '037 proceeding progressed to appeal to the point where, on June 8, 2010, patent owner filed an appeal brief.

5. On July 8, 2010, third party requester filed a respondent brief in the '037 proceeding accompanied by the present petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the patent owner's appeal brief, dated June 8, 2010.

DECISION

As pointed out, the third party requester filed the present petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the patent owner's appeal brief, dated June 8, 2010. However, there has been no decision by the examiner to either enter or not enter the patent owner's appeal brief. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the appeal brief because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed.

CONCLUSION

1. The July 8, 2010 third party requester's petition, which is treated as a petition under 37 CFR § 1.181, is dismissed.

2. Should the examiner enter the patent owner's brief into the record, the third party requester would be free to submit a petition under 37 CFR 1.181.

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

Gregory Morse
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,037	04/10/2008	7162458	8332.001.458	7186

7590 03/24/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/24/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,037	04/10/08	7162458	8332.001.458

EXAMINER
GRAHAM, MATTHEW

ART UNIT	PAPER
3993	

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DATE MAILED:

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MAR 24 2011

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MAR 24 2011

CENTRAL REEXAMINATION UNIT

In re Flanagan et al.	:	
Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,037	:	**DISMISSING**
Filed: April 10, 2008	:	**PETITION**
For: U.S. Patent No. 7,162,458	:	

This is a decision on the December 29, 2010 patent owner petition entitled "PETITION TO TERMINATE REEXAMINATION PROCEEDING UNDER 35 U.S.C. §317(b) and 37 CFR §1.182" (the petition under 37 CFR 1.182).

The patent owner petition under 37 CFR 1.182 to terminate the instant *inter partes* reexamination proceeding 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. On January 9, 2007, United States Patent Number 7,162,458 (the '458 patent) issued with claims 1-60. The '458 patent was assigned to Sky Technologies, LLC (hereinafter "patent owner").

2. On April 10, 2008, a request for *inter partes* reexamination of claims 1 and 16 of the '458 patent was filed by SAP Americas, Inc. (hereinafter "requester"), which request was assigned Reexamination Control No. 95/001,037 (the '1037 proceeding).

3. On June 20, 2008, the Office issued an order granting *inter partes* reexamination in the '1037 proceeding of claims 1 and 16 of the '458 patent. Also, on June 20, 2008, the Office issued a non-final Office action on the merits.

4. The '1037 proceeding progressed to the point where, on May 7, 2010, patent owner filed a notice of appeal, appealing the examiner's rejection of claims 1 and 16.

5. On June 8, 2010, patent owner filed an appellant's brief in the '1037 proceeding.

6. On July 8, 2010, requester filed a respondent's brief in the '1037 proceeding.

7. On September 24, 2010, the Office issued an Examiner's Answer.

8. On November 24, 2010, patent owner filed a request for oral hearing in the '1037 proceeding.

9. On December 29, 2010, patent owner filed the instant petition under 37 CFR 1.182 to terminate the '1037 proceeding.

10. Patent owner Sky Technologies, LLC and requester SAP Americas, Inc. were adversarial parties in concurrent litigation regarding the '458 patent in the U.S. District Court for the Eastern District of Texas (the district court).[1] On December 27, 2010, the court issued a "FINAL DECISION AND ORDER PURSUANT TO STIPULATION" (the final decision and order), dismissing the action with prejudice.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 317(b) states (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 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 <u>issues which that party or its privies raised or could have raised in such civil action</u> or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies <u>on the basis of such issues</u> 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.

[1] *Sky Technologies LLC. v. SAP AG and SAP America, Inc.*, Civil Action No. 2:06-cv-440 (E.D. Tex. Oct. 17, 2006). The CourtLink® record of this civil action indicates that the '458 was asserted by way of an amended complaint on February 6, 2007.

37 CFR 1.907(b) states:

> 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

1. The December 29, 2010 Patent Owner Petition to Terminate *Inter Partes* Reexamination

In the December 29, 2010 petition under 37 CFR 1.182, patent owner requests that the '1037 proceeding be terminated in view of the district court's December 27, 2010 final decision and order. In support of its request for termination of the '1037 proceeding, patent owner submitted a copy of the district court's December 27, 2010 final decision and order, which states (emphasis added):

> Pursuant to joint motion and stipulation of Plaintiff Sky Technologies LLC and Defendants SAP AG and SAP America, Inc., which includes the stipulation that this final decision should be entered, this Court enters a **final decision that SAP AG and SAP America, Inc. have not sustained their burden of proving invalidity of claims 1 and 16** of U.S. Patent No. 7,162,458.
>
> Pursuant to the Settlement Agreement executed by the parties on September 9, 2010, this action is hereby dismissed with prejudice. The Court shall retain jurisdiction to enforce the terms of the Settlement Agreement. Each party shall bear its own attorneys' fees, expenses, and costs. This decision is an Order of the Court which is **final, enforceable, and not appealable**. IT IS SO ORDERED.

In view of the final decision and order, patent owner requests that "the above-referenced *Inter Partes* reexamination which was requested by SAP AG and SAP America Inc., on the basis of the issues finally decided by the Federal District Court be terminated immediately as it can no longer be maintained by the Office" and that "[t]he attached Decision is a final adjudication which is 'not appealable.'"[2]

2. 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:

[2] Petition under 37 CFR 1.182 at page 2.

> 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.

The statute attaches the estoppel on a claim-by-claim basis. Thus, if petitioner establishes that the estoppel provisions attach only for certain specified claims, the reexamination proceeding would continue as to the remainder of the claims.

3. Analysis and Findings

In this instance, petitioner patent owner has established per the district court's December 27, 2010 final decision and order that (1) the third party requester was a party to the civil action and (2) the district court issued a final decision (*i.e.*, "not appealable") that the third party requester "has not sustained its burden of proving the invalidity of any of the patent claims in suit." Additionally patent owner has established that the claims of the '458 patent presented for reexamination in the '1037 proceeding (*i.e.*, claims 1 and 16) were asserted in the civil action.[3]

Patent owner has not sufficiently established, however, that the reexamination of the patent claims is based upon "issues which that party or its privies raised or could have raised in such civil action." While patent owner states on page two of the instant petition under 37 CFR 1.182 that the '1037 proceeding was requested by third party requester "on the basis of the issues finally decided by the Federal District Court," patent owner 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 patent owner 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

[3] While not explicitly stated in the instant petition under 37 CFR 1.182, identity of the claims under reexamination in the '1037 proceeding (*i.e.*, claims 1 and 16) and the claims asserted in the civil action has been established by virtue of the specific enumeration of claims 1 and 16 in the district court's December 27, 2010 final decision and order.

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. Accordingly, patent owner has not made a sufficient showing as to whether the issues raised in the '1037 proceeding are identical to those which were raised or could have been raised in the earlier civil action.

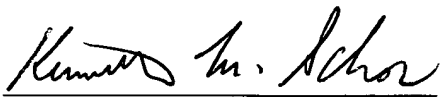
NOTE: The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation. If the joint motion and stipulation reflected in the district court's December 27, 2010 final decision and order was entered at a sufficiently early stage of the litigation proceeding, such that requester could have introduced the prior art and issues of the reexamination proceeding into the litigation, had the litigation not been terminated by the district court's December 27, 2010 final decision and order, then such prior art used in the reexamination proceeding "could have been raised" in the litigation proceeding. If patent owner provides a showing to that effect, such a showing can establish that the issue "could have been raised" by the third party requester in the context of the litigation, as set forth in U.S.C. 317(b).

In view of the above and under the present facts and circumstances, it has not been established that the estoppel provisions of 35 U.S.C. 317(b) preclude the maintenance of the '1037 proceeding, and patent owner's December 29, 2010 petition under 37 CFR 1.182 to terminate the '1037 proceeding is **dismissed**. In the event patent owner files a renewed petition, requesting termination of the '1037 proceeding, patent owner is advised to make the necessary showing, as described herein. No fee would be required should patent owner file such renewed petition.

CONCLUSION

1. Patent owner's December 29, 2010 petition under 37 CFR 1.182 to terminate the '1037 proceeding is dismissed.

2. Telephone inquires related to this 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

3-22-11
Kenpet8/IP/...

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,040	04/28/2008	7363167	069165.0124	9576

46764 7590 09/29/2010

REILLY INTELLECTUAL PROPERTY LAW FIRM
1325 East 16th Avenue
DENVER, CO 80218

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date: MAILED
SEP 2 9 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001040
PATENT NO. : 7363167
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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REILLY INTELLECTUAL PROPERTY LAW FIRM (For Patent Owner)
1325 EAST 16TH AVENUE
DENVER, CO 80218

BAKER BOTTS, LLP (For Third Party Requester)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

MAILED
SEP 29 2010
CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,040 : **DISMISSING**
Filed: April 28, 2008 : **PETITION**
For: U.S. Patent No. 7,363,167 :

This is a decision on third party requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 - REQUEST TO SUSPEND PAGE LIMITS UNDER 37 C.F.R. § 1.943(b)," filed on January 13, 2010 ("the petition under 37 CFR 1.183").

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

Pursuant to 37 CFR 1.17(f), the petition fee of $400.00 for the petition under 37 CFR 1.183 was charged to third party requester's deposit account on January 14, 2010.

DECISION

On January 13, 2010, concurrently with the instant petition under 37 CFR 1.183, third party requester (hereinafter "requester") filed a paper entitled "THIRD PARTY WRITTEN COMMENTS UNDER 35 U.S.C. § 314(b)(2) AND 37 C.F.R. § 1.951(b) REGARDING U.S. PATENT 7,363,167" (hereinafter "the written comments submission"), in addition to a paper entitled "THIRD PARTY WRITTEN COMMENTS UNDER 35 U.S.C. § 314(b)(2) AND 37 C.F.R. § 1.951(b) REGARDING U.S. PATENT 7,363,167 - Appendix I" (hereinafter "Appendix I").[1]

[1] Also filed on the same day were separate papers labeled Exhibit A (16 pages), Exhibit B (443 pages), a one-page unlabeled non-patent literature (NPL) document, and a two-page unlabeled NPL document. It is noted, that the pages of any claim charts presenting arguments and any claim charts applying the art to the claims, which are filed as part of a comments submission pursuant to 37 CFR 1.951(b), would be counted toward the 50-page limit of 37 CFR 1.943(b).

In the petition under 37 CFR 1.183, requester states that the concurrently filed written comments submission is 50 pages in length and that such submission complies with the page limit requirements under 37 CFR 1.943(b).[2] However, in the petition under 37 CFR 1.183, requester states that "[w]ithout impacting the compliance status of the Written Comments, Requestor has filed as Appendix I to the instant Petition a 9-page statement of case law" and that it requests waiver of 37 CFR 1.943(b) for entry and consideration of the 9-page Appendix I statement of case law as part of the written comments submission.[3]

Requester's January 13, 2010 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 its request for waiver of the rule, requester asserts that "the circumstances of the instant reexamination are extraordinary in terms of the number and complexity of the issues to be addressed in Requestors' Written Comments."[4] In particular, requester asserts that: "there are presently under consideration 29 separate grounds for rejecting one or more of the 34 pending claims"; "the Office required 112 pages to fully address these 29 grounds in the ACP"; "Patent Owner's Amendment and Response to Action Closing Prosecution dated December 14, 2009 ("ACP Response") proposed a number of claim amendments including the addition of 6 new claims and alleged that several of the rejections were unfounded"; and "28 of the 29 grounds pending relate to anticipation and/or obviousness over prior art with each potentially requited a detailed factual analysis...."[5]

While requester has asserted reasons why it believes justice requires waiver of the page limit, requester has not set forth with specificity why justice requires waiver of the page limit for entry of the statement of case law set forth in Appendix I. For example, requester has not asserted that the written comments submission relies on or is otherwise affected by the information presented in the statement of case law, or how the written comments submission relies on it. Rather, it appears that the information presented in the statement of case law is information that the Office is already aware of and can locate without needing to rely on the requester's statement of case law. Further, it is noted that requester could have included any argument as to applying the case law presented in Appendix I in the written comments submission, itself, and can also subsequently include arguments as to how the case law applies, if the Office's decision is appealed, as part of any appeal brief submission. Thus, the facts and circumstances in this particular instance do not give rise to an extraordinary situation in which justice requires waiver of the page limit of 37 CFR 1.943(b) for entry of the January 13, 2010 statement of case law (Appendix I) that accompanied requester's 50-page written comments submission. Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

---

[2] *See* petition under 37 CFR 1.183 at pages 1 and 2. It is noted that the last page of the written comments submission, which is solely a signature page that presents no arguments, is not counted toward the page limit of 37 CFR 1.943(b); therefore, only 49 pages of the January 13, 2010 written comments submission count toward the page limit.

[3] *Id.*

[4] *Id.* at page 2.

[5] *Id.* at page 2 (further asserting that "the shear bulk of the potential material to be addressed totals 149 pages (112-ACP + 37-page ACP Response)."

CONCLUSION

1. Requester's January 13, 2010 petition under 37 CFR 1.183 is **dismissed**.

2. Requester's January 13, 2010 9-page statement of case law (Appendix I) is being expunged from the record of the 95/001,040 proceeding by marking it "closed" and "not public" in the image file wrapper (IFW).

3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at 571-272-7717.

Kenneth M. Schor

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.
95/001,040	04/28/2008	7363167	069165.0124	9576

46764 7590 01/30/2012

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EXAMINER

ART UNIT	PAPER NUMBER

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PATENT DEPARTMENT
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AUSTIN, TX 78701-4039

Date:

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JAN 30 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001040
PATENT NO. : 7363167
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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JAN 30 2012

CENTRAL REEXAMINATION UNIT

Baker Botts LLP
Patent Department
98 San Jacinto BLVD, Suite 1500
Austin, TX 78701-4039

(For Third Party Requester)

In re Csore *et al.*	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/001,040	: **DISMISSING PETITIONS**
Filed: April 22, 2008	: **UNDER § 1.182 & 1.183**
For: U.S. Patent No. 7,363,167	:

This is a decision on the following petitions:

- The July 18, 2011 patent owner petition to suspend time limits under 37 C.F.R. 1.945(a) to permit consideration of a late-filed response to the Action Closing Prosecution ("ACP").
- the December 5, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 – Request for Continued Examination,"
- the December 5, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.183 – Request to Suspend Time Limits Under 36 C.F.R. § 1.945."

The 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 April 22, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,040 ("the '1040 proceeding"), with a filing date of April 28, 2008, the date that the filing requirements of 37 C.F.R. § 1.915 were received.

- Prosecution progressed until, on September 30, 2009, an Action Closing Prosecution (ACP) was issued.

- On October 16, 2009, and on November 30, 2009, the Office issued decisions granting patent owner requests for extension of time for response to the Office action dated

September 30, 2009, extending the period for response set forth in 37 CFR 1.951(a) until December 14, 2009.

- On December 14, 2009 patent owner filed a paper entitled "AMENDMENT AND RESPONSE TO ACTION CLOSING PROSECUTION;" the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date; and a petition entitled "PETITION UNDER 37 C.F.R. § 1.181 – REQUEST TO ENTER AMENDMENTS AFTER ACTION CLOSING PROSECUTION," requesting entry of an amendment and remarks filed on the same date.

- On February 1, 2010, the Office issued a decision dismissing the petition under § 1.182.

- On April 18, 2011, the Office issued a non-final action on the merits, entering the patent owner's claim amendments submitted on December 14, 2009. Claims 1-34 and 36-41 were addressed in the action, with unamended claim 4, amended claims 5, 9-18, 27-29 and newly proposed claims 34 and 36-41 being found patentable, and claims 1-3, 6-8, 19-26, and 30-33 being rejected. The action set a 2 month period for response; as the period for response ended on a Saturday, a response filed on June 20, 2011 would be considered timely.

- On June 20, 2011, patent owner filed a petition for a 30 day extension of time to file a response, based upon, in part, an unavailability of an inventor.

- On June 22, 2011, the Office mailed a decision dismissing the June 20, 2011 petition, noting the insufficiency of the "facts presented as to why they are unavailable and when specifically they will be available," and noting that this is the fourth request for extension of time in the proceeding.

- On July 18, 2011, patent owner filed a response. <u>No claim amendments were submitted with this response</u>; see page 2, which states "[n]o changes have been made to any of the pending claims" which "include claims 1-34 and 36-41." The July 18, 2010 patent response was held untimely and unentered. <u>On the same date, patent owner filed a petition under § 1.183 to suspend the time limits for the previous response filing, which are set under 37 C.F.R. § 1.945(a).</u>

- On July 19, 2011, the Office issued an Action Closing Prosecution ("ACP"). The Office action cited 37 C.F.R. § 1.957(c), which states that "[i]f claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time." Claims 1-3, 6-8, 19-26, and 30-33 were withdrawn from consideration, and prosecution was limited to claims 4, 5, 9-18, 27-29, 34, and 36-41, and to claims not expanding the scope of those claims.

- On August 19, 2011, patent owner filed a response, requesting entry of claim amendments and addition of new claims 42-52, alleged to be similar to confirmed claims

with the replacement of prior "means for" language with "logic element" language.[1] Third party requester filed timely comments on September 19, 2011.

- The Office issued a Right of Appeal Notice ("RAN") on November 3, 2011, with unamended claim 4, amended claims 5, 9-18, 27-29 and newly proposed claims 34 and 36-41 being found patentable, and claims 1-3, 6-8, 19-26, and 30-33 being rejected. The RAN stated that the August 19, 2011 claim amendment did not satisfy the requirements of 37 C.F.R. § 1.116, and was therefore unentered in the proceeding.

- On December 2, 2011, third party requester filed a notice of appeal.

- On December 5, 2011, patent owner filed the following papers:

  - A patent owner petition entitled "Petition Under 37 C.F.R. § 1.182 – Request for Continued Examination,"
  - A patent owner petition entitled "Petition Under 37 C.F.R § 1.183 – Request to Suspend Time Limits Under 36 C.F.R. § 1.945."
  - A notice of appeal.

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.

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(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. § 1.181(f) provides, in pertinent part:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

[1] Patent owner apparently re-filed the response on August 22, 2011.

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.957(c) states:

> If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

37 C.F.R. § 1.945(a) states:

> 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 C.F.R. § 41.66(a) provides:

> An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

1. Patent Owner's § 1.182 Petition for reopening of prosecution

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."[2] 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 which grants continuation of prosecution in a reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to present claim amendments filed on July 18, 2011, alleging that entry of such would advance prosecution, and that extraordinary circumstances arose due to the voluminous documentation in the case and the 2010 merger of patent owner's company with a larger company, and that the denial of a request for an extension of time submitted on June 20, 2011 "limited the Patent Owner's right to submit claim amendments."

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[2] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

As a preliminary matter, the record is clear that no claim amendment was submitted by patent owner on July 18, 2011. The July 18, 2011 response states that "[n]o changes have been made to any of the pending claims" which "include claims 1-34 and 36-41."[3] As best understood, the petition is referencing patent owner's August 19, 2011 proposed claim amendment which was refused entry by the November 3, 2011 Right of Appeal Notice ("RAN"). That proposed amendment has the features discussed by petitioner; *i.e.*, proposed newly added claims 42-52. The December 5, 2011 petition is treated in this decision as requesting reopening of prosecution to enter the substance of the July 18, 2011 response and the August 19, 2011 proposed amendment.

Patent owner alleges that the new claims do not broaden the claims previously held allowable, because new claims 42-52 are alleged to be similar to confirmed claims with the replacement of prior "means for" language with "logic element" language. Patent owner states that entry of the amendments "may actually further the process along and clarify the issues," but provides no explanation of how the amendment would accomplish such furtherance and clarification.

As such, entry of the amendment would, on the basis of the facts of record in the file, not clearly act to simplify or reduce entry of issues in the proceeding such that the issues in the proceeding would be better defined for appeal or issuance of a reexamination certificate. Both parties have filed notices of appeal in the case, with the patent owner identifying the rejection of claims 1-3, 6-8, 19-26, and 33 as being appealed. Patent owner's proposed amendment would merely add new claims, having new and previously unexamined claim limitations, to the existing questions in the proceeding. It is also noted that patent owner has had sufficient prior opportunities to enter claim amendments of the character requested in the August 19, 2011 proposed amendment.

Furthermore, it is unclear that the replacement of "means" language with the "logic element" language would act to narrow the claims as required by § 1.957(c), which currently governs the type of amendments that may be submitted in the proceeding,[4] and for which patent owner has not requested waiver. Additionally, the new language would need to be examined for compliance with 35 U.S.C. § 314(a), which states that "no proposed amendment or new claim enlarging the scope of the claims of the patent shall be permitted." Additionally, the new language would require examination under 35 U.S.C. § 112, 2nd paragraph, as detailed in the "Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications", stating that "[w]hen the claim limitation does not use the phrase 'means for' . . . examiners should determine whether the claim limitation uses a non-structural term (a term that is simply a substitute for the term 'means for')." [5]

Patent owner has not presented any reason why entry of this proposed amendment would further the reexamination proceeding towards completion, or clarify the issues. The Board of Patent Appeals and Interferences (the Board) would still need to address each currently rejected claim in an appeal, and entry of the amendment would merely introduce new issues that would potentially be appealed either by patent owner or by third party requester. Therefore, there exists no reasoning sufficient to justify the Office sanctioning a delay of the reexamination proceeding such that the proceeding would not be handled with "special dispatch" per 35 U.S.C. § 314(c).

---

[3] July 18, 2011 patent owner response, at 2. See also page 1, which states the contours of the response and does not reference any proposed new claims or claim amendments.
[4] July 19, 2011 ACP.
[5] 76 Fed. Reg. 7162, 7167.

Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the patent owner petition under § 1.182 is **dismissed**.

2. Patent owner's July 18, 2011 petition under § 1.183 to suspend time limits under 37 C.F.R. 1.945(a) to permit consideration of a late-filed response to the Action Closing Prosecution ("ACP").

Patent Owner's July 18, 2011 petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules. 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.

In the present instance, patent owner seeks waiver of 37 C.F.R. § 1.945(a), which states that "[t]he 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." Rule 1.945(a) does not set a maximum time limit for response; the rule merely sets a minimum time limit for the time to respond set forth in any Office action. Waiver of § 1.945 would permit the Office to require the patent owner to respond within a time period less than thirty days. Waiver of § 1.945, as can be seen from its text, would not mandate that patent owner be given a greater time to respond to an outstanding Office action. Even if patent owner's petition were granted and § 1.945 was waived, this would not result in any extension of the time to respond to the June 20, 2011 ACP such that patent owner's July 18, 2011 petition would be considered timely.

As to whether the more general relief of reopening prosecution to permit entry of patent owner's earlier-filed response would be proper, these concerns are addressed in the above treatment of patent owner's December 5, 2011 petition under § 1.182.

For this reason, the no extraordinary situation exists such that waiver of § 1.945(a) is required by justice under the facts set forth in the July 18, 2011 petition. Therefore, that petition is **dismissed**.

3. Patent Owner's December 5, 2011 Petition under § 1.183

Patent owner's December 5, 2011 petition is filed under § 1.183, which permits relief "[I]n an extraordinary situation, where justice requires" waiver of any requirement of the rules.

Patent owner petitioner filed the petition to request that the time for filing an appellant's brief be extended until patent owner's petitions under §§ 1.183 and 1.182 have been acted upon. Patent owner requested waiver of § 1.945(a) for that purpose. As discussed in the section above, waiver of § 1.945(a) does not result in a patent owner being given a greater amount of time to file a paper. Furthermore, § 1.945(a) is entirely inapplicable to a request to extend the time to file an appellant's brief, since the time to file an appellant's brief is set by appellant's notice of appeal, and not an Office action. The two month period for filing an appellant's brief is set by 37 C.F.R. § 41.66(a), which also states that the time for filing an appellant's brief may not be extended. Patent owner would need to request waiver of § 41.66(a), not § 1.945(a), to seek extension of the time to file an appellant's brief.

As to the more general relief sought under § 1.183, petitioner had requested such relief under § 1.183 in order that the time to file an appellant's brief not expire before patent owner's petitions under §§ 1.183 and 1.182 have been decided. Patent owner's petitions under §§ 1.183 and 1.182 are being dismissed in the present decision. Therefore, the question of any waiver of the rules for extension of time to file an appellant's brief has become moot. Therefore, the December 5, 2011 patent owner petition under § 1.183 is **dismissed**.

The time to file an appellant's brief in this proceeding expires two months from the filing date of the last-filed notice of appeal, *i.e.*, February 5, 2012 (two months from December 5, 2011), pursuant to 37 C.F.R. §§ 41.61 and 41.66(a). In view of the limited amount of time between that date and the mailing date of this decision, § 41.66(a) is waived to the extent that **the time for either party to file an appellant's brief is hereby extended two weeks from the original expiry date, *i.e.*, the time to file an appellant's brief now expires on February 19, 2012.**

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. **The time for either party to file an appellant's brief is hereby extended two weeks from the original expiry date, *i.e.*, to expire on February 19, 2012.**

4. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

January 30, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,042	04/29/2008	6,926,609	8157.008.RXUS00	8185

23446 7590 04/15/2011

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/15/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Apple, Inc.
v.
John R. Martin

Reexamination Control No. 95/001,042
Patent 6,926,609
Technology Center 3900

DECISION ON PETITION

This is a decision on third party requester's "Petition under 37 C.F.R. § 1.181 and § 1.183 to Declare the Appeal Brief of Patentee of March 17, 2011, an Improper Paper and Strike It from the Record," filed March 25, 2011 ("present petition"). Petitioner requests that the patent owner's appellant brief of March 17, 2011, be stricken for not being in compliance with 37 C.F.R. § 1.943(c). 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 25, 2011.

Patent owner filed an opposition to the petition on April 4, 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 4 of the opposition.

FINDINGS

1. On April 29, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,926,609, which was assigned control no. 95/001,042.
2. Reexamination was ordered on June 12, 2008, and a non-final Office action was mailed on August 10, 2009.
3. Patent owner filed a response to the Office action on November 25, 2009, and third party requester filed comments in reply to the Office action and patent owner's response on December 24, 2009.
4. On June 16, 2010, an Action Closing Prosecution (ACP) was mailed.
5. On December 3, 2010, a Right of Appeal Notice (RAN) was mailed.
6. Patent Owner filed a Notice of Appeal on January 3, 2011, appealing the rejections of claims 1, 2, 45, and 47.
7. Requester filed a Notice of Cross-Appeal on January 17, 2011, appealing the patentability of claims 44 and 46.
8. Requester filed an appellant brief on March 17, 2011.
9. Patent Owner filed an appellant brief on March 17, 2011.
10. Requester filed the present petition on March 25, 2011.
11. Patent owner filed an opposition to the petition on April 4, 2011.

DISCUSSION

In the present petition, third party requester requests that the patent owner's appellant brief of March 17, 2011, be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it purportedly exceeds the 30-page or 14,000 word limit. Petitioner alleges that the appellant's brief contains more than 15,000 words. Petitioner states that requester has applied Optical Character Recognition software, part of Adobe Acrobat, pasted the text of the Patentee's Appeal Brief into Word, reviewed the copy and paste to functions, and used its word count function to determine that a proper calculation of word count is greater than 15,000 words. Requester indicates that they counted the "Summary of Claimed Subject Matter" section, "Issues to Be Reviewed on Appeal," as well as the "Argument" section. Requester states that they did not include the word count from the Rice Declaration, which they assert should be considered in the word count.

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. § 1.943(c) provides:

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

MPEP 2667(I.)(A.)(2.) provides:

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

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it exceeds the word limit. Patent owner admits on page 2 of the opposition to the petition that the "Summary of Claimed Subject Matter" section and the Rice Declaration were not counted in the word count of the appellant brief. It is agreed that both should be counted in the page and word limit. Including these pages and words causes the patent owner's appellant brief of March 17, 2011, to exceed the page and word limit pursuant to 37 C.F.R. § 1.943(c).

The present petition is **granted**. The patent owner appellant brief of March 17, 2011, is not entered.

DECISION

In view of the foregoing, the Petition is GRANTED.

Patent owner appellant is given one opportunity to file a corrected appellant brief in compliance with 37 CFR § 1.943(c), within a non-extendable time period of 15 days 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.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,044	06/26/2008	J 7096776	718642.1656	8589

93853 7590 04/01/2011

Lawrence J. Koncelik, Jr.
37 Mile Hill Road
East Hampton, NY 11937

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/01/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SAMUEL DIGIROLAMO
HUSCH BLACKWELL SANDERS LLP
720 OLIVE STREET, SUITE 2400
ST. LOUIS, MO 63101

Date MAILED
APR 01 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001044
PATENT NO. : 7096776
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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APR 01 2011

CENTRAL REEXAMINATION UNIT

Lawrence J. Koncelik, Jr.
37 Mile Hill Road
East Hampton NY 11937

(For Patent Owner)

Samuel Digirolamo
720 Olive Street, Suite 2400
St. Louis, MO 63101

(For Third Party Requester)

Samuel Digirolamo
Husch Blackwell LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63105

(Courtesy Copy))

In re Lawrence J. Koncelik, Jr.	:	
Reexamination Proceeding	:	**DECISION DISMISSING**
Control No. 95/001,044	:	**PETITION TO STAY**
Filed: June 26, 2008	:	**REISSUE PROCEEDING**
For: U.S. Patent No. 7,096,776	:	

This is a decision on the January 18, 2011 third party requester petition entitled "Petition Under 37 CFR 1.182 For Stay of Reissue in View of Reexamination Already on Appeal." This petition was submitted with the required $400 petition fee, charged to requester's deposit account.

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed**.

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

[1] See MPEP 2267.

REVIEW OF THE FACTS

1. U.S. Patent 7,096,776 (the '776 patent) issued to Lawrence J. Koncelik, Jr. on August 29, 2006, having claims 1-16.

2. On May 16, 2008, a request for *inter partes* reexamination of claims 1-16 of the '776 patent, assigned control number 90/001,044 (the '1044 proceeding) was initially deposited by a third party requester on behalf of real party of interest Sunbeam Products, Inc. d/b/a Jarden Consumer Solutions, and a corrected request meeting the filing date requirements for a reexamination request was filed on June 26, 2008.

3. On August 1, 2008, *inter partes* reexamination was ordered on claims 1-16 of the '776 patent in the '1044 proceeding. Prosecution has reached the appeal stage, with a notice of defective appellant's brief having been mailed on March 3, 2011.

4. On February 18, 2010, patent owner filed a reissue application for reissue of the '776 patent, which application was assigned application number 12/707,859 (the '859 reissue application).

5. On January 18, 2011, the third party requester filed the instant petition, entitled "Petition Under 37 CFR 1.182 For Stay of Reissue in View of Reexamination Already on Appeal."

APPLICABLE REGULATIONS

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

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

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

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

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

> Notwithstanding any provision of the rules, any person at any time may file a paper in an inter partes reexamination proceeding notifying the Office of a prior

> or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current inter partes reexamination proceeding. Any paper not so limited will be returned to the sender.

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

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

DECISION

Third party requester has filed the instant petition requesting that the '859 reissue application be stayed pending completion of the instant '1044 *inter partes* reexamination proceeding. Third party requester has not, however, specified any statutory basis permitting such a third party requester paper, requesting that the Office take action with respect to a reissue proceeding in which requester is not a party.

A third party may file a paper notifying the Office of the existence of a concurrent reissue proceeding. However, 37 C.F.R. § 1.985(b) requires that any such paper "must be limited to merely providing notice of the other proceeding without discussion of issues of the current inter partes reexamination proceeding." Any paper that is not so limited will be returned to the sender per § 1.985(b) or expunged if inadvertently entered. The instant third party requester paper goes beyond mere notice as to requesting that the Office take action in a proceeding other than the '1044 reexamination proceeding in which the petition was filed. Therefore, the instant third party requester paper is not a proper submission under § 1.985(b).

The petition is improper because the third party requester is requesting action be taken in a proceeding other than the '1044 reexamination proceeding in which the petition was filed - a reissue proceeding in which requester is not a party. Neither 35 U.S.C. § 314(b)(2), nor any other provision of the reexamination statute, provides any right for the third party requester to file a

paper in an *inter partes* reexamination proceeding that requests action be taken in a separate proceeding.[2] While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of a reexamination proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to participate in other Office proceedings. Such a right was not provided in the enactment of the *inter partes* reexamination statute (nor in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

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

For the above reasons, the instant petition is dismissed as not having a right of entry, and the petition paper is expunged.

PETITIONER'S CORRESPONDENCE ADDRESS

The correspondence address that is given on the instant petition (Samuel Digirolamo, Husch Blackwell LLP, 190 Carondelet Plaza, Suite 600, St. Louis, MO 63105)) is different from that of record for the third party requester in the '1044 reexamination proceeding (Samuel Digirolamo, Husch Blackwell Sanders LLP, 720 Olive Street, Suite 2400, St. Louis, MO 63101). It is noted that recent correspondence sent to the address on file in the reexamination proceeding (Samuel Digirolamo, 720 Olive Street, Suite 2400, St. Louis, MO 63101) has been returned to the USPTO as "not deliverable as address, unable to forward." A courtesy copy has been sent to the petitioner's address; however, further correspondence will be mailed only to the requester's address of record in the reexamination proceeding.

CONCLUSION

1. The third party requester petition filed January 18, 2011 is dismissed as not having a right of entry.

2. The petition paper filed by the third party requester on January 18, 2011 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '1044 *inter partes* reexamination proceeding and marking the paper "closed" and "not public."

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

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

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

5. While a courtesy copy has been sent to the petitioner's address, further correspondence will be mailed only to the requester address on file in the reexamination proceeding - Samuel Digirolamo, Husch Blackwell Sanders LLP, 720 Olive Street, Suite 2400, St. Louis, MO 63101.

6. Telephone inquiries relating to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, to Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726.

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

March 29, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Hamilton & Terrile, LLP
P.O. Box 203518
Austin, TX 78720

(For Patent Owner)

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MAR 3 1 2011

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP
Attn: Tracy W. Druce
1000 Louisiana Ave.
Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

In re Postelnik et al.	: DECISION
Reexamination Proceeding	: ON
Control No. : 95/001,047	: PATENT OWNER'S
Filed: May 30, 2008	: PETITION
Patent No. 7,069,235	: UNDER 37 CFR 1.181

This is a decision addressing patent owner's petition, filed May 18, 2009, under 37 CFR 1.181 requesting reconsideration of the March 18, 2009 decision that stated that the declarations filed February 17, 2009 will not entered into the proceeding record. Although the petition contains statements that an alternative relief is sought under 37 CFR 1.182 and/or 1.183, the petition is being decided solely under 37 CFR 1.181. The patent owner's combined petition under 37 CFR 1.181, 1.182, and 1.183 is deemed improper because it combines three distinct petitions, which is not compliant with 37 CFR 1.4. Patent owner must file separate petitions if patent owner wants consideration of the issues under 37 CFR 1.182 and/or 1.183. In summary, this decision solely addresses the issues raised under 37 CFR 1.181, e.g., whether the March 18, 2009 decision to not enter the February 18, 2009 declarations followed the reexamination laws and procedures.

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. 7,069,235 (the '235 patent) issued on June 27, 2006.

2. A request for reexamination, assigned Control No. 95/001,047 (the '047 proceeding), was filed by a third party Requester on May 30, 2008.

3. Reexamination was ordered in the '047 reexamination proceeding on July 12, 2008. On the same day, an Office action on the merits was mailed. The Office action contained rejections of patent claims 1-6, 8-18, 20, and 23-27. Claims 7, 19, 21, and 22 were not subject to reexamination.

6. On September 12, 2008, Patent Owner filed a response to the Office action by the examiner. The response was supported by a declaration under 37 CFR 1.131 by inventor Igor Postelnik.

7. On September 25, 2008, third party requester filed a "Petition Requesting Vacating Patent Owner's Response to Office Action filed September 12, 2008."

8. On October 6, 2008, a decision dismissing third party requester's petition of September 25, 2008 as to the vacating of patent owner's response of September 12, 2008 was mailed. The decision did grant third party requester a period of 30 days from September 24, 2008 to submit comments on the patent owner's September 12, 2008 response.

9. On October 24, 2008, third party requester filed comment entitled "Third Party Requester's Comments to Patent Owner's Response in Inter Partes reexamination of U.S. Patent No. 7,069,235."

10. On February 17, 2009, patent owner filed a cover letter and two declarations with supporting exhibits (deemed a supplemental response to the Office action mailed July 12, 2008).

11. On March 10, 2009, third party requester filed "Petition under 37 CFR § 1.181 and/or 37 CFR § 1.182 and or 37 CFR § 1.183 for Immediate Supervisory Review and Determination That the February 17, 2009 Patent Owner Supplemental Response Will Not Be Entered."

12. On March 18, 2009, the Office mailed a "Notice of Defective Papers," which stated that the supplemental submission of February 17, 2009 will not be entered because it failed to meet the requirements of 37 CFR 1.945(b) for entry.

13. On May 18, 2009, patent owner filed the instant petition under 37 CFR 1.181.

14. On September 2, 2009, patent owner filed another declaration under 37 CFR 1.132.

DECISION UNDER 37 CFR 1.181

The patent owner (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 by requesting reconsideration of the March 18, 2009 decision that stated that the declarations and supporting exhibits, filed February 17, 2009, will not be entered into the proceeding record. Petitioner specifically requests that the Director find that the March 18, 2009 decision incorrectly deemed the papers filed on February 17, 2009 to be a supplemental response that is subject to the requirements of 37 CFR 1.945(b) for entry. See, e.g., pages 3-5 of the petition.

In response, the Director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures established that only certain papers have a right of entry in order to achieve the statutory mandate of special dispatch. See, e.g., 37 CFR 1.939 through 37 CFR 1.957. The petition does not state that the February 17, 2009 papers complied with the requirements of 37 CFR 1.945(b)[1], but instead alleges that these papers are not a supplemental response, and therefore, not subject to the requirements of 37 CFR 1.945(b). The record shows that the March 18, 2009 decision appropriately followed Office rules and procedures in the determination that the February 17, 2009 papers are a supplemental response, and did not categorically deprive the petitioner of its statutory rights to present evidence in reexamination proceedings.

Specifically, upon review of the record, it is noted that the February 17, 2009 papers included a cover letter, a declaration under 37 CFR 1.131 by Igor Postelnik, Jocelyn Goldfein, and Phil Gilbert, a declaration under 37 CFR 1.132 by Srinu Yerneni, and numerous exhibits to support the declarations. The cover letter, both declarations, and the supporting exhibits were filed in response to the rejection of claims 1-6, 8-18, 20, and 23-27 under 35 U.S.C. 102(e) based upon U.S. Patent No. 6,963,847 to Kennedy et al. in the Office action of July 12, 2008. In other words, the cover letter, the declarations, and supporting exhibits were filed in order to disqualify the Kennedy et al. patent as prior art against the claims of the '235 patent and overcome the rejection advanced in the July 12, 2008 Office action. Patent owner is requesting <u>reconsideration of the rejection</u> in the July 12, 2008 Office action in light of the factual evidence of prior invention provided by the declarations and supporting exhibits. See, e.g., pages 1-2 of the petition. Therefore, the record is clear that the February 17, 2009 cover letter, declarations, and supporting exhibits were presented <u>in response to the merits</u> of the July 12, 2008 Office action. Accordingly, the papers of February 17, 2009 were properly deemed a supplemental response to the July 12, 2008 Office action. Furthermore, the March 18, 2009 decision properly denied entry because the requirements of 37 CFR 1.945(b) were not met, in accordance with the special dispatch mandate of 35 U.S.C. 305.

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[1] It is noted that a "conditional" showing under 37 CFR 1.945(b) was filed with the petition. Such a conditional showing is untimely and not in accordance with reexamination laws and policies. See MPEP 2666. As this paper was not of record prior to May 18, 2009, it will not be further discussed in this decision, which is limited to whether the March 18, 2009 decision followed reexamination laws and policies.

In the petition, patent owner states that the declarations and supporting exhibits are "other papers" as mentioned in 37 CFR 1.943(a) and not a response. See, e.g., pages 3-4 of the petition. However, as discussed above, the record clearly shows that the cover letter, declarations, and supporting exhibits, were filed in response to the rejection in the July 12, 2008 Office action and that patent owner is requesting more than just entry, but consideration, of the declarations. Moreover, the "other papers" of 37 CFR 1.943(a) only refers to papers that are not "...responses, written comments, brief, [or] appendices ..." and have a right of entry provided by the *inter partes* reexamination regulations. 37 CFR 1.943(a) does not, by itself, give any right of entry into an *inter partes* reexamination proceeding, but only prescribes that papers having a right of entry must comply with the requirements of 37 CFR 1.52. Petitioner fails to state any regulation that would permit entry of the February 17, 2009 papers as "other papers." Therefore, even if the argument that the February 17, 2009 papers are "other papers" is persuasive (which it is not for the reasons expressed in this decision), the papers would be deemed unauthorized papers under 37 CFR 1.939 and would be expunged from the proceeding record.

The petitioner cites to various regulations (e.g., 37 CFR 1.111 and 1.116) as support for their position. However, none of these citations provide clear support for petitioner's position. For example, the citation to 37 CFR 1.111 is not dispositive because the fact that the regulation requires a reply to include arguments regarding patentability does not mean that a reply cannot include other elements, including evidence to support such arguments (such as arguments raised in the September 12, 2008 response or in the February 17, 2009 cover letter). Similarly, the fact that 37 CFR 1.116 addresses amendments separately from affidavit or other evidence is not dispositive that affidavits and other evidence are not a part of a response or reply. In addition, the argument that only clause (E) of 37 CFR 1.111(a)(2)(i) is applicable to declarations or affidavits is unsupported. It is not clear why patent owner fails to recognize that an effective and timely filed declaration or affidavit under 37 CFR 1.131 or 1.132 could also be in response to the examiner's suggestions, result in the claims being confirmed or allowed, in response to an Office requirement made after a first response was filed, and/or result in a simplification of issues for appeal (clauses B-D and F of 37 CFR 1.111(a)(2)(i)). In sum, petitioner's arguments are based on an overly narrow reading of portions of the regulations in isolation.

The Office deems affidavits or declarations filed under 37 CFR 1.130, 1.131, and 1.132 as part of a response in reexamination or a reply in examination of an application. See, e.g., 37 CFR 41.50(a)(2)(i) which states that "... a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence." See also 37 CFR 41.77(b)(1) and MPEP 2666 and 2667. In particular, MPEP 2666 discusses affidavits (and declarations) under 37 CFR 1.131 and 1.132 in the "Substance of the Response" subsection, and MPEP 2667 provides an exclusion for purposes of the page count limit of 37 CFR 1.943(b) for certain declarations or affidavits that provide factual evidence. If declarations or affidavits under 37 CFR 1.131 and 1.132 were not considered part of a response, MPEP 2667 would not have to provide the page count limit exception. To reiterate, declarations or affidavits under 37 CFR 1.131 and 1.132, like amendments and arguments, are considered part of a response in reexamination. Therefore, for these additional reasons, petitioner's arguments are not persuasive that the March 18, 2009 decision was in error.

The record shows that the March 18, 2009 decision appropriately followed the reexamination laws and procedures, e.g., as set forth in 37 CFR 1.945(b) and MPEP 2666 *et seq.*, in making the

determination that the February 17, 2009 papers are a supplemental response. For the reasons set forth above, it is deemed that the March 18, 2009 decision followed Office rules and procedures in its determination that the February 17, 2009 supplemental response did not satisfy the requirements for entry and denied entry into the proceeding record in the interest of special dispatch. Therefore, the patent owner's petition, as it relates to entry and consideration of the February 17, 2009 papers, is denied.

In view of the above, the papers attached to present petition do not have an entry right under the rules. For the same reasons and in the interest of special dispatch, the September 2, 2009 papers, including a cover letter, another declaration under 37 CFR 1.132 regarding the Kennedy patent, and supporting exhibit, are deemed a supplemental response and do not have an entry right under the rules because the requirements of 37 CFR 1.945(b) have not been met. As the papers have been entered into the electronic Image File Wrapper (IFW) record, the papers attached to the May 18, 2009 petition and the September 2, 2009 papers will be "returned" by closing the papers in the IFW, and marking the papers nonpublic to expunge it from the record. The May 18, 2009 petition and the present decision will, however, be of record in the reexamination proceeding. See MPEP 2267.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.181, filed May 18, 2009, is DENIED for the reasons discussed above. The May 18, 2009 petition will remain in the proceeding record.

2. The attachments to the May 18, 2009 petition will be expunged from the record as not having a right of entry.

3. For the same reasons expressed in this decision, the papers filed September 2, 2009 will be expunged from the record as not having a right of entry.

4. 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.
95/001,047	05/30/2008	7069235	8332.003.235	3487

33438 7590 03/31/2011
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/31/2011

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.
95/001047	05/30/08	7069235	8332.003.235

EXAMINER
ENGLISH, PETER

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ART UNIT	PAPER
3993	

DATE MAILED:
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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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(For Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re Postelnik *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,047
Filed: May 30, 2008
For: U.S. Patent No.: 7,069,235

DECISION DISMISSING PETITION

This is a decision on the March 26, 2009 third party requester petition for waiver of 37 CFR 1.943(b) entitled "CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE, IF NEEDED, THE 50-PAGE LIMITATION FOR REQUESTER'S WRITTEN COMMENTS".

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition for waiver of 37 CFR 1.943(b) is dismissed as premature.

FEES

The requisite petition fee for a petition under 37 CFR 1.183 is $400.00 pursuant to 37 CFR 1.17(f). Petitioner did not include payment of the petition upon EFS-WEB submission. Accordingly, the $400.00 fee will be charged to petitioner's Deposit Account No. 14-1437 as authorized in the March 26, 2009 petition.

BACKGROUND

1. On June 27, 2006 the Office issued U.S. Patent No. 7, 069,235 to Postelnik *et al.*

2. On May 30, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,047 ("the '1047 proceeding"), by a third party requester.

3. On July 12, 2008, the Office issued an order granting the request for *inter partes* reexamination. Concurrently, the Office issued a first Office action on the merits, setting a two month time period for patent owner to respond.

4. On September 12, 2008, patent owner filed a response to the July 12, 2008 Office action.

5. On September 25, 2008, third party requester filed a petition requesting vacatur of patent owner's September 12, 2008 response to the July 12, 2008 Office action.

6. On October 6, 2008, the Office issued a decision dismissing third party requester's September 25, 2008 petition and set a 30 day time period starting September 24, 2008 for third party requester to submit comments to patent owner's September 12, 2008 response.

7. On October 24, 2008, third party requester filed comments to patent owner's September 12, 2008 response. The third party requester comments consisted of a forty-one (41) page remarks section, two declarations totaling 105 pages and ten (10) exhibits totaling 783 pages.

8. On March 18, 2009, the Office issued a notice of defective papers determining that third party requester's October 24, 2008 comments exceeded the fifty (50) page limit requirement of 37 CFR 1.943(b). The notice set a fifteen day time period from the date of the notice to submit either redrafted or redacted comments conforming to the fifty page limit or submit a petition to waive the fifty (50) page limit.

9. On March 24, 2009, third party requester submitted revised comments consisting of a thirty-two (32) page remarks section, two declarations totaling twenty-one (21) pages and five (5) exhibits totaling forty-nine (49) pages.

10. Also on March 24, 2009, third party requester submitted a petition entitled, "PETITION UNDER 37 CFR § 1.181 FOR SUPERVISORY REVIEW AND ENTRY OF THE REVISED 37 CFR § 1.943(b) REQUESTER WRITTEN COMMENTS." As of the date of this decision the record does not reflect that this petition for supervisory review has been decided or that the revised comments have been reviewed for compliance with 37 CFR 1.943(b).

11. On March 26, 2009, third party requester submitted a petition entitled, "CONDITIONAL PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE, IF NEEDED, THE 50-PAGE LIMITATION FOR REQUESTER'S WRITTEN COMMENTS," which is the subject of this decision. The petition is seeking waiver of the fifty (50) page limit requirement under 37 CFR 1.943(b) relative to the March 24, 2009 submission.

DECISION

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).

The present petition for waiver of the fifty (50) page limit requirement for third party comments under 37 CFR 1.943(b) was filed two days after revised third party comments were submitted. The revised third party comments facially comply with 37 CFR 1.943(b), as the remarks section is thirty-two (32) pages in length and declarations and evidentiary exhibits often will not count against the fifty (50) page limit. Therefore, under the current facts and circumstances of the

present proceeding there is no need for the equitable relief of waiving the requirements of 37 CFR 1.943(b). However, if the Office determines that the March 24, 2009 third party comments do not comply with the page limit requirement of 37 CFR 1.943(b) then petitioner may renew their petition for waiver under 37 CFR 1.183. In any such renewed petition patent owner would need to specifically state the extraordinary facts and circumstances in the proceeding and the number of additional pages necessary for a complete discussion of the substantive issues in the proceeding. Furthermore, petitioner is advised to contact either the legal advisor listed in the conclusion in order to expedite its review. Accordingly, based upon the current facts and circumstances of this proceeding, the request to waive the relevant rule(s) and grant an unspecified number of additional pages necessary for a complete discussion of the substantive issues in the proceeding is dismissed as premature.

CONCLUSION

1. The patent owner petition for waiver of the 37 CFR 1.943(b) fifty (50) page limit, filed March 26, 2009 for third party comments filed March 24, 2009 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

Kenpet8/
3-29-11

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MAR 31 2011

CENTRAL REEXAMINATION UNIT

In re Postelnik *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,047
Filed: May 30, 2008
For: U.S. Patent No.: 7,069,235

DECISION DISMISSING PETITION

This is a decision on the June 4, 2009 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 TO DISMISS AND PERMANENTLY SEAL (I.E., "EXPUNGE") PATENT OWNER'S MAY 18, 2009 PETITION."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

1. On June 27, 2006 the Office issued U.S. Patent No. 7, 069,235 to Postelnik *et al.*

2. On May 30, 2008, a third party request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,047 ("the '1047 proceeding").

3. On July 12, 2008, the Office issued an order granting the request for *inter partes* reexamination. Concurrently, the Office issued a first Office action on the merits, setting a two month time period for patent owner to respond.

4. On September 12, 2008, patent owner filed a response to the July 12, 2008 Office action.

5. On September 25, 2008, third party requester filed a petition requesting the striking of patent owner's September 12, 2008 response to the July 12, 2008 Office action.

6. On October 6, 2008, the Office issued a decision dismissing third party requester's September 25, 2008 petition and setting a 30 day time period starting September 24, 2008 for third party requester to submit comments to patent owner's September 12, 2008 response.

7. On October 24, 2008, third party requester filed comments to patent owner's September 12, 2008 response. The third party requester comments consisted of a forty-one (41) page remarks section, two declarations totaling 105 pages and ten (10) exhibits totaling 783 pages.

8. On March 18, 2009, the Office issued a notice of defective papers determining that third party requester's October 24, 2008 comments exceeded the fifty (50) page limit requirement of 37 CFR 1.943(b). The notice set a fifteen day time period from the date of the notice to submit either redrafted or redacted comments conforming to the fifty page limit or submit a petition to waive the fifty (50) page limit.

9. On March 24, 2009, third party requester submitted revised comments consisting of a thirty-two (32) page remarks section, two declarations totaling twenty-one (21) pages and five (5) exhibits totaling forty-nine (49) pages for a total of 102 pages.

10. On April 2, 2009, third party requester submitted a second set of revised comments consisting of a twenty-seven (27) page remarks section, two declarations totaling eighteen (18) pages and a single five (5) page exhibit for a total of fifty (50) pages.

11. On May 18, 2009, patent owner submitted a petition entitled "PETITION UNDER 37 C.F.R. § 1.181 AND 1.183 TO DENY ENTRY OF THIRD PARTY REQUESTER COMMENTS AND IMPOSE OTHER SANCTIONS AS DEEMED APPROPRIATE BY THE USPTO."

12. On June 4, 2009, third party requester submitted the present petition entitled, "PETITION UNDER 37 C.F.R. § 1.182 TO DISMISS AND PERMANENTLY SEAL (I.E., "EXPUNGE") PATENT OWNER'S MAY 18, 2009 PETITION."

13. On July 6, 2009, the Office issued a decision dismissing patent owner's May 18, 2009 petition.

RELEVANT GUIDANCE

MPEP 2658.III.H states:

> If questions other than those indicated above (for example, questions of patentability based on public use or on sale, ***conduct issues,*** abandonment under 35 U.S.C. 102(c), etc.) are raised by the third party requester or the patent owner during a reexamination proceeding, *the existence of such questions will be noted by the examiner in the next Office action,* in which case the patent owner may desire to consider the advisability of filing a reissue application to have such questions considered and resolved. Such questions could arise in a reexamination requester's 37 CFR 1.915 request or in 37 CFR 1.947 comments by the third party requester. [Emphasis added]

DECISION

Third party requester on June 4, 2009 filed a petition requesting that patent owner's May 18, 2009 petition (which requested that third party requester's October 24, 2008 comments be denied entry and that requester be subject to sanctions) be dismissed and expunged. On July 6, 2009, the Office issued a decision dismissing patent owner's May 18, 2009 petition. Therefore the June 4, 2009 petition, as to the request that the May 18, 2009 petition be dismissed, is moot. Regarding the June 4, 2009 third party requester petition's request that the May 18, 2009 patent owner petition be expunged, the requested relief is not appropriate in accordance with MPEP section 2658.III.H and 37 CFR 1.906(c). Office procedure is to have the examiner note the existence of such questions in the next Office action and not to expunge papers that raise such issues. Therefore, third party requester's petition to expunge patent owner's May 18, 2009 petition is dismissed.

CONCLUSION

1. Third party requester's June 4, 2009 petition is **dismissed**.

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

Kenpetopposition/
3-29-11

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP
Attn: Tracy W. Druce
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Wells Fargo Plaza, 53rd Floor
Houston, TX 77002

(For Third Party Requester)

In re Postelnik et al.	: DECISION
Reexamination Proceeding	: DISMISSING
Control No. : 95/001,047	: REQUESTER'S
Filed: May 30, 2008	: PETITION
Patent No. 7,069,235	: 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 24, 2009 third party requester petition, entitled "Petition under 37 CFR § 1.181 for Supervisory Review and Entry of Revised 37 CFR § 1.943(b) Requester Written Comments." The petition is requesting that the replacement requester's comments of March 24, 2009 be entered into the proceeding record.

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

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,069,235 (the '235 patent) issued on January 27, 2006.

2. A request for reexamination, assigned Control No. 95/001,047 (the '047 proceeding), was filed by a third party Requester on May 30, 2008.

3. Reexamination was ordered in the '047 reexamination proceeding on July 12, 2008. On the same day, an Office action on the merits was mailed. The Office action contained rejections of patent claims 1-6, 8-18, 20, and 23-27. Claims 7, 19, 21, and 22 were not subject to reexamination.

6. On September 12, 2008, Patent Owner filed a response to the Office action by the examiner. The response was supported by a declaration under 37 CFR 1.131 by inventor Igor Postelnik.

7. On September 25, 2008, third party requester filed a "Petition Requesting Vacating Patent Owner's Response to Office Action filed September 12, 2008."

8. On October 6, 2008, a decision dismissing third party requester's petition of September 25, 2008 as to the vacating of patent owner's response of September 12, 2008 was mailed. The decision did grant third party requester a period of 30 days from September 24, 2008 to submit comments on the patent owner's September 12, 2008 response.

9. On October 24, 2008, the third party requester filed comment entitled "Third Party Requester's Comments to Patent Owner's Response in Inter Partes reexamination of U.S. Patent No. 7,069,235."

10. On March 18, 2009, the Office mailed a "Notice of Defective Papers," which stated that the requester's comments of October 24, 2008 will not be entered because it exceeded the 50 page count limit of 37 CFR 1.943(b).

11. On March 24, 2009, requester filed the instant petition under 37 CFR 1.181, and replacement comments in response to the March 18, 2009 notice.

12. On March 31, 2011, the Office mailed an Office action that entered the March 24, 2009 replacement requester comments.

DECISION

As pointed out, the third party requester filed a March 24, 2009 petition, which is a petition requesting entry of the concurrently filed replacement comments into the proceeding record. On March 31, 2011, the Office mailed an action that entered requester's replacement comments of March 24, 2009. Therefore, the relief requested by the March 24, 2009 petition has already been given by the March 31, 2011 Office action. Thus, the third party requester's March 24, 2009 petition is moot, and hereby, dismissed.

CONCLUSION

1. The March 24, 2009 third party requester's petition is dismissed as moot.

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

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

WAKE FOREST UNIVERSITY HEALTH SCIENCES
Patent Owner

SUSAN G. L. GLOVSKY
Third Party Requester – *Ex parte* Reexamination Control 90/008,693

SMITH & NEPHEW, INC. and BLUESKY MEDICAL GROUP, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,048

Merged *Ex parte* and *Inter partes* Reexamination Control 90/008,693 and 95/001,048
Patent 7,216,651

DECISION ON PETITION

This is a decision on "Petition by Patent Owner Under 37 C.F.R. 1.183 to Suspend or Waive the Page and/or Word Count Limits of 37 C.F.R. 1.943," filed July 14, 2010 ("Petition"). In the Petition, Patent Owner seeks approval to file a Respondent's Brief of 42 pages in length. Petition, pp. 1-2.

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

FINDINGS

1. Patent 7,216,651 issued on May 15, 2007.

2. An Ex Parte Request for Reexamination was submitted by Requester Susan G. L. Glovsky on June 11, 2007, and resubmitted on October 5, 2007. This Request was assigned control number 90/008,693.

3. On November 28, 2007, the Office issued an Order Granting Request for Ex Parte Reexamination of the '651 patent in the '693 proceeding.

4. An Inter Partes Request for Reexamination was submitted by Requester Smith & Nephew, Inc and BlueSky Medical Group, Inc. (collectively "Smith and BlueSky") on May 30, 2008, and assigned control number 95/001,048.

5. On August 4, 2008, the Office issued an Order Granting Request for Inter Partes Reexamination of the '651 patent in the '048 proceeding.

6. On October 14, 2008, the Office issued a Decision *Sua Sponte* to merge the '693 and '048 proceedings.

7. On January 15, 2010, the Examiner entered an Action Closing Prosecution.

8. On March 12, 2010 the Examiner entered a Right of Appeal Notice.

9. On June 14, 2010, requester Smith and BlueSky filed an Appeal Brief.

10. On July 14, 2010, Patent Owner filed a Respondent Brief having a page length of 41 pages and an undetermined word count.

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 provides:

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

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

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

On papers filed by the patent owner in an *inter partes* reexamination proceeding, MPEP § 2667 I.A.2 provides:

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

On papers filed by the third party requester in an *inter partes* reexamination proceeding, MPEP § 2667 I.B.2 provides:

For additional information with respect to the length of the papers, see subsection I.A.2. above.

ANALYSIS

A review of Patent Owner's Respondent Brief filed on July 14, 2010 reveals that it has a length of 41 pages counted with the exclusions identified

above in 37 C.F.R. § 1.943(b) and MPEP § 2667 I.A.2. Also, the sections of a respondent brief that are required under 37 C.F.R. § 41.68(b)(1)(i)-(iv) are deemed included in "reference materials" that do not count toward the page limit (real party in interest, related appeals and interferences, status of claims, and status of amendments).

Patent Owner argues that Requester Smith and BlueSky in its Appellant Brief raised 57 grounds of rejection against all 125 claims of the '651 patent, only 27 of which were initially adopted by the Examiner. Thus, prior to the appeal, Patent Owner has not fully addressed 30 of those grounds. Petition, pp. 3-4.

Patent Owner further argues that the present appeal involves consideration of extensive documentary evidence and transcripts that evolved from prior litigation, and of voluminous evidence of secondary factors introduced in the present reexamination proceedings. Petition, p. 4.

However, Patent Owner does not explain why Patent Owner requires 41 pages for its Respondent Brief while Requester's Appellant Brief filed June 16, 2010 has a page count of 29 using the page count rules set forth above.

Also, Patent Owner represents that its Respondent Brief in 6 point font is less than 15 pages and in 11 point font is 42 pages. Petition, pp. 1-2. In fact, however, an examination of the brief filed on July 14, 2010 having 41 countable pages is in a very small font, probably 6 point.

Further, Patent Owner has not provided a word count for its Respondent Brief, as required by 37 C.F.R. § 1.943(c).

For these latter reasons, Patent Owner's Petition is not deemed reasonable.

DECISION

For the forgoing reasons, the Petition is DENIED and Patent Owner is accorded one month in which to file a Respondent Brief that is in compliance with Rule 1.943(c).

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner Wake Forest University Health Sciences:
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

WAKE FOREST UNIVERSITY HEALTH SCIENCES
Patent Owner

DEC 22 2010

SUSAN G. L. GLOVSKY
Third Party Requester – *Ex parte* Reexamination Control 90/008,693

SMITH & NEPHEW, INC. and BLUESKY MEDICAL GROUP, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,048

Merged *Ex parte* and *Inter partes* Reexamination Control 90/008,693 and 95/001,048
Patent 7,216,651

ORDER VACATING DECISION ON PETITION

This Order is responsive to Patent Owner's "Petition Under 37 C.F.R. § 1.181(a)(3)," filed December 12, 2010 ("Petition"). The Petition seeks reversal of the Decision on Petition entered November 10, 2010 denying entry of Patent Owner's Respondent Brief filed July 14, 2010, and further seeks entry of the Respondent Brief.

FINDINGS

1. On November 10, 2010, the Chief Administrative Patent Judge entered a Decision on Petition denying Patent Owner's petition seeking a

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waiver of the page/word limits for Patent Owner's Respondent Brief filed July 14, 2010.

2. In the present Petition, Patent Owner argues, *inter alia,* that the Chief Administrative Patent Judge has no authority to decide petitions concerning appeal briefs filed earlier than August 17, 2010 in *inter partes* reexamination proceedings, citing 75 Fed. Reg. 50,750-51 (Aug. 17, 2010). Petition, pp. 5-6.

DICUSSION

As correctly argued by Patent Owner, in regard to appeal briefs in reexamination proceedings filed on or after August 17, 2010, the Federal Register Notice of August 17, 2010 expressly provides that the Chief Judge "will address any inquiries and petitions regarding entry of [such] appeal briefs." However, the Federal Register Notice does not expressly preclude the Chief Judge from deciding petitions concerning briefs filed earlier than August 17, 2010. Patent Owner has not cited any statute, rule or written guideline (MPEP) that requires such preclusion.

Notwithstanding the foregoing, the Office is desirous that its procedures be clearly understood as expressed by applicable statutes, rules and guidelines. In this situation, it is understandable how the relevant Federal Register Notice could be interpreted as precluding the Chief Judge from deciding petitions concerning appeal briefs filed before August 17, 2010.

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Ex parte Reexamination Control 90/008,693
Inter partes Reexamination Control 95/001,048
Patent 7,216,651

DECISION

In view of the forgoing, the present Petition is GRANTED to the extent that the Decision on Petition of November 10. 2010 is vacated and the Petition of July 14, 2010 is remanded to the Office of Patent Legal Administration for disposition.

James T. Moore
Acting Chief Administrative Patent Judge

Counsel for Patent Owner Wake Forest University Health Sciences:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 06/06/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/06/2011

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IRVINE, CA 92614

Date:
MAILED
JUN 06 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001048
PATENT NO. : 7216651
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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P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 06 2011

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

In re Argenta et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,693
Filed: October 5, 2007
For: U.S. Patent 7,216,651

In re Argenta et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,048
Filed: May 30, 2008
For: U.S. Patent No. 7,216,651

DECISION

GRANTING

PETITION

This is a decision on patent owner's petition entitled "Petition by Patent Owner Under 37 C.F.R. 1.183 to Suspend or Waive the Page and/or Word Count Limits of 37 C.F.R. 1.943", filed on July 14, 2010 (the July 14, 2010 patent owner petition).

This decision also addresses two respondent's briefs filed by patent owner on July 14, 2010.

The July 14, 2010 patent owner petition, the July 14, 2010 patent owner respondent's briefs, and the record as a whole, are before the Office of Patent Legal Administration (OPLA).

SUMMARY

Patent owner's July 14, 2010 petition is **granted to the extent that** patent owner's concurrently-filed 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**. Specifically, the provisions of 37 CFR 1.943(c) are being **waived**, and the format requirements set forth in this decision for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte* waived, to the extent that** patent owner's 42-page respondent brief with accompanying appendices, filed on July 14, 2010, is deemed to be page-length compliant.

Patent owner's 14-page respondent's brief with an accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

DECISION

On December 22, 2010, the Board of Patent Appeals and Interferences (Board) mailed a decision in this merged reexamination proceeding, granting an earlier-filed petition by patent owner[1] that requested supervisory review of a previous Board decision mailed on November 10, 2010. The Board's December 22, 2010 decision 1) grants patent owner's earlier-filed petition to the extent that the Board's November 10, 2010 decision is vacated; and 2) remands patent owner's July 14, 2010 petition to the Office of Patent Legal Administration (OPLA).

In view of the Board's remand of patent owner's July 14, 2010 petition, this decision is limited to a procedural analysis of the July 14, 2010 petition, and to a procedural analysis of the compliance of two patent owner's respondent's briefs, both of which were filed on July 14, 2010, with the provisions of 37 CFR 1.943, including the requirements of 37 CFR 1.52 pursuant to 37 CFR 1.943(a), and the page limit requirements set forth in 37 CFR 1.943(c). Thus, this decision does not analyze or otherwise address the content of patent owner's July 14, 2010 respondent's briefs pursuant to 37 CFR 41.68.

The patent owner requests waiver under 37 CFR 1.183 of the 15-page limit set forth in 37 CFR 1.943(c) for its July 14, 2010 42-page respondent's brief[2] with accompanying appendices. After brief review, a total of 42 pages of this brief is determined to be subject to the page limit.[3]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party.

In support of its request for waiver of 37 CFR 1.943, the patent owner argues that the *inter partes* requester "seeks review on appeal of . . . 57 originally proposed grounds of rejection, based on 18 references, against all 125 claims, including 12 independent claims of Patent Owner's '651 patent". The 57 originally proposed grounds, now on appeal, includes 30 grounds of rejection proposed by the *inter partes* requester, which the examiner determined not to adopt in the first non-final Office action that was mailed after merger of the *ex parte* and *inter partes* reexamination proceedings. The patent owner asserts that for this reason, it "has had no occasion to make arguments with respect to these 30 [non-adopted] proposed grounds that have already been fully argued by [the *inter partes* requester] in their . . . Request and . . . [accompanying] claim chart," which are referenced in *inter partes* requester's appellant brief. Thus, the patent owner requests waiver of the provisions of 37 CFR 1.943(c) to permit the entry of its July 14, 2010 42-page respondent's brief with accompanying appendices, which is asserted by the patent owner to be in 11 point font, in lieu of its concurrently-filed 14-page respondent's brief.

---

[1] The patent owner's earlier-filed petition was filed on December 10, 2010.
[2] Excluding the table of contents.
[3] The accompanying appendices are not deemed to be subject to the page limit.

In order to obtain a waiver of the page length requirements of 37 CFR 1.943, however, any grantable petition under 37 CFR 1.183 must be accompanied by a submission that:

1) is one-and-a-half or double-spaced;
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) **has a font size no smaller than 12-point;**
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.

In view of the specific circumstances of the present merged proceeding, the provisions of 37 CFR 1.943(c) are being **waived**, and the above-identified format requirements for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte* waived, to the extent that** patent owner's July 14, 2010 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**.[4]

The patent owner also argues that "Patent Owner, concurrently with this Petition, has already filed a Respondent's Brief that complies with the page requirements of 37 CFR 1.943(c) and the form requirements of 37 CFR 1.943(a)". The patent owner appears to be referring to its 14-page respondent brief[5] with an accompanying appendix, also filed on July 14, 2010. However, the 14-page respondent's brief with an accompanying appendix filed on July 14, 2010 is not readily legible when reproduced, in this case, by scanning, contrary to 37 CFR 1.52(a)(1)(v).[6] For this reason, patent owner's 14-page respondent's brief and accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

CONCLUSION

- The July 14, 2010 patent owner petition is **granted to the extent that** patent owner's concurrently-filed 42-page respondent brief with accompanying appendices is deemed to be **page-length compliant**. Specifically, the provisions of 37 CFR 1.943(c) are being **waived**, and the format requirements set forth in this decision for waiver under 37 CFR

---

[4] The patent owner is reminded, when filing future papers in *inter partes* reexamination proceedings with the Office, of the format requirements for waiver under 37 CFR 1.183 of the provisions of 37 CFR 1.943.

[5] The brief is believed to be 14 pages long, excluding the appendix, based on the page number appearing beneath the signature block of the last page of text.

[6] 37 CFR 1.52(a)(1)(v) provides, in pertinent part (emphasis added):

> [All papers must be] [p]resented in a form having sufficient clarity and contrast between the paper and the writing thereon **to permit the direct reproduction of readily legible copies** in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

1.183 of the provisions of 37 CFR 1.943 are being ***sua sponte*** **waived, to the extent that** patent owner's 42-page respondent brief with accompanying appendices, filed on July 14, 2010, is deemed to be page-length compliant.

- Patent owner's 14-page respondent's brief and accompanying appendix filed on July 14, 2010 is **improper**, and has been **expunged from the official record** by closing this paper in the Office's Image File Wrapper (IFW) database, and by marking it "non-public".

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

6/02/11

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,048	05/30/2008	7216651	0101-P00636US10	5005

110 7590 02/23/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,693	10/05/2007	7,216,651	0101-P00636US8	4961

110 7590 02/23/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

WAKE FOREST UNIVERSITY HEALTH SCIENCES
Patent Owner

SUSAN G. L. GLOVSKY
Third Party Requester – *Ex parte* Reexamination Control 90/008,693

SMITH & NEPHEW, INC. and BLUESKY MEDICAL GROUP, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,048

Merged *Ex parte* and *Inter partes* Reexamination Control 90/008,693 and 95/001,048
Patent 7,216,651

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Under 37 C.F.R. § 1.183," filed November 22, 2011 ("Petition") to:

> suspend or waive 37 C.F.R. § 1.939 to grant Patent Owner leave to submit a response to that portion of the Appellant/Requester Smith & Nephew . . . Rebuttal Brief which discusses material entered into the IFW <u>after</u> the date of filing the appeal and <u>after</u> the due date for submission of Patent Owner's Respondent Brief.

Petition, 1 (emphasis in original).

FINDINGS

1. On May 15, 2007, the Office issued Patent 7,216,651 ("'651 patent"), which is assigned to Wake Forest University Health Sciences ("Wake Forest").

2. On October 5, 2007, Susan G. L. Glovsky filed a request for *ex parte* reexamination of the '651 patent.

3. On November 26, 2007, the Office ordered *ex parte* reexamination of the '651 patent under control number 90/008,693.

4. On May 30, 2008, Smith & Nephew, Inc. and BlueSky Medical Group, Inc. (Smith & Nephew) filed a request for *inter partes* reexamination of the '651 patent.

5. On August 4, 2008, the Office ordered *inter partes* reexamination of the '651 patent under control number 95/001,048.

6. On October 14, 2008, the Office ordered that the *ex parte* and *inter partes* reexamination proceedings be merged.

7. Prosecution continued until the Office entered a Right of Appeal Notice (RAN) on March 12, 2010, confirming claims 1-125.

8. On April 12, 2010, Smith & Nephew filed a Notice of Appeal.

9. On June 14, 2010, Smith & Nephew filed an Appellant Brief.

10. On July 14, 2010, Wake Forest filed a Respondent Brief.

11. On October 18, 2010, the U.S. District Court for the Western District of Texas entered a judgment holding claims of the '651 patent invalid under 35 U.S.C. § 103.

12. On October 19, 2010, Smith & Nephew submitted a copy of the Texas Court judgment to the Office.

13. Also on October 19, 2010, Wake Forest submitted a copy of the Texas Court judgment to the Office.

14. On September 30, 2011, the Examiner entered an Examiner's Answer.

15. On October 31, 2011, Smith & Nephew filed a Rebuttal Brief presenting, *inter alia*, arguments based on the Texas Court judgment.

RELEVANT LEGAL AUTHORITY

37 C.F.R § 1.939(a) states:

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

Concerning the contents of a rebuttal brief filed by a requester in an *inter partes* reexamination proceeding, 37 C.F.R. § 41.71 specifies that:

> (c) (1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.
>
> (2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.
>
> (3) No new ground of rejection can be proposed by a requester.
>
> (4) The rebuttal brief of a requester shall not include any new or non-admitted affidavit or other evidence. See § 1.116(d) of this title for affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63(c) for affidavits or other evidence filed after the date of filing the appeal.

With respect to suspension or waiver of the rules, 37 C.F.R. § 1.183 provides:

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

As stated in 75 Fed. Reg. 50750 (Aug. 17, 2010):

> The Chief Judge of the Board . . . or his designee . . . will have the sole responsibility for determining whether appeal briefs filed in inter partes reexamination proceedings . . . comply with the applicable regulations . . . .

DISCUSSION

Pursuant to Rule 41.71(c), if Smith & Nephew's Rebuttal Brief were to present any new rejection or evidence, the Brief should be expunged. However, it appears that the Rebuttal Brief presents no new rejection or evidence but new arguments which arise from the Texas Court judgment in support of rejections that were proposed during prosecution of the present merged reexamination proceedings.

It cannot be disputed that, due to the timing of Wake Forest's Respondent Brief, filed July 14, 2010, and the Texas Court judgment, entered October 18, 2010, Wake Forest has not had an opportunity to address on the record in the present merged reexamination proceedings its position on the rationale applied by the Texas Court in holding claims of the '651 patent invalid. The situation in which the timing in an *inter partes*

reexamination proceeding appeal allows a requester to rely upon a newly entered district court judgment adverse to the patent in reexamination without the patent owner having an opportunity to respond is rare and extraordinary. Pursuant to Rule 1.183, in such a situation, the Office has authority to waive applicable rules. Accordingly, Wake Forest will be granted leave to respond to Smith & Nephew's arguments based on the Texas Court judgment.

DECISION

In view of the foregoing, Wake Forest's Petition is GRANTED and Wake Forest is given twenty-one days in which to file a response to the arguments presented in Smith & Nephew's Rebuttal Brief concerning the Texas Court judgment.

Smith & Nephew is given twenty-one days following the filing of Wake Forest's response in which to file a reply to such response.

Both Wake Forest's response and Smith & Nephew's reply are limited to ten pages.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 11/15/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/15/2010

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Date:
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NOV 15 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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 Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001,050

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 13 July 2009 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to 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

[*Signature*] SPE AU 3992
(Title)

U.S. Patent and Trademark Office
PTO-2295 (Rev. 09-2010)

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 11/18/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2010

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Date: NOV 1 8 2010

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
LEE W. HENDERSON
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, CA 92614

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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 Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001,050

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 05 November 2010 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 . In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit

/Mark Reinhart/	SPE AU 3992
[*Signature*]	(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 04/13/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

LEE W. HENDERSON
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, CA 92614

Date: MAILED APR 13 2011 CENTRAL REEXAMINATION UN

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001050
PATENT NO. : 6850130
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 Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001050

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed 07-13-2009 is granted.

2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

   A. ☒ Since the petition does not specify otherwise, the documents have been:
      i. ☒ Destroyed.
      ii. ☐ Expunged.

   B. ☐ Other/Comment:

3. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611, SPE AU 3992. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929, SPE in AU 3992 in the Central Reexamination Unit

/Mark Reinhart/	SPE AU 3992
[*Signature*]	(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,050	06/12/2008	6850130	265-235	9517

23117 7590 02/23/2012

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Radiacion y Microondas S.A. and Rymsa Micro Communications, Inc.
Third Party Requesters

v.

Kathrein-Werke KG
Patent Owner

Inter partes Reexamination Control 95/001,050
Patent 6,850,130

DECISION ON PETITION

This is a decision on Third Party Requesters' "Petition to Dismiss the Reexamination Proceedings," filed January 31, 2012. (Petition). The Petition states that the parties "have reached an amicable settlement . . . resolving the disputes between them. . . . In view of the amicable settlement . . . Third Party Requesters hereby withdraw the appeal and petition to dismiss the reexamination proceedings pursuant to 35 U.S.C. § 317(b)." Petition, p. 1.

In related litigation involving the same parties and same patent as are involved in the present reexamination proceeding, the Court, in an Order dismissing the litigation, noted that Third Party Requesters "have not sustained their burden of proving invalidity of any claim of U.S. Patent No.

6,850,130." Order dated January 26, 2012, p. 2, *Kathrein-Werke KG v. Radiacion Y Microondas S.A.* (N.D. Ill.).

35 U.S.C. 317(b) states that:

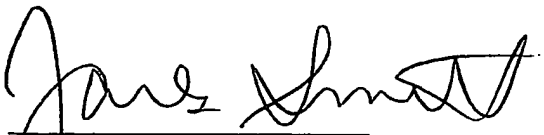
b) FINAL DECISION.- Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination 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 proceeding.

(emphasis added.)

DECISION

In view of the Illinois Court Order and 35 U.S.C. 317(b), the Petition is GRANTED to the extent that the appeal in this proceeding is hereby dismissed.

This reexamination proceeding is remanded to the Central Reexamination Unit for appropriate action.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,050
Patent 6,850,130

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,051	06/06/2008	6,478,711	3510-109	2787

6449 7590 08/04/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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AUG 04 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER *95/001,051*.

PATENT NUMBER *6,478,711*.

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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DELAND LAW OFFICE
P.O. BOX 69
KLAMATH RIVER, CA 96050-0069

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

REEXAMINATION CONTROL NUMBER *95/001,051*.

PATENT NUMBER *6,478,711*.

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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ROTHWELL, FIGG, ERNST & MANBECK, P.C. (For Patent Owner)
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

DELAND LAW OFFICE (For Requester)
P.O. BOX 69
KLAMATH RIVER, CA 96050-0069

In re Yoo	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/001,051	:	UNDER 37 CFR 1.181
Filed: June 6, 2008	:	
For: U.S. Patent No.: 6,478,711	:	

This is a decision on a petition filed by the patent owner on July 15, 2010. The petition is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the amendment filed October 19, 2009, which was filed in response to an Action Closing Prosecution (ACP).

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 15, 2010 is denied with respect to entering the post-ACP amendment into the record of the *Inter Partes* reexamination proceeding 95/001,051.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,478,711 (hereinafter, the '711 patent) issued on November 12, 2002.

2. A request for *inter partes* reexamination, assigned control No. 95/001,051, was filed by a third party requester on June 6, 2008.

3. *Inter partes* reexamination was ordered for claims 1-8 and 11-15 in the '051 reexamination proceeding on August 22, 2008. Reexamination of claims 9 and 10 was not requested. On the same day, a non-final Office action, which rejected claims 1-8 and 11-15, was mailed.

4. The patent owner filed a response to the non-final Office action on October 22, 2008. The response included proposed amendments to patent claims 7 and 8 and proposed new claims 16-25.

5. The third party filed comments on November 21, 2008 to the patent owner's response.

6. On September 18, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

7. On October 19, 2009, patent owner filed remarks in response to the ACP. The response included additional proposed amendments to patent claim 7 and amendments to proposed new claims 21-23 and 25.

8. On November 18, 2009, the third party filed comments to the patent owner's response.

9. On June 17, 2010, the Office mailed a Right of Appeal Notice (RAN), which denied entry of the post-ACP amendment to the claims. See pages 1-2 of the RAN.

10. On July 15, 2010, the patent owner filed the instant petition, requesting entry of the post-ACP amendment. The patent owner also filed a petition under 37 CFR 1.182, which will be address in a separate decision.

11. On July 19, 2010, patent owner filed an additional petition under 37 CFR 1.182 and a petition under 37 CFR 1.183. These petitions will be addressed in a separate decision. The patent owner also filed a Notice of Appeal on the same day.

12. On July 24, 2010, the third party filed a cross notice of appeal.

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed post-ACP amendment because the proposed amendment complies with 37 CFR 1.951 and 1.116 and presents the claims in better form for appeal by addressing issues raised in the ACP. See, e.g., pages 4-5 of the petition. The petitioner also states that the examiner's refusal to enter the post-ACP amendment is unfair and prejudices patent owner's rights. See pages 6-7 of the petition. .

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed post-ACP amendment, the director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

> It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.
>
> Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.
>
> In view of the fact that the patent owner <u>cannot</u> continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner <u>cannot</u> file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

Turning to the facts in this proceeding, the record shows that there was a non-final Office action to which patent owner responded with amendments that were entered into the record. Proposed

amendments to claims 7 and 8, and proposed new claims 16-25 were filed after the non-final Office action. For the unamended patent claims, the ACP appears to set forth essentially the same grounds of rejection based on prior art as set forth in the non-final Office actions. The new grounds of rejection were solely directed to amended claim 7 and proposed new claims 16-25. More importantly, the ACP does not introduce any new grounds of rejection that was not necessitated by amendments to the claims or proposed new claims.

In the petition, patent owner alleges that the examiner erred in deciding not to enter the proposed post-ACP amendment of October 19, 2009, because the proposed amendment would have clarified and focused the issues on appeal. The petition states that claim 7 was proactively amended in the October 19, 2009 response to address a potential antecedent basis issue. The petition also states that it is unfair to require that patent owner predict future rejections. Furthermore, the petition states that the examiner erred in refusing to enter the amendment because patent owner met the requirements of 37 CFR 1.116. However, upon review of the record, it is clear that the October 19, 2009 amendments do more than simply clarify issues for appeal. For example, the amendment to claim 7 adds additional limitations that were not previously claimed (e.g., the last two paragraphs in claim 7 in the October 19, 2009 response). Furthermore, it appears that the proposed amendment to claim 7 may also introduce issues under 35 U.S.C. 112, second paragraph, because of a double recitation of "stopper portion." The record shows that the October 19, 2009 amendment clearly does more than merely cancel claims, adopt examiner's suggestions, remove issues for appeal, or in some other way require only a cursory review by the examiner. Finally, the examiner did make a showing of why entry of the amendment would be an undue burden as required by 37 CFR 1.116. See page 2 of the RAN. Specifically, the examiner explained how entry of the post-ACP amendment would raise new issues because of the proposed amendments change the scope of the claimed invention. Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP amendments. Therefore, the patent owner's petition is <u>denied</u>.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP amendment and/or reopening of prosecution in the '051 reexamination proceeding is denied.

2. The proceeding will be forwarded to the appropriate deciding official in order to address the petitions filed under 37 CFR 1.182 and 1.183 in due course.

3. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Gregory A. Morse
Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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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.
95/001,051	06/06/2008	6,478,711	3885-0101	2787

6449 7590 09/17/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/17/2010

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

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P.O. BOX 69
KLAMATH RIVER, CA 96050-0069

Date:
MAILED
SEP 17 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001051
PATENT NO. : 6478711
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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SUITE 800
WASHINGTON DC 20005

(For Patent Owner)

MAILED

SEP 17 2010

CENTRAL REEXAMINATION UNIT

DELAND LAW OFFICE
P.O. BOX 69
KLAMATH RIVER CA 96050

(For Third Party Requester)

In re Yoo
Inter Partes Reexamination Proceeding
Control No. 95/001,051
Filed: June 6, 2008
For: U.S. Patent No. 6,478,711 B2

DECISION DISMISSING PETITIONS UNDER 1.182 AND 1.183

This is a decision on the July 19, 2010 patent owner petitions entitled "PETITION UNDER 37 C. F. R. § 1.182 REQUESTING FOR CONTINUED REEXAMINATION," "PETITION TO EXPEDITE UNDER 37 C. F. R. § 1.182," and "PETITION UNDER 37 C. F. R. § 1.183 – SUSPENSION OF RULES."

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

The petition fees under 37 C.F.R. § 1.17(f) of $400 have been submitted with each petition.

The petitions are **dismissed**.

BACKGROUND

- On June 6, 2008, a request for *inter partes* reexamination of U.S. Patent Number 6,478,711 B2 ("the '711 patent") was deposited by the third party requester, meeting the filing date requirements of 37 C.F.R. § 1.915, and the resulting reexamination proceeding was assigned control number 95/001,058 ("the '1058 proceeding").

- On August 22, 2008, reexamination was ordered for claims 1-8 and 11-15, of the '1058 patent.

- The proceeding progressed to the point where, on September 18, 2009, the Office issued an Action Closing Prosecution (ACP) rejecting all of the claims under reexamination, claims 1-8 and 11-25.

- On October 19, 2009, patent owner filed a response to the ACP and proposed claim amendments to original patent claims 7 and 8, and to proposed new claims 21-23 and 25. These amendments were for the purpose of presenting these rejected claims "in better form for consideration on appeal," but were "not intended to alter the scope of the respective claims." Remarks at 1. Third party requester filed comments on November 18, 2009.

- On June 17, 2010, the Office issued a Right of Appeal Notice (RAN), rejecting pending claims 1-8 and 11-25, and refusing entry of the patent owner proposed amendment of October 19, 2009, because the "proposed amendments substantially alter the scope of the claims" and "do no[t] simplify issues for appeal."

- On July 15, 2010, patent owner filed the instant petition requesting reopening of prosecution under § 1.182, and a petition under § 1.181 requesting entry of amendments after ACP.

- Also on July 19, 2010, patent owner filed the instant petition under § 1.183 requesting waiver of the rules to permit an extension of time to file an Appellant's Brief, and the instant petition under § 1.182 requesting expedited handling of the petition under § 1.183.

- Also on July 19, 2010, patent owner filed a notice of appeal.

- On July 24, 2010, third party requester filed a notice of cross-appeal.

- On August 4, 2010, the Office issued a decision dismissing the July 15, 2010, patent owner petition under § 1.181 requesting entry of amendments after ACP.

APPLICABLE REGULATIONS

35 U.S.C. § 314 provides, in pertinent part:

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

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

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 41.61(b) provides:

Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 C.F.R. § 41.66(a) provides:

An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

I. PETITION UNDER 37 C.F.R. § 1.182

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for

Reexamination While an Earlier Filed Reexamination is Pending."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Furthermore, 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." Therefore, any Office decision granting continuation of prosecution in a reexamination proceeding must further the handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution after the ACP to enter the October 19, 2009 claim amendments denied entry by the Office on June 17, 2010. Patent owner seeks relief under the provisions of March 2005 Notice discussed above. Patent owner's request for relief under 35 U.S.C. § 314 is grounded in the position that entry of the amendment would act to traverse rejections and thereby reduce issues for appeal.

In the present instance, patent owner's reasons as to why reopening the prosecution to enter the October 19, 2009 claim amendments would act to advance rather than retard the proceeding are not persuasive. In looking to the prosecution history of this proceeding, it is seen that the October 19, 2009 amendment does address §§ 112 and 314(a) rejections of claim 7 (grounds of rejection 10 and 11), as well as art rejections, through amendment of claim 7. However, entry of

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

the amendment would not affect the numerous grounds of rejections of original claims 1-6 and 11-15, which remain unamended, or new claims 16-20 and 24. The amendment, while addressing tangential rejections of dependent claims, would fail to address the great majority of the issues remaining for appeal.

Although a submission that merely reduces issues for appeal may, if timely filed, reduce issues such that reopening of prosecution by the Office might be in accord with special dispatch, the reduction of issues achievable by entry of the October 19, 2009 proposed claim amendments is minimal when viewed in the context of the amount and nature of issues remaining to be decided by the Board of Appeals. Therefore, entry of the desired proposed claim amendments does not justify the attendant reopening and delay of prosecution of the proceeding that would occur should the Office act, in granting this petition, to revert the proceeding to a pre-ACP stage. As the Office cannot act in violation of §314(c), requiring the Office to handle *inter partes* proceedings with special dispatch, this petition must be dismissed.

In view of the above and the facts and circumstances presented by the present record, entry of the amendment would not be in accordance with 35 U.S.C. § 314, and therefore the petition under 37 C.F.R. § 1.182 is dismissed.

II. PETITION UNDER 37 C.F.R. § 1.183

Patent owner petitions for rule waiver under § 1.183 to permit an extension of time to file the appeal brief "until after a decision on the petitions filed concurrently under 37 C.F.R. §§ 1.181 and 1.182. Under 37 C.F.R. § 41.66(a), patent owner may file an appeal brief no later than two months from the filing (by the last party entitled to do so) a notice of appeal or cross appeal as set forth in 37 C.F.R. § 41.61. § 41.61 provides a 14 day time period in which to file a notice of cross appeal after the patent owner has filed a notice of appeal. In the instant proceeding, patent owner filed a notice of appeal on July 19, 2010. Third party requester filed a notice of cross-appeal on July 24, 2010. Pursuant to § 41.66, patent owner may file an appeal brief no later than September 24, 2010.

A decision on the petition under 37 C.F.R. § 1.181 was issued by the Office on August 4, 2010. A decision on the petition under 37 C.F.R. § 1.182 appears above. Therefore, both petitions have been decided adequately prior to the date the appeal brief is due under 37 C.F.R. § 41.66(a) (quoted above). Therefore, patent owner's desired condition has been realized without the need for a waiver under § 1.183. Accordingly, the instant petition under § 1.183 is dismissed.

III. PETITION UNDER 37 C.F.R. § 1.182 TO EXPEDITE

Patent owner petitions under § 1.182 to expedite handling of the instant petition under § 1.183, discussed above. This petition is dismissed for three reasons. First, the Office is charged with handling *inter partes* proceedings with special dispatch under § 314(c). Thus, all papers in reexamination proceedings are handled expeditiously. Second, petitioner failed to provide any reasoning or support a justification such that the accompanying petition under § 1.183 be

handled expeditiously, as compared to petitions, and other papers, submitted by other parties. Third, the issue is moot as the petition under § 1.183 is addressed in the current decision. Accordingly, the instant petition under § 1.182 is dismissed.

CONCLUSION

1. The petitions are **dismissed**.

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

3. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.

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

September 17, 2010
Kenpet8/RCR/IP
Kenreex/EOT

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Wood, Herron & Evans, L.L.P. (Solta)
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(For Patent Owner)

MAILED
OCT 28 2010
CENTRAL REEXAMINATION UNIT

Hugh A. Abrams
Sidley Austin L.L.P.
One South Dearborn
Chicago, Illinois 60603

(For Third Party Requester)

In re Knowlton	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/001,052	: **TERMINATING**
Filed: June 11, 2008	: **REEXAMINATION**
For: U.S. Patent No. 7,189,230	:

The above-captioned *inter partes* reexamination proceeding is before the Office of Patent Legal Administration for consideration of whether the proceeding should be terminated pursuant to 35 U.S.C. § 317(b) and 37 CFR 1.907(b).

On July 30, 2010, the Office issued an order to show cause whether the Office should continue the '1052 *inter partes* reexamination, in whole or in part. On August 30, 2010, patent owner filed papers in response to the order to show cause. Third party requester did not file a response.

For the reasons set forth below, the present *inter partes* reexamination proceeding is **terminated**.

DECISION

II. Relevant Statute

35 U.S.C. § 317(b) provides (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 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...."

III. Analysis

The order to show cause explained that, for the estoppel provisions of 35 U.S.C. § 317(b) to require termination of the proceeding,

> "[t]he showing should identify, with supporting documentation from the record of the litigation, which claims from the '230 patent were subject to adjudication in the litigation. The showing must establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit." This showing should also include an identification of issues regarding prior art raised in the reexamination proceeding that were not raised in the civil proceeding. To that end, it should include a discussion of when the third party requester became aware of any prior art raised in the '1052 proceeding but not raised in the civil action and the status of the civil litigation 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. "

It is found that the showing made by patent owner (in the response of August 30, 2010) establishes (a) that there is a final decision that the third party requester (Alma Lasers) "has not sustained its burden of proving the invalidity of any of the patent claims in suit," (b) that the patent claims presented for reexamination and those in the suit were identical, and (c) that the reexamination of the patent claims is based upon "issues which that party or its privies raised or could have raised in such civil action." This showing establishes that the estoppel provisions of 35 U.S.C. 317(b) preclude the maintenance of the present '1052 proceeding.

Therefore, this decision hereby terminates the '1052 *inter partes* reexamination proceeding.

For conclusion of the 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 terminated proceeding will be assigned an 820 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.

IV. Additional Discussion

Termination of this proceeding due to the estoppel provisions of 35 U.S.C. § 317(b) is not a resolution on the merits of any substantial new question of patentability that gave rise to the '1052 proceeding, nor is it a determination of the patentability of the claims over the rejections of record (whether adopted or non-adopted) in the proceeding.

Accordingly, an *ex parte* reexamination request, by any party, based upon any substantial new question of patentability (SNQ) raised in this proceeding would not be precluded, i.e., such a SNQ could form the basis for instituting a further *ex parte* reexamination. Likewise, any SNQ raised in this proceeding would not be precluded in an *inter partes* reexamination request filed

by a party not subject to the estoppel provisions of 35 U.S.C. § 317(b) and could provide the basis for instituting a further *inter partes* reexamination.

CONCLUSION

1. The prosecution of the '1052 *inter partes* reexamination proceeding is hereby terminated, and the '1052 proceeding will be concluded.

2. The terminated proceeding will be assigned an 820 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.

3. Telephone inquires related to this Order should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

10-27-10
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,060	06/30/2008	6996561	096005-0104	2125

48329 7590 09/01/2011
FOLEY & LARDNER LLP
111 HUNTINGTON AVENUE
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BOSTON, MA 02199-7610

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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
NIXON PEABODY, LLP
401 9TH STREET N.W.
SUITE 900
WASHINGTON, D.C. 20004-2128

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001060
PATENT NO. : 6996561
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

Baker & McKenzie, LLP
Patent Department
2001 Ross Avenue
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Dallas, TX 75201

(For Third Party Requester)

In re de Hilster et al	:	
Inter partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No: 95/001,060	:	**PETITION TO**
Filing Date: June 30, 2008	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 6,996,561	:	**REEXAMINATION PROCEEDING**

This is a decision on patent owner's July 29, 2011 petition entitled "Petition for Termination of Reexamination Proceedings Pursuant to 37 CFR §§ 1.182" (patent owner's July 29, 2011 petition).

The July 29, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's July 29, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,060 (the '1060 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 6,996,561 (the '561 patent), was the subject of a consolidated civil action in district court, i.e., *Kenexa Brassring, Inc. v. Taleo Corporation, Kenexa Brassring Inc., v. Vurv Technology, Inc.*, Civil Action Nos. 07-521-SLR (CONSOLIDATED), 08-276 (SLR) (D. Del.). The patent owner submits a copy of a consent judgment and dismissal, entered by the district court on July 21, 2011, in which the district court stated that the "[d]efendants [which include the third party requester and real party in interest, Taleo Corporation] have not sustained their burden of proving the invalidity of any of the asserted claims (1-36) of the '561 patent" (brackets added, parentheses in original). The court also stated, in the July 21, 2011 consent judgment and dismissal, that "[a]ny remaining claims or counterclaims of the parties are dismissed with prejudice", and that "[t]he parties waive their right to an appeal or otherwise contest this Consent Judgment and Dismissal". Thus, elements 1-3 have been shown to be satisfied.[1]

In addition, the patent owner has submitted a copy of a document submitted by the requester in the consolidated civil action, dated July 23, 2010, and entitled "Expert Report of Martin E. Kaliski, Ph.D." (requester's July 23, 2010 expert report), which expressly sets forth, on pages 9-10, the prosecution history of the present '1060 proceeding up to the filing of the corrected appeal briefs (of both the patent owner and the requester) on May 24, 2010. In addition, the patent owner has submitted a copy of another document entitled "Amended Proposed Joint Pre-Trial Order", filed in the district court by the parties to the consolidated civil action on June 9, 2011, which indicates, on page 7, that trial did not begin until at least June 27, 2011. The copy of requester's July 23, 2010 expert report, in combination with the copy of the parties' June 9, 2011 "Amended Proposed Joint Pre-Trial Order", 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 '1060 proceeding, were either raised or could have been raised by the defendant/requester in the consolidated civil action. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's July 29, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,060 (the '1060 proceeding) is hereby **terminated**.

---

[1] The patent owner has also submitted evidence that the other defendant in the litigation, Vurv Technology, Inc., is a subsidiary of requester/defendant Taleo Corporation, and thus is in privy with the requester. See the press release entitled "Taleo to Acquire Vurv", which is attached to the present petition.

The '1060 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and 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 July 29, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **granted**.
- The prosecution of the '1060 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1060 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for further processing to conclude the '1060 proceeding, as set forth above.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

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

8-30-2011
Kenpet8

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(For Third Party Requester)

In re Stern et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,062
Filed: July 9, 2008
For: U.S. Patent No. 7,229,436

: **DECISION**
: **TERMINATING**
: **REEXAMINATION**

The above-captioned *inter partes* reexamination proceeding is before the Office of Patent Legal Administration for consideration of whether the proceeding should be terminated pursuant to 35 U.S.C. § 317(b) and 37 CFR 1.907(b).

On July 30, 2010, the Office issued an order to show cause whether the Office should continue the '1062 *inter partes* reexamination, in whole or in part. On August 30, 2010, patent owner filed papers in response to the order to show cause. Third party requester did not file a response.

For the reasons set forth below, the present *inter partes* reexamination proceeding is **terminated**.

DECISION

II. Relevant Statute

35 U.S.C. § 317(b) provides (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 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...."

III. Analysis

The order to show cause explained that, for the estoppel provisions of 35 U.S.C. § 317(b) to require termination of the proceeding,

> "[t]he showing should identify, with supporting documentation from the record of the litigation, which claims from the '436 patent were subject to adjudication in the litigation. The showing must establish whether the third party requester had the burden of proving invalidity of the various claims and that it "has not sustained its burden of proving the invalidity of any patent claim in suit." This showing should also include an identification of issues regarding prior art raised in the reexamination proceeding that were not raised in the civil proceeding. To that end, it should include a discussion of when the third party requester became aware of any prior art raised in the '1062 proceeding but not raised in the civil action and the status of the civil litigation 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. "

It is found that the showing made by patent owner (in the response of August 30, 2010) establishes (a) that there is a final decision that the third party requester (Alma Lasers) "has not sustained its burden of proving the invalidity of any of the patent claims in suit," (b) that the patent claims presented for reexamination and those in the suit were identical, and (c) that the reexamination of the patent claims is based upon "issues which that party or its privies raised or could have raised in such civil action." This showing establishes that the estoppel provisions of 35 U.S.C. 317(b) preclude the maintenance of the present '1062 proceeding.

Therefore, this decision hereby terminates the '1062 *inter partes* reexamination proceeding.

For conclusion of the 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 terminated proceeding will be assigned an 820 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.

IV. Additional Discussion

Termination of this proceeding due to the estoppel provisions of 35 U.S.C. § 317(b) is not a resolution on the merits of any substantial new question of patentability that gave rise to the '1062 proceeding, nor is it a determination of the patentability of the claims over the rejections of record (whether adopted or non-adopted) in the proceeding.

Accordingly, an *ex parte* reexamination request, by any party, based upon any substantial new question of patentability (SNQ) raised in this proceeding would not be precluded, i.e., such a SNQ could form the basis for instituting a further *ex parte* reexamination. Likewise, any SNQ raised in this proceeding would not be precluded in an *inter partes* reexamination request filed

by a party not subject to the estoppel provisions of 35 U.S.C. § 317(b) and could provide the basis for instituting a further *inter partes* reexamination.

CONCLUSION

1. The prosecution of the '1062 *inter partes* reexamination proceeding is hereby terminated, and the '1062 proceeding will be concluded.

2. The terminated proceeding will be assigned an 820 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.

3. Telephone inquires related to this Order should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.

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

10-27-10
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,063	07/28/2008	7318892	SMALT-5604D X1N6	1912

29200 7590 04/14/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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

Date MAILED
APR 14 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001063
PATENT NO. : 7318892
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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APR 14 2011

CENTRAL REEXAMINATION UNIT

Fish & Richardson, PC
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Requester)

In re Mark E. Connell et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,063
Filed: July 28, 2008
For: U.S. Patent No. 7,318,892

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

This is a decision on the March 31, 2011 patent owner petition titled "Petition For Revival Of An Unintentionally Abandoned Inter Partes Reexamination Under 37 C.F.R. § 1.958(b) And 37 C.F.R. 1.137(b)" to accept an unintentionally delayed notice of appeal and revive the present terminated[1] reexamination proceeding ("the March 31, 2011 patent owner petition to revive").

The March 31, 2011 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The March 31, 2011 patent owner petition to revive is **granted**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

[1] Although a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.957(b) for failure of either party to timely appeal under 37 CFR 1.953(c) after the February 9, 2011 Right of Appeal Notice (RAN).

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.953(c) provides:

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

37 CFR 1.957(b) provides:

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

37 CFR 1.958(b) provides:

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

MPEP 2668 provides, in pertinent part:

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

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the prosecution of the instant *inter partes* reexamination proceeding was terminated within the meaning of 37 CFR 1.957(b) due to the failure of either party to timely appeal under 37 CFR 1.953(c) after the February 9, 2011 Right of

Appeal Notice (RAN). In accordance with 37 CFR 1.953(c), the February 9, 2011 RAN set a one-month time period for either party to appeal. However, patent owner did not file a Notice of Appeal until March 31, 2011, which was untimely. Nevertheless, for the purpose of evaluating whether the March 31, 2011 patent owner petition to revive is a grantable petition, patent owner's submission of the March 31, 2011 Notice of Appeal satisfies item (1).[2]

A petition fee of $1,620.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the March 31, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the March 31, 2011 patent owner petition to revive is **granted**.

CONCLUSION

1. The March 31, 2011 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. Patent owner's March 31, 2011 Notice of Appeal is hereby entered in the record, thus triggering a cross appeal right for third party requester under 37 CFR 41.61(b)(2). Accordingly, third party requester may file a notice of cross appeal within **fourteen days** of the mailing date of this decision with respect to any final decision favorable to patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

3. An appellant's brief must be filed no later than two months from the mailing date of this decision or from the latest filing date of the last-filed notice of 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 may not be extended.

[2] Patent owner was charged the $540.00 37 CFR 41.20(b)(1) fee for filing a notice of appeal from the examiner to the Board.

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

Raul Tamayo
Legal Advisor
Office of Patent Legal Administration

04-14-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,063	07/28/2008	7318892	SMALT-5604D X1N6	1912

24395 7590 08/31/2011
WILMERHALE/DC
1875 PENNSYLVANIA AVE., NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

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Date: MAILED
AUG 3 1 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001063
PATENT NO. : 7318892
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)

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

John C. Phillips
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

(For Third Party Requester)

In re Connell *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,063
Filed: July 28, 2008
For: U.S. Patent No. 7,318,892

: **DECISION**
: **DISMISSING**
: **PETITION**
: **UNDER 37 CFR 1.182**

This is a decision regarding (1) Patent owner's June 7, 2011 petition entitled, "PETITION UNDER [37-*sic*] C.F.R. § 1.183 FOR SUSPENSION OF [37-*sic*] C.F.R. § 41.61(a) AND § 41.61(e) TO SUPPLEMENT NOTICE OF APPEAL IN INTER PARTES REEXAMINATION," requesting entry of inadvertently omitted new claims 8-10 from the Notice of Appeal; (2) Third party requester's June 9, 2011 opposition entitled "REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183," opposing entry of new claims 8-10 in light of the expiry of the '892 patent; and (3) Patent owner's June 14, 2011 paper entitled, "WITHDRAWAL OF PETITION UNDER 37 C.F.R. §1.183," withdrawing of the June 7, 2011 petition.

The petition, opposition and withdrawal papers are before the Office of Patent Legal Administration.

The patent owner petition is **dismissed as withdrawn.**

BACKGROUND

1. On January 15, 2008, the Office issued U.S. patent No. 7,318,892 ("the '892 patent") to Connell *et al.*

2. On July 9, 2008, third party requester deposited an incomplete request for *inter partes* reexamination of the '892 patent assigned reexamination proceeding Control Number 95/001,063 (the '1063 proceeding).

3. On July 28, 2008, the third party requester supplemented the July 9, 2008 deposit of papers completing the request for reexamination in accordance with 37 CFR 1.915.

4. On October 15, 2008 the Office issued an order granting *inter partes* reexamination of the '1063 patent.

5. On November 26, 2008, the Office issued a first Office action on the merits in the '1063 proceeding, giving patent owner sixty days to respond.

6. Prosecution in the '1063 proceeding advanced and on February 9, 2011, the Office issued a Right of Appeal Notice (RAN).

7. On March 31, 2011, patent owner filed a Notice of Appeal concurrently with a petition to revive the '1036 proceeding due to an unintentional delay to file the Notice of Appeal.

8. On April 14, 2011, the Office granted patent owner's March 31, 2011 petition to revive and entered the Notice of Appeal.

9. On June 7, 2011, patent owner filed a petition entitled, "PETITION UNDER [37-*sic*] C.F.R. § 1.183 FOR SUSPENSION OF [37-*sic*] C.F.R. § 41.61(a) AND § 41.61(e) TO SUPPLEMENT NOTICE OF APPEAL IN INTER PARTES REEXAMINATION," requesting entry of inadvertently omitted new claims 8-10 from the Notice of Appeal.

10. On June 9, 2011, third party requester filed an opposition entitled "REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.183," opposing entry of new claims 8-10 in light of the expiry of the '892 patent.

11. On June 14, 2011, patent owner filed a paper entitled, "WITHDRAWAL OF PETITION UNDER 37 C.F.R. §1.183," requesting withdrawal of the June 7, 2011 petition.

12. This decision addresses patent owner's June 7, 2011 petition, and June 14, 2011 withdrawal and third party requester's June 9, 2011 opposition.

DECISION

The Office acknowledges patent owner's June 14, 2011 withdrawal of the June 7, 2011 patent owner petition. Accordingly, the June 7, 2011 petition is **dismissed** as withdrawn. As the petition has been withdrawn, the requester opposition is moot.

CONCLUSION

1. The June 7, 2011 petition is **dismissed** as withdrawn.

2. Telephone inquiries regarding 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

8-30-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,070	07/21/2008	6519629	0065431-1008	3890

21839 7590 07/28/2011
BUCHANAN, INGERSOLL & ROONEY PC
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ALEXANDRIA, VA 22313-1404

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/28/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
FACEBOOK, INC.
v.
CROSS ATLANTIC CAPITAL PARTNERS, INC.

Reexamination Control No. 95/001,070
Patent 6,519,629 B2
Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition for Extension of Time Pursuant to 37 C.F.R. 41.77(g)," filed July 26, 2011 (present petition). In the present petition, patent owner requests that the Office extend the time period for filing an amendment 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 July 27, 2011.

FINDINGS

1. On June 28, 2011, 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, pp. 8-16.

2. The Decision on Appeal, citing 37 C.F.R. 41.77(b), notes that appellant 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 has been diligent in assessing options, analyzing the prior art applied in the new grounds of rejection, and drafting amended claims to overcome the Board's rejection. Petitioner indicates that the subject patent is currently involved in litigation, and coordination between the litigation attorneys and the reexamination attorneys is necessary. Petitioner asserts that additional time is required to prepare the final set of amended claims and arguments, and to obtain approval by all parties involved. Petition, p. 1.

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 coordination among attorneys is appreciated, petitioner has not explained the circumstances that have prevented such coordination from taking place. Note that *inter partes* reexaminations are required to proceed with special dispatch pursuant to 35 U.S.C. § 314(c):

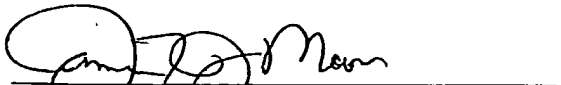
> Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

Petitioner has not established that sufficient cause exists for extending the due date for appellant to request reopening of prosecution in response to the new grounds of rejection.

Accordingly, the present petition is **denied**.

DECISION

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



James T. Moore
Vice Chief Administrative Patent Judge

Counsel for Patent Owner:
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Alexandria, VA 22314-1404

Counsel for Third Party Requester:
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BLAKELY SOKOLOFF TAYLOR & ZAFFMAN, LLP
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95/001,070	07/21/2008	6519629	0065431-1008	3890

21839 7590 09/20/2011

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BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes Facebook, Inc.
v.
Cross Atlantic Capital Partners, Inc.

Appeal 2011-005122
Reexamination Control No. 95/001,070
Patent 6,519,629 B2
Technology Center 3900

DECISION ON REQUEST TO WITHDRAW PETITIONS

This is a decision on third party requester's "Request to Withdraw Petitions under 37 C.F.R. § 1.181," filed September 1, 2011. Requester requests withdrawal of its petitions filed on August 9, 2011, seeking that patent owner's response be stricken as an inappropriate submission; and in the alternative seeking waiver of the page limit to permit responsive comments exceeding the 50 page limit. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f), has been charged to requester's deposit

account on September 1, 2011, per the authorization on page 2 of the present request.

The requester's request to withdraw the petitions filed on August 9, 2011, is **granted.** The patent owner's opposition of August 12, 2011, to the requester's petitions is **dismissed as moot.**

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

Counsel for Patent Owner:
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Post Office Box 1404
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Counsel for Third Party Requester:
Daniel M. Devos
BLAKELY SOKOLOFF TAYLOR & ZAFFMAN LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,070	07/21/2008	6519629	0065431-1008	3890

21839 7590 10/25/2011

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ART UNIT	PAPER NUMBER

DATE MAILED: 10/25/2011

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1279 OAKMEAD PARKWAY
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Date: **MAILED**

OCT 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001070
PATENT NO. : 6519629
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.

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 25 2011

CENTRAL REEXAMINATION UNIT

James A. LaBarre BUCHANAN, INGERSOLL & ROONEY PC P.O. BOX 1404 ALEXANDRIA, VA 22313-1404	:	(For Patent Owner)
Daniel M. De Vos BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040	:	(For 3rd Party Requester)
In re: Harvey *et alia* *Inter Partes* Reexamination Proceeding Control No. 95/001,070 Deposited on: 21 July 2008 For: US Patent No. 6,519,629	:	DECISION GRANTING PETITION FOR ENTRY OF AMENDMENTS PREVIOUSLY DENIED ENTRY - 37 CFR 1.181

This is a decision on the petition, filed 5 September 2011, to have amendments that were previously denied entry entered pursuant to 37 CFR 1.181.

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

REVIEW OF RELEVANT FACTS

- The Board of Patent Appeals and Interferences ("Board"), in a decision rendered on 28 June 2011 ("Decision"), reversed the Examiner's confirmation of patentability of claims 1-32 and entered six new grounds of rejection for these claims under 37 CFR 41.77(b).
- In a response filed on 28 July 2011 ("Response"), Patent Owner requested to reopen prosecution pursuant to 37 CFR 41.77(b)(1), where the Response included, *inter alia,* amendments to each of claims 1, 9, 17, and 25, namely the independent claims in claims 1-32, and also added proposed new claims 74-146.
- The Third Party Requester filed a petition ("Petition to Strike") on 9 August 2011 requesting that the Response be stricken for failure to comply with 37 CFR 41.77(b)(1).
- The Patent Owner filed an opposition to the Petition to Strike on 12 August 2011.

- The Third Party Requester filed comments on 29 August 2011 to the Patent Owner's Response of 28 July 2011.
- The Third Party Requester then filed a petition to withdraw the Petition to Strike on 1 September 2011, which was granted on 20 September 2011.
- The Examiner mailed a Notice of Defective Submission ("Notice") on 27 September 2011 indicating the Response was defective (1) because claims 76-146 were not rejected by the Decision's new grounds of rejection, such that these claims did not meet the "so rejection" provision of 37 CFR 41.77(b)(1) and (2) because the support provided by Patent Owner for the claim changes did not comply with 37 CFR 1.530(e).
- The Patent Owner filed a petition 5 October 2011 under 37 CFR 1.181 to have the amendments in the Response entered.
- The Third Party Requester filed a miscellaneous letter on 18 October 2011 indicating that the Third Party Requester did not object to the Response being entered and considered by the Examiner as long as such entry would not unduly burden the Examiner or the Patent Office.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(a) states:

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

37 C.F.R. § 1.127 states:

> From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Director under § 1.181.

37 C.F.R. § 1.181 states, in pertinent part:

> (a) Petition may be taken to the Director:
> (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court . . . .
> (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director

37 C.F.R. § 1.530(e) states:

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

37 CFR § 41.77(b)(1) states:

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

MPEP § 2682(II)(B) states, in pertinent part:

> Under 37 CFR 41.77(b)(1), the patent owner may amend the claims involved, or substitute new claims to avoid the art or reasons stated by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). . . The new ground of rejection raised by the Board does not "reopen the prosecution" (under 37 CFR 41.77(b)(1) and 37 CFR 41.77(c) through 37 CFR 41.77(f) except as to that subject matter to which the new rejection was applied. Accordingly, any amendment . . . not directed to that subject matter to which the new rejection was applied will be refused entry and will not be considered.

DECISION

Analysis for Issue under 37 CFR 41.77

When the Board enters a new ground of rejection under 37 CFR 41.77(b), the Patent Owner may file a response requesting reopening of prosecution before the Examiner. 37 CFR 41.77(b)(1). When filing such a response, the Patent Owner may amend the claims, or substitute new claims, MPEP § 2682(II)(B) (citing to *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904)), but any amended or new claim must be directed to the same subject matter as the claims subject to the new ground of rejection, *id.* (citing to *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904)). "The new grounds of rejection raised by the Board does not 'reopen the prosecution' . . . except as to that **subject matter** to which the new rejection was applied." *Id* (emphasis added). Thus, an examiner will refuse to enter or consider any amendment not directed to the subject matter to which the new rejection was applied. *Id.*

In the 5 October 2011 petition, Patent Owner has shown that new claims 76-146 are drawn to the subject matter of newly rejected claims 1-32. See pages 5-7 of the 5 October 2011 petition. Based upon these facts, Patent Owner has shown that the new claims are directed to the same

subject matter as that covered by the rejected claims when reopening prosecution under 37 CFR 41.77(b)(1). Accordingly, Patent Owner's request to enter proposed new claims 76-146 is granted.

Analysis for Issue under 37 CFR 1.530

Under 37 CFR 1.530(e), Patent Owner must supply "... on pages separate from the pages containing the changes . . . an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper." Turning to the review of the record, Patent Owner provided an explanation of support in the Response, see Response at 26, and the Examiner deemed such explanation to be insufficient, see Notice at 3. In response to the Notice, Patent Owner has included an additional explanation of support for the proposed new claims in the 5 October 2011 petition that supplements and clarifies the support shown in the Response. See the Appendix attached to the 5 October 2011 petition. This additional explanation is deemed sufficient to meet the requirements of 37 CFR 1.530(e). Therefore, the requirement regarding 37 CFR 1.530(e), as set forth in the Notice, is met by the additional explanation provided Appendix attached to the 5 October 2011 petition. In due course, the Examiner will consider the additional explanation when evaluating the proposed new claims filed in the Response.

Accordingly, good and sufficient reasons to enter the amendments presented in the Response in the reexamination proceeding have been provided, and the Patent Owner's 5 October 2011 petition, as it relates to entry of the amendments, is granted.

CONCLUSION

1. In view of the foregoing, the request pursuant to 37 CFR 1.181 to enter the amendments filed in the Response is **granted**.

2. The Response filed 28 July 2011, including the newly added claims 76-146, and the Appendix of the Petition, filed 5 October 2011, setting forth a mapping of the claims with support in the disclosure will be considered by the Examiner in due course.

3. The proceeding is being returned to the Examiner for issuance of the appropriate action.

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

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

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

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

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

5. Telephone inquiries related to this decision should be directed to Daniel Ryman, at (571) 272-3152 or Mark Reinhart, at (571) 272-1611, who are Supervisory Patent Examiners in Art Unit 3992. In their absence, telephone inquiries should be directed to the undersigned at (571) 272-0700.

Irem Yücel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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CHEN, JENNY
EASTWIND CONSULTANTS COMPANY LIMITED
7F, NO.1, ALLEY30, LANE 358, RUEIGUANG ROAD
NEIHU DISTRICT
TAIPEI, 114
TAIWAN

(For Patent Owner)

MAILED

OCT 05 2010

CENTRAL REEXAMINATION UNIT

JASON Y. PAHNG AND ASSOCIATES, LLC
12178 BRIDGEND RUN
FAIRFAX, VA 22030

(For Requester)

In re Kuo	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/001,072	:	UNDER 37 CFR 1.181
Filed: July 29, 2008	:	
For: U.S. Patent No.: 6,289,975	:	

This is a decision on a petition filed by the patent owner on July 21, 2010. The petition is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and enter the amendment filed December 9, 2009, which was filed in response to an Action Closing Prosecution (ACP).

The petition is before the Director having oversight over the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 21, 2010 is denied with respect to entering the post-ACP amendment into the record of the *Inter Partes* reexamination proceeding 95/001,072.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,289,975 (hereinafter, the '975 patent) issued on September 18, 2001.

2. A request for *inter partes* reexamination, assigned control No. 95/001,072, was filed by a third party requester on July 29, 2008.

3. *Inter partes* reexamination was ordered for the '072 reexamination proceeding on October 15, 2008. An non-final Office action accompanied the order for reexamination.

4. The patent owner filed a response to the non-final Office action on December 15, 2008.

5. The third party filed comments on January 14, 2009 in response to the patent owner's response.

6. On November 9, 2009, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments.

7. On December 14, 2009, patent owner filed an amendment and remarks in response to the ACP.

8. On January 20, 2010, third party requester filed remarks in response to the patent owner's response.

9. On February 1, 2010, patent owner filed a supplemental amendment and remarks in response to the ACP.

10. On June 30, 2010, the Office mailed a Right of Appeal Notice (RAN), which denied entry of the post-ACP amendment to the claims. See page 1 of the RAN.

11. On July 21, 2010, the patent owner filed the instant petition, requesting entry of the post-ACP amendment. The patent owner also filed a Notice of Appeal on the same day.

DECISION ON PETITION UNDER 37 CFR 1.181

The patent owner (petitioner) states that the examiner erred in deciding not to enter the proposed post-ACP amendment because the proposed amendment "... is made to clearly define the characteristics of the fin plate portion in accordance with the subject patent. . .to distinctively characterize the feature of the fin plate portion, that is, the position of the bottom end of the fin plate portion in relation to the stack portion" See pages 6-7 of the petition. The petitioner also states that the amendment presents the rejected claims in better form for consideration to distinguish over the prior art references and in better form for consideration on appeal. See page 8 of the petition. The petition also states that the amendment could not be earlier presented because it is now ". . .necessary to show the Examiner that the fin plate portion in accordance with the present invention should have certain distinct features, which Robbins and Bohm, either alone or combined, lack." See page 9 of the petition.

In response to patent owner's arguments that the examiner erred in deciding not to enter the proposed post-ACP amendment, the Director finds there are not good and sufficient reasons to enter the proposed amendment. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice and/or an action closing prosecution. Furthermore, MPEP 2673 states that:

> It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.
>
> Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.
>
> In view of the fact that the patent owner <u>cannot</u> continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d) nor by filing a Request for Continued Examination under 37 CFR 1.114 and the patent owner <u>cannot</u> file an *inter partes* reexamination request (see MPEP § 2612), the examiner should consider the feasibility of entering a proposed amendment paper, where the entirety of the amendment would result *only* in an additional claim (or claims) being indicated as patentable. The examiner is

> encouraged to enter such an amendment unless the entry would cause an "undue burden" on the examiner. Where the examiner does not enter the amendment, the examiner should explain the "undue burden."

Turning to the facts in this proceeding, the record shows that the ACP sets forth exactly the same grounds of rejection based on prior art as set forth in the non-final Office action, and more importantly, does not introduce any new grounds of rejection not necessitated by amendments to the claims or proposed new claims. Regarding the rejections, the ACP maintains the 35 U.S.C. 103(a) rejection of claims 1 and 2 as being unpatentable over Robbins in view of Bohm that was set forth in the non-final Office action. See paragraphs 6 and 6a-6f of the non-final Office action and paragraphs 6 and 6a-6f of the ACP. The examiner added a section to the ACP addressing patent owner's arguments regarding this rejection. See paragraphs 6g-6o of the ACP.

Regarding patent owner's allegations that the examiner erred in deciding not to enter the proposed post-ACP amendment, which amendment was necessary to clearly define the characteristics of the fin plate portion either to distinguish the claim over the prior art references or to further define the issues for appeal,
the petition fails to make any showing to support the statements that the post-ACP amendment does simplify and clarify issues for appeal and could not have been earlier presented. In adding the section in the ACP responding to patent owner's arguments, the examiner followed Office policy and fully addressed patent owner's arguments. She did not change her previous rejection at all. Patent owner had a full opportunity to address the rejection in the response to the non-final Office action. Patent owner should also have anticipated that the examiner would respond to patent owner's arguments. Obviously, this response by the examiner caused patent owner to reconsider and amend claim 1, but rules regarding amendments filed after ACP are specific and exacting and do not allow entry of a post-ACP amendment because the patent owner had a change of direction. See 37 CFR 1.116(b).

Furthermore, the petition states that the examiner did not make the required showing that entry of the amendment is an "undue burden." However, the examiner did make such a showing. See page 1 of the RAN. Specifically, the examiner explained how entry of the post-ACP amendment would raise new issues that would require further consideration and/or search because the limitation of "said fin plate portions of said heat dissipating plates having. . .bottom ends which extend to a level lower than said top edge <u>and higher than said bottom edge</u> was not previously presented. See paragraph 1a of the RAN. Therefore, the record shows that the examiner did make a showing of "undue burden" to support her determination that entry of the proposed post-ACP amendment should not be enter in accordance with the statutory mandate of "special dispatch."

Accordingly, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of "special dispatch." For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not enter the post-ACP amendments.

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

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the entry of the post-ACP amendment in the '072 reexamination proceeding is denied.

2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361 or in his absence to the undersigned at (571) 272-3838.

Irem Yucel, Ph.D., JD,
Director, TC 1600

United States Patent and Trademark Office

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ALEXANDRIA, VA 22313-1450
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Y. Rocky Tsao
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225 Franklin Street
Boston MA 02110-2804

(For Patent Owner)

MAILED

OCT 22 2010

CENTRAL REEXAMINATION UNIT

Jason Y. Pahng and Associates, Limited
12178 Bridgend Run
Fairfax, VA 22030

(For Third Party Requester)

Jenny Chen
Eastwind Consultants Company Limited
7F, No. 1, Alley 30, Lane 358
Rueiguang Road, Neihu District
Taipei, Taiwan 114, R.O.C.

(Courtesy Copy)

In re Kuo	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/001,072	: **DISMISSING PETITION**
Filed: July 29, 2008	: **UNDER 1.183**
For: U.S. Patent No. 6,289,975 B2	:

This is a decision on the July 21, 2010 patent owner petition entitled "PETITION UNDER 37 C.F.R. §1.183 – SUSPENSION OF RULES."

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

The petition is **dismissed as moot**.

BACKGROUND

- On July 29, 2008, a request for *inter partes* reexamination of U.S. Patent Number 6,289,975 B2, meeting the filing date requirements of 37 C.F.R. § 1.915, was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,072 ("the '1072 proceeding").

- Prosecution progressed, until, on June 30, 2010, a Right of Appeal Notice was mailed by the Office, setting a time period for filing of an appeal brief to run the longer of 1 month or thirty days from the date of the Right of Appeal Notice.

- On July 21, 2010, patent owner filed a notice of appeal and two petitions; the first entitled "PETITION TO ENTER AMENDMENT UNDER 37 C.F.R. § 1.181;" the second entitled "PETITION UNDER 37 C.F.R. §1.183 – SUSPENSION OF RULES." The latter petition, seeking an extension of time to file patent owner's appellant's brief, is the subject of this decision.

- On September 20, 2010, the patent filed an appellant's brief.

- On October 5, 2010, the Office dismissed the July 21, 2010 petition filed under 37 C.F.R. § 1.181.

- On October 19, 2010, the third party requester filed a respondent's brief.

PERTINENT REGULATIONS

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 41.66(a) provides:

> An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

Patent owner filed the instant petition to extend the time to file an appellant's brief "until after a decision on [the] petition filed under 37 C.F.R. § 1.181." However, patent owner has already filed its appellant's brief on September 20, 2010. Furthermore, on October 5, 2010, the Office dismissed the July 21, 2010 petition filed under 37 C.F.R. § 1.181. In view of these facts, the petition under § 1.183 is now moot. Therefore, the instant petition is dismissed.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceeding. Different patent owner addresses are of record for the reexamination proceeding and the patent. *The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings* pursuant to 37 CFR 1.33(c), and it is that of Y. Rocky Tsao, Fish & Richardson P.C., 225 Franklin Street, Boston MA 02110-2804. Accordingly, all future correspondence will be directed only to that address, unless patent owner changes the correspondence address of record in the patent, using form PTO/SB/123, or an appropriate substitute.

CONCLUSION

- The petition is **dismissed**.
- 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

October 21, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,073	07/30/2008	7240025 B2	23373-007RX1	4124

7590 03/13/2012

MICHAEL F. HELM
HELM, PAYNE & CHORUSH, LLP
600 TRAVIS STREET
SUITE 6710
HOUSTON, TX 77002

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/13/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN C. PHILLIPS
FISH & RICHARDSON P.C.
12390 EL CAMINO REAL
SAN DIEGO, CA 92130

Date:
MAILED
MAR 13 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001073
PATENT NO. : 7240025
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
www.uspto.gov

Michael F. Helm (For Patent Owner)
Helm, Payne & Chorush, LLP
600 Travis Street
Suite 6710
Houston, TX 77002

MAILED

MAR 1 8 2012

CENTRAL REEXAMINATION UNIT

John C. Phillips (For Requester)
Fish & Richardson, P.C.
12390 El Camino Real
San Diego, CA 92130

In re Stone et al	:	
Inter Partes Reexamination Proceeding	:	**DECISION DISMISSING**
Control No. 95/001,073	:	**PETITION TO TERMINATE**
Filed: July 30, 2008	:	***INTER PARTES* REEXAMINATION**
For: U.S. Patent No.: 7,240,025	:	**PROCEEDING**

This is a decision on patent owner's December 9, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 1.907(b)" (patent owner's December 9, 2011 petition to terminate).

This decision also addresses requester's December 21, 2011 opposition paper entitled "Requester's Opposition Under 37 CFR 1.181 to Patent Owner's Petition to Terminate *Inter Partes* Reexamination" (requester's December 21, 2011 opposition).

Patent owner's December 9, 2011 petition to terminate, requester's December 21, 2011 opposition, 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 95/001,073, filed on December 9, 2011, is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,073 (the '1073 proceeding), specifically with respect to claims 52, 63, 90, and 231 of U.S. Patent 7,240,025, 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 the claim(s) in suit of the patent, which claim(s) is/are 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 No. 7,240,025 (the '025 patent), was the subject of a civil action in the district court, i.e., *Function Media, L.L.C. v. Google, Inc. et al*, Case No. 2:07-cv-00279-CE (E.D. Tex.) (the litigation). The patent owner has submitted, with the present petition, a copy of the district court's September 9, 2011 judgment, which shows that the third party requester of this proceeding, Google, Inc., was a party to the litigation. Thus, element 1 has been shown to have been satisfied.

Regarding element 2, the patent owner has submitted a copy of patent owner's October 5, 2011 notice of appeal to the Federal Circuit, in which in the patent owner appealed the district court's "September 9, 2011 Final Judgment". Thus, the patent owner has provided evidence that the district court's decision is not a final decision with the meaning of 35 U.S.C. 317(b). A decision is "final" after all appeals have been exhausted, or the time for filing all appeals has expired, which is not the case here.[1]

The appeal by the patent owner of the district court's September 9, 2011 judgment, alone, provides sufficient evidence that the district court's decision is not a final decision within the meaning of 35 U.S.C. 317(b). However, in addition, the patent owner is also appealing the district court's "October 9, 2011 Memorandum Opinion and Order concerning claim construction issues".[2] As argued by the requester in its December 21, 2011 opposition, the patent owner is appealing the district court's construction of certain terms in 1) independent claim 1, from which claims 52, 63, and 90 depend, and 2) independent claim 179, from which claim 231 depends.[3] It is possible that a decision from the Federal Circuit may vacate the court's claim construction with a remand for a new trial.[4] If there is a remand for a new trial, it is entirely possible for the district court to alter its previous decision concerning the validity of the

---

[1] See MPEP 2686.04, subsection V.

[2] Again see the copy of patent owner's October 5, 2011 notice of appeal to the Federal Circuit.

[3] See *Function Media, L.L.C. v. Google, Inc.*, Case No. 2012-1020, Plaintiff-Appellant's Brief, filed in the Federal Circuit on December 12, 2011, under the section "Statement of the Issues":

> Whether the District Court erred in construing the terms "processing . . . the electronic advertisement . . . in compliance with the presentation rules of the internet media venue," "a second interface to the computer system through which a seller is prompted to input information to select one or more of the internet media venues," and "publishing the electronic advertisement to one or more of the selected internet media venues".

[4] The patent owner is also, in fact, appealing the district court's denial of patent owner's motion for a new trial. Again see the copy of patent owner's October 5, 2011 notice of appeal to the Federal Circuit.

claims at issue in the pending reexamination proceeding, either based on the resolved claim construction or based on other factors.

For these reasons, element 2 has not been shown to have been satisfied.

Because the patent owner has provided evidence that the district court's decision is not final, the Office need not address whether the patent owner has provided sufficient evidence to show whether elements 3 and 4 have been satisfied. For example, the fact that the district court decided, in its September 9, 2011 judgment, that claims 52, 63, 90, and 231 were valid, and essentially held that the requester did not sustain its burden of proving the invalidity of those claims, does not trigger the provisions of 35 U.S.C. 317(b) which would require the termination of the present proceeding as to those claims, because the district court's decision is not a final decision.

For the reasons given above, patent owner's December 9, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- Patent owner's December 9, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,073 is **dismissed**.
- The prosecution of the '1073 *inter partes* reexamination proceeding is **not terminated** and **will continue**.
- 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

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CENTRAL REEXAMINATION UNIT

Sterne Kessler Goldstein Fox
1100 New York Avenue NW
Washington DC 20005-3934

(For Patent Owner)

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Irvine, California 92612-7108

(For *Inter Partes* Requester)

In re Imanishi et al.
Inter partes Reexamination Proceeding
Control No. 95/001,076
Filed: November 12, 2008
For: U.S. Patent No. 6,770,748

: Decision on Petition
: under 37 CFR 1.181

This decision is in response to Patent Owner's petition filed on May 27, 2010, which is a request for reconsideration of the decision mailed April 14, 2010 that dismissed the request to expunge the comments by the Requester filed on March 27 & 30, 2009. The third party requester filed an opposition on June 24, 2010, opposing the May 27, 2010 petition.

The petition and opposition are before the Director of TC 1600, who oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is **DENIED** for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,700,748 (the '748 patent) issued on August 3, 2004.

2. A request for reexamination of the '748 patent was filed on August 22, 2008. The request was assigned control No. 95/001,076 (the '1076 reexamination proceeding).

3. On October 15, 2008, the Office vacated the filing date of August 22, 2008, because the request failed to comply with the requirements of 37 CFR 1.915(b)(3). The decision provided Requester one month to respond to the notice to vacate.

4. On November 3, 2008, Requester responded to the vacatur amending the request, however, requester failed to provide a certificate of service with the request. On November 12, 2008, the request papers met the requirements and was granted a filing date of November 12, 2008.

5. On December 31, 2008, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-5 of '748 patent. Concurrently, the Office also mailed an Office action.

5. On February 27, 2009, Patent Owner filed a response to the December 31, 2008 Office action. The response to the Office action included a declaration by Dr. Jesper Wengel and a declaration by Dr. Nanna Allback. *Curriculum vitae* were also included.

6. On March 27, 2009, Requester filed comments after Patent Owner's response. The comments paper was 34 pages and included 33 additional exhibits. Exhibit #2 contained material that has been asserted in requester's petition to expunge filed on April 23, 2009 as being privileged communication under the attorney-client privilege.

7. On March 30, 2009, requester filed a replacement of exhibit # 2, redacting five pages that were asserted to be considered privileged. Requester provided a redacted declaration to replace the unredacted exhibit #2 filed on March 27, 2009.

8. On April 13, 2009 the Patent Owner filed a petition titled "PETITION TO SUSPEND THE RULES under 37 CFR 1.183 and EXPUNGE THIRD PARTY REQUESTER'S SUPPLEMENTAL RESPONSE." Patent Owner requested that the Office suspend 37 CFR 1.939 to facilitate the requested relief under 37 CFR 1.183. Patent Owner requested that the supplemental paper filed on March 30, 2007, including corrected declaration #2 be expunged for being improper under

37 CFR 1.915(b)(3) and 37 CFR 1.947.

9. On April 13, 2009, Patent Owner also filed a petition under 37 CFR 1.183 to request waiver of 37 CFR 1.939. Patent Owner requested that the requester's comments be expunged from the record as being improper under 37 CFR 1.947.

10. On April 23 2009, the Requester submitted a petition opposing Patent Owner's petition under 37 CFR 1.183 to expunge Requester's redacted comments filed on March 27, 2009. Requester's petition included an exhibit outlining Requester's comments and how such comments correlate with rules 37 CFR 1.947 and 1.948.

11. On April 24, 2009, the Requester petitioned under 37 CFR 1.59 and MPEP 724.05 to expunge from the record pages 1-5 of exhibit 2 of Dr. Seth, because those pages are privileged attorney and client information and were inadvertently and unintentionally disclosed in exhibit 2.

12. On June 8, 2009, the Patent Owner filed a petition under 37 CFR 1.181 or 1.182 to maintain under seal Patent Owner's petition to deny the requester's petition to expunge information in requester's comments and to make available in the public record, only if necessary, redacted version of Patent Owner's petition to deny the requester's petition to expunge the requester's comments.

13. On July 6, 2009, Requester submitted a reply to the Patent Owner's petition to deny expungement.

14. On August 21, 2009, the Office mailed a composite decision on the April 13 & 24, 2009 petitions, the June 8, 2009 petition, and the July 6, 2009 requester reply. The decision denied Patent Owner's April 13, 2009 petition, held in abeyance Requester's April 24, 2009 petition, denied as premature Patent Owner's June 8, 2009 petition, and expunged Requester's July 6, 2009 reply.

15. On September 1, 2009, the Office mailed a decision dismissing Patent Owner's April 13, 2009 petition under 37 CFR 1.183 to suspend the requirement in 37 CFR 1.939(a).

16. On October 21, 2009, the Office mailed a non-final Office action, which was responsive to the Requester's comments, dated March 27 & 30, 2009.

17. On November 2, 2009, Patent Owner filed a petition under 37 CFR 1.181 to request expungement of the Requester's comments, dated March 27 & 30, 2009.

18. On November 19, 2009, the Requester filed an opposition to Patent Owner's November 2, 2009 petition.

19. On December 21, 2009, the Patent Owner filed a response to the October 21, 2009 Office action.

20. On January 20, 2010, the Requester filed comments on the Patent Owner's response and the October 21, 2009 Office action.

21. On April 14, 2010, the Office mailed a decision dismissing Patent Owner's petition dated November 2, 2009.

22. On May 27, 2010, Patent Owner filed the instant renewed petition under 37 CFR 1.181 in combination with petition under 37 CFR 1.182 and 1.183.

23. On June 24, 2010, the Requester filed opposition to Patent Owner's May 27, 2010 petition.

RELEVANT LAW AND REGULATIONS

37 CFR 1.59 provides:

Expungement of information or copy of papers in application file.

1. (a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

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

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

37 CFR 1.181 provides:

Petition may be taken to the Director:

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

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

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

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

37 CFR 1.939 provides:

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

37 CFR 1.947 provides:

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.

35 USC 314(b)(2) provides

(b) RESPONSE.-

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

ANALYSIS AND FINDINGS

Treatment of a Combination of Petitions under 37 CFR 1.181, 1.182 and 1.183

Although the petition contains statements that alternative relief is sought under 37 CFR 1.182 and 1.183, the petition is being decided solely under 37 CFR 1.181. In other words, the Patent Owner's combined petition under 37 CFR 1.181, 1.182, and 1.183 is improper because it combines at least three distinct petitions, which is not compliant with 37 CFR 1.4. Patent Owner must file separate petitions if Patent Owner wants consideration of the

issues under 37 CFR 1.182 and 1.183. In summary, the petitions for requested relief under 37 CFR 1.182 and 1.183 is, in effect, dismissed because the petition is not compliant with 37 CFR 1.4. Therefore, only issues raised under 37 CFR 1.181 will be address in this decision.

Decision on Reconsideration Petition under 37 CFR 1.181

The Patent Owner (Petitioner) states that they are seeking reconsideration of a decision on an earlier petition that requested relief under 37 CFR 1.181 to have Requester's comments, dated March 27 & 30, 2009 [hereinafter "the Requester's comments], expunged because the comments violate 37 CFR 1.915(b)(3) and 1.947. Patent Owner specifically states that the decision of April 14, 2010 failed to address the following reasons to support their request to expungement the Requester's comments:

1. The Requester's comments introduced a new theory of anticipation for claim 2;
2. The Requester's comments introduced a new ground of rejection for claims 1-5;
3. The Requester's comments violate 37 CFR 1.915(b)(3);
4. The Requester's comments are not limited to issues raised by the Office action or Patent Owner's response; and
5. The decision dismissing the petition to expunge is contrary to the mandate of special dispatch.

See pages 6-20 of the petition. Petitioner also set forth the Patent Owner's suggested conduct of the proceedings on page 21 of the petition.

The Requester filed an opposition to Patent Owner's petition on June 24, 2010. The Requester's opposition was untimely because it was not filed within two weeks from the date (May 26, 2010) indicated in Patent Owner's certificate of service. See MPEP 2667. Therefore, the opposition, dated June 24, 2010, is not considered but it will remain in the record.

Generally, in response to Petitioner Patent Owner's arguments for expunging the Requester's comments 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 Office action. Specifically, MPEP 266.05 states that "... the comments should not be held defective if the examiner can ascertain that all of the comments filed by the third party requester are directed to the issues and points in the Office action and/or the Patent Owner's response." The petition states that the decision mailed April 14, 2010 failed to follow Office policies and procedures because the Requester's comments violated 37

CFR 1.915(b)(3) and 1.947 and the statutory mandate of special dispatch for the reasons set forth in the petition. The specific reasons advanced by Petitioner are discussed below.

1. Petitioner advances that the Requester's comments introduced a new theory of anticipation for claim 2.

The record shows that the Requester's comments did not violate the requirements set forth in 37 CFR 1.947. The Requester's comments did not introduce any new theories of anticipation or new grounds of rejection for claim 2 as alleged by the Patent Owner on pages 6-7 of the petition. Specifically, the comments regarding "inherent" anticipation are made in support of Requester's position that the Nielsen thesis is enabled and teaches the claimed invention as set forth in the request for reexamination. See pages 4-13 of the Requester's March 27, 2009 comments. See also pages 5-6 of the Requester's opposition, dated November 19, 2009, in which Requester states that they were not raising new grounds of rejection. See specifically, page 6 of the November 19, 2009 opposition which essentially states that the Requester was not attempting to raise a new ground of rejection for claim 2 by stating that claim 2 was referenced "in passing." In addition, the record shows that the examiner did not treat this passing reference to claim 2 in the Requester's comments as a new ground of rejection. See pages 4-12 of the Office action dated October 21, 2009. Therefore, the record is clear that neither the third party Requester nor the Office considered there to be a proposed anticipation rejection of claim 2 introduced by the Requester's comments as advanced by the Petitioner. Furthermore, the October 21, 2009 Office action was a non-final action, which gave Patent Owner full opportunity to response with arguments, amendments, and/or evidence to the Requester's comments and the Office action. The record shows that on December 21, 2009, the Patent Owner filed an extensive response that must be considered by the examiner in the next Office action. Therefore, the record does not support Petitioner's assertion that their due process rights were violated by entry of the Requester's comments. For these reasons, Petitioner has failed to persuasively show that the Requester's comments are in violation of reexamination laws and procedures, including the statutorily mandate of special dispatch, and must be expunged from the record.

2. Petitioner advances that the Requester's comments introduced a new ground of rejection for claims 1-5.

The Requester's comments did not introduce any new ground of rejection for claims 1-5 as alleged by the Patent Owner on pages 8-9 of the petition. Similar to the issues discussed

above, the comments pertaining to obviousness based upon the Nielsen reference are addressing the examiner's determination that Nielsen was non-enabled in the first Office action in order to convince the examiner to reconsider the proposed obviousness rejections based upon Nielsen in combination with the secondary references, as set forth in the request for reexamination. See page 14 of the Requester's March 27, 2009 comments. See also pages 6-7 of the Requester's opposition, dated November 19, 2009, in which Requester states that they were only addressing the proposed obviousness rejections made in the request for reexamination. Upon review of the Office action dated October 21, 2009, the examiner's treatment of the Requester's comments is consistent with Requester's statements that no new grounds of rejections were raised, and nothing in the record shows that the examiner's interpretation was unreasonable or erroneous. The issues of enablement and obviousness were clearly raised by the examiner in the first Office action. Therefore, the Requester is permitted, under 37 CFR 1.947, to respond to enablement and obviousness issues raised by the examiner in the first Office action. Furthermore, the October 21, 2009 Office action was a non-final action, which gave Patent Owner full opportunity to respond with arguments, amendments, and/or evidence to the Requester's comments and the Office action. The record shows that on December 21, 2009, patent filed an extensive response that must be considered by the examiner in the next Office action. Therefore, the record does not support Petitioner's assertion that their due process rights were violated by entry of the Requester's comments. For these reasons, Petitioner has failed to persuasively show that the Requester's comments are in violation of reexamination laws and procedures, including the statutorily mandate of special dispatch, and must be expunged from the record.

3. Petitioner advances that the Requester's comments violate 37 CFR 1.915(b)(3).

In response to the allegations that the decision of April 14, 2010 fails to address Petitioner's position that the Requester's comments violate 37 CFR 1.915(b)(3), the record does not support Petitioner's position that the Requester's comments introduced any new proposed grounds of rejection, as discussed above and in the April 14, 2010 decision. Therefore, the requirements of 37 CFR 1.915(b)(3) are not applicable to the Requester's comments. In other words, the record does not support Petitioner's argument that the Requester is "... effectively allowed ... multiple bites of the apple..." by entry of the Requester's comments because no new grounds of rejection were proposed by the Requester's comments. Therefore, the record does not support Petitioner's assertion that the Requester's comments are subject to, and had violated, the requirements of 37 CFR 1.915(b)(3). For these reasons, Petitioner has failed to persuasively show that the Requester's comments are in violation of reexamination laws and procedures, including the statutorily mandate of special dispatch, and must be expunged from the record.

In addition, the Requester is permitted, under 37 CFR 1.947 and 1.948, to respond to issues raised by the Patent Owner's response and the Office action. In response to the arguments about presentation of evidence on page 11-13, the record clearly shows that determination of the effective filing date of the claimed invention, and therefore, which references qualify as prior art is also at issue. See pages 4-5 in the first Office action. In fact, a substantial portion of the Patent Owner's response to the first Office action was devoted to the issue of the effective filing date for the claimed invention and whether references were prior art. See pages 2-25 of the February 27, 2009 response. Therefore, the record clearly shows that the determination of the effective filing date of the claimed invention was an issue raised by the examiner and the Patent Owner. In addition, it is reasonable that the Requester submit evidence to support the publication date of the Nielsen thesis in light of all the issues presented regarding the effective filing date of the claimed invention. As discussed above, the Requester's comments are deemed to be limited to issues raised by the Patent Owner's response and the Office action, in accordance with 37 CFR 1.947 and 1.948. For these reasons, Petitioner has failed to persuasively show that the Requester's comments are in violation of reexamination laws and procedures, including the statutorily mandate of special dispatch, and must be expunged from the record.

4. <u>Petitioner advances that the Requester's comments are not limited to issues raised by the Office action or Patent Owner's response.</u>

In response, the record does not support Petitioner's position that the Requester's comments are in violation of the requirements in 37 CFR 1.947 and 1.948, as discussed above and in the April 14, 2010 decision. Petitioner alleges that the Requester's comments "improperly recast" issues and presents arguments to new issues. The issues regarding priority entitlement, which are advanced once again by the Petitioner on pages 14-17, were addressed above and in the April 12, 2010 decisions. In addition, some of Petitioner's arguments are, in effect, addressing the merits of the Requester's comments, which are not issues that are addressable by petitions. See MPEP 1201. More importantly, the record is clear that the examiner did not deem the Requester's comments to be addressing new issues in violation of the requirements of 37 CFR 1.947 and 1.948, and nothing in the record shows that the examiner's determination was unreasonable or erroneous. Petitioner states that statutes and rules are silent about allowing the Requester to file evidence after filing, and therefore, advances that Requester is prohibited from doing so. However, see 37 CFR 1.937(b), which, in effect, states that *inter partes* reexamination proceedings are conducted with the same regulations governing the application examination process. Therefore, the ability to present evidence pertaining to issues raised for both the Patent Owner and Requester are equally governed by 37 CFR 1.130, 1.131, and 1.132. See MPEP 2666 et seq. The record

shows that Patent Owner filed evidence to counter the Requester's position and the Office action. See pages 14-15 of the petition. Also, the record shows that, on December 21, 2009, Patent Owner filed an extensive response, including additional evidence to counter the position of the Requester, which must be considered by the examiner in the next Office action. Therefore, the record does not support Petitioner's assertion that their due process rights were violated by entry of the Requester's comments. For these reasons, Petitioner has failed to persuasively show that the Requester's comments are in violation of reexamination laws and procedures, including the statutorily mandate of special dispatch, and must be expunged from the record.

5. Petitioner advances that the decision dismissing the petition to expunge is contrary to the mandate of special dispatch.

In response, the record does not support Petitioner's position that the April 14, 2010 decision was in violation of the statutory mandate of special dispatch. As discussed above and in the April 14, 2010 decision, Petitioner has failed to make a sufficient showing that entry of the Requester's comments is in violation of reexamination laws and proceedings. Furthermore, expunging comments that have been of record for over 18 months and are addressed in multiple documents would clearly be against the statutory mandate of special dispatch in this case. In addition, the Petitioner's reliance on the statutory mandate of special dispatch as justification for their position seems inconsistent with their actions because the multiple rounds of petitions filed by Petitioner on this issue is slowing prosecution in this proceeding. Specifically, Petitioner has filed six petitions, some of which are combination of multiple petitions, regarding the entry of the Requester's comments. See the statement of relevant facts above. The director has reviewed the facts of this particular proceeding and has found that there is not enough justification to thwart the statutory mandate of special dispatch by expunging the Requester's comments and backing up prosecution to the same point it was almost two years ago. Petitioner's arguments that the Office's position "[t]aken to its extreme" would distort the reexamination process and deprive Patent Owner of their "fundamental rights" are simply not supported by the facts in this proceeding. In other words, Petitioner has not set forth sufficient facts to show the Office has failed to follow the reexamination laws and procedures in order to support their request to expunge the Requester's comments. Therefore, it is in the interest of special dispatch to advance the prosecution and not further delay the proceeding by granting Petitioner's request to expunge the Requester's comments.

In summary, the record shows that the examiner, and the April 14, 2010 decision that supported the examiner's action, appropriately followed Office's rules and procedures. Specifically, the examiner's determination to enter and address the Requester's comments is proper, and do not categorically deprive the Patent Owner of its statutory rights to present arguments and evidence relevant to issues raised by the examiner or the Requester in this reexamination proceeding. In other words, the record does not support Petitioner's allegation that the Requester's comments must be expunged from the record of this proceeding, which would result in denying the Requester their right to submit comments set forth in 35 U.S.C. 314(b)(2). Furthermore, expunging comments that have been of record for over 18 months and which are addressed in multiple documents would clearly be against the statutory mandate of special dispatch when Petitioner has failed to clearly show that entry of such comments are in violation of reexamination laws and procedures.

Accordingly, the Patent Owner's petition under 37 CFR 1.181 is DENIED.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed May 27, 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 Yücel, 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.
95/001,077	09/02/2008	11467510	VERM-001/01US	2486

100302 7590 11/22/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/22/2011

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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777-6TH STREET, NW SUITE 1100
WASHINGTON, DC 20001

Date:

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NOV 22 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001077
PATENT NO. : 7376831
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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In re Application of: Kollmyer *et al.* :
Control No. 95/001,077 : **DECISION**
Filed: September 2, 2008 : **DISMISSING**
For: U.S. Patent No. 7,376,831 : **PETITION**

This decision is in response to Patent Owner's petition, filed on November 9, 2009, under 37 CFR 1.181 requesting that the Director expunge any Requester's Comments in response to the Notice of October 23, 2009. The petition is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The Patent Owner's Petition to Expunge filed on November 9, 2009 is dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 7,376,831 (the '831 patent) issued on May 20, 2008.

2. A completed request for reexamination of the '831 patent was filed on September 2, 2008. The request was assigned control No. 95/001,077 (the '077 proceeding).

3. On November 28, 2008, the Office ordered that the patent be reexamined.

4. On March 30, 2009, the Office mailed a first Office action in the '077 proceeding.

5. On May 28, 2009, the Patent Owner filed a response to the Office action.

6. On June 1, 2009, the Patent Owner filed a replacement response.

7. On July 1, 2009, the Third Party Requester filed comments.

8. On September 18, 2009, the Office mailed a Notice of Defective Papers which stated that the Requester's Comments of July 1, 2009 were noncompliant with the requirements of 37 CFR 1.943. The Notice gave Requester 15 days to file replacement comments.

9. On October 5, 2009, the Requester filed replacement comments to the Patent Owner's response.

10. On October 23, 2009, the Office mailed a Notice of Defective Papers which stated that the Requester's comments, dated October 5, 2009, did not comply with the requirements of with 37 CFR 1.947. The Notice gave Requester 15 days to file replacement comments.

11. On November 8, 2009, the Requester filed replacement comments to the Patent Owner's response.

12. On November 9, 2009, the Patent Owner filed the instant petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of October 23, 2009 and expunge any replacement comments filed by the Requester in response to the October 23, 2009 Notice.

13. On November 11, 2009, the Requester filed a petition under 37 CFR § 1.183 requesting that the Director waive the rules and allow Requester to enter a response to Patent Owner's petition within a period no less than 10 days from a favorable decision on this petition. This petition will be addressed in a separate petition in due course.

14. On October 3, 2011, the Office mailed an action which determined that the November 8, 2009 comments are not compliant with Office regulations, and for this reason, are not considered. The action also clarified that the July 1, 2009 comments and the October 5, 2009 comments are not considered. Furthermore, the action stated that the Requester is

not permitted any further opportunities to submit comments in response to the March 23, 2009 Office action and the May 28, 2009 Patent Owner response.

DECISION

As pointed out, the Patent Owner filed a November 9, 2009 petition under 37 CFR 1.181 requesting withdrawal of the October 23, 2009 Notice and expungement of any Requester's comments filed in response to the Notice from the proceeding record. Patent Owner alleges that the October 23, 2009 Notice was not permitted because guidelines set forth in MPEP 2666.05 only permit one additional opportunity to provide replacement comments when notified of defective comments. See, e.g., pages 4-6 of the petition. For this reason, Patent Owner asserts that any Requester's comments filed in response to the Notice should be expunged from the proceeding record.

On October 3, 2011, as discussed above, the Office mailed an action that determined that the November 8, 2009 replacement comments are noncompliant with Office regulations and policy. Therefore, the November 8, 2009 replacement comments were not considered and are expunged from the record. In addition, the action made the record clear that the July 1, 2009 comments and the October 5, 2009 comments are not considered. These comments are also expunged from the record. As the July 1, 2009 comments, October 5, 2009 comments, and November 8, 2009 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments are expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

In regard to Patent Owner's assertion that the October 23, 2009 Notice is an unauthorized action, policies and procedures set forth in the MPEP contain instructions to the examiners, and do not have the force of law. See the Foreword of the MPEP. The instructions in MPEP 2666.05 require the examiner to notify the Requester at least once of the reasons for noncompliance and to give the Requester an additional opportunity to file replacement comments. The instructions in MPEP 2666.05 do not preclude the examiner from using his/her discretion to give an additional opportunity to supply corrected comments, especially in the situation where the first Notice failed to explain all the reasons why the originally-filed comments were not compliant. Specifically, in this proceeding, the September 18, 2009 Notice failed to state that the originally-filed comments were not compliant with the requirements of 37 CFR 1.947. Therefore, the examiner used his/her authorized discretion to send a second Notice in order to give the Requester a full and fair opportunity to make comments as provided by in 35 USC 314(b)(2). Accordingly, the October 23, 2009 Notice is deemed an authorized paper and will not be withdrawn or vacated by the Office.

As a result of the October 3, 2011 Office action, however, the remedy of expungement of any replacement comments submitted in response to the October 23, 2009 Notice is already given. In other words, the ultimate relief requested by the November 8, 2009 petition was given by the recent Office action.

For these reasons, the Patent Owner's November 9, 2009 petition is moot, and hereby, dismissed.

CONCLUSION

1. The November 9, 2009 Patent Owner's petition is dismissed as moot.

2. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,077	09/02/2008	11467510	VERM-001/01US	2486

100302 7590 01/10/2012

Google Inc/ Frommer Lawrence & Haug LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/10/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP
777-6TH STREET, NW SUITE 1100
WASHINGTON, DC 20001

Date:

MAILED
JAN 1 0 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001077
PATENT NO. : 7376831
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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Google Inc/ Frommer, Lawrence & Haug LLP (For Patent Owner)
745 Fifth Avenue
New York, NY 10151

Cooley LLP (For Third Party Requester)
Attn: Patent Group
Suite 1100
777 - 6th Street, NW
Washington, DC 20001

MAILED
JAN 10 2012
CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,077 : **DISMISSING**
Filed: September 2, 2008 : **PETITION**
For: U.S. Patent No. 7,376,831 : **AS MOOT**

This is a decision on third party requester's November 11, 2009 petition entitled "REQUEST TO SUBMIT RESPONSE TO PETITION UNDER 37 C.F.R. §1.181 TO EXPUNGE COMMENTS OF THIRD PARTY REQUESTOR FROM THE RECORD," requesting waiver of 37 CFR 1.939 under 37 CFR 1.183 to submit a response to patent owner's November 9, 2009 petition entitled "PETITION UNDER 37 C.F.R. §1.181." The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In light of the decision issued by the Central Reexamination Unit (CRU) on November 22, 2011, dismissing patent owner's November 9, 2009 petition under 37 CFR 1.181 as moot, the instant petition under 37 CFR 1.183 is dismissed as moot.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.

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

01-05-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,078	09/04/2008	7193562	PA2894REX	4648

22830 7590 08/25/2010

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO, CA 94303

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/25/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,078	09/04/08	7193562	PA2894REX

SCHWEGMAN, LUNDBERG & WOESSNER PA
P O BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DATE MAILED: MAILED

AUG 25 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,078	09/04/08	7193562	PA2894REX

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

SCHWEGMAN, LUNDBERG & WOESSNER PA
P O BOX 2938
MINNEAPOLIS, MN 55402

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.

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MAILED

AUG 25 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

CARR & FERRELL LLP
2200 GENG ROAD
PALO ALTO CA 94303

(For Third-Party Requester)

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

In re Shtrom *et alia*	:
Reexamination Proceeding	: DECISION
Control No. 95/001,078	: DISMISSING PETITION
Request Deposited: September 4, 2008	:
For: U.S. Patent No. 7,193,562	:

This is a decision on the June 2, 2010 Patent Owner (PO) paper entitled "PETITION TO STRIKE THIRD PARTY REQUESTER'S AMENDED APPEAL BRIEF UNDER 37 C.F.R. §1.181".

The paper is before the Central Reexamination Unit for consideration.

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

BACKGROUND AND DECISION

Claims 1-10 and 18-32 are not subject to reexamination and claims 11-17 stand confirmed. Third Party Requester (3PR) has appealed the examiner's decision to not adopt proposed rejections of claims 11-17. 3PR filed an appeal brief on October 5, 2009. The brief was held defective in the notification mailed March 2, 2010 for reasons other than compliance with 37 CFR 1.52. 3PR filed an amended appeal brief on April 1, 2010 via the electronic filing system (efs). PO filed the present petition on June 2, 2010.

PO has styled the petition under 37 CFR 1.181 and the office considers the petition pursuant to 37 CFR 1.181. PO petitions to strike the appeal brief that was entered in the record by being filed via efs on April 1, 2010 as noticed in the electronic acknowledgement receipt of April 1, 2010. PO alleges that "[t]he amended appeal brief remains defective for violating various provisions of 37 C.F.R. § 1.52 (RULE 52)." PO requests relief in the dismissal of the appeal ("[a]s the defective amended appeal brief continues to be non-compliant, the third party requester's appeal should be dismissed").

37 CFR 1.181(f) states, in part:

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

As PO is requesting relief more than two months from the notice from which relief is requested, the petition is **dismissed as untimely**.

However, a review of the allegations set forth in the petition does not appear to be consistent with the appeal brief in the record. Specifically, PO alleges (on page 4 of the petition) that all 34 pages of the amended appeal brief had a top margin of 1.5 cm (below the requirement of 2.0 cm from 37 CFR 1.52(a)). The undersigned printed a copy of the amended appeal brief on standard 21.6cm by 27.9cm paper and measured the top margin as 2.2cm (with a bottom margin of 3.2cm).

The undersigned also printed a copy of the appeal brief of October 5, 2009 and measured the same margins in that submission. *In arguendo*, had both briefs been filed with margins that do not comply with 37 CFR 1.52, petitioner does not present a cogent argument as to why an alleged defect first identified in the amended appeal brief would warrant dismissal of the appeal.

CONCLUSION

1. The petition is **dismissed**.

2. This decision is without prejudice to a request for reconsideration or higher-level review.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or in his absence to Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,078	09/04/2008	7193562	PA2894REX	4648

22830 7590 01/24/2011

CARR & FERRELL LLP
120 CONSTITUTION DRIVE
MENLO PARK, CA 94025

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 Rayspan Corporation and Netgear, Inc. v. Ruckus Wireless, Inc.

Reexamination Control No. 95/001,078
Patent 7,193,562
Technology Center 3900

ORDER CANCELING ORAL ARGUMENT
(37 C.F.R. § 41.47(f))

Third Party Requester Appellant requested an oral hearing on October 12, 2010. In response, the Board sent a Notification of Appeal Hearing scheduling the oral hearing before a merits panel of the Board of Patent Appeals and Interferences for February 2, 2011. On January 11, 2011, the Third Party Requester Appellant filed a reply indicating "HEARING ATTENDANCE WAIVED." On same date, the Patent Owner filed a "Request for Oral Hearing" by facsimile transmission.

However, the Patent Owner did not appeal, and did not file a Respondent Brief in reply to Third Party Requester's Appellant's Brief of April 1, 2010.

37 C.F. R. § 41.73 states in pertinent part:

> (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.

In this instance, the Patent Owner has waived oral argument and the Third Party Requester has not filed a brief. Neither party would be permitted to make oral arguments pursuant to 37 C.F. R. § 41.73(e)(1).

For the reasons given above, it is:

Ordered that the oral hearing scheduled for February 2, 2011, is canceled pursuant to 37 C.F. R. § 41.73(f).

James T. Moore
Acting Chief Administrative Patent Judge

Inter Partes Reexamination 95/001,078
Patent No. 7/193,562

Counsel for Patent Owner:
Stephen R. Bachmann
CARR & FERRELLL, LLP
120 Constitution Drive
Menlo Park, CA 94025

Counsel for Third Party Requester:
Thomas C. Reynolds
SCHWEGMAN, LUNDBERG & WOESSNER PA
P.O. BOX 2938
Minneapolis, MN 55402

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 08/04/2010
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001080
PATENT NO. : 7321783
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.
95/001,183	04/29/2009	7321783	RIK107440B	7201

40401 7590 08/04/2010
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
AKIN GUMP STRAUSS HAUER & FELD, LLP
P.O. BOX 688
DALLAS, TX 75313-0688

Date:

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AUG 04 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001183
PATENT NO. : 7321783
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.
90/010,623	07/28/2009	7321783	RK107440C	2837

40401 7590 08/04/2010
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED

AUG 04 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010623
PATENT NO. : 7321783
ART UNIT : 3992

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

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

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AUG 04 2010

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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314
(For Patent Owner)

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002
(For '1080 *Inter Partes* & *ex parte* Requester)

Akin, Gump, Strauss, Hauer & Feld LLP
1700 Pacific Avenue, Suite 4100
Dallas, TX 75201-4675
(For '1183 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,080
Filed: September 9, 2008
For: U.S. Patent No. 7,321,783

Inter Partes Reexamination Proceeding
Control No. 95/001,183
Filed: April 29, 2009
For: U.S. Patent No. 7,321,783

Ex Parte Reexamination Proceeding
Control No. 90/010,623
Filed: July 28, 2009
For: U.S. Patent No. 7,321,783

DECISION DENYING PATENT OWNER REQUEST TO WITHDRAW THE DECISION TO MERGER REEXAMINATION PROCEEDINGS

This is a decision on the following papers:

(1) The petition filed February 26, 2010 by patent owner entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE DECISION TO MERGE REEXAMINATION PROCEEDINGS UNDER 37 CFR 1.989," which is being taken as a petition for reconsideration of the Office's December 30, 2009 merger decision and a request that the Office dissolve the merger under 37 CFR 1.182.

(2) The opposition filed March 12, 2010 by the '1080 third party requester entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE DECISION TO MERGE REEXAMINATION PROCEEDINGS UNDER 37 CFR 1.989."

The proceeding, the patent owner petition, and the third party requestor opposition are before the Office of Patent Legal Administration.

Patent owner's February 26, 2010 petition under 37 CFR 1.182 is denied.

This decision on the February 26, 2010 petition is designated as a final agency action under 5 U.S.C. § 704.

FEES

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 March 1, 2010 pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal filed on February 26, 2010.

The '1080 third party requester opposition is being taken as a petition under 37 CFR 1.182. The fee set forth in 37 CFR 1.17(f) for this petition is $400. A $400 will be charged to the '1080 requester's deposit account no. 14-1437, pursuant to the authorization on page one of requester's March 12, 2010 petition.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,321,783 (the '783 patent) issued to Ki Il Kim on January 22, 2008.

2. On September 9, 2008, a first request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123, was filed by third party requester and real party in interest, Apple Inc. The request was assigned control number 95/001,080 (the '1080 proceeding).

3. On November 29, 2008, *inter partes* reexamination was ordered on the claims requested in the '1080 proceeding based on the examiner's determination that the September 9, 2008 request raised a substantial new question of patentability.

4. On February 24, 2009, a non-final Office action was mailed in the '1080 proceeding, rejecting claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27, /39, /55), 70, 76-78, 79 (/27, /55, /70, /76, /77, /78), 80 (/1, /2, /76), 83, 85 (/32), 87 (/1, /2), 89 (/1, /2, /76) 106-107, 111, 118, 119 (/70, /118), and 120-123 of the '783 patent.

5. On April 23, 2009, patent owner timely filed, in the '1080 proceeding, an amendment and response to the February 24, 2009 Office action, presenting new claims 126-150. No claims were amended or canceled.

6. On April 29, 2009, a second request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10-21, 27-31, 43, 45 (/43), 46, 48 (/46), 49, 51, 53, 55, 56, 57 (/1, /2, /27,

/43, /46, /51, /56), 58 (/27, /43, /46, /51, /55), 59-78, 79 (/27, /43, /46, /55, /56, /61, /64, /66, /70, /74, /76, /77, /78), 80 (/1, /2, /27, /46, /51, /55, /61, /66, /72, /73, /74, /77), 81(/51, /74, /76, /77, /78), 83, 85 (/51), 86, 87 (/1, /2, /51, /73, /74, /77), 88 (/51), 89 (/1, /2, /27, /43, /46, /55, /56, /61, /64, /66, /70, /72, /73, /74, /76, /77, /78), 90-101, 106-107, 111, 114-119 and 121-125, was filed by third party requester and real party in interest, ALLTEL Communications, LLC. The request was assigned control number 95/001,183 (the '1183 proceeding).

7. On June 4, 2009, third party requester Apple, Inc., timely filed in the '1080 proceeding written comments.[1]

8. On July 21, 2009, *inter partes* reexamination was ordered on the claims requested in the '1183 proceeding, based on the examiner's determination that the April 29, 2009 request raised a substantial new question of patentability.

9. On July 28, 2009, an *ex parte* request for reexamination of the '783 patent, on claims 18 (/16, /1), 18 (/16, /2), 33(/32), 34 (/33, /32), 35 (/32), 36 (/32), 40 (/39), 42, 48 (/46), 50, 52 (/50), 54 (/50), 82 (/1, /2, /55, /76), 84 (/50), 88 (/50), 102 (/42), 103 (/42), 104, 105 (/104), 108 (106), 109 (/106), 110 (/108), 110 (/109), and 112-113, was filed by the first *inter partes* requester, Apple Inc. The request was assigned control number 90/010,623 (the '10623 proceeding).

10. On August 28, 2009, *ex parte* reexamination was ordered on the claims requested in the '10623 proceeding, based on the examiner's determination that the July 28, 2009 request raised a substantial new question of patentability.

11. On December 30, 2009, the Office *sua sponte* merged the '1080 and '1183 *inter partes* proceedings and the '10623 *ex parte* proceeding (the merged proceeding). The decision also implemented a rejection under 35 USC 112, second paragraph requiring patent owner to place the same claim sets in all three, now merged, proceedings.

12. On January 28, 2010, patent owner filed a response amending the claims in accordance with the December 30, 2009 merger decision and rejection.

13. On February 26, 2010, the '1183 third party requester filed comments.

14. Also on February 26, 2010, patent owner filed a petition entitled, "PATENT OWNER'S PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE DECISION TO MERGE REEXAMINATION PROCEEDINGS UNDER 37 CFR 1.989."

15. On March 12, 2010, the '1080 third party requester filed an opposition to patent owner's February 26, 2010 petition.

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[1] Third party requester's comments are considered timely as patent owner's April 23, 2009 response was non-compliant with regards to 37 CFR 1.943 page limit requirements until May 5, 2009 when the Office issued a waiver of the page limit requirement.

DECISION

I. Relevant Law and Procedure:

35 U.S.C. 302 states (in part):

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title.

35 U.S.C. 303(a) states:

> (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. 304 states:

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

35 U.S.C. 305 states:

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

patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

35 U.S.C. 311(a) states:

IN GENERAL - Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

35 U.S.C. 312 (a) states:

(a) REEXAMINATION. - Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. 314 states:

(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 1.989 states:

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

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

MPEP 2686.01 states (in part):

Initially, it is appropriate to point out who can file a second or subsequent request for reexamination while a first reexamination proceeding is pending.

Case (1) - The earlier (pending) reexamination is an *inter partes* reexamination:

(1)(a) The subsequent request is an *inter partes* reexamination request. Pursuant to 35 U.S.C. 317(a), once an order for *inter partes* reexamination has been issued in a first reexamination proceeding, neither the third party requester, nor its privy, may file a subsequent request for an *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued, unless authorized by the Director of the USPTO. In addition, the patent owner is not entitled to file any *inter partes* reexamination request (see MPEP § 2612). Thus, only a third party who is not a party to the earlier pending inter partes reexamination proceeding (nor a privy) can file the subsequent *inter partes* reexamination request.

(1)(b) The subsequent request is an *ex parte* reexamination request. **Any party (including the patent owner) can file the subsequent *ex parte* reexamination request.** (Emphasis added)

MPEP 2686.01 I. WHEN PROCEEDINGS ARE MERGED states (in part):

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

II. Issues Raised and Relief Requested as to 37 CFR 1.181 Petition to Withdraw Decision to Merge Reexamination Proceedings Under 37 CFR 1.989

Patent owner asserts, without citation to any statutory authority, that the December 30, 2009 decision merging the '1080 and 1183 *inter partes* proceedings and the '10623 *ex parte* proceeding was improper, because patent owner feels the *inter partes* third party requesters are receiving an expansion of their third party comment rights that places patent owner in an unfair position.

Patent owner requests, as a remedy, either withdrawal of the December 30, 2009 merger decision or in the alternative a modification of the December 30, merger decision that prevents the *inter partes* requesters from commenting on all issues raised in the '10623 *ex parte* reexamination proceeding.

The '1080 third party requester opposes patent owner's February 26, 2010 petition asserting that merger of the present proceedings are in accordance with the statutory mandate of special dispatch, the relevant regulatory requirements of 37 CFR 1.989 and Office policy. The '1080 third party requester further notes that patent owner's alternative relief, in addition to being unnecessary, would be contrary to the statutory mandate of special dispatch.

The '1080 third party requester therefore requests that patent owner's request relief be denied and the merger of the proceeding be maintained.

III. Findings and Analysis as to 37 CFR 1.181 Petition to Withdraw Decision to Merge Reexamination Proceedings Under 37 CFR 1.989

A. Findings:

<u>*Ex parte* Reexamination.</u> The *ex parte* reexamination provisions, 35 U.S.C. 302 *et seq.*, permits any member of the public to file a request for reexamination.[2] The *ex parte* reexamination statutory provisions protect a patent owner from harassment by requiring the establishment of substantial new question of patentability (SNQ) as a prerequisite for the Director ordering reexamination.[3] The Director, by statutory mandate, is required to make a determination that a request raises an SNQ.[4] The Director conducts examination of the ordered ex *parte*

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[2] See 35 U.S.C. 302.
[3] See 35 U.S.C. 303.
[4] Id. at 303(a).

reexamination, in accord with the statutory mandate of special dispatch, so that all issues of patentability are resolved in a timely fashion.[5] The Director has the discretion to consolidate, i.e., merge, the ordered *ex parte* reexamination proceedings with other ordered *ex parte* reexamination proceedings.[6] The Director exercises this statutory authority in the interests of the public and all parties concerned to resolve all issues of patentability in a compact and consistent manner. Finally, the patent owner retains the right to appeal any decision in a reexamination proceeding which is adverse to the patentability of any original or proposed amended or new claim.[7]

Inter Partes Reexamination. The *inter partes* reexamination provisions, 35 U.S.C. §§ 311 *et seq.*, provide analogous rights to the public and analogous authority to the Director as in the *ex parte* reexamination provisions. For example, pursuant to 35 U.S.C. 314(c) *inter partes* reexamination proceedings must be conducted with special dispatch, and the Director has the discretion to consolidate, i.e., merge, the ordered *inter partes* reexaminations with ordered ex *parte* reexamination proceedings and/or *inter partes* reexaminations.[8] The *inter partes* reexamination provisions also provides third party requesters additional opportunities to participate in the patent reexamination procedure, as compared to *ex parte* reexamination procedures. Specifically, the *inter partes* reexamination statute permits third-party requesters (i) to submit a written comment each time the patent owner files a response to an "action on the merits" issued by the Office; (ii) to appeal an adverse decision of the patent examiner to the Board of Patent Appeals and Interferences (BPAI) and then to the court; and (iii) to have full participation rights in a patent owner's appeal to the BPAI and to the court.[9] In return for these expanded opportunities to comment, *inter partes* proceedings estop a third party requester from later asserting in a civil action, or in a subsequent *inter partes* reexamination, the invalidity of any claim found valid and patentable on any ground the third-party requester raised or could have raised in the *inter partes* reexamination.[10]

B. Analysis and Discussion:

Reexamination of the '783 patent has been ordered in the '10623 *ex parte* proceeding and the '1080 and '1183 *inter partes* proceedings, and the proceedings have been merged. The first issue to be decided is whether merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where both *inter partes* requests were filed and ordered before the filing of an *ex parte* request and where one of the *inter partes* requesters is the same party that filed the *ex parte* request. The second issue to be decided is whether patent owner is entitled to a modification of the December 30, merger decision to prevent the *inter partes* requesters from commenting on all issues raised in the '10623 *ex parte* reexamination proceeding.

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[5] See 35 U.S.C. 305; See also Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1998).
[6] See 37 CFR 1.565(c).
[7] See 35 U.S.C. 306.
[8] See 37 CFR 1.989(a).
[9] Sony, Inc. v. Dudas, 2006 U.S. Dist. LEXIS 36856, 12-13 (E.D. VA 2006); See also 35 U.S.C. 315(b).
[10] See 35 U.S.C. 317(b).

Initially, it is pointed out that the determination whether to merge reexamination proceedings is an act reserved to the sole discretion of the Office. (See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I.,[11] MPEP 2686.01 IV,[12] MPEP 2283,[13] and MPEP 2286.[14])

The relevant regulation makes it clear that the Office has the discretion to decide whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).[15] The MPEP makes it clear that the decision to merge is within the "sole discretion" of the Office, on a case-by-case basis, to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.[16] Therefore, the Office will exercise its authority to merge co-pending reexamination proceedings for reexamination of the same patent where special dispatch is best served by such a merger. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.[17,18]

In the merger, the Office has the statutory authority to address all issues raised in the merged proceedings, as such facilitates "special dispatch" in all the proceedings. 35 U.S.C. 314(a) states that "[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. 132(a) provides that "the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application." Thus, the Office may use any known relevant patents and printed publications, during the examination of a reexamination proceeding. Furthermore, 35 U.S.C. 312 provides that "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." To the extent that the Office has a right to consider other patents or printed publications, the Office has a right to include, and conduct reexamination based on, such other patents or printed publications.

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[11] "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings."

[12] "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

[13] "However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 305 to conduct reexamination with 'special dispatch.'"

[14] "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

[15] "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 in bold).

[16] Id.

[17] See "Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis."

[18] "[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office." *Id.* at 18902.

In the present proceeding, one third party requester in the proceedings has filed both an *inter partes* reexamination and a later filed *ex parte* reexamination, and another third party requester has filed only an *inter partes* reexamination. In the December 30, 2009 merger, the Office effectively consolidated all issues raised in the three pending proceedings into a single merged proceeding, because the Office concluded merger to be the most efficient way to facilitate "special dispatch" for all the proceedings. The resulting merger permits each requesting party to participate *only* to the extent permitted by the statutes and regulations that govern the proceeding that requester initiated. Thus, in a merged proceeding, the *ex parte* requester possesses no comment rights. On the other hand, the *inter partes* requester possesses comment rights as established by 35 U.S.C. 314(b)(2). 35 U.S.C. 314(b)(2) states that "[e]ach 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...." Therefore, any comments submitted by the *inter partes* third party requesters are entitled to address all the issues raised in the action of the Office or the patent owner's response. Accordingly, patent owner's requests that either the merger must be dissolved, or that third party requesters must be denied their comment rights are both contrary to statute. Patent owner has provided no statutory basis for the alleged impropriety of the merger of the proceedings, and the regulatory basis cited by patent owner is unfounded in light of the above explication of the statutory and regulatory framework. Thus, the December 30, 2009 merger of *inter partes* and *ex parte* reexamination proceedings in this circumstance do not violate any relevant statute or regulation. Accordingly, patent owner's requests cannot be granted.

As to the filing of both an *inter partes* reexamination and an *ex parte* reexamination by one party, the *ex parte* reexamination was filed significantly later in time than the *inter partes* reexamination. The later *ex parte* reexamination filing has been made in keeping with the spirit and intent of the following discussion set forth during the rule making process regarding proposed rule 37 CFR § 1.948, which governs the submission of prior art by a third party requester in an *inter partes* reexamination proceeding:

> Later submissions of previously known or available prior art would only be permissible to rebut a position taken by the examiner or the patent owner, or through the filing of an *ex parte* reexamination request (which, if ordered, would be merged with the *inter partes* reexamination proceedings).[19]

This is not a situation where the same party filed the first reexamination request, and immediately thereafter filed a second request before the first request was ordered. Rather, this is a situation where prosecution of the first reexamination had advanced and then the requesting party presented art via a second request as discussed above. In this situation, the Office has determined within its sole discretion that "special dispatch" is best served by simply consolidating the newly presented art, and issues raised by same, with the currently pending *inter partes* reexaminations of the patent (to provided a 3-way merged reexamination proceeding).

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[19] Federal Register, Vol. 65, No. 67, 18154, 181164 (2000).

Therefore, for all the reasons set forth above, the merged proceeding is proper and in accordance with the relevant statues, rules and Office policies and will continue as a merged proceeding. The merger does not place a patent owner in an unfair position, but instead promotes benefit to all interested parties, by promoting special dispatch so that resolution of all raised SNQs as to patent owner's patent rights due to the multiple reexamination proceedings, will be more quickly resolved. Accordingly, patent owner's February 26, 2010 petition is denied.

CONCLUSION

1. Patent owner's February 26, 2010 petition is denied.

2. This decision is designated as a final agency action under 5 U.S.C. § 704.

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

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

4. Jurisdiction over the merged reexamination files is returned to the Central Reexamination Unit (CRU).

5. Any questions 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

7-26-10
kenpetmerger

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 02/18/2011
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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Date: [illegible] 8 2009

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
AKIN GUMP STRAUSS HAUER & FELD, LLP
P.O. BOX 130688
DALLAS, TX 75313-0688

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001183
PATENT NO. : 7321783
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date MAILED
8 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001080
PATENT NO. : 7321783
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 Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
FEB 18 2011
CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010623
PATENT NO. : 7321783
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

(For Patent Owner)

MAILED

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002

(For '1080 *Inter Partes* &. '10623 *Ex Parte* Requester)

CENTRAL REEXAMINATION UNIT

Akin, Gump, Strauss, Hauer & Feld LLP
P.O. Box 130688
Dallas, TX 75313-0688

(For '1183 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,080
Filed: September 9, 2008
For: U.S. Patent No. 7,321,783

Inter Partes Reexamination Proceeding
Control No. 95/001,183
Filed: April 29, 2009
For: U.S. Patent No. 7,321,783

Ex Parte Reexamination Proceeding
Control No. 90/010,623
Filed: July 28, 2009
For: U.S. Patent No. 7,321,783

DECISION ON PETITIONS

This is a decision on the following petitions requesting waiver of 37 CFR 1.943(b):

(1) Petition filed on December 6, 2010 by patent owner entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.183 TO WAIVE THE PAGE LIMIT PROVISIONS OF 37 CFR 1.943(b)."

(2) Petition filed on January 5, 2011 by the 95/001,183 third party requester (ALLTEL Communications, LLC,, hereinafter "ALLTEL") entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR 1.183 TO WAIVE THE PAGE LIMIT PROVISIONS OF 37 CFR 1.943(b)."

The patent owner's petition, the third party requester ALLTEL's petition and the merged proceeding are before the Office of Patent Legal Administration.

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is granted to the extent that the page limit for patent owner's response is extended to not exceed 83 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

Third party requester ALLTEL's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester is granted to the extent that the page limit for written comments by third party requester ALLTEL is extended to not exceed 63 pages in length.

REVIEW OF THE RELEVANT FACTS

1. U.S. Patent No. 7,321,783 (the '783 patent) issued to Ki Il Kim on January 22, 2008.

2. On September 9, 2008, a first request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1, /2), 58 (/27,/39,/55), 70, 76-78, 79 (/27,/55,/70,/76,/77,/78), 80 (/1,/2,/76), 83, 85 (/32), 87 (/1, /2), 89 (/1,/2,/76), 106-107, 111, 118, 119 (/70,/118), and 120-123, was filed by third party requester and real party in interest, Apple Inc. The request was assigned control number 95/001,080 (the ' 1080 proceeding).

3. On November 29, 2008, *inter partes* reexamination was ordered on the claims requested in the '1080 proceeding based on the examiner's determination that the September 9, 2008 request raised a substantial new question of patentability.

4. On February 24, 2009, a non-final Office action was mailed in the ' 1080 proceeding, rejecting claims 1-5, 7-8, 10, 13-17, 19-20, 27-28, 29(/27), 30 (/27), 32, 39, 43, 46, 55, 57 (/1,/2), 58 (/27,/39,/55), 70, 76-78, 79 (/27,/55,/70,/76,/77,/78), 80 (/1,/2,/76), 83, 85 (/32), 87 (/1,/2), 89 (/1,/2,/76), 106-107, 111, 118, 119 (/70,/118), and 120-123 of the '783 patent.

5. On April 23, 2009, patent owner timely filed, in the '1080 proceeding, an amendment and response to the February 24, 2009 Office action, presenting new claims 126-150. No claims were amended or canceled.

6. On April 29, 2009, a second request for *inter partes* reexamination of the '783 patent, on claims 1-5, 7-8, 10-21, 27-31,43, 45 (/43), 46, 48 (/46), 49, 51, 53, 55, 56, 57 (/1,/2,/27, /43,/46,/51,/56), 58 (/27,/43,/46,/51,/55), 59-78, 79 (/27,/43,/46,/55,/56,/61,/64,/66, /70,/74,/76,/77,/78), 80 (/1,/2,/27,/46,/51,/55,/61,/66,/72,/73,/74,/77), 81(/51,/74, /76,/77,/78), 83, 85 (/51), 86, 87 (/1,/2,/51,/73,/74,/77), 88 (/51), 89 (/1,/2,/27,/43,/46, /55,/56,/61,/64,/66,/70,/72,/73,/74,/76,/77,/78), 90-101,106-107, 111, 114-119 and 121-125,

was filed by third party requester and real party in interest, ALLTEL. The request was assigned control number 95/001,183 (the '1183 proceeding).

7. On June 4, 2009, third party requester Apple, Inc., timely filed in the '1080 proceeding written comments.[1]

8. On July 21, 2009, *inter partes* reexamination was ordered on the claims requested in the '1183 proceeding, based on the examiner's determination that the April 29, 2009 request raised a substantial new question of patentability.

9. On July 28, 2009, an *ex parte* request for reexamination of the '783 patent, on claims 18 (/16, /1), 18 (/16,/2), 33(/32), 34 (/33,/32), 35 (/32), 36 (/32), 40 (/39), 42, 48 (/46), 50, 52 (/50), 54 (/50), 82 (/1,/2,/55,/76), 84 (/50), 88 (/50), 102 (/42), 103 (/42), 104, 105 (/104), 108 (106), 109 (/106), 110 (/108), 110 (/109), and 112-113, was filed by the first *inter partes* requester, Apple Inc. The request was assigned control number 90/010,623 (the '10623 proceeding).

10. On August 28, 2009, *ex parte* reexamination was ordered on the claims requested in the '10623 proceeding, based on the examiner's determination that the July 28, 2009 request raised a substantial new question of patentability.

11. On December 30, 2009, the Office *sua sponte* merged the '1080 and '1183 *inter partes* proceedings and the '10623 *ex parte* proceeding (the merged proceeding). The decision also implemented a rejection under 35 USC 112, second paragraph requiring patent owner to place the same claim sets in all three, now merged, proceedings.

12. On October 6, 2010, the Office mailed a non-final Office action, rejecting claims 1-5, 7-8, 10-21, 27-32, 33, 34(/33,/32), 35(/32), 36(/32), 39, 40(/39), 42-43, 45(/43), 46, 48(/46), 49-51, 52(/50), 53, 54(/50), 55-56, 57(/1,/2,/27,/43,/46,/51,/56), 58(/27,/39,/43,/46, /51,/55), 59-78, 79(/27,/43,/46,/55,/56,/61,/64,/66,/70,/74,/76,/77,/78), 80(/1,/2,/27,/46,/51,/55,/61,/66,/72,/73,/74,/77), 81(/51,/74,/76,/77,/78), 82(/1,/2,/55,/76), 83, 84(/50), 85(/32,/51), 86, 87(/1,/2,/51,/73,/74,/78), 88(/50,/51), 89(/1,/2,/27,/43,/46,/55,/56,/61,/64,/66,/70,/72,/73,/74,/76,/77,/78), 90-101,102(/42), 103(/42), 104, 105(/104), 106-107, 108(/106), 109(/106), 110(/108), 110 (/109), 111-125 and 126-150. Claims 6 (/5/1), 6 (/5/2), 9(/1), 9(/2), 22-26, 37, 38, 41 (/39), 41(/40/39), 44(/43), 45 (/44/43), 47, 48 (/47/46), 52 (/51), 54 (/51), 57 (/22), 57(/32), 57(/39), 57 (/42), 57(/50), 58(/22), 58(/32), 58(/42), 58(/50), 79(/39), 79(/42), 80(/32), 80(/39), 80(/42), 80(/50), 81(/42), 81(/50), 82(/20/16/1), 82(/20/16/2), 82(/22), 82(/27), 82(/43), 82(/46), 82(/56), 82(/61), 82(/64), 82(/66), 82(/70), 82(/72), 82(/73), 82(/74), 82(/77), 82(/78), 89(/39), 89(/42), 89(/50), I02(/39), and 103(/39) are not subject to reexamination.

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[1] Third party requester's comments were considered timely as patent owner's April 23, 2009 response was non-compliant with regards to 37 CFR 1.943 page limit requirements until May 5, 2009 when the Office issued a waiver of the page limit requirement.

13. On December 6, 2010, the patent owner timely filed a response to the October 6, 2010 non-final Office action, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(b).

14. On January 5, 2011, the third party requester timely filed written comments after the December 6, 2010 patent owner response, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(b).

RELEVANT REGULATIONS AND PROCEDURE

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

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

DECISION

I. Patent Owner's December 6, 2010 Petition Under 37 CFR 1.183

In its instant petition under 37 CFR 1.183, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the October 6, 2010 non-final Office action, and requests that the page limit be extended to 77 pages.[2] Patent owner concurrently filed a response to the non-final Office action with the instant patent owner petition.

In support of its request for waiver of the rule, patent owner argues that additional pages are needed to address the voluminous non-final Office Action.[3] The patent owner asserts that the outstanding Office action is 113 pages long and incorporated by reference the '1080 Request filed on September 8, 2008, the Revised '1183 Request filed on July 6, 2009, the '1080 Comments filed on June 4, 2009 and the '1183 Comments filed on February 26, 2010.[4]

II. Third Party Requester ALLTEL's January 5, 2011 Petition

In its instant petition under 37 CFR 1.183, third party requester ALLTEL requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester ALLTEL's comments filed on January 5, 2011. Third party requester ALLTEL notes that patent owner filed a similar petition for page limit waiver of its response. Third party requester ALLTEL requests a commensurate page limit increase.[5]

In support of its request for waiver of the rule, third party requester ALLTEL argues that additional pages are needed to respond to both the 113 page Office action issued by the examiner on October 6, 2010 and patent owner's 99-page response, not counting exhibits.[6] Third party requester ALLTEL asserts that it "has made an effort to limit the total number of pages in its Comments and thus has only presented a document with 60 total pages (not counting exhibits)."[7]

III. Analysis and Findings

A. Patent Owner Has Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Patent Owner's Response

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's December 6, 2010 response, excluding the amendment to the claims, includes 83 pages which are subject to the 50 page limit.

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[2] Patent owner petition at 2.
[3] *Id.* at 3.
[4] *Id.* at 2.
[5] Third party requester petition at 2.
[6] *Id.* at 2.
[7] *Id.*

The patent owner response is also accompanied by twelve attachments. Attachments 1-4 pertain to declaration evidence under 37 CFR 1.131. Attachments 5-11 are foreign references and their respective translations. Attachment 12 is a statement by the translator.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The twelve attachments do not contain legal arguments and are not counted toward the page limit.

Accordingly, the December 6, 2010 patent owner response *in toto* is 83 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. The October 6, 2010 non-final Office action is 113 pages on its face and incorporates at least 350 pages from the following documents: the '1080 Request filed on September 8, 2008, the Revised '1183 Request filed on July 6, 2009, the 90/010,623 Request filed on July, 28, 2009, the '1080 Comments filed on June 4, 2009 and the '1183 Comments filed on February 26, 2010.

Under the facts and circumstances currently of record in the present reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 83 pages in length is appropriate in the interest of justice.

Accordingly, the patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the patent owner's response to exceed the page limit by up to 33 pages. This waiver makes the patent owner's December 6, 2010 response page-length compliant.

B. Third Party Requester ALLTEL Has Shown the Existence of an Extraordinary Situation Requiring Waiver of the Page Limit Rule For Third Party Requester ALLTEL's Written Comments

The third party requester ALLTEL's instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester ALLTEL's January 5, 2011 written comments include 60 pages of remarks, which are subject to the 50 page limit.

The third party requester ALLTEL's written comments are also accompanied by Exhibits A-C.

Exhibit A, which is a copy of third party requester ALLTEL's opposition to patent owner's November 29, 2010 petition to expunge, is of record in this merged proceeding; therefore, a copy of this opposition does not count toward the page limit.

Exhibit B is a court document containing claim construction by the court for the patent under reexamination in the present proceeding, which does not count toward the page limit.

Exhibit C consists of 3 pages of an Office action in a related *inter partes* proceeding 95/001,191. Page 29 of third party requester ALLTEL's written comments rely on these 3 pages of the 95/001,191 Office action to support its arguments regarding analogous art.

Accordingly, the January 5, 2011 third party requester ALLTEL's comments *in toto* is 63 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 13 pages of arguments in excess of 50 required to complete the third party requester ALLTEL's comments are not unreasonable in this instance, in view of the present facts and circumstances.. It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present merged reexamination proceeding, the third party requester ALLTEL's instant petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester ALLTEL's comments to run 63 pages in length is appropriate in the interest of justice. However, since third party requester ALLTEL has demonstrated that only 63 pages are needed to complete its comments, a commensurate page limit increase to 83 pages, which is being granted to patent owner in this decision, is not required in this instance.

Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester ALLTELL's comments submission to exceed the page limit by up to 13 pages. This waiver makes requester ALLTEL's January 5, 2011 comments submission page-length compliant.

CONCLUSION

1. Patent owner's December 6, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that patent owner's response to the October 6, 2010 Office action not exceed 83 pages in length. This waiver makes the December 6, 2010 patent owner response page-length compliant.

2. Third party requester ALLTEL's January 5, 2011 petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester ALLTEL's comments filed on January 5, 2011 not exceed 63 pages in length. This waiver makes the January 5, 2011 third party requester ALLTEL's comments submission page-length compliant.

3. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2/14/11
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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,080	09/09/2008	7321783	RIK107440A	9118

40401 7590 01/24/2012
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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.
95/001,183	04/29/2009	7321783	RIK107440B	7201

40401 7590 01/24/2012
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,623	07/28/2009	7321783	RK107440C	2837

40401 7590 01/24/2012
Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

JAN 24 2012

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010623
PATENT NO. : 7321783
ART UNIT : 3992

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office
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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

JAN 24 2012

CENTRAL REEXAMINATION UN

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001080
PATENT NO. : 7321783
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
AKIN GUMP STRAUSS HAUER & FELD, LLP
P.O. BOX 130688
DALLAS, TX 75313-0688

Date:
MAILED
JAN 24 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001183
PATENT NO. : 7321783
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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Hershkovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

(For Patent Owner)

MAILED

JAN 24 2012

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg LLP
1000 Louisiana Avenue
53rd Floor
Houston, TX 77002

(For '1080 *Inter Partes* Requester)

Akin, Gump, Strauss, Hauer & Feld LLP
1700 Pacific Avenue, Suite 4100
Dallas, TX 75201-4675

(For '0579 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,080
Filed: September 9, 2008
For: U.S. Patent No. 7,321,783

Inter Partes Reexamination Proceeding
Control No. 95/001,183
Filed: April 29, 2009
For: U.S. Patent No. 7,321,783

Ex Parte Reexamination Proceeding
Control No. 90/010,623
Filed: July 28, 2009
For: U.S. Patent No. 7,321,783

DECISION ON PETITIONS

This is a decision on the following papers:

1) The petition filed 11/10/10 by Patent Owner entitled "Patent Owner's petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the requester's comments in the Image File Wrapper (IFW) record of the merged proceeding".

2) The opposition petition filed 11/29/10 by the '0579 third party requester entitled "Third Party Requester's opposition to Patent Owner's petition under 37 C.F.R. 1.181".

The petitions are considered pursuant to 37 CFR 1.181; No fee is required.

Patent Owner's petition is dismissed as untimely and Third Party Requester's petition is dismissed as moot.

REVIEW OF RELEVANT FACTS

1) U.S. Patent No. 7,321,783 (the '783 patent) issued to Ki Il Kim on January 22, 2008.

2) On September 9, 2008, a first request for inter partes reexamination of the '783 patent, was filed by third party requester and real party in interest, Apple Inc. The request was assigned control number 95/001,080 (the' 1080 proceeding).

3) On November 29, 2008, inter partes reexamination was ordered on the claims requested in the '1080 proceeding based on the examiner's determination that the September 9, 2008 request raised a substantial new question of patentability. On February 24, 2009, a non-final Office action was mailed in the ' 1080 proceeding.

4) On April 23, 2009, patent owner timely filed, in the '1080 proceeding, an amendment and response to the February 24, 2009 Office action.

5) On April 29, 2009, a second request for inter partes reexamination of the '783 patent was filed by third party requester and real party in interest, ALLTEL. The request was assigned control number 95/001,183 (the '1183 proceeding).

5) On June 4, 2009, third party requester Apple, Inc., timely filed in the '1080 proceeding written comments.

6) On July 21, 2009, inter partes reexamination was ordered on the claims requested in the '1183 proceeding, based on the examiner's determination that the April 29, 2009 request raised a substantial new question of patentability.

7) On July 28, 2009, an ex parte request for reexamination of the '783 patent, was filed by the first inter partes requester, Apple Inc. The request was assigned control number 90/010,623 (the '10623 proceeding).

8) On August 28, 2009, ex parte reexamination was ordered on the claims requested in the '10623 proceeding, based on the examiner's determination that the July 28, 2009 request raised a substantial new question of patentability.

9) On December 30, 2009, the Office sua sponte merged the '1080 and '1183 inter partes proceedings and the '10623 ex parte proceeding (the merged proceeding). The decision also implemented a rejection under 35 USC 112, second paragraph requiring patent owner to place the same claim sets in all three, now merged, proceedings.

10) On January 28, 2010, Patent Owner filed a response amending the claims in accordance with the December 30, 2009 merger decision and rejection.

11) On February 26, 2010, the '1183 third party requester filed comments.

12) On August 3, 2010, the PTO mailed a decision expunging improper petitions.

12) On October 6, 2010, the Office mailed a non-final Office action.

13) On November 10, 2010, the present Patent Owner petition was filed.

14) On November 29, 2010, the present Third Party Requester petition was filed.

15) On December 6, 2010, the patent owner timely filed a response to the October 6, 2010 non-final Office action, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(b).

16) On January 5, 2011, the third party requester timely filed written comments after the December 6, 2010 patent owner response, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(b).

17) On February 18, 2011, a decision granting the petitions filed December 6, 2010 and January 5, 2011 was mailed.

DECISION

37 C.F.R. § 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.

In view of the relevant facts above, Patent Owner's petition filed November 10, 2010 is untimely.

Patent Owner seeks to expunge the First Comments, made on June 4, 2009, and the Second and Third Comments, made on February 26, 2010. Patent Owner's petition is also responsive to the August 3, 2010 PTO decision expunging improper petitions. Patent Owner's petition filed November 10, 2010 is filed more than two months past any of these critical dates.

Accordingly, Patent Owner's petition is dismissed as untimely. Third Party Requester's opposition petition is therefore moot in view the dismissal of Patent Owner's petition.

CONCLUSION

1. Patent Owner's petition is **Dismissed** as untimely. Third Party Requester's petition is **MOOT** in view of the dismissal of Patent Owner's petition.

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered

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

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

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

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

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,083	10/01/2008	6991483	8157.013.RXUS00	1620

50659 7590 08/06/2010

BUTZEL LONG
IP DOCKETING DEPT
350 SOUTH MAIN STREET
SUITE 300
ANN ARBOR, MI 48104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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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

AUG 06 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001083
PATENT NO. : 6991483
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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BUTZEL LONG
IP DOCKETING DEPT
350 SOUTH MAIN STREET
SUITE 300
ANN ARBOR, MI 48104

(For Patent Owner)

MAILED

AUG 06 2010

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Requester)

In re Milan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,083
Filed: October 1, 2008
For: U.S. Patent No. 6,991,483

: **DECISION DISMISSING**
: **PATENT OWNER PETITION**
: **UNDER 37 CFR 1.182 AND**
: **THIRD PARTY REQUESTER**
: **OPPOSITION**

This is a decision (a) on the June 16, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION" and (b) on the July 9, 2010 third party requester opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITIONS REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION."

The patent owner petition and third party requester opposition are before the Office of Patent Legal Administration.

For the reasons set forth below, the petition and opposition are **dismissed.**

FEES

The requisite petition fee for a petition under 37 CFR 1.182 is $400.00 pursuant to 37 CFR 1.17(f). The $400.00 fee has been paid for the June 16, 2010 patent owner petition under 37 CFR 1.182 and the July 9, 2010 third party requester opposition under 37 CFR 1.182.

BACKGROUND

1. On January 31, 2006, the Office issued U.S. Patent No. 6,991,483 (the '483 patent) to Milan et al.

2. On October 1, 2008, a request for *inter partes* reexamination of the '483 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,083 (hereinafter '1083).

3. On October 8, 2008, the Office issued a notice of the filing of the '1083 *inter partes* reexamination with an assigned filing date of October 1, 2008.

4. On November 28, 2008, the Office issued an order granting the '1083 *inter partes* reexamination request, with an accompanying first Office action on the merits rejecting claims 1-5, 13, and 14. Reexamination was not requested for patent claims 6-12.

5. On December 29, 2008, patent owner filed a response retaining original claims 1-5, 13, and 14 as not amended and adding new claims 15-17.

6. On June 26, 2009, the Office mailed a Notice of Defective Paper. The Notice stated that the December 29, 2008 amendment did not comply with 37 CFR 1.530.

7. On July 27, 2009, patent owner filed a corrected amendment.

8. On August 26, 2009, third party requester timely filed comments under 37 CFR 1.947.

9. On September 23, 2009, the Office mailed an Action Closing Prosecution (ACP) rejecting original claims 1-5, 13, and 14, and newly added claims 15-17.

10. On October 23, 2009, patent owner filed a petition entitled "PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION OR ENTRY OF AMENDMENT AFTER ACTION CLOSING PROSECUTION," that was accompanied by a response to the ACP that included a proposed amendment amending claims 1-4, and 13, cancelling claims 5, and 15-17 and adding claims 18-26, and a declaration of Mr. Henry Milan and Mr. John C. Beard attached as Exhibit A.

11. On November 23, 2009, third party requester filed comments under 37 CFR 1.951.

12. On December 2, 2009, the Office mailed a decision dismissing the October 23, 2009 petition under 37 CFR 1.182 as being premature.

13. On February 19, 2010, the Office mailed a Right of Appeal Notice (RAN) denying entry of the October 23, 2009 proposed amendment. The RAN stated that (1) the amendment raised new issues that would require further search and consideration, (2) the amendment added new claims without cancelling a corresponding number of finally rejected claims, (3) the amendment was not deemed to place the application in better form for appeal by materially

reducing or simplifying the issues for appeal, and (4) the declaration of Mr. Henry Milan and Mr. John C. Beard failed to provide a showing of good and sufficient reasons why the declaration was necessary and not earlier presented.

14. On March 17, 2010, patent owner filed a Notice of Appeal.

15. On March 17, 2010, patent owner filed a petition entitled "RENEWED PETITION UNDER 37 CFR 1.181 REQUESTING ENTRY OF AMENDMENT."

16. On March 17, 2010, patent owner filed a petition entitled "RENEWED PETITION UNDER 37 CFR 1.182 REQUESTING CONTINUED REEXAMINATION."

17. On April 26, 2010, the Office mailed a decision dismissing the March 17, 2010 petition under 37 CFR 1.181.

18. On May 14, 2010, the Office mailed a decision dismissing the March 17, 2010 patent owner petition under 37 CFR 1.182.

19. On June 14, 2010, the Office mailed a Notice of Intent to Issue a Reexamination Certificate.

20. On June 16, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION."

21. On June 16, 2010, patent owner filed a petition entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION."

22 .On June 21, 2010, patent owner filed a petition entitled "PETITION UNDER 37 CFR 1.183 REQUESTING EXTENSION OF TIME TO FILE APPEAL BRIEF."

23. On June 30, 2010, patent owner filed an appellant's brief.

24. On July 9, 2010, third party requester filed the instant opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITIONS REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION."

25. On July 27, 2010, the Office mailed a decision dismissing patent owner's petiton for extension of time.

DECISION

I. Third Party Requester's July 9, 2010 Opposition

Third party requester has filed the present opposition, in which:

1) Third party requester opposes the June 16, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION,"[1] and

2) Third party requester opposes the June 16, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING RECONSIDERATION OF DECISION DISMISSING PETITION."[2]

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.

Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. As pointed out above, the present petition includes oppositions to two separate petitions. They are: (1) The opposition to the June 16, 2010 patent owner petition under 37 CFR 1.182 is addressed in the Office of Patent Legal Administration (OPLA), and (2) The opposition to the June 16,2010 patent owner petition under 37 CFR 1.181 is addressed in the CRU by the CRU Director.

Accordingly, it would be required that the two oppostions be made by two separate papers, and the present combined third party requester opposition is dismissed under 37 CFR 1.4(c). It is also to be noted 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 37 CFR 1.182 petition to request continuing reexamination, the granting of which is within the discretion of the Office.

In addition, as stated in the July 27 2010 Office decision dismissing patent owner's petition for an extension of time, the present opposition filed on July 9, 2010 is dismissed, since the instant proceeding is terminated due to patent owner's failure to timely file an appellant brief before May 31, 2010.[3]

II. Patent owner's June 16, 2010 petition under 37 CFR 1.182

As stated above, instant proceeding is terminated due to patent owner's failure to timely file an appellant brief before May 31, 2010.[4] Accordingly, the June 16, 2010 patent owner petition under 37 CFR 1.182 is dismissed.

---

[1] Third party requester opposition at page 1.
[2] *Id.*
[3] July 27, 2010 Office decision at page 4.
[4] *Id.*

CONCLUSION

1. Third party requester's July 9, 2010 opposition and patent owner's June 16, 2010 petition under 37 CFR 1.182 are **dismissed**.

2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,083	10/01/2008	6991483	8157.013.RXUS00	1620

50659 7590 04/18/2011
BUTZEL LONG
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SUITE 300
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EXAMINER
BROWNE, LYNNE HAMBLETON

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
04/18/2011	PAPER

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

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

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HOUSTON, TX 77002

Date:
MAILED
APR 18 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001083
PATENT NO. : 6991483
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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Butzel Long
IP Docketing Dept
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Suite 300
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(For Patent Owner)

MAILED

APR 18 2011

CENTRAL REEXAMINATION UNIT

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, TX 77002

(For Requester)

In re Henry Milan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,083
Filed: October 1, 2008
For: U.S. Patent No. 6,991,483

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

This is a decision on the August 20, 2010 patent owner petition under 37 CFR 1.137(b) to revive the present terminated reexamination proceeding ("the August 20, 2010 patent owner petition to revive").

The August 20, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The August 20, 2010 patent owner petition to revive is **granted**.

Reexamination Certificate No. C1 6,991,483 issued September 14, 2010, for the present proceeding, and the June 14, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) for the present proceeding, are hereby **vacated**.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

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

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

35 U.S.C. 133 provides:

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

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

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

37 CFR 1.137 provides, in pertinent part:

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

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

*
*

(d) *Terminal disclaimer.*

*
*

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

37 CFR 1.953(c) provides:

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

37 CFR 1.957(b) provides:

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

37 CFR 1.958(b) provides:

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

37 CFR 41.63 provides, in pertinent part:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.61 canceling claims may be admitted where such cancellation does not affect the scope of any other pending claim in the proceeding.

(b) All other amendments filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by § 41.77(b)(1).

37 CFR 41.66(a) provides:

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

MPEP 2668 provides, in pertinent part:

II. PETITION BASED ON UNINTENTIONAL DELAY

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

*

*

IV. PETITION REQUIREMENTS

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

MPEP 2674 provides, in pertinent part:

It should be noted that under 37 CFR 41.63(a), amendments filed after the date of filing an appeal (under 37 CFR 41.61) canceling claims may be admitted, where such cancellation does not affect the scope of any other pending claim in the proceeding. However, as to all other amendments filed after the date of filing an appeal, 37 CFR 41.63(b) states that such amendments will not be admitted except as permitted where the patent owner takes action for reopening prosecution under 37 CFR 41.77(b)(1).

MPEP 2675 provides, in pertinent part:

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

DECISION

The Petition Under 37 CFR 1.137(b) is Granted

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

Regarding item (1), the prosecution of the instant *inter partes* reexamination proceeding was terminated within the meaning of 37 CFR 1.957(b) due to patent owner's failure to timely submit a proper response under 37 CFR 1.953(c) to the February 19, 2010 Right of Appeal Notice (RAN). Although patent owner timely filed a Notice of Appeal on March 17, 2010, patent owner failed to timely file an appellant's brief after the March 17, 2010 Notice of Appeal.

Patent owner submitted its appellant's brief on August 20, 2010. The August 20, 2010 appellant's brief was referred to the Board of Patent Appeals and Interferences for review as to its compliance with 37 CFR 41.67 and has been found to be in compliance with the regulation. Further, patent owner was charged the $270.00 37 CFR 41.20(b)(2) fee for filing its brief in support of an appeal on July 1, 2010. Item (1) has thus been satisfied.

A petition fee of $810.00 and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the August 20, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the August 20, 2010 patent owner petition to revive is **granted**.

In this instance, Reexamination Certificate No. C1 6,991,483 issued for the present proceeding on September 14, 2010. Based on the granting of the petition to revive, both the June 14, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) and the reexamination certificate are hereby **vacated**.

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

> All reference to Reexamination Certificate No. C1 6,991,483 to Henry Milan of Rochester Hills, MI (US) et al. for FLASH MEMORY DRIVE WITH QUICK CONNECTOR, appearing in the *Official Gazette* of September 14, 2010, should be deleted, since the reexamination certificate has been vacated.

CONCLUSION

1. The August 20, 2010 patent owner petition to revive under 37 CFR 1.137(b) is **granted**.

2. The termination of the prosecution noted in the June 14, 2010 NIRC, and the NIRC itself, are **vacated**.

3. The *Inter Partes* Reexamination Certificate issued September 14, 2010, is **vacated**.

4. Patent owner's August 20, 2010 appellant's brief is hereby entered in the record, thus triggering the third party requester's right to file a respondent's brief under 37 CFR 41.68. The third party requester may file a respondent's brief within one month of the mailing date of this decision.

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

/Kenneth M. Schor/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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INTELLECTUAL PROPERTY
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ATLANTA, GA 30357-0037

(For second *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,285
Filed: September 21, 2007
For: U.S. Patent No. 7,097,719

Inter Partes Reexamination Proceeding
Control No. 95/001,085
Filed: October 2, 2008
For: U.S. Patent No. 7,097,719

DECISION GRANTING RENEWED PETITION FOR WAIVER OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE

This is a decision on the July 2, 2010 patent owner's petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION" (hereinafter "the renewed petition under 37 CFR 1.183"). The petition requests waiver of the 37 CFR 1.943(b) requirement that patent owner's response to an office action in an *inter partes* reexamination proceeding not exceed 50 pages in length.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

Patent owner's renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

FEES

No fee is required for patent owner's renewed petition.

BACKGROUND

1. U.S. Patent No. 7,097,719 (the '719 patent) issued to Bray *et al.* on August 29, 2006.

2. A first request for *inter partes* reexamination of the '719 patent was filed on September 21, 2007, by a first third party requester, which request was assigned control number 95/000,285 (the '0285 proceeding).

3. On December 19, 2007, *inter partes* reexamination was ordered for the '0285 proceeding.

4. A second request for *inter partes* reexamination of the '719 patent was filed on October 2, 2008, by a second third party requester, which request was assigned control number 95/001,085 (the '1085 proceeding).

5. On December 12, 2008, *inter partes* reexamination was ordered for the '1085 proceeding.

6. On March 24, 2009 the Office mailed a decision ("the merger decision"), *sua sponte*, merging into a single proceeding the '0285 and the '1085 proceedings ("the merged proceeding").

7. The merged proceeding progressed to the point where, on April 1, 2010, the Office issued a non-final Office action in the merged proceeding.

8. On April 26, 2010 patent owner filed a petition entitled "PETITION TO EXCEED THE PAGE LIMIT FOR PATENT OWNER'S RESPONSE IN AN *INTER PARTES* REEXAMINATION" ("the petition under 37 CFR 1.183") to waive the page limit requirements of 37 CFR 1.943(b), concurrently with a request for extension of time pursuant to 37 CFR 1.956.

9. On May 10, 2010, the Office mailed a decision dismissing the patent owner's April 26, 2010 request for extension of time.

10. On May 24, 2010, patent owner filed a second request for extension of time pursuant to 37 CFR 1.956.

11. On May 28, 2010, the Office mailed a decision granting patent owner's second request for extension of time, extending the time period for patent owner's response to the April 1, 2010 Office action to July 1, 2010.

12. On June 30, 2010, the Office issued a decision dismissing the patent owner's April 26, 2010 petition under 37 CFR 1.183 to waive the page limit for its response to the April 1, 2010 Office action.

13. On July 2, 2010, patent owner filed the instant renewed petition under 37 CFR 1.183, to waive the page limit for its response to the April 1, 2010 Office action, concurrently with an "Amendment and Response" to the April 1, 2010 Office action.

14. On August 2, 2010, first third party requester filed comments after patent owner's July 2, 2010 response. Concurrently, on August 2, 2010, second third party requester filed comments after patent owner's July 2, 2010 response.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

Patent Owner's Renewed Petition under 37 CFR 1.183

On June 30, 2010, the Office mailed a decision dismissing patent owner's April 26, 2010 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.943(b). On July 2, 2010, patent owner submitted a response to the April 1, 2010 Office action, concurrently with the renewed petition under 37 CFR 1.183.[1] In the July 2, 2010 renewed petition under 37 CFR 1.183, patent owner states that it believes the July 2, 2010 response is in compliance with the 50-page limit but that "out of an abundance of caution, and in case that the Patent Office concludes that any additional pages of the four declaration[s] should be applied to the page count limit, Patent Owner requests that 37 C.F.R. § 1.943(b) be suspended to allow the submission of a response that exceeds the fifty (50) page limit of that rule."[2]

---

[1] The July 2, 2010 response is accompanied by four declarations subsequently referred to herein as the "Sawtell declaration", the "Goodman declaration", the "Grandt declaration" and the "Bray declaration."
[2] The renewed petition under 37 CFR 1.183 at page 4.

In this instance, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages. Patent owner asserts that it "diligently worked to comply with the 50 page limit, and believe[s] it is in compliance as shown on pages 32-33 of the accompanying Amendment and Response."[3] In addition to the showing, patent owner has also substantiated its request for waiver of the 50-page limit of 37 CFR 1.943(b) with specific facts regarding the length of the April 1, 2010 Office action, the number and nature of rejections, and the number of references relied upon therein.[4]

It has been determined that a total of 69 pages of patent owner's July 2, 2010 response, including the four accompanying declarations, count toward the page limit of 37 CFR 1.943(b). In particular, the remarks portion of the July 2, 2010 response includes 34 pages of arguments,[5] and the four accompanying declarations include approximately 35 pages of arguments that count toward the page limit pursuant to MPEP 2667(I)(A)(2).[6] Thus, the portions of patent owner's July 2, 2010 response, including the portions of the four accompanying declarations, which count toward the page limit, exceed 50 pages by 19 pages.

Based on the specific facts set forth in the renewed petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages), and the individual facts and circumstances of this case (such as the length of the April 1, 2010 Office action),[7] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, the renewed petition under 37 CFR 1.183 is granted to the extent of permitting patent owner's July 2, 2010 response to exceed the page limit by 19 pages. This waiver makes patent owner's July 2, 2010 response page-length compliant.

---

[3] *See* the July 2, 2010 response at pages 32-33, and the renewed petition under 37 CFR 1.183 at page 4 (stating that the remarks portion of the response spans 24 pages (pp. 8-31) and that patent owner believes no pages of the accompanying Bray, Goodman and Grandt declarations count toward the page limit, but that 7 pages of the Sawtell declaration count toward the page limit.)

[4] *See* the renewed petition under 37 CFR 1.183 at pages 2 and 3 (asserting that "[t]he Office Action sets forth eighteen different grounds of rejection"; that the first seventeen grounds of rejection essentially incorporate by reference the '1085 request, the '285 request, the November 19, 2009 comments, and the May 19, 2009 comments; that the eighteen different grounds of rejection are based on several legal theories, including under 35 USC 102, 103, 112 and 314(a); and that the eighteen grounds of rejection cite thirteen references spanning over 350 pages.)

[5] *See, e.g.*, pages 8-31 of the remarks portion of the July 2, 2010 response. Additionally, on page 12 of the July 2, 2010 response, patent owner relies on arguments made on pages 24-30 of its prior response and on pages 15-17 of the previously-submitted "2009 Bray declaration." Although these arguments are not repeated in the body of the July 2, 2010 response itself, the 10 pages on which those arguments appear count toward the page limit because patent owner relies upon them in response to the April 1, 2010 Office action.

[6] *See, e.g.*, pages 6-8 and 12-35 of the Bray declaration, pages 10-11 of the Grandt declaration, and pages 4-6 and 10-12 of the Sawtell declaration. It does not appear that any pages of the Goodman declaration count toward the page limit. *See* MPEP 2667(I)(A)(2) (providing that only those pages of the accompanying affidavits/declarations that contain opinon(s) of the affiant/declarant that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination are counted toward the 50-page limit.)

[7] On its face, the April 1, 2010 Office action spans approximately 22 pages and incorporates by reference approximately 49 pages from the '1085 request, the '285 request, the November 19, 2009 comments, and the May 19, 2009 comments, for a total of 71 pages.

CONCLUSION

1. Patent owner's July 2, 2010 petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 2, 2010 response to the April 1, 2010 Office action to exceed the page limit by 19 pages. This waiver makes patent owner's July 2, 2010 response page-length compliant.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, Office of Patent Legal Administration, at (571) 272-8150 or Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

09-22-2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,088	10/10/2008	6188988	1911-001	2615

20792 7590 08/16/2010

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,088	10/10/2008	6188988	1911-001

EXAMINER
HUGHES, DEANDRA

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039-0460

ART UNIT	PAPER
3992	

DATE MAILED:

MAILED

AUG 16 2010

CENTRAL REEXAMINATION UNIT

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,088	10/10/2008	6188988	1911-001

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DECHERT LLP
P O BOX 390460
MOUNTAIN VIEW, CA 94039-0460

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner) MAILED

AUG 16 2010

CENTRAL REEXAMINATION UNIT

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

(For Third-Party Requester)

Dechert LLP c/o Jonathan D. Loeb
2440 W. El Camino Real, Suite 700
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(For Third-Party Requester)

GOODMAN, ALLEN & FILETTI PLLC
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GLEN ALLEN, VA 23060

In re Barry *et alia* Reexamination Proceeding Control No. 95/001,088 Request Deposited: October 13, 2008 For: U.S. Patent No. 6,188,988	DECISION DISMISSING PETITIONS
In re Barry *et alia* Reexamination Proceeding Control No. 90/009,213 Request Deposited: June 26, 2008 For: U.S. Patent No. 6,188,988	

This is a decision on the April 12, 2010 papers entitled "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL" and "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS". This decision also

addresses the papers filed April 15, 2010 entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" and "PETITION UNDER 37 C.F.R. §1.182 IN OPPOSITION TO PATENT OWNER'S PETITION REQUESTING 'REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS'".

The papers are before the Director of the Central Reexamination Unit for consideration.

The petitions are **dismissed** for the reasons set forth below.

BACKGROUND AND DECISION

Third-Party Requester in *inter partes* control number 95/001,088 filed a Notice of Appeal on January 21, 2010. Patent Owner was not entitled to file a cross appeal as no claims were finally rejected (see 37 CFR 41.61(b)(1)). An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross-appeal, if any party to the proceeding is entitled to file an appeal or cross-appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended (see 37 CFR §41.66(a)). Appellant's brief was due on March 22, 2010 (as March 21, 2010 was a Sunday). The paper filed April 2, 2010 is untimely.

In view of the issuance of the Notice of Intent to Issue Reexamination Certificate mailed August 13, 2010, the petition to dismiss the appeal filed April 12, 2010 is **dismissed as moot**.

Similarly, the petition requesting to refuse to consider arguments presented in the untimely filed paper is **dismissed as moot**. The opposition petition to the petition requesting to refuse to consider arguments is also **dismissed as moot**.

The paper entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" is **dismissed** under 37 CFR 1.4(c). Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Furthermore, it does not appear that 37 CFR 1.812 or 37 CFR 1.813 are the proper rules to cite.

CONCLUSION

1. The petitions filed on April 12, 2010 entitled "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR DISMISSAL OF APPEAL" and "PETITION UNDER 37 C.F.R. §1.182 FOR RELIEF NOT OTHERWISE PROVDED FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS" and the petitions filed on April 15, 2010 entitled "OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R. §1.812 REQUESTING DISMISSAL OF THE APPEAL OR IN THE ALTERNATIVE, PETITION UNDER 37 C.F.R. §1.813 TO SUSPEND THE RULES IN THE INTEREST OF JUSTICE" and "PETITION UNDER 37 C.F.R. §1.182 IN OPPOSITION TO PATENT OWNER'S PETITION REQUESTING 'REFUSAL OF CONSIDERATION OF REQUESTER'S IMPROPER ARGUMENTS'" are **dismissed**.

2. This decision is without prejudice to a request for reconsideration or higher-level review.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or in his absence to Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,089	10/13/2008	7035281	29776.87	3676

7590 08/13/2010

TONY D. ALEXANDER
TECHNOLOGY LEGAL COUNSEL LLC
POST OFFICE BOX 1728
EVANS, GA 30809-1728

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2010

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

Date:

MAILED

AUG 13 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001089
PATENT NO. : 7035281
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 13 2010

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

Tony D. Alexander
TECHNOLOGY LEGAL COUNSEL LLC
Post Office Box 1728
Evans GA 30809-1728

(For Third-Party Requester)

HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re Spearman *et alia*	: DECISION
Reexamination Proceeding	: DISMISSING PETITION
Control No. 95/001,089	:
Request Deposited: October 13, 2008	:
For: U.S. Patent No. 7,035,281	:

This is a decision on the March 15, 2010 paper entitled "PETITION UNDER 37 C.F.R. §1.181" requesting withdrawal of the Defective Appellant Brief mailed on March 1, 2010.

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

The request is **dismissed as moot** for the reasons set forth below.

BACKGROUND AND DECISION

Third-Party Requester (3PR) filed an appeal brief on October 28, 2009 and Patent Owner (PO) filed a respondent brief on November 25, 2009. Both briefs were held to be defective in a Notification of Defective Appellant Brief mailed on March 1, 2010.

3PR petitioned to withdraw the March 1, 2010 notification on March 15, 2010. However, the office issued a new Notification of Defective Appellant Brief on March 29, 2010 which withdrew the March 1, 2010 Notification.

Accordingly, the petition of March 15, 2010 is **dismissed as moot**.

3PR filed a corrected appeal brief on March 31, 2010 which appears to have crossed in the mail with the new Notification of Defective Appellant Brief of March 29, 2010. 3PR subsequently filed a corrected appeal brief on April 26, 2010, which was timely filed in response to the Notification of Defective Appellant Brief of March 29, 2010. The April 26, 2010 is accepted. PO filed a respondent brief on May 10, 2010, which is timely after the appeal brief of April 26, 2010.

The proceeding is forwarded to the examiner to issue an examiner's answer in response to the 3PR appeal brief of April 26, 2010 and the PO respondent brief of May 10, 2010.

CONCLUSION

1. Patent Owner's request is **dismissed as moot**.

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

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

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

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

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

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

for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, Mark Reinhart, at (571) 272-1611, or Jessica Harrison, at (571) 272-4449.

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,095	10/24/2008	7300662	CRDS-0106	8887

45511 7590 09/16/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Michael G. Raucci
SUGHRUE MION PLLC
2100 Pennsylvania Ave., NW, Suite 800
Washington, DC 20037

Date:

MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001095
PATENT NO. : 7300662
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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COMMISSIONER FOR PATENTS
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Joseph Lucci
Woodcock Washburn LLP
Cira Centre
2929 Arch St. 12th Floor
Philadelphia, PA 19104-2891

(For Patent Owner)

MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,095
Filed: October 24, 2008
For: U.S. Patent No. 7,300,662

DECISION DISMISSING REQUEST FOR SUSPENSION AND GRANTING OPPOSITION PETITION TO BE HEARD

This is a decision addressing the June 28, 2010 patent owner's petition under 37 CFR 1.182 requesting suspension of this *inter partes* reexamination proceeding. This decision also addresses third party requester's July 14, 2010 petition to be heard in opposition to patent owner's petition.

The petitions are before the Office of Patent Legal Administration for consideration.

Patent owner's request for suspension is dismissed.
Third party requester's petition to be heard in opposition is granted.

BACKGROUND

1. U.S. Patent 7,300,662 (the '662 patent) issued on November 27, 2007, with claims 1-25. Cordis Corporation is the owner of the '662 patent.

2. There are two civil litigations involving the '662 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07:cv 765 filed November 27, 2007, and (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07:cv 5636 filed November 27, 2007.

3. A request for *inter partes* reexamination of claims 1-25 of the '662 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,095 (the '1095 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-25 of the '662 patent on December 31, 2008.

5. The proceeding then progressed to the point where an action closing prosecution was mailed June 24, 2010.

6. On June 28, 2010, patent owner filed the subject petition requesting suspension of prosecution in this *inter partes* reexamination proceeding. This petition is addressed herein.

7. On July 14, 2010, the third party requester filed a petition to be heard in opposition to patent owner's June 28 petition. This petition is addressed herein.

8. On July 21, 2010, the third party requester filed a notification of decision in concurrent litigation proceedings.

9. On July 26, 2010, patent owner filed comments under 37 CFR 1.951(a) after the action closing prosecution.

10. The issue of confidentiality of certain submitted information in the proceeding has been raised. On July 27, 2010, a decision was mailed dismissing a patent owner request for reconsideration of a request for an extension of time and providing patent owner and the third party requester an opportunity to resubmit their own respective confidential materials for consideration.

11. On July 30, 2010, patent owner filed a miscellaneous letter identifying the four related reexamination proceedings.

12. On August 10, 2010, the patent owner filed a response to the July 27, 2010 decision identifying certain confidential materials. The third party requester has filed no subsequent objection or identification of confidential materials.

13. On August 25, 2010, the third party requester filed comments under 37 CFR 1.951(b) after the action closing prosecution.

DECISION

RELEVANT LAWS AND REGULATIONS

35 U.S.C. 314:

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 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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.

37 CFR 1.985 Notification of prior or concurrent proceedings in inter partes reexamination.

(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 CFR 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this subchapter.
(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-

(1) Striking the offending paper;
(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
(4) Affecting the weight given to the offending paper; or
(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

ANALYSIS AND FINDINGS

Patent owner requests that this proceeding be suspended in favor of the district court litigation identified above (Background, part (2)) and offers these reasons, summarized below:

- The validity of the patent under reexamination "is currently being adjudicated in both the District Courts and ... the Office";
- The issue of secondary considerations of non-obviousness is common to both the district court litigations and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power;
- Patent owner is not able to enter identified evidence in the reexamination proceeding due to the procedural posture taken by the Office and failure to suspend reexamination "in favor of the District Court proceeding" would abridge the patent owner's fundamental right to procedural due process;

- During discovery in the concurrent district court litigations, patent owner identified evidence of secondary considerations that support patentability of its claims, but is confidential to the third party requester and subject to a protective order to which patent owner committed;
- Patent owner began discussion with the third party requester over one year ago regarding submission of the evidence and filed a letter with the district court on April 21, 2010;
- The Office procedures do not provide a mechanism for the patent owner to introduce confidential evidence of patentability;
- Patent owner has a property right in the subject patent and a final determination of invalidity in the reexamination would result in permanent deprivation of patent owner's property right;
- Suspending reexamination will remove this issue of submitting confidential documents from the district court and allow the district court to focus its limited resources on the merits of the case.

Third party requester opposes the petition for suspension and offers these reasons, summarized below:

- Patent owner requests indefinite suspension, which violates the mandate of conducting the proceeding with special dispatch;
- Suspension based on the existence of district court proceedings would eviscerate the *inter partes* reexamination statute for litigated patents (which always permit discovery and consideration of confidential information) and deny requester's statutory right to *inter partes* reexamination, which provides a different burden of proof and no presumption of validity;
- The district court proceedings are inactive, because patent owner's patents have been found invalid on summary judgment based on issues under 35 USC 112, first paragraph;
- Patent owner has repeatedly filed petitions based on the need for requester's confidential information despite the Office March 18, 2010 Decision that stated that further papers and petitions on the issue of filing confidential information will not be entertained;
- The need for requester's confidential discovery documents, expressed by patent owner, is not a source of information typically available to patentees, is cumulative of evidence of record in the proceeding, and has been satisfied by the expert declarations filed in this proceeding;
- Excessive delay has been created by the numerous petitions, yet patent owner opposed a stay of the litigation based on the length of reexamination proceedings;
- Patent owner has not acted diligently to resolve the issue of confidential information.

It is noted that subsequent to the filing of the petition and the opposition, the third party requester filed a notice of concurrent proceedings on July 21, 2010, including a July 20 Letter Order from the District Court of the District of New Jersey denying modification to the protective order *because the request by patent owner was not timely.* The Letter Order indicates that the district court actions were dismissed January 27, 2010, and that fact discovery was closed for over a year prior to the request for modification.

Patent owner has failed to show good cause for suspension of the reexamination proceeding. In fact, there are compelling reasons to go forward with the proceeding. Patent owner requests that the proceeding be suspended ***in favor of the district court proceedings*** and that the confidential information issue can be removed from the court so that the court can focus its resources on the merits of the case. However, the court has already resolved the confidential information issue by denying the patent owner's request for modification based on untimeliness of the request. Additionally, the merits of the case are no longer being addressed by the district courts, as the cases have been terminated, *which patent owner failed to state*. No paper indicating that the cases have been appealed has been filed in the proceeding. Moreover, the patents have been found invalid at present under 35 USC 112, first paragraph, so the issue of secondary considerations relevant under 35 USC 103 does not pertain to the district court proceedings and is not common to the litigation and reexamination proceedings, contrary to patent owner's assertions.

Patent owner's argues that the Office procedures abridge patent owner's right to procedural due process. The Office procedures do not prevent patent owner from filing the requester's confidential information – it is the courts' protective orders, which patent owner voluntarily agreed to be bound by, that prevent patent owner from disclosing the requester's confidential information. Further, the Office imposes no duty that information favorable to patentability be submitted. If patent owner chooses to submit such information, it could have, and should have, availed itself of the courts' procedures in a timely manner to obtain permission.

Patent owner's request to suspend the proceeding is dismissed. Third party requester's request to enter arguments in opposition is granted.

The parties are again reminded of **37 CFR 11.18(b)(1) and (b)(2)** reproduced above (renumbered from 37 CFR 10.18(b)(1) and (b)(2)).

CONFIDENTIAL INFORMATION

Patent owner filed a response to the July 27, 2010 Decision identifying certain information that was previously submitted as its own confidential information, including redacted listings of the information. The redacted listings information can be considered, and may be entered into the record - if the examiner determines that it is material to patentability. However, the prior bulk submission includes the protected information that must be expunged. The original submission is sealed, and the examiner cannot review it, since separating out the non-expunged information would include looking at the expunged information. The original submission must be expunged in its entirety, and patent owner must arrange to have copies of only its own information (the redacted listings) submitted, if patent owner desires the information to be considered.

Patent owner can arrange for retrieval of the original information in order to remove the protected material by following the procedures outlined in the May 26, 2010 Decision. Any other confidential information that was previously submitted will be expunged in accordance with the May 26, 2010 decision.

NOTIFICATION OF CONCURRENT PROCEEDINGS

It is observed that the patent owner has failed to file a notice regarding the concurrent litigation proceedings. The paper filed July 30, 2010 merely identifies related reexamination

proceedings and entirely omits information regarding the district court litigations. The July 27, 2010 decision specifically pointed out that the patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 CFR 1.985(a). The requested paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, was not filed, despite the reliance of the related litigation proceedings in patent owner's petition. See MPEP §§ 2686, 2686.04

CONCLUSION

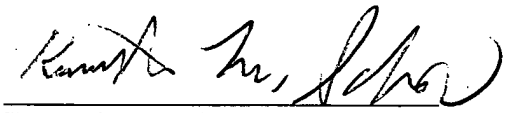
1. Patent owner's June 28, 2010 petition to suspend is dismissed.

2. Third party requester's July 14, 2010 petition to be heard in opposition is granted.

3. The reexamination proceeding will continue with special dispatch within the Office with the next appropriate action.

4. To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

5. Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.



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

9-14-10
Kenpet8/IP/suspend
Kenpet8/expunge/Ct order...

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JAN 21 2011

CENTRAL REEXAMINATION UNIT

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2929 Arch St. 12th Floor
Philadephia, PA 19104-2891

(FOR PATENT OWNER)

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave., Suite 800
Washington, D.C. 20037

(FOR THIRD PARTY REQUESTER)

In re	: DECISION
Reexamination Proceeding	: ON
Control No. : 95/001,095	: REQUESTER'S
Filed: October 24, 2008	: PETITION
Patent No. 7,300,662	: UNDER 37 CFR 1.181

This is a decision addressing Requester's petition, filed January 3, 2011, under 37 CFR 1.181 requesting clarification that requester's submissions regarding alleged "Patent Owner admissions," which were filed as part of Requester's March 1, 2010 comments, are entered in the record of this proceeding.

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is GRANTED to the extent that this decision clarifies that the papers submitted by the requester on March 1, 2010 are entered in the record of this proceeding.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,300,662 (the '662 patent) issued on November 27, 2007.

2. A request for reexamination, assigned Control No. 95/001,095 (the '095 proceeding), was filed by a third party Requester on October 24, 2008.

3. Reexamination was ordered in the '095 reexamination proceeding on December 31, 2008.

4. The proceeding progressed to the point where an Action Closing Prosecution (ACP) was mailed on June 24, 2010. The ACP stated that the Requester's arguments and documents, filed on March 1, 2010, regarding alleged admissions and testimony made in Federal court litigation are noted but will not be addressed. See Pages 2-3 of the ACP.

5. On July 26, 2010, Patent Owner filed a response to the ACP, which included a second declaration by Dr. Mikos.

6. On August 25, 2010, the Requester filed comments on the Patent Owner's response, which includes a second declaration by Dr. Hubbell.

7. On November 18, 2010, the Office mailed a Right of Appeal Notice (RAN). The RAN entered both the Patent Owner's and the Requester's post-ACP responses.

8. On December 17, 2010, the Patent Owner filed a Notice of Appeal.

9. On January 3, 2011, the Requester filed the instant petition under 37 CFR 1.181. The Requester also filed a Notice of Cross-Appeal.

DECISION

The Requester (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to request clarification as to whether the exhibits containing alleged Patent Owner admissions, which were filed on March 1, 2010, are entered into the record. Specifically, the petitioner states the examiner erred in the RAN by stating that the alleged admissions are improper. See, e.g., pages 1-2 of the petition.

Upon review of the record, it is noted that the ACP was the first Office action that addressed the Requester's submission of March 1, 2010 that contained the alleged admissions by the Patent Owner. See pages 2-3 of the ACP. The ACP stated that the submission of the alleged admissions is noted but the alleged admissions will not be specifically addressed. The ACP did not state that the March 1, 2010 response, or any part of the response, was not entered into the record. The RAN maintained the position set forth in the ACP. See page 3 of the RAN, which referred to the ACP. However, the RAN, in further addressing the Requester's arguments filed August 25, 2010, also stated

that the "admissions" are improper. Therefore, the Requester is questioning whether the RAN implied that portions of the March 1, 2010 comments, which contained the alleged admissions, were not entered into the record. The record does not contain any positive statement that the Requester's March 1, 2010 submission, or any part thereof, was not entered into the record.

This decision clarifies that Requester's March 1, 2010 comments and supporting documents are of record in this proceeding. Therefore, the instant petition is granted in that the requested clarification is made in the record of this proceeding.

To the extent that the grounds of argument presented in the petition address the merits of the examiner's determinations, this decision notes that such issues are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of whether the examiner correctly responded to Patent Owner's arguments and evidence are appealable issues, and therefore, cannot be addressed by petition. Therefore, the merits of the examiner's actions in maintaining, withdrawing, or not adopting rejections will not be addressed in this decision.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed January 3, 2011, is **GRANTED** as to the requested clarification of the record, as discussed above.

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

Irem Yücel, Director
Technology Center 1600

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.
95/001,095	10/24/2008	7300662	CRDS-0106	8887

45511 7590 08/30/2011

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

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 Abbott Laboratories
v.
Cordis Corporation and Wyeth

Reexamination Control No. 95/001,095
Patent 7,300,662
Technology Center 3900

DECISION ON PETITION

This is a decision on "Requester's Petition under § 1.182 to Strike Patent Owner's Untimely Request for Oral Hearing and Contingent Request for Withdrawal of Requester's Oral Hearing Request," filed July 20, 2011 ("Present Petition"). Petitioner requests that the Office strike patent owner's request for oral hearing as not being timely filed. Petitioner also contingently requests that if patent owner's request for oral hearing is stricken, then the requester's oral hearing request be withdrawn. The

petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on August 23, 2011.

FINDINGS

1. On October 24, 2008, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,300,662, which was assigned Control No. 95/001,095.
2. On December 31, 2008, reexamination was ordered and a non-final action was mailed.
3. Prosecution was conducted and on November 18, 2010, a Right of Appeal Notice was mailed.
4. Patent owner filed a Notice of Appeal on December 17, 2010, and requester filed a Notice of Cross-Appeal on January 3, 2011.
5. Patent owner and requester both filed appellant briefs on March 3, 2011.
6. Patent owner filed a respondent brief on April 1, 2011, and requester filed a respondent brief on April 4, 2011.
7. On April 27, 2011, an examiner's answer was mailed.
8. Patent owner and requester both filed rebuttal briefs on May 27, 2011.
9. Requester filed a request for oral hearing on June 27, 2011.
10. Patent owner filed a request for oral hearing on June 29, 2011.
11. Requester filed the present petition on July 20, 2011.

RELEVANT AUTHORITY

37 C.F.R. § 1.182 provides:

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

37 C.F.R. § 41.73 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 requests that the Office strike patent owner's request for oral hearing as not being timely filed. It should be noted that a petition to strike another party's submission is only appropriate if a submission is improper. Petitioner also contingently requests that if patent owner's request for oral hearing is stricken, then the requester's oral hearing request be withdrawn. Petitions dependent upon a condition ordinarily will not be addressed on the merits. In the instant *inter partes* reexamination proceeding, the contingency is not a concern for the reasons explained below.

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.

The examiner's answer was mailed on April 27, 2011, and the patent owner's request for oral hearing was filed via the Office's electronic filing system (eFS) on June 29, 2011. Therefore, the request for oral hearing is two days late. The patent owner's request for oral hearing is **not entered**.

Because the patent owner's request for oral hearing is not entered, the present petition is taken as a petition to withdraw the requester's oral hearing request of June 27, 2011. The present petition is **granted**. The requester's oral hearing request is **withdrawn**.

A decision on the appeal will be based on the briefs.

DECISION

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

Jurisdiction of the instant *inter partes* reexamination is returned to the Central Reexamination Unit (CRU) for preparation of the next appropriate Office action in view of the receipt of the rebuttal briefs of May 27, 2011.

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.
95/001,096	10/24/2008	7217286	CRDS-0109	8893

45511 7590 09/16/2010

WOODCOCK WASHBURN LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2010

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David P. Emery
SUGHRUE MION PLLC
2100 Pennsylvania Ave, NW, Suite 800
Washington, DC 20037

Date:
MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001096
PATENT NO. : 7217286
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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COMMISSIONER FOR PATENTS
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Joseph Lucci
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(For Patent Owner)

MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286

DECISION DISMISSING REQUEST FOR SUSPENSION AND GRANTING OPPOSITION PETITION TO BE HEARD

This is a decision addressing the June 28, 2010 patent owner's petition under 37 CFR 1.182 requesting suspension of this *inter partes* reexamination proceeding. This decision also addresses third party requester's July 14, 2010 petition to be heard in opposition to patent owner's petition.

The petitions are before the Office of Patent Legal Administration for consideration.

Patent owner's request for suspension is dismissed.
Third party requester's petition to be heard in opposition is granted.

BACKGROUND

1. U.S. Patent 7,217,286 (the '286 patent) issued on May 15, 2007, with claims 1-5. Cordis Corporation is the owner of the '286 patent.

2. The following civil litigations involve the '286 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv333 filed May 25, 2007 (closed); (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07cv2265 filed May 15, 2007 (closed); (3) *Abbott Laboratories et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv259 filed May 15, 2007 (closed); (4) *Boston Scientific Corporation et al. v. Cordis Corporation et al.*, U.S. District Court of New Jersey, 3:10cv296 filed January 20, 2010 (closed); (5) *Boston Scientific Corporation et al. v. Cordis Corporation et al.*, U.S. District Court of Minnesota, 0:09cv2585 filed September 22, 2009 (closed) .

3. A request for *inter partes* reexamination of claims 1-5 of the '286 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,096 (the '1096 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-5 of the '286 patent on December 22, 2008.

5. The proceeding then progressed to the point where an action closing prosecution was mailed May 28, 2010.

6. On June 28, 2010, patent owner filed the subject petition requesting suspension of prosecution in this *inter partes* reexamination proceeding. This petition is addressed herein.

7. On June 28, 2010, patent owner filed comments under 37 CFR 1.951(a) after the action closing prosecution.

8. On July 14, 2010, the third party requester filed a petition to be heard in opposition to patent owner's June 28 petition. This petition is addressed herein.

9. On July 21, 2010, the third party requester filed a notification of decision in concurrent litigation proceedings.

10. The issue of confidentiality of certain submitted information in the proceeding has been raised. On July 27, 2010, a decision was mailed dismissing a patent owner request for reconsideration of a request for an extension of time and providing patent owner and the third party requester an opportunity to resubmit their own respective confidential materials for consideration.

11. On July 30, 2010, patent owner filed a miscellaneous letter identifying the four related reexamination proceedings.

12. On August 10, 2010, the patent owner filed a response to the July 27, 2010 decision identifying certain confidential materials. The third party requester has filed no subsequent objection or identification of confidential materials.

DECISION

RELEVANT LAWS AND REGULATIONS

35 U.S.C. 314:

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 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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.

37 CFR 1.985 Notification of prior or concurrent proceedings in inter partes reexamination.

(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 CFR 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this subchapter.
(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-

(1) Striking the offending paper;
(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
(4) Affecting the weight given to the offending paper; or
(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

ANALYSIS AND FINDINGS

Patent owner requests that this proceeding be suspended in favor of the district court litigation identified above (Background, part (2)) and offers these reasons, summarized below:

- The validity of the patent under reexamination "is currently being adjudicated in both the District Courts and ... the Office";
- The issue of secondary considerations of non-obviousness is common to both the district court litigations and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power;
- Patent owner is not able to enter identified evidence in the reexamination proceeding due to the procedural posture taken by the Office and failure to suspend reexamination

"in favor of the District Court proceeding" would abridge the patent owner's fundamental right to procedural due process;

- During discovery in the concurrent district court litigations, patent owner identified evidence of secondary considerations that support patentability of its claims, but is confidential to the third party requester and subject to a protective order to which patent owner committed;
- Patent owner began discussion with the third party requester over one year ago regarding submission of the evidence and filed a letter with the district court on April 21, 2010;
- The Office procedures do not provide a mechanism for the patent owner to introduce confidential evidence of patentability;
- Patent owner has a property right in the subject patent and a final determination of invalidity in the reexamination would result in permanent deprivation of patent owner's property right;
- Suspending reexamination will remove this issue of submitting confidential documents from the district court and allow the district court to focus its limited resources on the merits of the case.

Third party requester opposes the petition for suspension and offers these reasons, summarized below:

- Patent owner requests indefinite suspension, which violates the mandate of conducting the proceeding with special dispatch;
- Suspension based on the existence of district court proceedings would eviscerate the *inter partes* reexamination statute for litigated patents (which always permit discovery and consideration of confidential information) and deny requester's statutory right to *inter partes* reexamination, which provides a different burden of proof and no presumption of validity;
- The district court proceedings are inactive, because patent owner's patents have been found invalid on summary judgment based on issues under 35 USC 112, first paragraph;
- Patent owner has repeatedly filed petitions based on the need for requester's confidential information despite the Office March 18, 2010 Decision that stated that further papers and petitions on the issue of filing confidential information will not be entertained;
- The need for requester's confidential discovery documents, expressed by patent owner, is not a source of information typically available to patentees, is cumulative of evidence of record in the proceeding, and has been satisfied by the expert declarations filed in this proceeding;
- Excessive delay has been created by the numerous petitions, yet patent owner opposed a stay of the litigation based on the length of reexamination proceedings;
- Patent owner has not acted diligently to resolve the issue of confidential information.

It is noted that subsequent to the filing of the petition and the opposition, the third party requester filed a notice of concurrent proceedings on July 21, 2010, including a July 20 Letter Order from the District Court of the District of New Jersey denying modification to the protective order *because the request by patent owner was not timely.* The Letter Order indicates that the district court actions were dismissed January 27, 2010, and that fact discovery was closed for over a year prior to the request for modification.

Patent owner has failed to show good cause for suspension of the reexamination proceeding. In fact, there are compelling reasons to go forward with the proceeding. Patent owner requests that the proceeding be suspended ***in favor of the district court proceedings*** and that the confidential information issue can be removed from the court so that the court can focus its resources on the merits of the case. However, the court has already resolved the confidential information issue by denying the patent owner's request for modification based on untimeliness of the request. Additionally, the merits of the case are no longer being addressed by the district courts, as the cases have been terminated, *which patent owner failed to state*. No paper indicating that the cases have been appealed has been filed in the proceeding. Moreover, the patents have been found invalid at present under 35 USC 112, first paragraph, so the issue of secondary considerations relevant under 35 USC 103 does not pertain to the district court proceedings and is not common to the litigation and reexamination proceedings, contrary to patent owner's assertions.

Patent owner's argues that the Office procedures abridge patent owner's right to procedural due process. The Office procedures do not prevent patent owner from filing the requester's confidential information – it is the courts' protective orders, which patent owner voluntarily agreed to be bound by, that prevent patent owner from disclosing the requester's confidential information. Further, the Office imposes no duty that information favorable to patentability be submitted. If patent owner chooses to submit such information, it could have, and should have, availed itself of the courts' procedures in a timely manner to obtain permission.

Patent owner's request to suspend the proceeding is dismissed. Third party requester's request to enter arguments in opposition is granted.

The parties are again reminded of **37 CFR 11.18(b)(1) and (b)(2)** reproduced above (renumbered from 37 CFR 10.18(b)(1) and (b)(2)).

CONFIDENTIAL INFORMATION

Patent owner filed a response to the July 27, 2010 Decision identifying certain information that was previously submitted as its own confidential information, including redacted listings of the information. The redacted listings information can be considered, and may be entered into the record - if the examiner determines that it is material to patentability. However, the prior bulk submission includes the protected information that must be expunged. The original submission is sealed, and the examiner cannot review it, since separating out the non-expunged information would include looking at the expunged information. The original submission must be expunged in its entirety, and patent owner must arrange to have copies of only its own information (the redacted listings) submitted, if patent owner desires the information to be considered.

Patent owner can arrange for retrieval of the original information in order to remove the protected material by following the procedures outlined in the May 26, 2010 Decision. Any other confidential information that was previously submitted will be expunged in accordance with the May 26, 2010 decision.

NOTIFICATION OF CONCURRENT PROCEEDINGS

It is observed that the patent owner has failed to file a notice regarding the concurrent litigation proceedings. The paper filed July 30, 2010 merely identifies related reexamination proceedings and entirely omits information regarding the district court litigations. The July 27, 2010 decision specifically pointed out that the patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 CFR 1.985(a). The requested paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, was not filed, despite the reliance of the related litigation proceedings in patent owner's petition. See MPEP §§ 2686, 2686.04

CONCLUSION

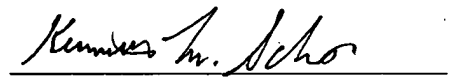
1. Patent owner's June 28, 2010 petition to suspend is dismissed.

2. Third party requester's July 14, 2010 petition to be heard in opposition is granted.

3. The reexamination proceeding will continue with special dispatch within the Office with the next appropriate action.

4. To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

5. Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.



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

9-14-10
Kenpet8/IP/suspend
Kenpet8/expunge/Ct order...

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

MAILED
SEP 28 2010
CENTRAL REEXAMINATION UNIT

(For Patent Owner)

SUGHRUE MION PLLC
2100 PENNSYLVANIA AVE. NW
SUITE 800
WASHINGTON, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No.: 95/001,096
Filed: October 24, 2008
For: U.S. Patent No. 7,217,286 B2

DECISION GRANTING PETITION

This is a decision on the patent owner petition of June 24, 2010, entitled "Petition for Increase of Page Limit for Patent Owner's Response to Action Closing Prosecution Response Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" ("the petition under 37 CFR 1.183").

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition under 37 CFR 1.183 is granted.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 23-3050, as authorized in the concluding paragraph of the present petition.

BACKGROUND

1. U.S. Patent No. 7,217,286 ("the '286 patent") issued to Falotico *et al.* on May 15, 2007.

2. On October 24, 2008, a request for *inter partes* reexamination of the '286 patent was filed by a third party requester, and assigned control number 95/001,096 ("the '1096 proceeding").

3. On December 22, 2008, an Order Granting *Inter Partes* Reexamination was mailed in the

'1096 proceeding, concurrently with a non-final Office action on the merits.

4. The '1096 proceeding progressed to the point where, on May 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. On June 24, 2010, patent owner filed the present petition under 37 CFR 1.183.

6. On June 28, 2010, patent owner filed a response to the ACP ("the June 28, 2010 submission after the ACP").

DECISION

I. Applicable Regulatory Provisions

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. Findings and Analysis

The present 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.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limit on the length of a patent owner submission after the ACP be waived to permit an 80 page response. Pet. at 1. Additionally, on page one of patent owner's June 28, 2010 submission after the ACP, patent owner requests consideration of the present petition in connection with the June 28, 2010 submission after the ACP. In support of waiver of 37 CFR 1.943(b), patent owner states in the present petition that the ACP is "128 pages long and addresses 66 separate grounds of rejection for alleged obviousness that are said to find basis in 18 prior publications and numerous admissions that Patent Owner is alleged to have made in patent prosecution and District Court litigation." Pet at 2. Patent owner further asserts that "50 pages are plainly insufficient for its response to an action of such magnitude and depth" and that "[b]y any

objective standard, 50 pages is not sufficient for a reasoned response to the issues raised...." Pet at 2.

In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the June 28, 2010 submission after the ACP, which submission exceeds the 50-page limit of 37 CFR 1.943(b) by 27 pages.[1] 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 ACP and the number of rejections and references relied upon therein.

Based on the specific facts set forth in the petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit by attempting to draft a response in compliance with the page limit and submitting the June 28, 2010 submission after the ACP (which submission is in excess of 50 pages), and the individual facts and circumstances of this case (e.g., the length of the May 28, 2010 ACP)[2], it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's June 28, 2010 submission after the ACP to exceed the 50-page limit by 27 pages.

Accordingly, patent owner's June 24, 2010 petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to **27 pages** of patent owner's June 28, 2010 submission after the ACP, which are included in the regulatory page count, that exceed the 50-page limit.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's submission after the ACP as set forth in this decision shall not exceed 77 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 28, 2010 submission after the ACP page-length compliant, to file a comments paper pursuant to 37 CFR 1.951(b). *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner'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 patent owner's June 28, 2010 submission after the ACP to exceed the page limit by 27 pages. This waiver makes the patent owner's

[1] Excluded from the page count are the first page of the Patent Owner's June 28, 2010 submission after ACP, which does not include any legal arguments, and the one-page listing of the claims (Appendix A). However, patent owner's June 28, 2010 submission after ACP included a 7-page "Deposition of Leonard Pinchuk, Ph.D.," four pages of which are included in the page count as containing legal arguments.

[2] The substantive portions of the May 28, 2010 ACP span approximately 120 pages.

June 28, 2010 submission after the May 28, 2010 ACP page-length compliant.

2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments to patent owner's submission after the ACP (addressed by this decision) filed by third party requester shall not exceed 77 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins**. Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 28, 2010 submission after the ACP page-length compliant, to file a comments paper pursuant to 37 CFR 1.951(b).

3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole Dretar, Legal Advisor, at 571-272-7717.

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 09/16/2010
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/16/2010

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
SUGHRUE MION PLLC
2100 PENNSYVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 20037

Date:

MAILED

SEP 1 3 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001097
PATENT NO. : 7223286
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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,097	10/24/08	7223286	CRDS-0108

EXAMINER
O'CONNOR, CARY

ART UNIT	PAPER
3993	

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, NW
SUITE 800
WASHINGTON, DC 20037

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

COMMISSIONER FOR PATENTS
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Joseph Lucci
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(For Patent Owner)

MAILED

SEP 1 3 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION DISMISSING REQUEST FOR SUSPENSION AND GRANTING OPPOSITION PETITION TO BE HEARD

This is a decision addressing the June 28, 2010 patent owner's petition under 37 CFR 1.182 requesting suspension of this *inter partes* reexamination proceeding. This decision also addresses third party requester's July 14, 2010 petition to be heard in opposition to patent owner's petition.

The petitions are before the Office of Patent Legal Administration for consideration.

Patent owner's request for suspension is dismissed.
Third party requester's petition to be heard in opposition is granted.

BACKGROUND

1. U.S. Patent 7,223,286 (the '286 patent) issued on May 29, 2007, with claims 1-77. Cordis Corporation is the owner of the '286 patent.

2. The following civil litigations involve the '286 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07:cv 348 filed Jun 1, 2007, and (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07:cv 2477 filed May 29, 2007.

3. A request for *inter partes* reexamination of claims 1-77 of the '286 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,097 (the '1097 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-77 of the '286 patent on December 19, 2008.

5. On June 28, 2010, patent owner filed the subject petition requesting suspension of prosecution in this *inter partes* reexamination proceeding. This petition is addressed herein.

6. On July 14, 2010, the third party requester filed a petition to be heard in opposition to patent owner's June 28 petition. This petition is addressed herein.

7. On July 21, 2010, the third party requester filed a notification of decision in concurrent litigation proceedings.

8. The issue of confidentiality of certain submitted information in the proceeding has been raised. On July 27, 2010, a decision was mailed dismissing a patent owner request for reconsideration of a request for an extension of time and providing patent owner and the third party requester an opportunity to resubmit their own respective confidential materials for consideration.

9. On July 30, 2010, patent owner filed a miscellaneous letter identifying the four related reexamination proceedings.

10. On August 10, 2010, the patent owner filed a response to the July 27, 2010 decision identifying certain confidential materials. The third party requester has filed no subsequent objection or identification of confidential materials.

11. The proceeding has progressed to the point where an action closing prosecution was mailed Sept. 3, 2010 (correcting a prior action mailed August 20, 2010).

DECISION

RELEVANT LAWS AND REGULATIONS

35 U.S.C. 314:

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 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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.

37 CFR 1.985 Notification of prior or concurrent proceedings in inter partes reexamination.

(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 CFR 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this subchapter.
(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-

(1) Striking the offending paper;
(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
(4) Affecting the weight given to the offending paper; or
(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

ANALYSIS AND FINDINGS

Patent owner requests that this proceeding be suspended in favor of the district court litigation identified above (Background, part (2)) and offers these reasons, summarized below:

- The validity of the patent under reexamination "is currently being adjudicated in both the District Courts and ... the Office";
- The issue of secondary considerations of non-obviousness is common to both the district court litigations and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power;
- Patent owner is not able to enter identified evidence in the reexamination proceeding due to the procedural posture taken by the Office and failure to suspend reexamination "in favor of the District Court proceeding" would abridge the patent owner's fundamental right to procedural due process;
- During discovery in the concurrent district court litigations, patent owner identified evidence of secondary considerations that support patentability of its claims, but is confidential to the third party requester and subject to a protective order to which patent owner committed;

- Patent owner began discussion with the third party requester over one year ago regarding submission of the evidence and filed a letter with the district court on April 21, 2010;
- The Office procedures do not provide a mechanism for the patent owner to introduce confidential evidence of patentability;
- Patent owner has a property right in the subject patent and a final determination of invalidity in the reexamination would result in permanent deprivation of patent owner's property right;
- Suspending reexamination will remove this issue of submitting confidential documents from the district court and allow the district court to focus its limited resources on the merits of the case.

Third party requester opposes the petition for suspension and offers these reasons, summarized below:

- Patent owner requests indefinite suspension, which violates the mandate of conducting the proceeding with special dispatch;
- Suspension based on the existence of district court proceedings would eviscerate the *inter partes* reexamination statute for litigated patents (which always permit discovery and consideration of confidential information) and deny requester's statutory right to *inter partes* reexamination, which provides a different burden of proof and no presumption of validity;
- The district court proceedings are inactive, because patent owner's patents have been found invalid on summary judgment based on issues under 35 USC 112, first paragraph;
- Patent owner has repeatedly filed petitions based on the need for requester's confidential information despite the Office March 18, 2010 Decision that stated that further papers and petitions on the issue of filing confidential information will not be entertained;
- The need for requester's confidential discovery documents, expressed by patent owner, is not a source of information typically available to patentees, is cumulative of evidence of record in the proceeding, and has been satisfied by the expert declarations filed in this proceeding;
- Excessive delay has been created by the numerous petitions, yet patent owner opposed a stay of the litigation based on the length of reexamination proceedings;
- Patent owner has not acted diligently to resolve the issue of confidential information.

It is noted that subsequent to the filing of the petition and the opposition, the third party requester filed a notice of concurrent proceedings on July 21, 2010, including a July 20 Letter Order from the District Court of the District of New Jersey denying modification to the protective order *because the request by patent owner was not timely*. The Letter Order indicates that the district court actions were dismissed January 27, 2010, and that fact discovery was closed for over a year prior to the request for modification.

Patent owner has failed to show good cause for suspension of the reexamination proceeding. In fact, there are compelling reasons to go forward with the proceeding. Patent owner requests that the proceeding be suspended ***in favor of the district court proceedings*** and that the confidential information issue can be removed from the court so that the court can focus its resources on the merits of the case. However, the court has already resolved the confidential information issue by

denying the patent owner's request for modification based on untimeliness of the request. Additionally, the merits of the case are no longer being addressed by the district courts, as the cases have been terminated, *which patent owner failed to state*. No paper indicating that the cases have been appealed has been filed in the proceeding. Moreover, the patents have been found invalid at present under 35 USC 112, first paragraph, so the issue of secondary considerations relevant under 35 USC 103 does not pertain to the district court proceedings and is not common to the litigation and reexamination proceedings, contrary to patent owner's assertions.

Patent owner's argues that the Office procedures abridge patent owner's right to procedural due process. The Office procedures do not prevent patent owner from filing the requester's confidential information – it is the courts' protective orders, which patent owner voluntarily agreed to be bound by, that prevent patent owner from disclosing the requester's confidential information. Further, the Office imposes no duty that information favorable to patentability be submitted. If patent owner chooses to submit such information, it could have, and should have, availed itself of the courts' procedures in a timely manner to obtain permission.

Patent owner's request to suspend the proceeding is dismissed. Third party requester's request to enter arguments in opposition is granted.

The parties are again reminded of **37 CFR 11.18(b)(1) and (b)(2)** reproduced above (renumbered from 37 CFR 10.18(b)(1) and (b)(2)).

CONFIDENTIAL INFORMATION

Patent owner filed a response to the July 27, 2010 Decision identifying certain information that was previously submitted as its own confidential information, including redacted listings of the information. The redacted listings information can be considered, and may be entered into the record - if the examiner determines that it is material to patentability. However, the prior bulk submission includes the protected information that must be expunged. The original submission is sealed, and the examiner cannot review it, since separating out the non-expunged information would include looking at the expunged information. The original submission must be expunged in its entirety, and patent owner must arrange to have copies of only its own information (the redacted listings) submitted, if patent owner desires the information to be considered.

Patent owner can arrange for retrieval of the original information in order to remove the protected material by following the procedures outlined in the May 26, 2010 Decision. Any other confidential information that was previously submitted will be expunged in accordance with the May 26, 2010 decision.

NOTIFICATION OF CONCURRENT PROCEEDINGS

It is observed that the patent owner has failed to file a notice regarding the concurrent litigation proceedings. The paper filed July 30, 2010 merely identifies related reexamination proceedings and entirely omits information regarding the district court litigations. The July 27, 2010 decision specifically pointed out that the patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 CFR 1.985(a). The requested paper advising the Office of the status of all related proceedings, including appeals and the status

of the patent claims, was not filed, despite the reliance of the related litigation proceedings in patent owner's petition. See MPEP §§ 2686, 2686.04

CONCLUSION

1. Patent owner's June 28, 2010 petition to suspend is dismissed.

2. Third party requester's July 14, 2010 petition to be heard in opposition is granted.

3. The reexamination proceeding will continue with special dispatch within the Office with the next appropriate action.

4. To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

5. Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

9-14-10
Kenpet8/IP/suspend
Kenpet8/expunge/Ct order...

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,097	10/24/2008	7223286	CRDS-0108	8894

45511 7590 09/29/2010

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

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

Date:

SUGHRUE MION PLLC
2100 PENNSYVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 20037

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001097
PATENT NO. : 7223286
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

SEP 29 2010

CENTRAL REEXAMINATION UNIT

Sughrue Mion PLLC
2100 Pennsylvania Avenue NW
Suite 800
Washington, DC 20037

For 3rd Party Requester

Inter Partes Reexamination Proceeding
Control No. 95/001,097
Filed: October 24, 2008
For: U.S. Patent No. 7,223,286

DECISION ON PETITION

This is a decision on the September 23, 2010, paper titled "PETITION FOR WITHDRAWAL OF ACTION PROSECUTION". The petition will be considered under 37 CFR 1.181.

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

The petition is dismissed as moot for the reasons set forth below.

Decision

The petition filed by the patent owner seeks to have the Action Closing Prosecution (ACP) mailed September 3, 2010 withdrawn. Upon further consideration of the record in the instant reexamination proceeding, the examiner in charge of the proceeding has withdrawn the ACP and issued in its place a non-final Office action that was mailed September 27, 2009, which Office action set a two-month period for response that is to begin with the mailing date of said action. In view of the withdrawal of the ACP and the mailing of a new non-final Office action, the instant petition is dismissed as being moot.

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

Gregory Morse, Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,102	10/24/2008	7,229,473	CRDS-0107 / JJI-51-CON3	8914

EXAMINER

ART UNIT	PAPER NUMBER

45511 7590 09/16/2010

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

DATE MAILED: 09/16/2010

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2100 PENNSYLVANIA AVENUE, N.W.
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WASHINGTON, DC 20037

Date:

MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001102
PATENT NO. : 7229473
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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Joseph Lucci
Woodcock Washburn LLP
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2929 Arch St. 12th Floor
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(For Patent Owner)

MAILED

SEP 16 2010

CENTRAL REEXAMINATION UNIT

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473

DECISION DISMISSING REQUEST FOR SUSPENSION AND GRANTING OPPOSITION PETITION TO BE HEARD

This is a decision addressing the June 28, 2010 patent owner's petition under 37 CFR 1.182 requesting suspension of this *inter partes* reexamination proceeding. This decision also addresses third party requester's July 14, 2010 petition to be heard in opposition to patent owner's petition.

The petitions are before the Office of Patent Legal Administration for consideration.

Patent owner's request for suspension is dismissed.
Third party requester's petition to be heard in opposition is granted.

BACKGROUND

1. U.S. Patent 7,229,473 (the '473 patent) issued on June 12, 2007, with claims 1-5. Cordis Corporation is the owner of the '473 patent.

2. The following civil litigations involve the '473 patent: (1) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Delaware, 1:07cv409 filed June 22, 2007 (closed); (2) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:10cv296 filed January 20, 2010 (closed); (3) *Boston Scientific Corp. et al. v. Johnson & Johnson Inc. et al.*, U.S. District Court of Minnesota, 1:09cv2585 filed September 22, 2009 (closed); (4) *Cordis Corp. v. Abbott Laboratories*, U.S. District Court of New Jersey, 3:07cv2728 filed June 11, 2007 (closed).

3. A request for *inter partes* reexamination of claims 1-5 of the '473 patent was filed October 24, 2008, by third party requester, Abbott Laboratories, and assigned control No. 95/001,102 (the '1102 proceeding).

4. *Inter partes* reexamination was ordered for claims 1-5 of the '473 patent on January 5, 2009.

5. The proceeding then progressed to the point where an action closing prosecution was mailed May 28, 2010.

6. On June 28, 2010, patent owner filed the subject petition requesting suspension of prosecution in this *inter partes* reexamination proceeding. This petition is addressed herein.

7. On June 28, 2010, patent owner filed comments under 37 CFR 1.951(a) after the action closing prosecution.

8. On July 14, 2010, the third party requester filed a petition to be heard in opposition to patent owner's June 28 petition. This petition is addressed herein.

9. On July 21, 2010, the third party requester filed a notification of decision in concurrent litigation proceedings.

10. The issue of confidentiality of certain submitted information in the proceeding has been raised. On July 27, 2010, a decision was mailed dismissing a patent owner request for reconsideration of a request for an extension of time and providing patent owner and the third party requester an opportunity to resubmit their own respective confidential materials for consideration.

11. On July 30, 2010, patent owner filed a miscellaneous letter identifying the four related reexamination proceedings.

12. On August 10, 2010, the patent owner filed a response to the July 27, 2010 decision identifying certain confidential materials. The third party requester has filed no subsequent objection or identification of confidential materials.

DECISION

RELEVANT LAWS AND REGULATIONS

35 U.S.C. 314:

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 1.987 Suspension of inter partes reexamination proceeding due to litigation.

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.

37 CFR 1.985 Notification of prior or concurrent proceedings in inter partes reexamination.

(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 CFR 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this subchapter.
(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that-

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of-

(1) Striking the offending paper;
(2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
(4) Affecting the weight given to the offending paper; or
(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

ANALYSIS AND FINDINGS

Patent owner requests that this proceeding be suspended in favor of the district court litigation identified above (Background, part (2)) and offers these reasons, summarized below:

- The validity of the patent under reexamination "is currently being adjudicated in both the District Courts and ... the Office";
- The issue of secondary considerations of non-obviousness is common to both the district court litigations and the reexamination that can best be decided in court due to the availability in court of discovery and subpoena power;
- Patent owner is not able to enter identified evidence in the reexamination proceeding due to the procedural posture taken by the Office and failure to suspend reexamination "in favor of the District Court proceeding" would abridge the patent owner's fundamental right to procedural due process;

- During discovery in the concurrent district court litigations, patent owner identified evidence of secondary considerations that support patentability of its claims, but is confidential to the third party requester and subject to a protective order to which patent owner committed;
- Patent owner began discussion with the third party requester over one year ago regarding submission of the evidence and filed a letter with the district court on April 21, 2010;
- The Office procedures do not provide a mechanism for the patent owner to introduce confidential evidence of patentability;
- Patent owner has a property right in the subject patent and a final determination of invalidity in the reexamination would result in permanent deprivation of patent owner's property right;
- Suspending reexamination will remove this issue of submitting confidential documents from the district court and allow the district court to focus its limited resources on the merits of the case.

Third party requester opposes the petition for suspension and offers these reasons, summarized below:

- Patent owner requests indefinite suspension, which violates the mandate of conducting the proceeding with special dispatch;
- Suspension based on the existence of district court proceedings would eviscerate the *inter partes* reexamination statute for litigated patents (which always permit discovery and consideration of confidential information) and deny requester's statutory right to *inter partes* reexamination, which provides a different burden of proof and no presumption of validity;
- The district court proceedings are inactive, because patent owner's patents have been found invalid on summary judgment based on issues under 35 USC 112, first paragraph;
- Patent owner has repeatedly filed petitions based on the need for requester's confidential information despite the Office March 18, 2010 Decision that stated that further papers and petitions on the issue of filing confidential information will not be entertained;
- The need for requester's confidential discovery documents, expressed by patent owner, is not a source of information typically available to patentees, is cumulative of evidence of record in the proceeding, and has been satisfied by the expert declarations filed in this proceeding;
- Excessive delay has been created by the numerous petitions, yet patent owner opposed a stay of the litigation based on the length of reexamination proceedings;
- Patent owner has not acted diligently to resolve the issue of confidential information.

It is noted that subsequent to the filing of the petition and the opposition, the third party requester filed a notice of concurrent proceedings on July 21, 2010, including a July 20 Letter Order from the District Court of the District of New Jersey denying modification to the protective order *because the request by patent owner was not timely*. The Letter Order indicates that the district court actions were dismissed January 27, 2010, and that fact discovery was closed for over a year prior to the request for modification.

Patent owner has failed to show good cause for suspension of the reexamination proceeding. In fact, there are compelling reasons to go forward with the proceeding. Patent owner requests that the proceeding be suspended ***in favor of the district court proceedings*** and that the confidential information issue can be removed from the court so that the court can focus its resources on the merits of the case. However, the court has already resolved the confidential information issue by denying the patent owner's request for modification based on untimeliness of the request. Additionally, the merits of the case are no longer being addressed by the district courts, as the cases have been terminated, *which patent owner failed to state*. No paper indicating that the cases have been appealed has been filed in the proceeding. Moreover, the patents have been found invalid at present under 35 USC 112, first paragraph, so the issue of secondary considerations relevant under 35 USC 103 does not pertain to the district court proceedings and is not common to the litigation and reexamination proceedings, contrary to patent owner's assertions.

Patent owner's argues that the Office procedures abridge patent owner's right to procedural due process. The Office procedures do not prevent patent owner from filing the requester's confidential information – it is the courts' protective orders, which patent owner voluntarily agreed to be bound by, that prevent patent owner from disclosing the requester's confidential information. Further, the Office imposes no duty that information favorable to patentability be submitted. If patent owner chooses to submit such information, it could have, and should have, availed itself of the courts' procedures in a timely manner to obtain permission.

Patent owner's request to suspend the proceeding is dismissed. Third party requester's request to enter arguments in opposition is granted.

The parties are again reminded of **37 CFR 11.18(b)(1) and (b)(2)** reproduced above (renumbered from 37 CFR 10.18(b)(1) and (b)(2)).

CONFIDENTIAL INFORMATION

Patent owner filed a response to the July 27, 2010 Decision identifying certain information that was previously submitted as its own confidential information, including redacted listings of the information. The redacted listings information can be considered, and may be entered into the record - if the examiner determines that it is material to patentability. However, the prior bulk submission includes the protected information that must be expunged. The original submission is sealed, and the examiner cannot review it, since separating out the non-expunged information would include looking at the expunged information. The original submission must be expunged in its entirety, and patent owner must arrange to have copies of only its own information (the redacted listings) submitted, if patent owner desires the information to be considered.

Patent owner can arrange for retrieval of the original information in order to remove the protected material by following the procedures outlined in the May 26, 2010 Decision. Any other confidential information that was previously submitted will be expunged in accordance with the May 26, 2010 decision.

NOTIFICATION OF CONCURRENT PROCEEDINGS

It is observed that the patent owner has failed to file a notice regarding the concurrent litigation proceedings. The paper filed July 30, 2010 merely identifies related reexamination

proceedings and entirely omits information regarding the district court litigations. The July 27, 2010 decision specifically pointed out that the patent owner is required to notify the Office of the status of prior and concurrent proceedings in accordance with 37 CFR 1.985(a). The requested paper advising the Office of the status of all related proceedings, including appeals and the status of the patent claims, was not filed, despite the reliance of the related litigation proceedings in patent owner's petition. See MPEP §§ 2686, 2686.04

CONCLUSION

1. Patent owner's June 28, 2010 petition to suspend is dismissed.

2. Third party requester's July 14, 2010 petition to be heard in opposition is granted.

3. The reexamination proceeding will continue with special dispatch within the Office with the next appropriate action.

4. To arrange for pick up of the sealed papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740.

5. Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Legal Advisor, at (571) 272-7729.

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

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(For Third Party Requester)

MAILED
SEP 28 2010
CENTRAL REEXAMINATION

Inter Partes Reexamination Proceeding	: **DECISION**
Control No.: 95/001,102	: **GRANTING**
Filed: October 24, 2008	: **PETITION**
For: U.S. Patent No. 7,229,473 B2	:

This is a decision on the patent owner petition of June 24, 2010, entitled "Petition for Increase of Page Limit for Patent Owner's Response to Action Closing Prosecution Response Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" ("the petition under 37 CFR 1.183").

The petition and the above-captioned *inter partes* reexamination proceeding are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, patent owner's petition under 37 CFR 1.183 is granted.

PETITION FEE

37 CFR 1.183 requires payment of the petition fee under 37 CFR 1.17(f), which is $400.00. Therefore, $400.00 has been charged to patent owner's Deposit Account No. 23-3050, as authorized in the concluding paragraph of the present petition.

BACKGROUND

1. U.S. Patent No. 7,229,473 ("the '473 patent") issued to Falotico *et al.* on June 12, 2007.

2. On October 24, 2008, a request for *inter partes* reexamination of the '473 patent was filed by a third party requester, and assigned control number 95/001,102 ("the '1102 proceeding").

3. On January 5, 2009, an Order Granting *Inter Partes* Reexamination was mailed in the '1102

proceeding, concurrently with a non-final Office action on the merits.

4. The '1102 proceeding progressed to the point where, on May 28, 2010, an Action Closing Prosecution (ACP) was mailed.

5. On June 24, 2010, patent owner filed the present petition under 37 CFR 1.183.

6. On June 28, 2010, patent owner filed a response to the ACP ("the June 28, 2010 submission after the ACP").

DECISION

I. Applicable Regulatory Provisions

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. Findings and Analysis

The present 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.

In the present petition, patent owner specifically requests that the 37 CFR 1.943(b) 50-page limit on the length of a patent owner submission after the ACP be waived to permit a 90 page response. Pet. at 1. Additionally, on page one of patent owner's June 28, 2010 submission after the ACP, patent owner requests consideration of the present petition in connection with the June 28, 2010 submission after the ACP. In support of waiver of 37 CFR 1.943(b), patent owner states in the present petition that the ACP is "extensive and voluminous, is 155 pages long and addresses 82 separate grounds of rejection for alleged obviousness that are said to find basis in 18 prior publications and numerous admissions that Patent Owner is alleged to have made in patent prosecution and District Court litigation." Pet at 2. Patent owner further asserts that "50 pages are plainly insufficient for its response to an action of such magnitude and depth" and that

"[b]y any objective standard, 50 pages is not sufficient for a reasoned response to the issues raised...." Pet at 2.

In this instance, the petitioner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the June 28, 2010 submission after the ACP, which submission exceeds the 50-page limit of 37 CFR 1.943(b) by 42 pages.[1] 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 ACP and the number of rejections and references relied upon therein.

Based on the specific facts set forth in the petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit by attempting to draft a response in compliance with the page limit and submitting the June 28, 2010 submission after the ACP (which submission is in excess of 50 pages), and the individual facts and circumstances of this case (e.g., the length of the May 28, 2010 ACP)[2], it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. In particular, the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's June 28, 2010 submission after the ACP to exceed the 50-page limit by 42 pages.

Accordingly, patent owner's June 24, 2010 petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to **42 pages** of patent owner's June 28, 2010 submission after the ACP, which are included in the regulatory page count, that exceed the 50-page limit.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's submission after the ACP as set forth in this decision shall not exceed 92 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one and a half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 28, 2010 submission after the ACP page-length compliant, to file a comments paper pursuant to 37 CFR 1.951(b). *See* MPEP 2667(I)(A)(2).

CONCLUSION

1. Patent owner'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 patent owner's June 28, 2010 submission after the ACP to exceed the page limit by 42 pages. This waiver makes the patent owner's

[1] Excluded from the page count are the first page of the Patent Owner's June 28, 2010 submission after ACP, which does not include any legal arguments, and the one-page listing of the claims (Appendix A). However, patent owner's June 28, 2010 submission after ACP included a 7-page "Deposition of Leonard Pinchuk, Ph.D.," four pages of which are included in the page count as containing legal arguments.

[2] The substantive portions of the May 28, 2010 ACP span approximately 150 pages.

June 28, 2010 submission after the May 28, 2010 ACP page-length compliant.

2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments to patent owner's submission after the ACP (addressed by this decision) filed by third party requester shall not exceed 92 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins**. Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's June 28, 2010 submission after the ACP page-length compliant, to file a comments paper pursuant to 37 CFR 1.951(b).

3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole Dretar, Legal Advisor, at 571-272-7717.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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(For Patent Owner)

MAILED

JAN 13 2011

CENTRAL REEXAMINATION UNI

Michael G. Raucci
Sughrue Mion PLLC
2100 Pennsylvania Ave. Suite 800
Washington, DC 20037

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,102
Filed: October 24, 2008
For: U.S. Patent No. 7,229,473

DECISION RETURNING IMPROPER PAPERS AND DISMISSING PETITION AS MOOT

This is a decision addressing the Nov. 8, 2010 patent owner's petition to expunge protective order papers pursuant to MPEP § 724. The submission of the Nov. 8, 2010 papers with the Information Disclosure Statement is improper, as the submission does not include a certification that the patent owner has, prior to filing the information, informed the court of its intention to submit the information to the Office in a proceeding that will open the information to unlimited public access, if found to be material to patentability, and that the court has approved such submission. Therefore, the papers will not be entered into the file and will be destroyed within 30 days if pick up of the papers is not arranged by that point in time.

Further, patent owner's Nov. 8, 2010 submission of the protected materials appears to be in blatant violation of prior decisions in this proceeding regarding submission of protected materials. See in particular the May 26, 2010 Decision, which states "Information covered by the court's protective orders is not to be submitted without evidence that permission has been granted for public disclosure of the information. **Further filings that include information covered by a protective order will be expunged until permission for submission has been provided in this proceeding.**" See also, the Decisions mailed July 27, 2010 and September 16, 2010. See also MPEP 2609 which provides:

> 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. For example, it is expected that submissions of papers that are not provided for in the reexamination regulations and/or appear to be excluded by the regulation will either be filed with an appropriate petition to accept the paper and/or waive the

> regulation(s), or not filed at all.... It is expected that the parties will adhere to the provisions of 37 CFR 11.18(b) throughout the course of a reexamination proceeding.

The petition filed with the protective order papers requesting expungement is dismissed as moot, since the papers will not be reviewed by the examiner and will not become part of the proceeding file.

It is also noted that patent owner does not appear to have complied with 37 CFR 1.985(a) despite several reminders regarding the requirement to notify the Office of the status of prior and concurrent proceedings. No notice has ever been filed by patent owner relating to the litigations involving the patent at issue. See MPEP §§ 2686, 2686.04.

To arrange for pick up of the returned papers, telephone inquiries are to be directed to Manuel Saldana at (571) 272-7740. Telephone inquiries with regard to the substance of the decision should be directed to Caroline D. Dennison, Senior Legal Advisor, at (571) 272-7729.

/Kenneth M. Schor/

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

1-7-11
Kenpet8/expunge/Ct order...

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.
95/001,105	11/06/2008	6751696	38512.12	4093

22852 7590 01/28/2011

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901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/28/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,105

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,133

Merged *Inter partes* Reexamination Control 95/001,105 and 95/001,133
Patent 6,751,696

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed December 22, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office expunge Micron's appeal brief from the record because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,133 ...), and because the Examiner did not adopt or maintain those issues in these proceedings." Petition, p. 1.

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

FINDINGS

1. Patent 6,751,696 issued on June 15, 2004 with 60 claims. The '696 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '696 patent on November 6, 2008. Reexamination Control 95/001,105 was assigned to this request.

3. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '696 patent on December 31, 2008. Reexamination Control 95/001,133 was assigned to this request.

4. On January 9, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '105 proceeding.

5. On January 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '133 proceeding.

6. On March 9, 2009, the '105 and '133 proceedings were merged.

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

8. The merged proceeding progressed to the point where, on July 2, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1 and 4.

9. On August 20, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1 and 4.

10. On September 20, 2010, Micron filed a Notice of Appeal for claims 1 and 4.

11. On November 22, 2010, Micron filed an Appeal Brief.

12. On December 22, 2010, Rambus filed a Respondent Brief along with the present Petition.

13. On January 13, 2011, Micron filed Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief ("Opposition").

14. The rejections advanced by Micron in its Appeal Brief that originally were proposed by Samsung were considered by the Examiner during prosecution. In the RAN, the Examiner found claims 1 and 4 patentable over such rejections.

RELEVANT AUTHORITY

35 U.S.C. § 315(b) provides statutory authority for requesters to participate in appeals in *inter partes* reexamination proceedings:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and
> (2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

With respect to issues that can be raised by a requester on appeal, MPEP § 2674(B) specifies that:

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

(emphasis in original).

Concerning the contents of a requester's appellant brief, 37 C.F.R. §§ 41.67(c)(1)(vi) provides:

> (vi) *Issues to be reviewed on appeal.* A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

THE PARTIES' POSITIONS

A. Rambus's Position

Rambus argues that because Micron's Appeal Brief is directed to rejections originally proposed by Samsung and not Micron, the brief should be expunged. Specifically, Rambus contends that:

> Micron filed an appeal brief on November 22, 2010, devoting a majority of its brief (portions of sections VII.D and sections VII.F-VII.H) to Samsung-proposed issues. Micron did not raise these issues in its request for reexamination.

Petition, p. 3.

In support of its argument, Rambus cites MPEP § 2674(B), *Meadwestvaco Packaging Systems, LLC v. Patent of C. Brown Lingamfelter*, Appeal 2009-002578 (BPAI Jan. 12, 2010), and *Vanguard Identification Systems, Inc. v. Patent of Bank of America Corp.*, Appeal 2009-002973 (BPAI Mar, 23, 2010).

Rambus agrees that a rejection adopted by the Examiner may be addressed by a requester on appeal even though that requester did not initially propose the rejection. Petition, pp. 2, 3, 4, 5.

B. Micron's Position

Micron, relying principally on 35 U.S.C. § 315(b), points out that this statutory provision states literally that a requester may appeal **any** decision favorable to patentability. Opposition, p. 4.

Further, with respect to MPEP § 2674, Micron points out that the full text of the relevant paragraph includes the statement that:

> 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, Micron argues:

> [R]ead in full, M.P.E.P. § 2674 merely assures that the third party requester appeals specific final decisions that the third party requester disagrees with instead of merely appealing the general allowability/patentability of a claim.

Opposition, p. 6,

With respect to *Meadwestvaco* and *Vanguard*, Micron argues that the facts in those cases are inapposite to the relevant facts here.

ANALYSIS

A careful reading of the relevant statute (35 U.S.C. § 315(b)) and MPEP section (MPEP § 2674(B)) in such a manner as to give meaning to both suggests that a requester can appeal any decision previously made by the Examiner favorable to patentability irrespective of whether another requester initially raised the issue. This logic is consistent with the agreed upon concept that any requester can address on appeal a rejection that is adopted by the examiner irrespective of the source of the rejection, i.e., the examiner or another requester.

DECISION

In view of the forgoing, 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.
95/001,105	11/06/2008	6751696	38512.12	4093

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,105

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,133

Merged *Inter partes* Reexamination Control 95/001,105 and 95/001,133
Patent 6,751,696

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief," filed February 28, 2011 ("Recon. Petition"). In the Recon. Petition, Patent Owner contends that "the [initial Decision on Petition] is contrary to the statute, prior Board decisions, and the Office's procedures. Thus, Rambus requests that the Director overturn the [initial Decision on Petition] and expunge Micron's appeal brief from the record." Recon. Petition, p. 1.

FINDINGS

1. Patent 6,751,696 issued on June 15, 2004 with 60 claims. The '696 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '696 patent on November 6, 2008. Reexamination Control 95/001,105 was assigned to this request.

3. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '696 patent on December 31, 2008. Reexamination Control 95/001,133 was assigned to this request.

4. On January 9, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '105 proceeding.

5. On January 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '133 proceeding.

6. On March 9, 2009, the '105 and '133 proceedings were merged.

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

8. The merged proceeding progressed to the point where, on July 2, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1 and 4.

9. On August 20, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1 and 4.

10. On September 20, 2010, Micron filed a Notice of Appeal for claims 1 and 4.

11. On November 22, 2010, Micron filed an Appeal Brief.

12. On December 22, 2010, Rambus filed a Respondent Brief along with a Petition to Expunge Micron's Appeal Brief.

13. On January 13, 2011, Micron filed an Opposition to Patent Owner's Petition to Expunge Micron's Appeal Brief.

14. On January 28, 2011, the Board issued a Decision on Petition denying Rambus's Petition to Expunge.

15. On February 28, 2011, Rambus filed the present Recon. Petition.

16. On March 30, 2011, Micron filed an Opposition to the Recon. Petition.

DISCUSSION

As in several other *inter partes* reexamination appeals involving Patent Owner Rambus and Third Party Requester Micron, Rambus has again sought expungement of a Micron brief on the ground that the Micron brief raises patentability issues that were first presented by Samsung. As the Board repeatedly has held, the origin of a patentability issue is immaterial to a requester's right to raise the issue on appeal. *See, e.g.,* Decision on Petition entered April 27, 2011 in merged proceeding 95/000,250 and 95/001,124. Accordingly, further analysis of this issue is not required.

DECISION

In view of the forgoing, the Recon. Petition is DENIED.

James D. Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,105 and 95/001,133
Patent 6,751,696

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95/001,105	11/06/2008	6751696	38512.12	4093

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BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,105

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,133

Merged *Inter partes* Reexamination Control 95/001,105 and 95/001,133
Patent 6,751,696

DECISION ON PETITIONS

This is a decision on:

1. Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed December 22, 2010 ("Rambus Petition"). The Rambus Petition "requests that the Office accept [Patent Owner's] respondent brief, which is 30 pages and 17,898 words in length." Rambus Petition, p.1.
2. "Third Party Requester's Petition Under 37 C.F.R § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c)," filed May 23, 2011 ("Micron

Petition"). The Micron Petition seeks "a limited waiver of 37 C.F.R. § 1.943(c) so that Micron may submit a rebuttal brief up to 10,381 words or 26 pages." Micron Petition, p.1.

FINDINGS

1. Patent 6,751,696 issued on June 15, 2004 with 60 claims. The '696 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '696 patent on November 6, 2008. Reexamination Control 95/001,105 was assigned to this request.

3. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '696 patent on December 31, 2008. Reexamination Control 95/001,133 was assigned to this request.

4. On January 9, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '105 proceeding.

5. On January 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1 and 4 of the '696 patent in the '133 proceeding.

6. On March 9, 2009, the '105 and '133 proceedings were merged.

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

8. The merged proceeding progressed to the point where, on July 2, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1 and 4.

9. On August 20, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1 and 4. The RAN is 98 pages long.

10. On September 20, 2010, Micron filed a Notice of Appeal for claims 1 and 4.

11. On November 22, 2010, Micron filed Third Party Requester's Cross-Appeal Brief Pursuant to 37 C.F.R. § 41.67. Micron's Appeal Brief is 32 pages in length.

12. On December 22, 2010, Rambus filed Patent Owner's Respondent Brief and the present Rambus Petition. Rambus's Respondent Brief is 30 pages and 17,898 words in length.

13. On April 21, 2011, The Examiner entered an Examiner's Answer.

14. On May 23, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 and the present Micron Petition. Micron's Rebuttal Brief is 26 pages and 10,381 words in length.

RELEVANT LEGAL AUTHORITY

With respect to the length of briefs in *inter partes* reexamination proceedings, 37 C.F.R. §§ 1.943(c) specifies:

37 C.F.R. § 1.943(c):

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

(emphasis added).

With respect to waiver of regulations, 37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*,

or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

ANALYSIS

Rambus Respondent Brief

Rambus seeks a waiver of the page/word limits of Rule 1.943(c) for its Respondent Brief. Rambus's Respondent Brief is 30 pages and 17,898 words in length. Thus, the page limit of 15 is exceeded by 15 and the word limit of 7,000 is exceeded by 10,898. The relatively large number of words reflects that Rambus's Respondent Brief is single-spaced.

Micron's Cross-Appeal Brief is 32 pages long with line spacing of one and one-half. Rambus identifies six contested issues presented by Micron's Cross-Appeal Brief to which Rambus must respond in its Respondent Brief – five claim rejections and one priority issue. Rambus Petition, pp. 3-4.

The Office recognizes that in a merged *inter partes* reexamination proceeding, in some circumstances, as are present here, the patent owner may be required to respond in a single brief to issues initially raised by two different third party requesters. However, in determining the appropriateness of a waiver from the page/word limits of Rule 1.943(c), the primary determining factors are the number and complexity of the issues. Here, two claims are the subject of five rejections, based on combinations of six references, and a priority issue. Micron Cross-Appeal Brief, p. 3. In its Cross-Appeal Brief, Micron presented these issues in 32 pages with line spacing of one and one-half. These facts do not present an extraordinary situation for which justice requires a waiver of the maximum respondent

brief word count of 7,000 for a brief containing over two and one-half times that number of words. Rambus's Respondent Brief filed December 22, 2010 will not be considered.

Micron Rebuttal Brief

Micron seeks a waiver of the page/word limits of Rule 1.943(c) for its Rebuttal Brief. Micron's Rebuttal Brief is 26 pages and 10,381 words in length. Thus, the page limit of 15 is exceeded by 11 and the word limit of 7,000 is exceeded by 3,281.

Micron's Rebuttal Brief responds, *inter alia*, to Rambus's Respondent Brief (and the Examiner's Answer). See 37 C.F.R. § 41.71(c).

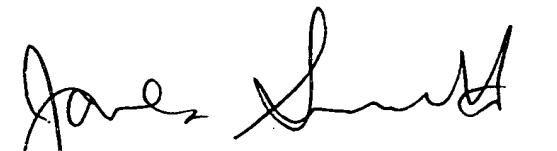
In light of the denial of the Rambus Petition and non-consideration of Rambus's December 22, 2010 Respondent Brief, the Micron Petition will be dismissed as moot and the Micron Rebuttal Brief of May 23, 2011 will not be considered.

DECISION

In view of the foregoing:

The Rambus Petition is DENIED and the Rambus Respondent Brief of December 22, 2010 will not be considered. Rambus is given one month from the mailing date hereof to file a respondent brief in compliance with Rule 1.943(c).

The Micron Petition is DISMISSED and Micron is given one month from the filing date of a replacement respondent brief by Rambus to file a replacement rebuttal brief in compliance with Rule 1.943(c).



James Donald Smith
Chief Administrative Patent Judge

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95/001,106	11/06/2008	6266285	38512.18	4245

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Third Party Requester – *Inter partes* Reexamination Control 95/001,106

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,131

Merged *Inter partes* Reexamination Control 95/001,106 and 95/001,131
Patent 6,266,285

DECISION ON PETITIONS

This is a decision on:

1. Patent Owner's "Petition To Expunge Third-Party Requester's Appeal Brief," filed November 5, 2010 ("Appeal Brief Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed January 6, 2011 ("Appeal Brief Opposition"); and

2. Patent Owner's "Petition to Expunge Third-Party Requester's Respondent Brief," filed December 30, 2010 ("Respondent Brief Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to

Expunge Third Party Requester's Respondent Brief," filed January 14, 2011 ("Respondent Brief Opposition").

FINDINGS

1. Patent 6,266,285 issued on July 24, 2001 with 33 claims. The '285 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '285 patent on November 6, 2008. Reexamination Control 95/001,106 was assigned to this request.

3. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '285 patent on December 31, 2008. Reexamination Control 95/001,131 was assigned to this request.

4. On January 9, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13, 15 and 16 of the '285 patent in the '106 proceeding.

5. On January 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13, 15 and 16 of the '285 patent in the '131 proceeding.

6. On March 9, 2009, the '106 and '131 proceedings were merged.

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

8. The merged proceeding progressed to the point where, on July 2, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1 and 4.

9. On June 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 15 and 16, and rejecting claim 13.

10. On July 22, 2010, Rambus filed a Notice of Appeal.

11. On August 5, 2010, Micron filed a Notice of Cross-Appeal.

12. On October 5, 2010, Rambus filed an Appeal (appellant) Brief and Micron filed a Cross-Appeal (appellant) Brief.

13. On November 5, 2010, Rambus filed a Respondent Brief and the present Appeal Brief Petition.

14. Also on November 5, 2010, Micron filed a Respondent Brief.

15. On December 30, 2010, Rambus filed the present Respondent Brief Petition.

16. On January 6, 2011, Micron filed the present Appeal Brief Opposition.

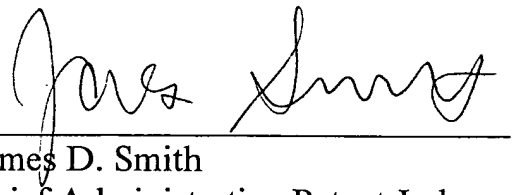
17. On January 14, 2011, Micron filed the present Respondent Brief Opposition.

DISCUSSION

As in several other *inter partes* reexamination appeals involving Patent Owner Rambus and Third Party Requester Micron, Rambus again has sought expungement of Micron briefs on the ground that the Micron briefs raise patentability issues that initially were presented by Samsung. As the Board repeatedly has held, the origin of a patentability issue is immaterial to a requester's right to raise the issue on appeal. *See, e.g.,* Decision on Petition entered April 27, 2011 in merged proceeding 95/000,250 and 95/001,124. Accordingly, further analysis of this issue is not required.

DECISION

In view of the forgoing, the Appeal Brief Petition and the Respondent Brief Petition are DENIED.



James D. 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.
95/001,106	11/06/2008	6266285	38512.18	4245

22852 7590 06/22/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,106

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,131

Merged *Inter partes* Reexamination Control 95/001,106 and 95/001,131
Patent 6,266,285

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Rebuttal Brief," filed June 6, 2011. ("Petition"). Specifically, Patent Owner "requests that the Office waive the requirements of 37 C.F.R. § 1.943(c) limiting rebuttal briefs to 15 pages or 7,000 words in length to the extent that the Office determines that citations to an expert declaration that is part of the record count towards the page limits." Petition, p.1.

FINDINGS

1. Patent 6,266,285 issued on July 24, 2001 with 33 claims. The '285 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '285 patent on November 6, 2008. Reexamination Control 95/001,106 was assigned to this request.

3. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '285 patent on December 31, 2008. Reexamination Control 95/001,131 was assigned to this request.

4. On January 9, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13, 15 and 16 of the '285 patent in the '106 proceeding.

5. On January 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13, 15 and 16 of the '285 patent in the '131 proceeding.

6. On March 9, 2009, the '106 and '131 proceedings were merged.

7. The merged proceeding progressed to the point where, on October 23, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding.

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

9. On June 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 15 and 16, and rejecting claim 13.

10. On July 22, 2010, Rambus filed a Notice of Appeal.

11. On August 5, 2010, Micron filed a Notice of Cross-Appeal.

12. On October 5, 2010, Rambus filed an Appeal (appellant) Brief.

13. Also on October 5, 2010, Micron filed a Cross-Appeal (appellant) Brief.

14. On November 5, 2010, Rambus filed a Respondent Brief.

15. Also on November 5, 2010, Micron filed a Respondent Brief.

16. On June 6, 2011, Rambus filed a Rebuttal Brief along with the present Petition.

17. Also on June 6, 2011, Micron filed a Rebuttal Brief.

RELEVANT LEGAL AUTHORITY

The maximum length of briefs in *inter partes* reexamination proceeding appeals is specified in 37 C.F.R. § 1.943(c):

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

With respect to expert declarations, MPEP § 2667(I)(A)(2) provides:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party

requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of (sic) 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.

The criteria for waiver of a rule is specified by 37 C.F.R. § 1.183:

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

DISCUSSION

Rambus's Rebuttal Brief includes citations to pages of a previously filed declaration of an expert witness. Rambus does not deny that MPEP § 2667 explicitly requires that the pages of a declaration or affidavit that contain patentability arguments and that are cited in a rebuttal brief are to be included in the page count for the brief.

In the present situation, Rambus requests that, to the extent the Office holds that pages of the cited declaration are to be included in the page count for its rebuttal brief, the Office waive the rebuttal brief page limit to permit inclusion of the cited declaration testimony. Petition, p. 1-2.

Rambus also argues that to the extent MPEP § 2667 is applied in determining the page count of its rebuttal brief, the application of such determination violates Rambus's due process rights. Petition, pp. 3-5.

Rambus does not provide any explanation as to why the rebuttal brief page limit imposed by 37 C.F.R. § 1.943(c) – 15 pages – is inadequate in the present situation. Thus, Rambus has failed to demonstrate that good cause exists for waiving the page limit.

Further, in the absence of an extraordinary situation for which justice requires waiver of the page limit, Rambus's due process argument is hypothetical.

DECISION

In view of the forgoing, the Petition is DENIED without prejudice to the filing of a rebuttal brief in conformance with Rule 1.943(c) and/or a renewed petition seeking waiver of the page limit prescribed by the Rule within one month from the mailing date hereof.

James D. Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,107	11/07/2008	6314051	38512.19	6166

22852 7590 06/30/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,107

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,132

Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132
Patent 6,314,051

DECISION ON PETITIONS

This is a decision on:

Patent Owner's "Petition to Expunge Third-Party Requester's Appeal Brief," filed November 4, 2010 ("Appeal Brief Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed January 7, 2011 ("Appeal Brief Opposition"); and

Patent Owner's "Petition to Expunge Third-Party Requester's Respondent Brief," filed December 30, 2010 ("Respondent Brief Petition");

and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Respondent Brief," filed January 14, 2011 ("Respondent Brief Opposition").

FINDINGS

1. On November 6, 2001, the Office issued Patent 6,314,051 ("'051 patent"), which is assigned to Rambus Inc. ("Rambus").

2. On November 7, 2008, Third Party Requester Samsung Electronics Co. Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,107.

3. On December 31, 2008, Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,132.

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

5. On January 22, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

6. On March 6, 2009, the Office merged the 95/001,107 and 95/001,132 proceedings (creating the "merged proceeding").

7. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

8. The merged proceeding progressed to a point where, on June 21, 2010, the Office issued a Right of Appeal Notice, confirming claims 27 and 43, and rejecting claim 34.

9. On July 20, 2010, Rambus filed Patent Owner's Notice of Appeal Under 37 C.F.R. § 41.61.

10. On August 3, 2001, Micron filed Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

11. On October 1, 2010, Rambus filed Patent Owner's Appeal Brief.

12. On October 4, 2010, Micron filed Third Party Requester's Cross Appeal Brief Pursuant to 37 C.F.R. § 41.67.

13. On November 1, 2010, Micron filed Third Party Requester's Respondent Brief Pursuant to 37 C.F.R. § 41.68.

14. On November 4, 2010, Rambus filed Patent Owner's Respondent Brief.

15. Also on November 4, 2010, Rambus filed the present Appeal Brief Petition.

16. On December 30, 2010, Rambus filed the present Respondent Brief Petition.

17. On January 7, 2011, Micron filed the present Appeal Brief Opposition.

18. On January 14, 2010, Micron filed the present Respondent Brief Opposition.

DISCUSSION

Rambus seeks expungement of Micron's Appeal and Respondent Briefs because those briefs present arguments premised on rejections initially proposed by Samsung and not by Micron. As recently discussed in the Decision on Petition entered April 27, 2011 in merged reexamination proceeding 95/000,250 and 95/001,124, involving the same parties that are involved here, the Office has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed rejections that were before the Office at the time of the RAN. In view of the detailed analysis that the Office has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

DECISION

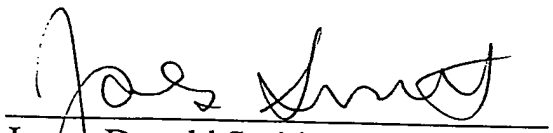
For the forgoing reasons,

Rambus's Appeal Brief Petition is DENIED;

Micron's Appeal Brief Opposition is GRANTED;

Rambus's Respondent Brief Petition is DENIED;

Micron's Respondent Brief Opposition is GRANTED.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,107 and 95/001132
Patent 6,314,051

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,107	11/07/2008	6314051	38512.19	6166

22852 7590 07/13/2011

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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

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,107

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,132

Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132
Patent 6,314,051

DECISION ON PETITIONS

This is a decision on "Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Waiver of 37 C.F.R. § 1.943(c)," filed November 1, 2010 ("Petition"). The Petition requests a "waiver of 37 C.F.R. § 1.943(c) so that Micron may submit a respondent brief up to 8,765 words." Petition, p.1.

FINDINGS

1. On November 6, 2001, the Office issued Patent 6,314,051 ("'051 patent"), which is assigned to Rambus Inc. ("Rambus").

2. On November 7, 2008, Third Party Requester Samsung Electronics Co. Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,107.

3. On December 31, 2008, Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,132.

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

5. On January 22, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

6. On March 6, 2009, the Office merged the 95/001,107 and 95/001,132 proceedings (creating the "merged proceeding").

7. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

8. The merged proceeding progressed to a point where, on June 21, 2010, the Office issued a Right of Appeal Notice, confirming claims 27 and 43, and rejecting claim 34.

9. On July 20, 2010, Rambus filed Patent Owner's Notice of Appeal Under 37 C.F.R. § 41.61.

10. On August 3, 2010, Micron filed Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

11. On October 1, 2010, Rambus filed Patent Owner's Appeal Brief.

12. On October 4, 2010, Micron filed Third Party Requester's Cross Appeal Brief Pursuant to 37 C.F.R. § 41.67.

13. On November 1, 2010, Micron filed Third Party Requester's Respondent Brief Pursuant to 37 C.F.R. § 41.68.

14. Also on November 1, 2010, Micron filed the present Petition.

RELEVANT LEGAL AUTHORITY

With respect to the format of papers filed in reexamination proceedings, 37 C.F.R. §§ 1.943 and 1.52 specify:

37 C.F.R. § 1.943:

(a) **The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.**
(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.
(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

(emphasis added).

37 C.F.R. § 1.52(b)(2):

2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:
(i) **Lines that are 1 1/2 or double spaced;**
(ii) **Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having**

capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6); and

(iii) Only a single column of text.

(emphasis added).

With respect to waiver of regulations, 37 C.F.R. § 1.183 provides:

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

ANALYSIS

Micron seeks a waiver of the page/word limits of Rule 1.943 for its Respondent Brief. Micron's Respondent Brief is 24 pages and 8,675 words in length. Thus, the page limit of 15 pages is exceeded by 9 and the word limit of 7,000 words is exceeded by 1,678.

Rambus's Appeal Brief, to which Micron's Respondent Brief responds, is 30 pages in length. The font size of Rambus's brief appears to be 11 or 12, and the line spacing is single space.

Under Rule 1.52(b)(2), the single space line spacing of Rambus's Appeal Brief is improper.

Micron argues that in order to comprehensively respond to Rambus's Appeal Brief, the excess pages and words are required for its Respondent Brief. The excess pages and words of Micron's Respondent Brief are deemed reasonable in the interest of justice to allow Micron to respond to Rambus's single-space, 30-page Appeal Brief.

At this stage of the appeal, additional and extraordinary delay would ensue by rejecting Rambus's Appeal Brief (single line spacing) and Micron's Respondent Brief (page and word limits exceeded) than by proceeding with the present briefs.

DECISION

In view of the foregoing, Micron's Petition is GRANTED and the Respondent Brief filed November 1, 2010 is accepted.

James Donald Smith
Chief Administrative Patent Judge

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Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,107

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,132

Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132
Patent 6,314,051

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Rebuttal Brief," filed May 23, 2011. ("Petition"). The Petition "requests that the Office waive the requirement of 37 C.F.R. § 1.943(c) limiting rebuttal briefs to 15 pages or 7,000 words in length to the extent that the Office determines that citations to an expert declaration that is part of the record count towards the page limits." Petition, p.1.

FINDINGS

1. On November 6, 2001, the Office issued Patent 6,314,051 ("'051 patent"), which is assigned to Rambus Inc. ("Rambus").

2. On November 7, 2008, Third Party Requester Samsung Electronics Co. Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,107.

3. On December 31, 2008, Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,132.

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

5. On January 22, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

6. On March 6, 2009, the Office merged the 95/001,107 and 95/001,132 proceedings (creating the "merged proceeding").

7. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

8. The merged proceeding progressed to a point where, on June 21, 2010, the Office issued a Right of Appeal Notice, confirming claims 27 and 43, and rejecting claim 34.

9. On July 20, 2010, Rambus filed Patent Owner's Notice of

Appeal Under 37 C.F.R. § 41.61.

10. On August 3, 2010, Micron filed Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

11. On October 1, 2010, Rambus filed Patent Owner's Appeal Brief.

12. On October 4, 2010, Micron filed Third Party Requester's Cross Appeal Brief Pursuant to 37 C.F.R. § 41.67.

13. On November 1, 2010, Micron filed Third Party Requester's Respondent Brief Pursuant to 37 C.F.R. § 41.68.

14. On November 4, 2010, Rambus filed Patent Owner's Respondent Brief.

15. On April 21, 2011, the Examiner entered an Examiner's Answer.

16. On May 23, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 46.71.

17. Also on May 23, 2011, Rambus filed Patent Owner's Rebuttal Brief consisting of 15 pages and 6,965 words in length.

18. Also on May 23, 2011, Rambus filed the present Petition.

RELEVANT LEGAL AUTHORITY

With respect to the length of briefs in *inter partes* reexamination proceedings, 37 C.F.R. §§ 1.943(c) specifies:

37 C.F.R. § 1.943(c):

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

(emphasis added).

With respect to waiver of regulations, 37 C.F.R. § 1.183 provides:

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

With respect to expert declarations and affidavits, MPEP § 2667(I)(A)(2) specifies:

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

ANALYSIS

Rambus seeks a waiver of the page/word limits of Rule 1.943(c) for its Rebuttal Brief. Rambus's Rebuttal Brief is 15 pages and 6,965 words in

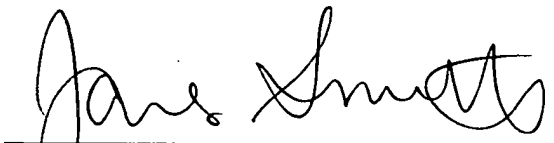
length. Thus, the length of the Brief appears to be within the page limit of 15 and word limit of 7,000, as required by Rule 1.943(c). Rambus expresses concern, however, that the Office will count as part of the Brief, pages from the Declaration of a technical expert, Robert J. Murphy, that are cited in the Rebuttal Brief. Petition, pp. 1-2.

With respect to testimony in the Murphy Declaration identified by citations in the Rebuttal Brief, Rambus, in the Petition, has not contended that such testimony is either factual explanation or legal argument. To the extent such testimony is factual explanation, pages containing such testimony would not be included in the Rebuttal Brief page count. For example, expert testimony explaining the structure and operation of either claimed or prior art subject matter is factual explanation and not a legal argument either for or against patentability.

Since neither Rambus, nor Micron, nor the Office has attempted to categorize the relevant Murphy testimony as legal argument, any basis for the present Petition is hypothetical.

DECISION

In view of the foregoing, the present Petition is dismissed as moot.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,107 and 95/001132
Patent 6,314,051

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,107	11/07/2008	6314051	38512.19	6166

22852 7590 07/13/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,107

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,132

Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132
Patent 6,314,051

DECISION ON PETITIONS

This is a decision on:

1. Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed November 4, 2010 ("Rambus Petition"). The Rambus Petition "requests that the Office accept [Patent Owner's] respondent brief, which is 27 pages and 13,982 words in length." Rambus Petition, p.1.
2. "Third Party Requester's Petition Under 37 C.F.R § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c)," filed May 23, 2011 ("Micron

Petition"). The Micron Petition seeks "a limited waiver of 37 C.F.R. § 1.943(c) so that Micron may submit a rebuttal brief up to 7,377 words or 19 pages." Micron Petition, p.1.

FINDINGS

1. On November 6, 2001, the Office issued Patent 6,314,051 ("'051 patent"), which is assigned to Rambus Inc. ("Rambus").

2. On November 7, 2008, Third Party Requester Samsung Electronics Co. Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,107.

3. On December 31, 2008, Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination of the '051 patent and the Office assigned reexamination control proceeding 95/001,132.

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

5. On January 22, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 27, 34 and 43 of the '051 patent.

6. On March 6, 2009, the Office merged the 95/001,107 and 95/001,132 proceedings (creating the "merged proceeding").

7. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

8. The merged proceeding progressed to a point where, on June 21, 2010, the Office issued a Right of Appeal Notice, confirming claims 27 and 43, and rejecting claim 34.

9. On July 20, 2010, Rambus filed Patent Owner's Notice of Appeal Under 37 C.F.R. § 41.61.

10. On August 3, 2010, Micron filed Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

11. On October 1, 2010, Rambus filed Patent Owner's Appeal Brief.

12. On October 4, 2010, Micron filed Third Party Requester's Cross Appeal Brief Pursuant to 37 C.F.R. § 41.67.

13. On November 1, 2010, Micron filed Third Party Requester's Respondent Brief Pursuant to 37 C.F.R. § 41.68.

14. On November 4, 2010, Rambus filed Patent Owner's Respondent Brief. Rambus's Respondent Brief is 27 pages and 13,982 words in length.

15. Also on November 4, 2010, Rambus filed the Rambus Petition.

16. On May 23, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 46.71. Micron's Rebuttal Brief is 19 pages and 7,377 words in length.

17. Also on May 23, 2011, Micron filed the Micron Petition.

RELEVANT LEGAL AUTHORITY

With respect to the length of briefs in *inter partes* reexamination proceedings, 37 C.F.R. §§ 1.943(c) specifies:

37 C.F.R. § 1.943(c):

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

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

(emphasis added).

With respect to waiver of regulations, 37 C.F.R. § 1.183 provides:

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

ANALYSIS

Rambus seeks a waiver of the page/word limits of Rule 1.943(c) for its Respondent Brief. Rambus's Respondent Brief is 27 pages and 13,982 words in length. Thus, the page limit of 15 is exceeded by 12 and the word limit of 7,000 is exceeded by 6,982.

Micron's Appeal Brief is 37 pages long. Rambus has identified nine contested issues presented by Micron's Appeal Brief to which Rambus must respond in its Respondent Brief – eight claim rejections and one priority issue. Petition, pp. 3-4. Further, Micron's brief "cites to Samsung's request for reexamination to support the proposed claim rejections." Petition, p. 4.

In light of the number and complexity of the issues that Rambus must address in its Respondent Brief, and the fact that Micron's Appeal Brief is 37 pages long are deemed sufficient cause for waiving the page and word limits for Rambus's Respondent Brief.

Micron seeks a waiver of the page/word limits of Rule 1.943(c) for its Rebuttal Brief. Micron's Rebuttal Brief is 19 pages and 7,377 words in

length. Thus, the page limit of 15 is exceeded by 4 and the word limit of 7,000 is exceeded by 377.

Micron's Rebuttal Brief responds, *inter alia*, to Rambus's Respondent Brief (and the Examiner's Answer). See 37 C.F.R. § 41.71(c).

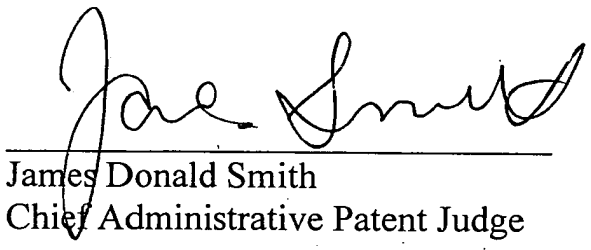
In light of granting the Rambus Petition relating to Rambus's Respondent Brief, fairness requires that the Micron Petition relating to Micron's Rebuttal Brief also be granted.

DECISION

In view of the foregoing:

The Rambus Petition is GRANTED and Rambus's Respondent Brief filed November 4, 2010 is accepted; and

The Micron Petition is GRANTED and Micron's Rebuttal Brief filed May 23, 2011 is accepted.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,107 and 95/001132
Patent 6,314,051

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,108	11/07/2008	6584037	38512.15	6309

22852 7590 09/03/2010

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EXAMINER

ART UNIT	PAPER NUMBER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,108	11/07/2008	6584037	38512.15

EXAMINER
OVIDIO, ESCALANTE

ART UNIT	PAPER
3992	

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DATE MAILED:

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CENTRAL REEXAMINATION U

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(For patent owner)

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(For the '1108 *inter partes* requester)

Tracy W. Druce
NOVAK, DRUCE & QUIGG, LLP
1000 Louisiana Avenue, 53rd Floor
Houston, TX 77002

(For the '1154 *inter partes* requester)

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No.: 6,584,037

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,154
Filed: March 3, 2009
For: U.S. Patent No.: 6,584,037

DECISION DISMISSING PETITION

This is a decision on the July 26, 2010 third party requester opposition entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO STRIKE PORTIONS OF THE THIRD PARTY REQUESTER'S APPEAL BRIEF AND UNMERGE THE MERGED REEXAMINATION PROCEEDING."

The opposition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The opposition is dismissed as moot.

BACKGROUND

1. On June 24, 2003 the Office issued U.S. Patent No. 6,584,037 to Farmwald *et al.*

2. On November 7, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,108 ("the '1108 proceeding"), by third party requester Samsung Electronics, Co. Ltd., the real party in interest.

3. On January 9, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1108 proceeding.

4. On February 13, 2009, the Office issued a first Office action on the merits in the '1108 proceeding.

5. On March 9, 2009, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,154 ("the '1154 proceeding"), by third party requester Micron Technology, the real party in interest.

6. On April 22, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1154 proceeding.

7. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1108 proceeding.

8. On June 12, 2009, third party requester timely filed comments after the May 13, 2009 patent owner response.

9. On July 21, 2009, the Office *sua sponte* issued a decision merging the '1108 and '1154 proceedings ("the merged proceeding").

10. On February 19, 2010, prosecution in the merged proceeding advanced to where the Office issued a Right of Appeal Notice (RAN).

11. On March 10, 2010, the '1154 third party requester filed a Notice of Appeal.

12. On May 10, 2010, the '1154 third party requester filed an Appellant's Brief.

13. On June 10, 2010, patent owner filed a petition concurrently with a Respondent's Brief.

14. On July 26, 2010, third party requester filed an opposition to patent owner's June 10, 2010 petition.

15. On July 27, 2010, the Office issued a decision dismissing patent owner's June 10, 2010 petition.

DECISION

On July 26, 2010 third party requester submitted an opposition to patent owner's June 10, 2010 petition. Prior to matching of the opposition with the proceeding, the Office decided to dismiss patent owner's June 10, 2010 and submitted the decision to dismiss for mailing. As the Office decision dismissed patent owner's June 10, 2010 petition, third party requester's opposition is rendered moot.

CONCLUSION

1. Third party requester's July 26, 2010 opposition is **dismissed as moot**.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,108	11/07/2008	6584037	38512.15	6309

22852 7590 11/23/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,108	11/07/2008	6584037	38512.15

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
3992	

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DATE MAILED:

11/23/10

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,108	11/07/2008	6584037	38512.15

EXAMINER
ESCALANTE, OVIDIO

ART UNIT	PAPER
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INTER PARTES REEXAMINATION COMMUNICATION

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CENTRAL REEXAMINATION UNIT

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(For patent owner)

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(For the '1154 *inter partes* requester)

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,108
Filed: November 7, 2008
For: U.S. Patent No.: 6,584,037

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,154
Filed: March 3, 2009
For: U.S. Patent No.: 6,584,037

DECISION DISMISSING PETITION

This is a decision on the August 27, 2010 patent owner petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING PETITION."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

1. On June 24, 2003 the Office issued U.S. Patent No. 6,584,037 to Farmwald *et al.*

2. On November 7, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,108 ("the '1108 proceeding"). Samsung Electronics, Co. Ltd. is identified as the real party in interest. Reexamination was ordered on January 9, 2009, and a first action on the merits was issued on February 13, 2009.

3. On March 9, 2009, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,154 ("the '1154 proceeding"). Micron Technology is identified as the real party in interest. Reexamination was ordered on April 22, 2009.

4. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1108 proceeding.

5. On June 12, 2009, third party requester timely filed comments after the May 13, 2009 patent owner response.

6. On July 21, 2009, the Office *sua sponte* issued a decision merging the '1108 and '1154 proceedings ("the merged proceeding").

7. On February 19, 2010, prosecution in the merged proceeding advanced to where the Office issued a Right of Appeal Notice (RAN).

8. On March 10, 2010, the '1154 third party requester filed a Notice of Appeal.

9. On May 10, 2010, the '1154 third party requester filed an Appellant's Brief.

10. On June 10, 2010, patent owner filed a petition concurrently with a Respondent's Brief.

11. On July 26, 2010, third party requester filed an opposition to patent owner's June 10, 2010 petition.

12. On July 27, 2010, the Office issued a decision dismissing patent owner's June 10, 2010 petition.

13. On August 27, 2010, patent owner filed the present petition requesting reconsideration of the Office's July 27, 2010 decision.

14. On September 3, 2010, the Office issued a decision dismissing third party requester's July 26, 2010 opposition.

15. On September 30, 2010, the Office issued an Examiner's Answer.

16. On November 1, 2010, third party requester submitted a Rebuttal Brief.

DECISION

Patent owner requests reconsideration of the July 27, 2010 Office decision dismissing patent owner's June 10, 2010 petition. Patent owner's June 10, 2010 petition requested both the striking of portions of requester's May 10, 2010 Appeal Brief and also demerger of the merged proceeding. The Office dismissed patent owner's June 10, 2010 petition as improper under 37 CFR 1.4(c) and, in regard to the issue of demerger, untimely under 37 CFR 1.181(f).

Patent owner's reconsideration has corrected the 37 CFR 1.4(c) issue and now only requests reconsideration of the decision's basis for demerger. Patent owner argues that the request for demerger is not untimely as the petition is not in response to the July 21, 2009 Office merger decision, but instead in response to a recent change in circumstance in the merged proceeding.

Patent owner asserts that demerger now instead of retention of merger will better facilitate special dispatch. Specifically, patent owner alleges that demerger will result in immediate issuance of a reexamination certificate in the '1108 proceeding. Patent owner also alleges that demerger will streamline the '1154 proceeding's appeal, hence also supporting special dispatch.

Patent owner's position is not persuasive. The reexamination proceeding has progressed as a merged proceeding to the point that an Examiner's determination has been appealed, briefed and answered. As the time period for submission of rebuttal briefs has lapsed, the briefing phase is complete. All that remains is the rendering of a Board decision. Accordingly, dissolution of the merger at this very late stage of the proceeding does not serve the interests of special dispatch in the Office.

CONCLUSION

1. Patent Owner's August 27, 2010 petition is **dismissed**.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,108	11/07/2008	6584037	38512.15	6309

22852 7590 07/06/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES[1]

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,108

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,154

Merged *Inter partes* Reexamination Control 95/001,108 and 95/001,154
Patent 6,584,037

DECISION ON PETITIONS

This is a decision on the following petitions filed by Patent Owner Rambus, Inc. ("Rambus") and Third Party Requester Micron Technology, Inc. ("Micron"), including:

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[1] The Central Reexamination Unit has authority to review Rambus's Petition to Expunge Appeal Brief, filed August 23, 2010, and the Board of Patent Appeals and Interferences has authority to review Rambus's Petition to Expunge Rebuttal Brief, filed December 30, 2010. *See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010).

- Rambus's Renewed Petition to Expunge Third Party Requester's Appeal Brief ("Petition to Expunge Appeal Brief"), filed August 23, 2010;
- Micron's Third Party Requester's Opposition to Patent Owner's Renewed Petition to Expunge Third Party Requester's Appeal Brief ("Opposition to Petition to Expunge Appeal Brief"), filed January 7, 2011;
- Rambus's Petition to Expunge Third Party Requester's Rebuttal Brief ("Petition to Expunge Rebuttal Brief"), filed December 30, 2010; and
- Micron's Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Rebuttal Brief ("Opposition to Petition to Expunge Rebuttal Brief"), filed January 14, 2010.

FINDINGS

1. On June 24, 2003, the Office issued Patent No. 6,584,037 ("'037 patent"), which is assigned to Rambus.

2. On November 7, 2008, Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '037 patent ("Samsung Request for Reexamination") and the Office assigned reexamination number 95/001,108.

3. Third Party Requester Samsung relied on U.S. Patent 5,590,086 ("Park") and the Joint Electron Device Engineering Council (JEDEC) Standard No. 21-C, Revision 9 (1999) ("JEDEC Standard") as intervening references, among other prior art references, to assert that claim 34 of the

'037 patent is unpatentable over the prior art. (*See* Request for *Inter Partes* Reexamination under 35 U.S.C. §§ 311-318, filed November 7, 2008, p. 6.)

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claim 34 of the '037 patent.

5. On February 13, 2009, the Examiner issued an Office Action rejecting claim 34 of the '037 patent, but not adopting the proposed rejections over JEDEC Standard or Park. (*See* Office Action of February 13, 2009, p. 3.)

6. On March 3, 2009, Third Party Requester Micron filed a request for *inter partes* reexamination of the '037 patent ("Micron Request for Reexamination") and the Office assigned reexamination number 95/001,154.

7. Third Party Requester Micron did not rely on the JEDEC Standard or Park reference in the Micron Request for Reexamination. (*See* Information Disclosure Statement by Applicant, filed March 3, 2009.)

8. On April 22, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claim 34 of the '037 patent.

9. On July 21, 2009, the Office, *sua sponte*, merged the 95/001,108 and 95/001,154 proceedings (creating the "merged proceeding").

10. On August 7, 2009, the Examiner issued a non-final Office Action in the merged proceeding, rejecting claim 34 of the '037 patent, again noting that the proposed rejections over JEDEC Standard and Park were not adopted. (Office Action of August 7, 2009, pp. 24-25.)

11. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

12. The merged proceedings progressed to a point where, on February 19, 2010, the Examiner issued a Right of Appeal Notice, again confirming the patentability of claim 34 of the '037 patent.

13. On March 10, 2010, Micron filed a Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

14. On May 10, 2010, Micron filed a Third Party Requester's Appeal Brief Pursuant to 37 C.F.R. § 41.67 ("Appeal Brief"), including issues to be reviewed relating to JEDEC and Park references. (*See* Appeal Brief, p. 3.)

15. On June 10, 2010, Rambus filed Patent Owner's Respondent Brief.

16. On June 10, 2010, Rambus filed a Petition to Strike Portions of the Third Party Requester's Appeal Brief and Unmerge the Merged Reexamination Proceedings ("original petition"). Micron filed a petition in opposition on July 26, 2010.

17. On July 27, 2010, the Office dismissed Rambus's original petition as being improper by requesting multiple forms of relief and as being untimely. (Decision Dismissing Petition, p. 3.)

18. On August 23, 2010, Rambus filed the Petition to Expunge Appeal Brief.

19. On August 27, 2010, Rambus filed a Petition for Reconsideration of Decision Dismissing Petition, requesting that reexamination 95/001,108 and reexamination 95/001,154 be severed.

20. On November 23, 2010, the Office dismissed Rambus's Petition for Reconsideration of Decision Dismissing Petition requesting the reexamination proceedings be severed.

21. On September 30, 2010, the Examiner filed an Answer, incorporating by reference the Right of Appeal Notice of February 19, 2010.

22. On November 1, 2010, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 ("Rebuttal Brief").

23. On December 30, 2010, Rambus filed the Petition to Expunge Rebuttal Brief.

24. On January 7, 2011, Micron filed the Opposition to Petition to Expunge Appeal Brief.

25. On January 14, 2011, Micron filed the Opposition to Petition to Expunge Rebuttal Brief.

ANALYSIS

Rambus argues that because Micron's Appeal and Rebuttal Briefs raise issues that Micron did not propose in the Micron Request for Reexamination and that, according to Rambus, do not pertain to the reexamination that Micron initiated (95/001,154), Micron's Appeal and Rebuttal Briefs should be expunged. (*See* Petition to Expunge Appeal Brief, p. 1-2, and Petition to Expunge Rebuttal Brief, p. 1.)

As recently discussed in the Decision on Petition entered April 27, 2011, in merged reexamination proceeding 95/000,250 and 95/001,124, involving the same parties that are involved here, the Office has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed

rejections that were before the Office at the time of the Right of Appeal Notice. In view of the detailed analysis that the Office has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

DECISION

In view of the foregoing:

Rambus's Petition to Expunge Appeal Brief is DENIED and Micron's Opposition to Petition to Expunge Appeal Brief is GRANTED.

Irem Yucel, Director
Central Reexamination Unit

Rambus's Petition to Expunge Rebuttal Brief is DENIED and Micron's Opposition to Petition to Expunge Rebuttal Brief is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control Nos. 95/001,108 and 95/001154
Patent 6,584,037

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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 08/03/2010

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/03/2010

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SUITE 700
DALLAS, TX 75219

Date:
MAILED

AUG 03 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001109
PATENT NO. : 6546446
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.
~~95/001,155~~	03/11/2009	6546446	8963.002.446	7688

22852 7590 08/03/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/03/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Ave., 53rd Floor
Houston, TX 77002

Date:

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AUG 03 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001155
PATENT NO. : 6546446
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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Haynes and Boone, LLP
IP Section
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Dallas, TX 75219 (For the '1109 *inter partes* requester)

NOVAK, DRUCE & QUIGG, LLP
(NDQ Reexamination Group)
1000 Louisiana Avenue, 53rd Floor
Houston, TX 77002 (For the '1155 *inter partes* requester)

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,109
Filed: November 11, 2008
For: U.S. Patent No.: 6,546,446

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,155
Filed: March 11, 2009
For: U.S. Patent No.: 6, 546,446

DECISION DISMISSING PETITION

This is a decision on the June 21, 2010 patent owner petition entitled "PETITION TO UNMERGE THE MERGED REEXAMINATION PROCEEDINGS."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

1. On April 8, 2003, the Office issued U.S. Patent No. 6,546,446 (the '446 patent) to Farmwald *et al.*

2. On November 11, 2008, a first request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,109 ("the '1109 proceeding"), by third party requester Samsung Electronics, Co. Ltd., the real party in interest.

3. On January 9, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1109 proceeding.

4. On February 13, 2009, the Office issued a first Office action on the merits in the '1109 proceeding.

5. On March 11, 2009, a second request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,155 ("the '1155 proceeding"), by third party requester Micron Technology, the real party in interest.

6. On April 23, 2009, the Office issued an order granting the request for *inter partes* reexamination in the '1155 proceeding.

7. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1109 proceeding.[1]

8. On June 12, 2009, the '1109 third party requester timely filed comments after the May 13, 2009 patent owner response.

9. On July 23, 2009, the Office *sua sponte* issued a decision merging the '1109 and '1155 proceedings ("the merged proceeding").

10. On June 4, 2010, prosecution in the merged proceeding advanced to the point where the Office issued a Right of Appeal Notice (RAN).

11. On June 21, 2010, patent owner filed the present petition to unmerge the merged proceedings.

12. On July 6, 2010, the '1155 third party requester filed a Notice of Appeal.

RELEVANT RULE AND GUIDANCE

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.

DECISION

[1] On March 26, 2009, the Office granted patent owner a one month extension of time to respond to the February 13, 2009 Office action.

37 CFR 1.181(f) provides that any petition submitted under part 1 of 37 C.F.R. that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Patent owner's June 21, 2010 petition is requesting demerger of the proceedings merged by the July 23, 2009 Office decision to merge *inter partes* proceedings 95/001,109 and 95/001,155. Patent owner's June 21, 2009 petition requesting demerger of proceedings was submitted almost a year after the decision to merge was issued, and more important, after a Right of Appeal Notice for the merged proceeding has issued. It would be inequitable to delay the proceeding and possibly regress the proceeding at this time. The petition is untimely; accordingly, the June 21, 2010 petition to demerge is dismissed as untimely.

It is to be observed that the decision to merge is within the "sole discretion" of the Office, on a case-by-case basis, to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with special dispatch. [2] And, the Office will exercise its authority to merge co-pending reexamination proceedings for reexamination of the same patent where special dispatch is best served by such a merger. In this instance, petitioner has not filed the petition to unmerge until after the RAN was issued and one party has appealed; the delay resulting from splitting the merged proceedings would clearly run contrary to the statutory mandate to conduct reexamination proceedings with special dispatch.

CONCLUSION

1. Patent owner's June 21, 2010 petition is **dismissed**.

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

Kenneth M. Schor

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

[2] MPEP 2686.01 I. provides - "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**." [Emphasis added.]

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 11/23/2010

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ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,155	03/11/2009	6546446	8963.002.446	7688

22852 7590 11/23/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001109
PATENT NO. : 6546446
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:

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CENTRAL REEXAMINATION U

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001155
PATENT NO. : 6546446
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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(For patent owner)

MAILED

NOV 23 2010

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(For the '1109 *inter partes* requester)

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(For the '1155 *inter partes* requester)

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,109
Filed: November 11, 2008
For: U.S. Patent No.: 6,546,446

In re Farmwald *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,155
Filed: March 11, 2009
For: U.S. Patent No.: 6, 546,446

DECISION DISMISSING PETITION

This is a decision on the August 27, 2010 patent owner petition entitled "PETITION FOR RECONSIDERATION OF DECISION DISMISSING PETITION."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

BACKGROUND

1. On April 8, 2003, the Office issued U.S. Patent No. 6,546,446 (the '446 patent) to Farmwald *et al.*

2. On November 11, 2008, a first request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,109 ("the '1109 proceeding"). Samsung Electronics, Co. Ltd. is identified as the real party in interest. Reexamination was ordered on January 9, 2009, and a first action on the merits was issued on February 13, 2009.

3. On March 11, 2009, a second request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,155 ("the '1155 proceeding"). Micron Technology is identified as the real party in interest. Reexamination was ordered on April 23, 2009.

4. On May 13, 2009, patent owner timely filed a response to the February 13, 2009 Office action of the '1109 proceeding.[1]

5. On June 12, 2009, the '1109 third party requester timely filed comments after the May 13, 2009 patent owner response.

6. On July 23, 2009, the Office *sua sponte* issued a decision merging the '1109 and '1155 proceedings ("the merged proceeding").

7. On June 4, 2010, prosecution in the merged proceeding advanced to the point where the Office issued a Right of Appeal Notice (RAN).

8. On June 21, 2010, patent owner filed the present petition to unmerge the merged proceedings.

9. On July 6, 2010, the '1155 third party requester filed a Notice of Appeal.

10. On August 3, 2010, the Office issued a decision dismissing patent owner's June 21, 2010 petition.

11. On August 27, 2010, patent owner filed the present petition requesting reconsideration of the Office's August 3, 2010 decision.

12. On September 7, 2010, the '1155 requester filed an Appeal Brief.

13. On October 7, 2010, patent owner filed a Respondent Brief.

DECISION

Patent owner requests reconsideration of the July 27, 2010 Office decision dismissing patent owner's June 21, 2010 petition. Patent owner's June 21, 2010 petition requested demerger of the merged proceeding. The Office dismissed patent owner's June 21, 2010 petition as untimely under 37 CFR 1.181(f).

Patent owner now requests reconsideration of the decision's basis for demerger. Patent owner argues that the request for demerger is not untimely as the petition is not in response to the July 23, 2009 Office merger decision, but instead in response to a recent change in circumstance in the merged proceeding. Patent owner asserts that demerger now instead of retention of merger will better facilitate special dispatch. Specifically, patent owner alleges that demerger will result in immediate issuance of a reexamination certificate in the '1109 proceeding. Patent owner also alleges that demerger will streamline the '1155 proceeding's appeal, hence also supporting special dispatch.

[1] On March 26, 2009, the Office granted patent owner a one month extension of time to respond to the February 13, 2009 Office action.

Patent owner's position is not persuasive. The reexamination proceeding has progressed as a merged proceeding to the point that an Examiner's determination has been appealed and fully briefed. Thus all that remains is an Examiner's Answer, the rebuttal briefing phase and the rendering of a Board decision. Accordingly, dissolution of the merger at this very late stage of the proceeding does not serve the interests of special dispatch in the Office.

CONCLUSION

1. Patent owner's August 27, 2010 petition is **dismissed**.

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 06/17/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/17/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,109

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,155

Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155
Patent 6,546,446

DECISION ON PETITIONS

This is a decision on the following petitions filed by Patent Owner Rambus, Inc. ("Rambus") and Third Party Requester Micron Technology, Inc. ("Micron"):

- Patent Owner Rambus's Petition to Expunge Third Party Requester's Appeal Brief ("Petition to Expunge Appeal Brief"), filed October 7, 2010; and
- Micron's Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief

("Opposition to Petition to Expunge Appeal Brief"), filed January 7, 2011.

FINDINGS

1. On April 6, 2003, the Office issued Patent No. 6,546,446 ("'446 patent"), which is assigned to Rambus.

2. On November 11, 2008, Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '446 patent ("Samsung Request for Reexamination") and the Office assigned reexamination number 95/001,109.

3. Third Party Requester Samsung relied on U.S. Patent 5,590,086 ("Park") and the Joint Electron Device Engineering Council (JEDEC) Standard No. 21-C, Revision 9 (1999) ("JEDEC Standard") as intervening references, among other prior art references, to assert that claims 1-4 of the '446 patent are unpatentable over the prior art. (*See* Request for *Inter Partes* Reexamination under 35 U.S.C. §§ 311-318, filed November 7, 2008, p. 8.)

4. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

5. On February 13, 2009, the Examiner issued an Office Action rejecting claims 1-4 of the '446 patent, but either not adopting or modifying the proposed rejections over JEDEC Standard or Park. (*See* Office Action of February 13, 2009, pp. 14-15.)

6. On March 11, 2009, Third Party Requester Micron filed a request for *inter partes* reexamination of the '446 patent ("Micron Request

for Reexamination") and the Office assigned reexamination number 95/001,155.

7. Third Party Requester Micron did not rely on the JEDEC Standard or Park reference in the Micron Request for Reexamination. (*See* Information Disclosure Statement by Applicant, filed March 3, 2009.)

8. On April 23, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

9. On July 23, 2009, the Office, *sua sponte*, merged the 95/001,109 and 95/001,155 proceedings (creating the "merged proceeding").

10. On August 7, 2009, the Examiner issued a non-final Office Action in the merged proceeding, rejecting claims 1-4 of the '446 patent, again noting that the proposed rejections over JEDEC Standard and Park were not adopted or modified. (Office Action of August 7, 2009, pp. 31-33.)

11. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

12. The merged proceedings progressed to a point where, on June 4, 2010, the Examiner issued a Right of Appeal Notice, again confirming the patentability of claims 1-4 of the '446 patent.

13. On June 21, 2010, Rambus filed a Petition to Unmerge the Merged Reexamination Proceedings ("Petition to Unmerge"), which was dismissed by the Office on August 3, 2010.

14. On July 6, 2010, Micron filed a Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

15. On August 27, 2010, Rambus filed a Petition for Reconsideration of Decision Dismissing Petition, requesting that the Office grant Rambus's Petition to Unmerge. The Office dismissed this petition on November 23, 2010.

16. On September 7, 2010, Micron filed Third Party Requester's Appeal Brief Pursuant to 37 C.F.R. § 41.67 ("Appeal Brief"), including issues to be reviewed relating to JEDEC and Park references. (*See* Appeal Brief, pp. 3-4.)

17. On October 7, 2010, Rambus filed Patent Owner's Respondent Brief.

18. On October 7, 2010, Rambus filed a Petition to Expunge Third Party Requester's Appeal Brief ("Petition to Expunge Appeal Brief").

19. On January 7, 2010, Micron filed a Third Party's Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief "Opposition to Petition to Expunge").

20. On April 21, 2011, the Examiner filed *Inter Partes* Reexamination Examiner's Answer, incorporating the Right of Appeal Notice by reference and maintaining every determination not to make a proposed rejection.

21. On May 23, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71.

ANALYSIS

Rambus argues that because Micron's Appeal Brief raises issues Micron did not propose in the Micron Request for Reexamination and that, according to Rambus, do not pertain to the reexamination Micron initiated

(95/001,155), Micron's Appeal Brief should be expunged. (*See* Petition to Expunge Appeal Brief.)

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

At this juncture, further detailed consideration and discussion of the issue merely would be repetitive of the analysis presented in prior relevant decisions and therefore would be wasteful of the Office's limited resources.

DECISION

For the forgoing reason, Rambus's Petition to Expunge Appeal Brief is DENIED and Micron's Opposition to Petition to Expunge Appeal Brief is GRANTED.

James Donald Smith
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 06/22/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,109

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,155

Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155
Patent 6,546,446

DECISION ON PETITIONS

This is a decision on the following petitions filed by Patent Owner Rambus, Inc. ("Rambus") and Third Party Requester Micron Technology, Inc. ("Micron"):

- Patent Owner Rambus's Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Appeal Brief ("Rambus's Petition to Waive"), filed October 7, 2010;
- Micron's Third Party Requester's Opposition to Patent Owner's Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's

Respondent Appeal Brief ("Micron's Opposition"), filed November 1, 2010; and

- Micron's Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c) ("Micron's Petition to Waive"), filed May 23, 2011.

FINDINGS

1. On April 6, 2003, the Office issued Patent No. 6,546,446 ("'446 patent"), which is assigned to Rambus.

2. On November 11, 2008, Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '446 patent ("Samsung Request for Reexamination") and the Office assigned reexamination number 95/001,109.

3. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

4. On February 13, 2009, the Examiner issued an Office Action rejecting claims 1-4 of the '446 patent. (*See* Office Action of February 13, 2009, pp. 14-15.)

5. On March 11, 2009, Third Party Requester Micron filed a request for *inter partes* reexamination of the '446 patent ("Micron Request for Reexamination") and the Office assigned reexamination number 95/001,155.

6. On April 23, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

7. On July 23, 2009, the Office merged the 95/001,109 and 95/001,155 proceedings (creating the "merged proceeding").

8. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

9. The merged proceedings progressed to a point where, on February 22, 2010, the Office issued an Action Closing Prosecution ("ACP"), confirming the patentability of claims 1-4.

10. On June 4, 2010, the Office issued a Right of Appeal Notice ("RAN"), again confirming the patentability of claims 1-4 of the '446 patent.

11. On July 6, 2010, Micron filed a Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

12. On September 7, 2010, Micron filed Third Party Requester's Appeal Brief Pursuant to 37 C.F.R. § 41.67 ("Appeal Brief"). (*See* Appeal Brief, pp. 3-4.) The Appeal Brief contains 35 pages countable under 37 C.F.R. § 1.943(c).

13. Micron certified that its Appeal Brief includes 13,540 words. (Certificate Regarding Number of Words Pursuant to 37 C.F.R. § 1.943(c), filed September 7, 2010.)

14. On October 7, 2010, Rambus filed Patent Owner's Respondent Brief ("Respondent Brief"). Rambus's Respondent Brief contains 29 pages countable under 37 C.F.R. § 1.943(c), and is single spaced.

15. On May 23, 2011, Micron filed Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 ("Rebuttal Brief"). The Rebuttal Brief contains 22 pages countable under 35 C.F.R. § 1.943(c).

16. Micron certified that its Rebuttal Brief includes 8,603 words. (Certificate Regarding Number of Word's Pursuant to 37 C.F.R. § 1.943(c), filed May 23, 2011.)

RELEVANT AUTHORITY

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

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

This and other rules of the Office may be suspended, as follows:

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

37 C.F.R. § 1.183.

ANALYSIS

Rambus requests in its Petition to Waive that the Office accept its Respondent Brief of 29 pages and 16,036 words because "Micron's 37-page appeal brief addresses sixteen proposed rejections and a priority issue." (Rambus's Petition to Waive, p. 2.) Rambus argues that some issues raised by Micron in its Appeal Brief were raised only by Samsung and that,

because the reexaminations were merged and Samsung has chosen not to participate, the current page limits unfairly limit Rambus's ability to respond to these issues. (*Ibid.*)

Regardless of the origin of the issues presented by Micron on Appeal or the number of parties participating, Micron filed an Appeal Brief within the limit of 14,000 words. Rambus argues that Micron incorporated portions of its Request for Reexamination by reference and relied upon a lengthy patent document regarding patentability of the '446 patent (Rambus's Petition to Waive, p. 2), but, again, Micron presented all of its arguments within 14,000 words. Rule 1.943(c) provides for a two to one ratio between the length of the Appeal Brief and "all other briefs filed by any party. . . ." Given that Micron was able to present the issues for appeal within the limits provided by 37 C.F.R. § 1.943(c), Rambus has not sufficiently explained why an extraordinary situation exits so that it's Respondent's Brief cannot also comply with the Rule.

Rambus also argues that the page limits "are arbitrary and violate Rambus's due process rights, especially given the facts here." (Rambus's Petition to Waive, p. 2.) Rambus argues the basis for Rule 1.943(c) is arbitrary because Rambus is limited to half the number of pages of the Micron Appeal Brief, while the Examiner has no limits and there are no limits in appeals of *ex parte* reexamination proceedings. (*Id.*)

The page and word limits specified in Rule 1.943(c) apply to all Appellants and Respondents in *inter partes* reexaminations. Rambus has not provided sufficient evidence that an extraordinary situation exists in the application of Rule 1.943(c) in the present appeal. Routine application of

the Rule does not support a waiver of the Rule-specified page and word limits or a deprivation of due process claim.

Rambus's Petition to Waive is denied.

Micron also petitions "to the extent the Office allows Rambus to submit a respondent brief of 16, 036 words and 29 pages" to submit a rebuttal brief of 8,603 words and 22 pages. Because Rambus's Petition to Waive is denied, Micron's Petition to Waive is also denied.

DECISION

For the forgoing reasons,

Rambus's Petition to Waive is DENIED;

Micron's Opposition is GRANTED; and

Micron's Petition to Waive is DENIED.

Rambus's Respondent Brief filed October 7, 2010, and Micron's Rebuttal Brief filed May 23, 2011, are expunged from the record. Patent Owner Rambus is given one month from the date of this decision to file a compliant respondent brief, pursuant to 37 C.F.R. § 41.66(b). By rule, the time for filing this brief may not be extended.

Pursuant to 37 CFR 41.66(d), once Patent Owner Rambus's respondent's brief has been properly filed, any rebuttal brief must be filed by Appellant Micron within one month from the date of service of Rambus's respondent brief. By rule, the time for filing a rebuttal brief may not be extended.

James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control Nos. 95/001,109 and 95/001155
Patent 6,546,446

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95/001,109	11/11/2008	6546446	38512.20	9305

22852 7590 09/15/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,155	03/11/2009	6546446	8963.002.446	7688

22852 7590 09/15/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/001,109

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,155

Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155
Patent 6,546,446

DECISION ON PETITION

This is a decision on the "Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief" ("Petition for Review") filed by Patent Owner Rambus, Inc. ("Rambus") on July 22, 2011.

FINDINGS

1. On April 8, 2003, the Office issued Patent No. 6,546,446 ("'446 patent"), which is assigned to Rambus.

2. On November 11, 2008, Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed a request for *inter partes* reexamination of the '446 patent ("Samsung Request for Reexamination") and the Office assigned reexamination number 95/001,109.

3. On January 9, 2009, the Office granted Samsung's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

4. On February 13, 2009, the Examiner issued an Office Action rejecting claims 1-4 of the '446 patent. (*See* Office Action of February 13, 2009, 14-15.)

5. On March 11, 2009, Third Party Requester Micron filed a request for *inter partes* reexamination of the '446 patent ("Micron Request for Reexamination") and the Office assigned reexamination number 95/001,155.

6. On April 23, 2009, the Office granted Micron's request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-4 of the '446 patent.

7. On July 23, 2009, the Office merged the 95/001,109 and 95/001,155 proceedings (creating the "merged proceeding").

8. On February 11, 2010, Third Party Requester Samsung filed a Notice of Non-Participation in *Inter Partes* Reexamination, giving notice that it "no longer intends to participate in the present reexamination."

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9. The merged proceedings progressed to a point where, on February 22, 2010, the Office issued an Action Closing Prosecution ("ACP"), confirming the patentability of claims 1-4.

10. On June 4, 2010, the Office issued a Right of Appeal Notice ("RAN"), again confirming the patentability of claims 1-4 of the '446 patent.

11. On July 6, 2010, Micron filed a Third Party Requester's Notice of Appeal Pursuant to 35 U.S.C. § 315 and 37 C.F.R. § 41.61.

12. On September 7, 2010, Micron filed a Third Party Requester's Appeal Brief Pursuant to 37 C.F.R. § 41.67 ("Appeal Brief"). (*See* Appeal Brief, 3-4.) The Appeal Brief contains 35 pages countable under 37 C.F.R. § 1.943(c).

13. Micron certified that its Appeal Brief includes 13,540 words. (Certificate Regarding Number of Words Pursuant to 37 C.F.R. § 1.943(c), filed September 7, 2010.)

14. On October 7, 2010, Rambus filed a Patent Owner's Respondent Brief and a Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Appeal Brief ("Rambus's Petition to Waive"). Rambus's Respondent Brief contains 29 pages countable under 37 C.F.R. § 1.943(c), and is single spaced.

15. On May 23, 2011, Micron filed a Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 and a Third Party Requester's Petition Under 37 C.F.R. § 1.183 for limited Waiver of 37 C.F.R. § 1.943(c) ("Micron's Petition to Waive"). The Rebuttal Brief contains 22 pages countable under 35 C.F.R. § 1.943(c) and Micron certified that included 8,603 words. (Certificate Regarding Number of Word's Pursuant to 37 C.F.R. § 1.943(c), filed May 23, 2011.)

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16. On June 22, 2011, Rambus's Petition to Waive and Micron's Petition to Waive were denied in a Decision on Petitions.

17. On July 22, 2011, Rambus filed the Petition for Review, along with Exhibit A, a Replacement Respondent Brief that is 15 pages long under the requirements of 37 C.F.R. § 1.943(c) and cites two expert declarations, which Rambus asserts are part of the record of this Reexamination, and Exhibit B, an Alternative Replacement Respondent Brief that does not cite the expert declarations.

RELEVANT AUTHORITY

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

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

This and other rules of the Office may be suspended, as follows:

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

37 C.F.R. § 1.183.

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ANALYSIS

Rambus requests that the Decision on Petitions be reviewed and overturned, allowing Rambus to file a Respondent Brief of 29 pages and 16,036 words, for several reasons. First, Rambus argues that because Micron improperly incorporated arguments from its request for reexamination, an extraordinary situation has occurred that merits waiver of the page limits imposed by 37 C.F.R. § 1.943(c) on Rambus. (Petition for Review, 4-6.) Rambus also argues that because the reexamination is a merger of two reexamination proceedings, Rambus's rights are unfairly limited by the page limitations imposed. (*Id.* at 6.) Finally, Rambus argues that its due process rights are violated by 37 C.F.R. § 1.943(c) because a respondent is allowed only half the pages an appellant is allowed to file and the Examiner is allowed unlimited pages in the Answer. (*Id.* at 6-7.)

These arguments were addressed in the Decision on Petitions and were not found to be persuasive. (Decision on Petitions, 4-6.)

The Office appreciates the filing of a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), and accepts the version provided in Attachment B, without citation to expert declarations. *See* Manuel of Patent Examining Procedure § 2667 ("Any affidavit or declaration (or a clearly defined portion thereof) that contains opinon(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit

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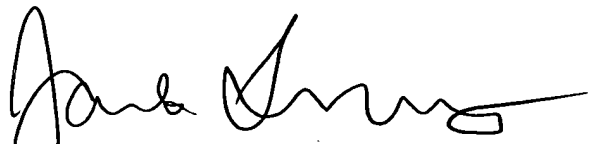
requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count.") The 15-page Patent Owner's Replacement Respondent Brief provided in Attachment B, filed on July 22, 2011, is **entered**. The respondent brief provided in Attachment A is **not entered**.

DECISION

For the forgoing reasons, Rambus's Petition for Review 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.
95/001,110	12/01/2008	7424133	GEOC:002RX	9399

30589 7590 08/18/2010
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EXAMINER

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United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,110	12/01/2008	7424133	GEOC:002RX

EXAMINER

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ART UNIT	PAPER
3992	

DATE MAILED:

08/18/10

INTER PARTES REEXAMINATION COMMUNICATION

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,110	12/01/2008	7424133	GEOC:002RX

EXAMINER

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ART UNIT	PAPER
3992	

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INTER PARTES REEXAMINATION COMMUNICATION

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(For Requester)

MAILED

AUG 18 2010

CENTRAL REEXAMINATION UNIT

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AUSTIN, TX 78701

In re: Schultz *et alia*	: **DECISION DISMISSING**
Reexamination Proceeding	: **PETITION TO**
Control No. 95/001,110	: **WITHDRAW RAN**
Request Deposited: December 1, 2008	:
For: U.S. Patent No. 7,424,133	:

The *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed March 25, 2010 entitled "PETITION TO REOPEN PROSECUTION IN *INTER PARTES* REEXAMINATION".

Although petitioner cites to 37 CFR 1.116 and/or MPEP 2673.01 as authority (see page 1 of the petition, "It is respectfully submitted that the present petition is expressly authorized by 37 C.F.R. § 1.116(e)-(f) and/or M.P.E.P. § 2673.01(II)"), petitioner requests "reconsideration and withdrawal of the Right of Appeal Notice mailed February 26, 2010" (see page 2 of the petition). Therefore the petition is considered pursuant to 37 CFR §1.181. No fee is required.

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

DECISION

Petitioner argues the merits of the rejection and the sufficiency of the declaration to disqualify a reference as prior art. These arguments relate to the merits of the rejections, which are appealable. They do not relate to whether the examination in this proceeding complied with the policies set forth in e.g. 37 CFR or Chapter 2600 of the MPEP.

The merits of any individual rejection are subject to appeal to the Board of Patent Appeals and Interferences and are not a petitionable issue. It is noted that the arguments in the petition (such

as the eligibility of the Rattigan reference as prior art) are largely repeated in the appeal brief. This decision takes no position as to the merits of any rejection.

Therefore, the petition is **dismissed**.

CONCLUSION

1. Petitioner's request to withdraw the RAN is **dismissed**.

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

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

Gregory Morse
Director, Central Reexamination Unit

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95/001,112 95/009,183	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 09/07/2010

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/07/2010

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DALLAS, TX 75219

Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183, 95/001,112
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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HOUSTON, TX 77002

Date:

MAILED

SEP 07 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112 ; 95/000,183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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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MAILED

SEP 07 2010

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(For 95/001,112 Requester)

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,183
Filed: August 24, 2007
For: U.S. Patent No. 6,182,184

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,112
Filed: November 17, 2008
For: U.S. Patent No. 6,182,184

DECISION GRANTING PETITIONS

This is a decision on the May 10, 2010 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S APPEAL BRIEF," and on the June 10, 2010 third party requester Micron petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)," requesting waiver of 37 CFR 1.943(c) for its respondent brief.

The petitions are before the Office of Patent Legal Administration.

The petition fee of $400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

The petitions are granted.

REVIEW OF THE RELEVANT FACTS

1. U. S. Patent Number 6,182,184 (the '184 patent) issued to Farmwald et al. on January 30, 2001, with 29 claims.

2. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,183 ('183 proceeding), was initially deposited by third party requester on October 4, 2006. A corrected request was then filed, and received a filing date of August 24, 2007. Samsung Electronics Co., Ltd., ("Samsung") was identified as the real party in interest.

3. On October 19, 2007, the Office issued an order for the '183 reexamination proceeding, granting reexamination of claims 1-29 of the '184 patent.

4. A request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,112 ('1112 proceeding), was filed November 17, 2008, by third party requester Micron Technology Inc. ("Micron").

5. An order granting reexamination of claims 13 and 14 of the '184 patent was mailed for the '1112 reexamination proceeding on January 16, 2009.

6. On March 6, 2009, the '183 and '1112 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, patent owner filed comments in response to the ACP.

9. On October 21, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

10. On January 29, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 26, 2010, patent owner filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, requester Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 1010, patent owner filed an appellant's brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

15. On June 10, 2010, third party requester Micron filed a respondent brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

16. On July 2, 2010, patent owner filed a petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by third party requester Samsung. This petition is being addressed by a separate decision mailed on even date with the present decision, as will be discussed below.

RELEVANT AUTHORITY

37 CFR 1.183 provides:

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

37 CFR 1.943(c) provides:

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

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

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

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides (in pertinent part):

For additional information with respect to the length of papers, see Subsection I.A.2 above.

DECISION

I. Patent Owner's Petition of May 10, 2010

In its May 10, 2010 petition, petitioner patent owner requests waiver of 37 CFR 1.943(c), which limits appellant briefs to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit patent owner to file its appellant brief of 26,278 words in length, which has been concurrently submitted with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant brief in compliance with the 30-page limit, and submitting the resulting response, which has a length of 67 pages that count toward the regulatory page limit. Patent owner asserts that it "has made every effort to pare down the arguments in its appeal brief."[1]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted to permit patent owner's May 10, 2010 appellant brief to exceed the page limit by 37 pages. This waiver makes patent owner's May 10, 2010 appellant brief page-length compliant.

II. Third Party Requester Micron's Petition of June 10, 2010

In its June 10, 2010 petition, petitioner third party requester Micron requests waiver of 37 CFR 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit third party requester Micron to file a respondent brief of 37 pages or 17,266 words in length. Third party requester concurrently submitted its respondent brief with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

Waiver is requested only if the Office grants the patent owner's May 10 , 2010 petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c) for patent owner's appellant brief.[2]

In this instance, third party requester Micron has made a showing in support of the request for waiver of the 15-page limit of 37 CFR 1.943(c) by attempting to draft a respondent brief in compliance with the 15-page limit, and submitting the resulting response, which has a length of 32 pages that count toward the regulatory page limit. And, the proffered respondent brief is half the size of the appellant brief, in keeping with the ratio of respondent brief to appellant brief, in 37 CFR 1.943(c).

Based on the particular circumstances of the present merged proceeding, it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) for requester's respondent brief in this instance by an amount proportional to the amount granted for patent owner's appellant brief. Therefore, third party requester's petition under 37 CFR 1.183 is granted to permit third party requester's

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[1] Patent owner's May 10, 2010 petition at page 3.
[2] Third party requester's June 10, 1010 petition at page 2.

respondent brief to exceed the page limit by 17 pages. This waiver makes third party requester Micron's June 10, 2010 respondent brief page-length compliant.

On even date with this decision, the Office is dismissing patent owner's July 2, 2010 petition under 37 CFR 1.182/1.183 to strike portions of third party requester Micron's June 10, 2010 respondent brief. The Office's dismissal of patent owner's July 2, 2010 petition to strike portions of third party requester Micron's respondent brief will therefore not affect the present determination of the page limit waiver of third party requester Micron's respondent brief.

III. Appendix

What is Included or Excluded from the Page Limit Count

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Furthermore, the sections of the appellant brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)[3] are deemed to be included in "reference materials" that do not count toward the page limits. If any portion of the relevant section includes material that goes beyond that which is required by those sections, the entire section will be counted toward the page total. Partial pages will be tallied as whole pages for this purpose.

A comparison of 37 CFR 41.67(c) and 37 CFR 41.68(b), which set out the respective requirements for an appellant's brief and a respondent's brief, reveals that the claims appendix is the only item required in the appellant's brief that is not required in the respondent's brief. Section 1.943 does not, however, specify that reference materials are excluded from the page count of respondent's brief. To the extent that the rule can be read as giving unequal treatment to reference materials in determining the page count of appellant and respondent briefs, the rule is hereby waived. Specifically, "reference materials such as prior art references" that are properly part of an appendix to the respondent's brief are not being counted toward the page limit set in § 1.943(c). Furthermore, the sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and 37 CFR 41.68(b)(1)(i)-(iv) respectively are deemed to be included in "reference materials" that do not count toward the page limits.

It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count only insofar as they are documents that are formally required in the appendix. Note that this requirement only covers copies of decisions rendered by a court of the Board as identified in the "Related appeals and interferences" section of the brief. Any documents that are not required to be submitted (such as Office actions, requests for reexamination, etc.) are counted toward the size limit of the brief.

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[3] i.e., (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments, (ix) Evidence Appendix, (x) Related Proceedings Appendix, and (xi) Certificate of Service.* The Claims Appendix is already explicitly included in the rule.

CONCLUSION

1. Patent owner's and third party requester's petitions under 37 CFR 1.183 are both granted, making the proffered appellant brief and a respondent's brief (respectively) page length compliant.

2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Kenneth M. Schor

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

8-31-10
kenAppeal/length

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,112 95/000,183	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 09/07/2010

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DALLAS, TX 75219

Date:
MAILED
SEP 07 2010
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000183 95/001,112
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001112; 95/000,183
PATENT NO. : 6181284
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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(For Patent Owner)

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In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No.: 95/000,183
Filed: August 24, 2007
For: U.S. Patent No. 6,182,184

In re Farmwald et al.
Inter partes Reexamination Proceeding
Control No. 95/001,112
Filed: November 17, 2008
For: U.S. Patent No. 6,182,184

DECISION DISMISSING PATENT OWNER'S PETITION TO STRIKE PORTIONS OF REQUESTER'S RESPONDENT BRIEF

This is a decision on the July 2, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THIRD-PARTY REQUESTER'S RESPONDENT BRIEF." Since the petition is actually on challenging the making of record of the respondent brief by the Central Reexamination Unit (CRU), the petition will be taken and decided as a petition under 37 CFR 1.181 challenging an action taken by the CRU – see the below discussion.

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

The petition is dismissed for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. U. S. Patent Number 6,182,184 (the '184 patent) issued to Farmwald et al. on January 30, 2001, with 29 claims.

2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,183 ('183 proceeding), was initially deposited by third party requester on October 4, 2006. A corrected request was then filed, and received a filing date of August 24, 2007. Samsung Electronics Co., Ltd., ("Samsung") was identified as the real party in interest.

3. On October 19, 2007, the Office issued an order for the '183 reexamination proceeding, granting reexamination of claims 1-29 of the '184 patent.

4. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/001,112 ('1112 proceeding), was filed November 17, 2008, by third party requester Micron Technology Inc. ("Micron").

5. An order granting reexamination of claims 13 and 14 of the '184 patent was mailed for the '1112 reexamination proceeding on January 16, 2009.

6. On March 6, 2009, the '183 and '1112 proceedings were merged.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, patent owner filed comments in response to the ACP.

9. On October 21, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.

10. On January 29, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-23 and confirming claims 24-29.

11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.

12. On February 26, 2010, patent owner filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, requester Micron filed a Notice of Cross Appeal for claims 13-14.

14. On May 10, 1010, patent owner filed an appellant's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

15. On June 10, 2010, third party requester Micron filed a respondent brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.

16. On July 2, 2010, patent owner filed the present petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by third party requester Samsung.

RELEVANT AUTHORITY

35 U.S.C. § 312 (Determination of issue by Director) provides (in pertinent part):

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

35 U.S.C. § 313 (*Inter partes* reexamination order by Director) provides:

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

35 U.S.C. § 314 (Conduct of *inter partes* reexamination proceedings) provides (in pertinent part):

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

35 U.S.C. § 315 (Appeal) provides (in pertinent part):

(b)THIRD-PARTY REQUESTER.— A third-party requester—
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and
(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

35 U.S.C. § 317 (Inter partes reexamination prohibited) provides (in pertinent part):

(a) ORDER FOR REEXAMINATION.— Notwithstanding
any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent

request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

37 CFR 1.181 provides (in pertinent part):

(a)Petition may be taken to the Director:
(1)From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 provides:

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

37 CFR 1.183 provides:

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

37 CFR 41.68 provides (in pertinent part):

(a)(1)Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.
(2)The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).
(3)The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.
(4) A requester's respondent brief may not address any brief of any other requester.

DECISION

I. Patent owner's July 2, 2010 Petition

In its present petition, patent owner requests under 37 CFR 1.182 and if necessary, under 37 CFR 1.183, that those portions of Requester Micron's respondent brief filed on June 10, 2010 addressing rejections proposed by Requester Samsung and not raised by Micron in its request for reexamination be stricken. In support of its request that portions of Requester Micron's respondent brief addressing issues raised by another third party requester be striken, petitioner patent owner points to the following authority: (1) MPEP 2675.02 and 37 CFR 41.68(a)(3) state

that the "respondent brief must ...be limited to issues raised in the appellant brief to which the respondent brief is directed," and (2) 37 CFR 41.68(a)(4) states "[a] requester's respondent brief may not address any brief of any other requester."[1]

Patent owner further argues that Rambus's appeal brief addresses rejections raised by both Samsung and Micron because the Office merged the Micron initiated reexamination proceeding (the '1112 proceeding) with the Samsung initiated reexamination proceeding (the '183 proceeding), and that merger of the two proceedings should "neither expand Micron's reexamination rights nor allow Micron to address rejections in its respondent brief that it did not previously propose and that it could not have addressed if the Office had not merged the reexamination proceeding."[2] Patent owner specifically requests that "the Office should strike Sections VII.A-VII.E at pages 1-25 and Section VII.G at pages 29-31 of Micron's Respondent Brief"[3] that address the "six Samsung-proposed rejections – anticipation rejections based on *iAPX* and *Budde*, obviousness rejections over *iAPX* or *Budde* in view of *Inagaki*, and obviousness rejections of *iAPX* or *Budde* in view of *Lofgren*."[4]

Patent owner further argues that "[b]y appealing and addressing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second reexamination of the '184 patent."[5]

Finally, patent owner cites to two specific Board decisions, to support its present request. Patent owner argues that "[t]he Board had indicated that that [sic] a requester cannot appeal a rejection that it did not propose,"[6] and cites as exemplary decisions to *Meadwestvaco Packaging Sys., LLC v. Patent of C. Brown Lingamfelter*. Appeal No. 2009-002578, 2010 WL 191281 (B.P.A.I. Jan. 12, 2010) and *Vanguard Identification Sys., Inc. v. Patent of Bank of Am. Corp.* Appeal No. 2009-002973, 2010 WL 1064484 (B.P.A.I. Mar. 23, 2010).[7]

II. Analysis and Findings

As pointed out above, patent owner's petition under 37 CFR 1.182/1.183 is taken as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the requester's respondent brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions of the respondent brief. Patent owner is actually asserting that the requester respondent brief was improperly placed of record in the Image File Wrapper (IFW)) for the proceeding, and requesting that it be expunged, with requester being directed to replace the brief by a redacted or revised respondent brief to exclude the portions of the paper argued to be improper.

Patent owner's petition has been fully considered, and not found persuasive. A review of Requester Micron's respondent brief reveals that it does address the six Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1112

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[1] Petition at page 2.
[2] *Id.* at pages 2 and 5.
[3] *Id.* at page 2.
[4] *Id.* at page 6.
[5] *Id.* at page 4.
[6] *Id.*
[7] *Id.*

proceeding). However, these six proposed Samsung rejections have been adopted and maintained by the examiner in the present merged proceeding. Once the examiner adopted the Samsung-proposed rejections, they became the Office's own claim rejections, and under 35 U.S.C. § 314(b)(2) and 35 U.S.C. § 315(b)(2), they became subject to requester addressing the rejections.

Patent owner argues that 37 CFR 41.68(a)(4) limits requester Micron's respondent brief by stating that a requester's respondent brief may not address any brief of any other requester. Such argument is unpersuasive and not on point. 37 CFR 41.68(a)(4) is directed to filing a respondent brief in response to the brief of the other requester (in this case, Samsung), which was not filed in the instant proceeding. Rather, Micron's respondent brief is a respondent brief in response to the brief of the patent owner.

Patent owner argues that MPEP 2675.02 states that the respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. This does not support patent owner's position that requester Micron cannot address issues raised in patent owner's appellant brief, since the examiner's adopted rejections (originally proposed by Samsung) are addressed by patent owner's appellant brief, and Micron's respondent brief is entitled to then address what patent owner's appellant brief said about those rejections.

Patent owner presents arguments that the Board has indicated, in its decisions, that a requester cannot appeal a rejection that it did not propose. These arguments again are not on point, since requester Micron's respondent brief is addressing patent owner's argument as to the rejection the Office has adopted, as its own, and requester is not appealing a rejection that it did not propose. A third party requester may comment on an issue that has been adopted by the examiner and raised in patent owner's appeal brief, as the proposed rejections that are adopted become the examiner's rejections in the reexamination proceeding. Furthermore, 35 U.S.C. § 315(b)(2) states that a requester may be a party to any appeal taken by the patent owner and the statute does not provide the extent of the party.

Patent owner argues that requester Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '184 patent by addressing issues not raised in its request. This argument is not persuasive. First, the issues addressed by Micron are already part of the present reexamination proceeding, as discussed above. Second, this argument does not relate to the propriety of the issues raised in requester Micron's respondent brief, based on the statute, regulations, and practice.

Since requester Micron's respondent brief is limited to addressing issues raised in the patent owner's appellant brief that have been adopted by the examiner, the issues raised in requester Micron's respondent brief are not improper. Accordingly, patent owner's July 2, 2010 petition is dismissed.

CONCLUSION

1. Patent owner's July 2, 2010 petition to strike portions of Requester Micron's respondent brief is **dismissed**.

3. Any questions concerning this communication should be directed to the undersigned at (571) 272-3838.

Gregory Morse
Director
Central Reexamination Unit

8-31-10
KenAppeal/decisions/entry issues

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,112	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 02/23/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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EXAMINER

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DATE MAILED: 02/23/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on Patent Owner's "Petition to Expunge Third Party Requester's Rebuttal Brief," filed December 27, 2010 ("Rebuttal Brief Petition"); and Requester Micron's "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Rebuttal Brief," filed January 18, 2011 ("Rebuttal Brief Opposition"). In the Rebuttal Brief Petition, Patent Owner "requests that the Office expunge Micron's rebuttal brief because it raises issues that Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding (control no. 95/001,112 . . .)." Rebuttal Brief Petition, p. 1.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 22, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

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

10. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

11. On March 10, 2010, Micron filed a Notice of Cross Appeal for claims 13-14.

12. On May 10, 2010, Rambus filed an Appeal Brief.

13. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

14. On June 10, 2010, Rambus filed a Respondent Brief.

15. Also on June 10, 2010, Micron filed a Respondent Brief.

16. On September 24, 2010, the Examiner entered an Examiner's Answer.

17. On October 25, 2010, Rambus filed a Rebuttal Brief.

18. Also on October 25, 2010, Micron filed a Rebuttal Brief.

19. On December 27, 2010, Rambus filed the present Petition.

20. On January 18, 2011, Micron filed the present Opposition.

RELEVANT AUTHORITY

With respect to the contents of a rebuttal brief filed by a requester, 37 C.F.R. § 41.71(c) provides:

> (c) (1) The rebuttal brief of any requester may be directed to the examiner's answer and/or the respondent brief of the owner.
> (2) The rebuttal brief of a requester may not be directed to the respondent brief of any other requester.
> (3) No new ground of rejection can be proposed by a requester.

See also MPEP § 2678.

ANALYSIS

The parties do not contest that the relevant patentability issues were first presented by Requester Samsung in the Samsung-initiated proceeding. Those issues have been discussed in Micron's Appellant Brief, Rambus's Respondent Brief and Micron's Rebuttal Brief.

In a Petition filed June 2, 2010, Rambus sought to have stricken "those portions of Micron's appeal brief that raise issues that Micron did not propose in its request for reexamination." Appeal Brief Petition, p. 1. The Appeal Brief petition was denied in a Decision on Petition issued November 18, 2010.

In seeking expungement of Micron's Rebuttal Brief, Rambus relies on the same arguments as it did in the Appeal Brief Petition. Rambus does not contend that Micron's Rebuttal Brief does not comply with 37 C.F.R § 41.71(c), quoted above.

There are two dispositive factors to be considered here. First, during prosecution, the Examiner, i.e., the Office, has considered and taken a position on the patentability issues proposed by both Samsung and Micron. Those issues may be addressed by all parties in this merged proceeding.

Second, Rambus relies on MPEP § 2674, which states:

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

(emphasis in original).

The focus of this passage is that on appeal, a requester can address only rejections previously proposed during prosecution and cannot address a rejection first proposed on appeal. Here there is no disagreement that the issues addressed in Micron's Rebuttal Brief were first proposed during prosecution, albeit by Samsung.

DECISION

In view of the forgoing, the Rebuttal Brief Petition is DENIED.

James T. Moore
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,112	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 04/15/2011

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on Patent Owner Rambus Inc.'s "Petition for Reconsideration of Decision Denying Patent Owner's Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed December 20, 2010 ("Recon Petition"), and Third Party Requester Micron Technology, Inc's. "Third Party Requester's Opposition to Patent Owner's Petition for Reconsideration of Decision Denying Patent Owner's Petition to Strike Portions of the Third Party Requester's Appeal Brief," filed January 5, 2011 ("Recon Opposition").

In the Recon Petition, Patent Owner again requests that "the Office expunge from the record those portions of Micron's appeal brief that raise

issues that Micron did not propose in its reexamination request," citing the Decision on Petition on a similar issue in Merged Reexamination Proceeding 95/001,026 and 95/001,128. Recon Petition, p. 1.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

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

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross-Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief along with an initial Petition seeking expungement of portions of Micron's Cross-Appeal Brief.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On July 26, 2010, Micron filed an Opposition to Rambus's initial Petition.

19. On November 19, 2010, the Office entered a Decision on Petition denying Rambus's initial Petition.

20. On December 20, 2010, Rambus filed the present Recon Petition.

21. On January 5, 2011, Micron filed the present Recon Opposition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

Also relevant is MPEP § 2674(B):

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

(emphasis in original).

ANALYSIS

The Board confirms that the relevant statutes, rules and MPEP sections quoted above are intended to include all proposed rejections presented by the Examiner, patent owner or requester(s) during prosecution of a single unmerged reexamination proceeding or plural merged reexamination proceedings.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the following language of that section:

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

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

As the parties undoubtedly are aware, in the Merged Reexamination Proceeding 95/001,026 and 95/001,128, the Board reversed its initial

holding on this issue and denied Rambus's petition to expunge Micron's Cross-Appeal Brief. See Decision on Petition, February 16, 2011.

DECISION

For the forgoing reason, the Recon Petition is DENIED. This Decision constitutes final agency action on this matter.

James T. Moore
Acting Chief Administrative Patent Judge

Inter partes Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

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95/001,112	11/17/2008	6,182,184	8963.002.184	6635

22852 7590 04/27/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

RAMBUS, INC.
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.
Third Party Requester – *Inter partes* Reexamination Control 95/000,183

MICRON TECHNOLOGY, INC.
Third Party Requester – *Inter partes* Reexamination Control 95/001,112

Merged *Inter partes* Reexamination Control 95/000,183 and 95/001,112
Patent 6,182,184

DECISION ON PETITION

This is a decision on:

1. Patent Owner Rambus Inc.'s ("Rambus") "Petition Seeking Review of Decision Dismissing Patent Owner's Petition to Strike Portions of Third Party Requester's Respondent Brief," filed October 15, 2010 ("Respondent Brief Recon Petition"), and Third Party Requester Micron Technology, Inc's. ("Micron") "Third Party Requester's Opposition to Patent Owner's Petition Seeking Review of Decision Dismissing Patent Owner's Petition to Strike Portions of Third Party Requester's Respondent Brief," filed January 5, 2011 ("Respondent Brief Recon Opposition"); and

2. Rambus's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Rebuttal Brief," filed March 23, 2011 (Rebuttal Brief Recon Petition).

In the Respondent Brief Recon Petition and Rebuttal Brief Recon Petition, Rambus requests that the Office expunge Micron's Respondent Brief and Rebuttal Brief, respectively, because the briefs address issues that initially were raised in the reexamination request of Requester Samsung Electronics Co., Ltd. ("Samsung") and not by Micron. Respondent Brief Recon Petition, pp. 1-2, Rebuttal Brief Recon Petition, pp. 1-2.

FINDINGS

1. Patent 6,182,184 issued on January 30, 2001 with 29 claims. The '184 patent is assigned to Patent Owner Rambus.

2. Third Party Requester Samsung filed an initial request for *inter partes* reexamination on October 4, 2006 and a corrected request on August 24, 2007. Reexamination Control 95/000,183 was assigned to this request.

3. On October 19, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-29 of the '184 patent in the '183 proceeding.

4. Third Party Requester Micron filed a request for *inter partes* reexamination on November 17, 2008. Reexamination Control 95/001,112 was assigned to this request.

5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 13-14 of the '184 patent in the '1112 proceeding.

6. On March 6, 2009, the '183 and '1112 proceedings were merged into a single proceeding.

7. The merged proceeding progressed to the point where, on August 21, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-29.

8. On September 21, 2009, Rambus filed comments in response to the ACP.

9 On October 21, 2009, Samsung and Micron both separately filed comments in response to the ACP.

10. On January 29, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-23 and confirming claims 24-29.

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

12. On February 26, 2010, Rambus filed a Notice of Appeal for claims 1-23.

13. On March 10, 2010, Micron filed a Notice of Cross-Appeal for claims 13-14.

14. On May 10, 2010, Rambus filed an Appeal Brief.

15. Also on May 10, 2010, Micron filed a Cross-Appeal Brief.

16. On June 10, 2010, Rambus filed a Respondent Brief and a Petition seeking expungement of portions of Micron's Cross-Appeal Brief.

17. Also on June 10, 2010, Micron filed a Respondent Brief.

18. On July 2, 2010, Rambus filed a Petition seeking expungement of portions of Micron's Respondent Brief.

19. On July 26, 2010, Micron filed an Opposition to Rambus's Appeal Brief Petition.

20. On September 7, 2010, the Office entered a Decision on Petition denying Rambus's Respondent Brief Petition.

21. On October 15, 2010, Rambus filed a Petition seeking reconsideration of the Office's Decision denying Rambus's Respondent Brief Petition.

22. On October 25, 2010, Rambus filed a Rebuttal brief.

23. Also on October 25, 2010, Micron filed a Rebuttal Brief.

24. On November 19, 2010, the Office entered a Decision denying Rambus's Appeal Brief Petition.

25. On December 20, 2010, Rambus filed a Petition seeking reconsideration of the Office's Decision denying Rambus's Appeal Brief Petition.

26. On December 27, 2010, Rambus filed a Petition seeking expungement of Micron's Rebuttal Brief.

27. On January 5, 2011, Micron filed an Opposition to Rambus's Petition seeking reconsideration of the Office's Decision denying Rambus's Appeal Brief Petition.

28. Also on January 5, 2011, Micron filed an Opposition to Rambus's Petition seeking reconsideration of the Office's Decision denying Rambus's Respondent Brief Petition.

29. On January 18, 2011, Micron filed an Opposition to Rambus's Rebuttal Brief Petition.

30. On February 23, 2011, the Office entered a Decision denying Rambus's Rebuttal Brief Petition.

31. On March 23, 2011, Rambus filed a petition seeking reconsideration of the Office's Decision denying Rambus's Rebuttal Brief Petition.

32. On April 15, 2011, the Office entered a Decision denying Rambus's Petition seeking reconsideration of the Decision denying Rambus's Appeal Brief Petition.

RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

> (b) THIRD-PARTY REQUESTER.- A third-party requester-
> (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent* . . . .

(emphasis added).

Similarly, 37 C.F.R. § 41.61(b)(2) provides:

> Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20 (b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to *any final decision favorable to the patentability*, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(emphasis added).

Similarly, MPEP § 2674.01 provides:

> Within fourteen days of service of a patent owner's notice of appeal, a third party requester who has not filed a notice of appeal may file a notice of cross appeal, the cross appeal being with respect to *any final decision (i.e., decision in the RAN) favorable to the patentability of any claim of the patent.*

(emphasis added).

Also relevant is MPEP § 2674(B):

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

each previously proposed rejection to be contested.

(emphasis in original).

In respect to merged reexamination proceedings, MPEP § 2686.01 III provides:

> A decision to merge the reexamination proceedings should include a requirement that the patent owner maintain identical claims in both files. It will further require that responses/comments by the patent owner and the third party requester(s) must consist of a single response/comment paper, addressed to both files, filed in duplicate each bearing a signature, for entry in both files.

ANALYSIS

The Board confirms that the relevant statutes, rules and MPEP sections quoted above are intended to include all proposed rejections presented by the Examiner, patent owner or requester(s) during prosecution of a merged reexamination proceeding.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the following language of that section:

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

(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See,* MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of

rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

Also noteworthy is the requirement in MPEP § 2686.01 III that in a merged proceeding, the parties are required to address a single set of claims and submit identical responses in all merged reexamination proceeding files. Thus, all rejections adopted or rejected by the Examiner, whether originating from the Examiner or a requester, are before all of the requesters.

As the parties undoubtedly are aware, in the present merged proceeding, on April 15, 2011, the Board reached a similar result on a Rambus Petition for reconsideration seeking expungement of portions of Micron's Appeal Brief. Also, in Merged Reexamination Proceeding 95/001,026 and 95/001,128, on February 16, 2011, the Board reversed its initial position on this issue and denied Rambus's Petition to expunge Micron's Cross-Appeal Brief.

DECISION

In view of the foregoing, Rambus's Respondent Brief Recon Petition and Rebuttal Brief Recon Petition are DENIED. This Decision constitutes Final Agency Action on these matters.

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Acting Chief Administrative Patent Judge

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