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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,114	11/18/2008	7219744	069669-0007-06	8073
9629	7590	09/23/2010	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ART UNIT	PAPER NUMBER

DATE MAILED: 09/23/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
BRACEWELL & GIULIANI LLP  
P.O. BOX 61389  
HOUSTON, TX 77208-1389

Date:

**MAILED**

**SEP 23 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001114  
PATENT NO. : 7219744  
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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**SEP 23 2010**

**CENTRAL REEXAMINATION UNIT**

In re Pietras  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,114  
Filed: November 18, 2008  
For: U.S. Patent No. 7,219,744

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

This decision is in response to the July 26, 2010 requester petition entitled "Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 2/16/2010" (the July 26, 2010 requester petition).

The July 26, 2010 requester petition and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.183 has been received.

**SUMMARY**

The July 26, 2010 requester petition is **dismissed**.

**BACKGROUND**

- On May 22, 2007, U.S. Patent 7,219,744 (the '744 patent) issued to Pietras.
- On November 18, 2008, the requester filed a request for *inter partes* reexamination. The reexamination proceeding was assigned control no. 95/001,114 (the '1114 proceeding).
- On February 6, 2009, the Office mailed an order granting reexamination and a first Office action in the '1114 proceeding.
- Prosecution progressed until, on December 18, 2009, the Office mailed an action closing prosecution (ACP).
- On January 19, 2010, the patent owner filed comments to the December 18, 2009 ACP.
- On February 16, 2010, the requester filed comments.

- On March 12, 2010, the Office mailed a right of appeal notice (RAN), in which the examiner refused to address rejections newly proposed by the requester in its February 16, 2010 comments, because the newly proposed rejections were not presented in accordance with MPEP 2617.
- On April 9, 2010, the requester filed a notice of appeal.
- On April 12, 2010, the patent owner filed a notice of appeal.
- On June 9, 2010, the requester filed an appellant brief.
- On June 14, 2010, the patent owner filed an appellant brief on appeal.
- On July 2, 2010, the requester filed a petition entitled “Petition Under 37 CFR § 1.181, 1.182, and/or 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester’s Comments Dated 2/16/2010” (the July 2, 2010 requester petition).
- On July 9, 2010, the patent owner filed a respondent brief, in response to requester’s June 9, 2010 appellant brief.
- On July 14, 2010, the requester filed a respondent brief, in response to patent owner’s June 14, 2010 appellant brief on appeal.
- On July 21, 2010, the Office mailed a decision dismissing the July 2, 2010 requester petition as untimely under 37 CFR 1.181(f).
- On July 26, 2010, the requester filed the present petition, entitled ““Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester’s Comments Dated 2/16/2010” (the July 26, 2010 requester petition).

## **STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

### **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.

\*

\*

(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 1.183 provides:**

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

**37 CFR 1.903 provides:**

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

### DECISION

As in requester's (earlier) July 2, 2010 petition under 37 CFR 1.181, the requester again requests "that the rejections proposed in Requester's response filed on 2/16/2010, that were not considered by the Examiner, be considered proper, entered into the record, and considered by the Office". The requester also requests waiver of 37 CFR 1.951, "such that Requester may submit replacement comments that are strictly limited to the contents of the previously filed comments". The requester also points to the July 21, 2010 decision dismissing requester's earlier July 2, 2010 petition, in which the Office reminded the requester that petitions under 37 CFR 1.183 (or 37 CFR 1.182) must be filed under separate cover pursuant to 37 CFR 1.4(c), in order for the Office to enter and consider the petitions. The requester apparently states that for this reason, "the Requester files this petition under 37 § [sic] C.F.R. § 1.183".

The July 21, 2010 decision by the Office, however, dismissed requester's July 2, 2010 petition because it was untimely pursuant to 37 CFR 1.181(f). To be timely, any petition under 37 CFR 1.181, 1.182, or 1.183 must be filed within two months of the action or notice from which relief is requested. In the present case, any petition under 37 CFR 1.181, 1.182, or 1.183 must have been filed within two months from the mail date of the March 12, 2010 right of appeal notice (RAN), i.e., on or before May 12, 2010. For this reason, the instant petition filed on July 26, 2010 is also untimely, and would have been untimely even if filed at the time the 37 CFR 1.181 was filed. Accordingly, the present petition is treated as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.181(f).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an *extraordinary* situation, *when justice requires*, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

Addressing the instant petition under 37 CFR 1.183, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. The requester has provided no explanation for the delay in filing its initial petition under 37 CFR 1.181 on July 2, 2010. The requester has also failed to provide an explanation as to why it failed to file the July 2, 2010 petition until after the proceeding was on appeal by both parties, *and after the appeal had been briefed by both parties.*

For the reasons given above, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

Note that even if the present petition under 37 CFR 1.183 for waiver of 37 CFR 1.181(f) had been granted, the response to any such waiver would have been a petition under 37 CFR 1.181(a), since the entire argument presented by the present petition is challenging the propriety of the examiner's action.

#### CONCLUSION

- The July 26, 2010 requester petition is **dismissed**.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for appropriate action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, David Reip, of CRU Art Unit 3993, at (571) 272-4702.
- Any further correspondence with respect to this matter should be addressed as follows:

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

By Mail: Mail Stop Petition  
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By Fax: (571) 273-9900

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

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



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

Kenpet8  
9-22-10



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95/001,114	11/18/2008	7219744	069669-0007-06	8073
9629	7590	04/14/2011	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP (WA) 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
			ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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Date:

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**APR 14 2011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001114  
PATENT NO. : 7219744  
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 14 2011

CENTRAL REEXAMINATION UNIT

In re Pietras  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,114  
Filed: November 18, 2008  
For: U.S. Patent No. 7,219,744

: DECISION DISMISSING  
: PETITION, EXPUNGING  
: PAPERS, AND *SUA SPONTE*  
: VACATING OFFICE ACTIONS

This decision is in response to the October 18, 2010 renewed requester petition entitled "Petition for Consideration of Proposed Rejections" (the October 18, 2010 requester petition).

The October 18, 2010 requester petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.183 has been received.

SUMMARY

1. The October 18, 2010 requester petition is dismissed.
2. However, in view of certain procedural irregularities noted by the Office in the present proceeding, the December 18, 2009 action closing prosecution (ACP), the March 12, 2010 right of appeal notice (RAN), and the September 24, 2010 examiner's answer, are *sua sponte* vacated.
3. The requester's May 6, 2009 and February 16, 2010 comments, as well as the requester's appellant's, respondent's and rebuttal briefs filed on June 9, 2010, July 14, 2010, and October 22, 2010, respectively, are improper, and are being expunged from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.<sup>1</sup>
4. The requester is given **fifteen (15) days** from the mailing date of this decision to submit one corrected comments submission, in response to patent owner's April 6, 2009 response, in accordance with this decision and its guidance. **If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be expunged, and no further § 1.947 comments opportunity,**

<sup>1</sup> See MPEP 2667.

**pursuant to 35 U.S.C. 314(b)(2), will be provided** for the requester to address issues raised by patent owner's amendment of April 6, 2009, or to address any issues regarding the April 6, 2009 amendment that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.

5. Any papers going to the merits, including, for example, the Office actions (including the examiner's answer), and all responses, comments, or briefs, filed by the parties subsequent to patent owner's April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits.**

### BACKGROUND

- On May 22, 2007, U.S. Patent 7,219,744 (the '744 patent) issued to Pietras.
- On November 18, 2008, the requester filed a request for *inter partes* reexamination. The reexamination proceeding was assigned control no. 95/001,114 (the '1114 proceeding).
- On February 6, 2009, the Office mailed an order granting reexamination and a first Office action in the '1114 proceeding.
- On April 6, 2009, the patent owner filed a response, including an amendment to the claims.
- On May 6, 2009, the requester filed comments, including a first set of newly proposed rejections.
- On December 18, 2009, the Office mailed an action closing prosecution (ACP), in which the examiner refused to adopt the first set of rejections newly proposed by the requester in its May 6, 2009 comments, because of requester's failure to provide an explanation for the submission of a reference pursuant to 37 CFR 1.948(a)(3).<sup>2</sup>
- On January 19, 2010, the patent owner filed comments under 37 CFR 1.951(a), including an amendment identical to the amendment which was submitted with patent owner's April 6, 2009 response and which was previously entered by the Office. As stated by the patent owner on page 7 of the January 19, 2010 comments: "No new amendments are proposed in this response".

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<sup>2</sup> MPEP 2666.05 provides, in pertinent part:

... 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.

- On February 16, 2010, the requester filed comments under 37 CFR 1.951(b), including a second set of newly proposed rejections.
- On March 12, 2010, the Office mailed a right of appeal notice (RAN), in which the examiner refused to address the second set of rejections newly proposed by the requester in its February 16, 2010 comments, because the newly proposed rejections were not presented in accordance with MPEP 2617.
- On April 9, 2010, the requester filed a notice of appeal.
- On April 12, 2010, the patent owner filed a notice of appeal.
- On June 9, 2010, the requester filed an appellant's brief.
- On June 14, 2010, the patent owner filed an appellant's brief.
- On July 2, 2010, the requester filed a petition entitled "Petition Under 37 CFR § 1.181, 1.182, and/or 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 2/16/2010" (the July 2, 2010 requester petition).
- On July 9, 2010, the patent owner filed a respondent's brief, in response to requester's June 9, 2010 appellant's brief.
- On July 14, 2010, the requester filed a respondent's brief, in response to patent owner's June 14, 2010 appellant's brief.
- On July 21, 2010, the Office mailed a decision dismissing the July 2, 2010 requester petition as untimely under 37 CFR 1.181(f).
- On July 26, 2010, the requester filed a petition entitled "Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 2/16/2010" (the July 26, 2010 requester petition).
- On September 23, 2010, the Office mailed a decision dismissing the July 21, 2010 requester petition.
- On September 24, 2010, the Office mailed an examiner's answer.
- On October 18, 2010, the requester filed the present petition, entitled "Petition for Consideration of Proposed Rejections" (the October 18, 2010 requester petition).
- On October 22, 2010, the requester filed a rebuttal brief.
- On October 25, 2010, the patent owner filed a rebuttal brief.

- On January 21, 2011, the Office mailed a communication notifying the parties that the October 22 and October 25, 2010 rebuttal briefs had been entered.
- On January 31, 2011, the Office mailed a notice entitled “Board of Appeals and Interferences Docketing Notice”.
- On February 17, 2011 and on February 24, 2011, the Office mailed a notice entitled “Notice of Hearing”, notifying the parties of a hearing scheduled for March 16, 2010.
- On March 28, 2011, the present proceeding was remanded by the Board of Patent Appeals and Interferences (BPAI) for consideration of the present petition, filed by the requester on October 18, 2010.

## DECISION

### *The October 18, 2010 Petition Is Dismissed*

The requester requests a waiver of the requirement of 37 CFR 1.181(f), “that petitions filed under 37 CFR § 1.181, 1.182, or 1.183 must be filed within two months of the action for which relief is sought”. Specifically, requester requests that the Office consider rejections which were newly proposed by the requester in its comments filed February 16, 2010, and which were refused consideration by the examiner in the March 12, 2010 RAN. **The requester, however, failed to file a petition requesting such relief until July 2, 2010, nearly four months after the mail date of the RAN.**

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an *extraordinary* situation, *when justice requires*, on petition of the interested party. The burden is on the petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

The requester argues that an extraordinary situation exists because “[the r]equester may be denied due process if this petition is denied”. The requester asserts that it had “timely” presented the proposed rejections in the April 9, 2010 notice of appeal (filed within two months of the March 12, 2010 RAN),<sup>3</sup> and included detailed arguments in its June 9, 2010 appellant’s brief. The requester argues that, for this reason, the September 23, 2010 dismissal asserting that the petitions were not filed until well into the appeal process “is not accurate”. The requester admits that “the request was not raised in the form of a petition”. The requester argues, however, that to deny that the issue was raised, even in the absence of a petition, “is putting form over substance”.

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<sup>3</sup> Exhibit J of the October 18, 2010 petition consists of a copy of the requester’s April 9, 2010 appeal notice. Page 2 of the notice is entitled, in part, as “Grounds of Rejection . . . That Were Not Adopted by the Examiner *Which The 3<sup>rd</sup> Party Intends To Contest*” (emphasis added). The Office also notes that while there are only three sheets, each sheet is paginated to indicate that there are four sheets.

35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings be conducted with special dispatch. Accordingly, in an *inter partes* reexamination proceeding, it is especially important that petitions under 37 CFR 1.181, 1.182, and 1.183 be filed within the two-month time period provided by 37 CFR 1.181(f).

The RAN, which refused to address nine of the rejections newly proposed on February 16, 2010, was mailed on March 12, 2010. **The requester failed to file any petition regarding the issuance of the RAN within two months of the mail date of the RAN.** Furthermore, a review of requester's April 9, 2010 notice of appeal does not reveal the presence of an accompanying petition under 37 CFR 1.181 requesting review of the RAN, including an explanation of the grounds relied upon to contest the examiner's refusal to consider the proposed rejections, or the presence, for that matter, of any other accompanying petition in regard to issuance of the RAN. **In addition, requester's appellant's brief of June 9, 2010 was not accompanied by a petition under 37 CFR 1.181, seeking review of the RAN, and by a petition under 37 CFR 1.183, seeking waiver of the two-month period set forth in 37 CFR 1.181(f) to permit consideration of the petition under 37 CFR 1.181.**

Additionally, the manner of presentation of the proposed rejections, within the notice of appeal and the appellant brief, did not serve, in the absence of a petition, to promptly alert the Office to any issue which may be the subject of a request for review of the RAN. It is for this reason that *any* such petition **must** be submitted as a separate paper pursuant to 37 CFR 1.4(c).

A petition for relief was eventually filed by the requester on July 2, 2010, well after the March 12, 2010 RAN, the April 9 and April 12, 2010 notices of appeal, and the June 9 and June 14, 2010 appellant briefs. The July 2, 2010 petition under 37 CFR 1.181 was dismissed on July 21, 2010, and a petition under 37 CFR 1.183, filed on July 26, 2010, was dismissed on September 23, 2010. The September 23, 2010 dismissal was based on timeliness considerations, noting **the failure of the requester to provide any explanation** for waiting until (a) July 2, 2010 to file its initial petition, and in particular, waiting until (b) after the appeal by both parties, and (c) after the appeal had been briefed by both parties.<sup>4</sup>

The requester fails to directly address the basis for the September 23, 2010 dismissal, by supplying facts and circumstances relating to the delay in submitting a petition. Rather, the requester simply characterizes the lack of a timely filed petition as merely "putting form over substance". The failure to timely file a petition for relief, however, was a serious omission, which caused a substantial delay; as the proceeding is now well into the appeal stage. Given the statutory mandate for special dispatch in *inter partes* reexamination proceedings, the Office will not accept unexplained delays (a) in moving the proceeding forward on the merits, and (b) in seeking relief from an action or requirement of the Office.

In summary, the requester has not provided any explanation for the delay in submitting its initial petition.

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<sup>4</sup> September 23, 2010 dismissal, page 4.

For the reasons given above, the requester has not met its burden of establishing an extraordinary situation where justice would require waiver of the provisions of 37 CFR 1.181(f). Accordingly, the present petition under 37 CFR 1.183 is dismissed.

***The December 18, 2009 ACP, the March 12, 2010 RAN, and the September 24, 2010 Examiner's Answer, Are Sua Sponte Vacated***

Upon further consideration, the Office has noted certain procedural irregularities in this proceeding. Accordingly, the Office is *sua sponte* issuing the following decision.

The examiner failed to separately notify the requester that the May 6, 2009 requester comments and the February 16, 2010 requester comments, respectively, were improper. Specifically, the examiner failed to separately provide the requester with a complete analysis of the impropriety of the rejections newly proposed by requester's May 6, 2009 and February 16, 2010 comments, respectively. In addition, the examiner failed to provide the requester, in each instance, with **an opportunity to file corrected comments pursuant to MPEP 2666.05**. Instead, in the December 18, 2009 ACP, the examiner provided only one reason why the presentation of the newly proposed rejections was improper,<sup>5</sup> and refused to adopt the proposed rejections, without any consideration of the proposed rejections on the merits (obviousness or anticipation). In the March 12, 2010 RAN, the examiner objected, for the first time, to certain newly proposed rejections due to their failure to comply with MPEP 2617, and simply did not consider, on the merits, the proposed rejections newly advanced by the requester, and did not make the determination to adopt, or refuse to adopt, the newly proposed rejections.<sup>6</sup> And, in each instance, the examiner further failed to 1) refuse entry of requester's comments with an explanation of their impropriety, and 2) provide the requester with a 15-day time period to file a corrected comments submission, pursuant to MPEP 2666.05.

To remedy these procedural irregularities, the December 18, 2009 ACP, the March 12, 2010 RAN, and the September 24, 2010 examiner's answer, are hereby vacated.

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<sup>5</sup> The examiner correctly objected to the citation of RU '617 under 37 CFR 1.948(a)(3) in the May 6, 2009 comments, for the failure of the requester to explain the circumstances under which the prior art first became known or available to the requester, including the date and manner that the art became known or available, and why it was not available earlier, as set forth in MPEP 2666.05.

<sup>6</sup> The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitations on what newly cited prior art the requester may file in an *inter partes* reexamination as part of, for example, a document entitled "information disclosure statement", which is filed with requester's comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement". To newly propose a rejection based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by amendment. See MPEP 2666.05. In the present case, the requester states that the additional prior art search was conducted "upon review of patent owner's amendment", but fails to show how the newly proposed rejection applying the RU '617 reference was necessitated by the amendment. Similarly, if the requester wishes to newly propose a rejection citing this reference to rebut an argument in patent owner's response, pursuant to 37 CFR 1.948(a)(2), the requester must show how the newly proposed rejection is necessitated by patent owner's amendment, which is not the case here.

For the reasons given *infra*, the requester's May 6, 2009 and February 16, 2010 comments, as well as the requester's appellant's, respondent's and rebuttal briefs filed on June 9, 2010, July 14, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

Any papers going to the merits, including, for example, the Office actions (including the examiner's answer), and all responses, comments, or briefs, filed by the parties subsequent to patent owner's April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits.**

### ***Requester's May 6, 2009 Comments Are Improper***

Requester's May 6, 2009 comments are improper due to the defective presentation of the newly proposed rejections appearing on pages 11-32.

#### **1. The Newly Proposed Rejections Are Not in Compliance with MPEP 2617.**

The requester has repeatedly argued, in papers filed subsequent to the RAN, that the guidelines set forth in MPEP 2617 do not apply to requester's comments after patent owner's response (see, e.g., requester's July 2, 2010 petition, pages 6-7).<sup>7</sup> See, however, MPEP 2666.05, which is expressly entitled "Third Party Comments after Patent Owner's Response",<sup>8</sup> and which provides, in pertinent part (emphasis added):

... where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), **the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617**, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future

<sup>7</sup> This decision does not address whether the November 18, 2008 request complies with the Office's regulatory filing date requirements, such as those explained in MPEP 2614 and 2617 (to the extent that waiver is needed, waiver is hereby given). However, the request is replete with inappropriate language that lumps together multiple alternative proposed rejections. See, e.g., page 212 of the request: "... claim 6 is obvious under 35 U.S.C. § 103 over Krasnov '422 in view of one or more of Delano '968, Willis '927, and Brown '347". The request is also accompanied by references which the request fails to identify as raising an SNQ (and fails to provide the corresponding explanation as to how the reference raises an SNQ), or which the request fails to cite as part of a reference combination including at least one reference which the requester has properly identified as providing the basis for an SNQ, in a proposed rejection. See, for example, the Willis '814 and Gjedebo '617 references. The request also fails to definitively identify these documents as part of a proposed rejection, and provide the explanation required by 37 CFR 1.915. It is also unclear over which references the requester intends to include in each proposed rejection. For example, see page 45 of the request, which includes a discussion of Willis '814. This reference, however, is not identified as part of any proposed rejection. The requester also improperly discusses issues not within the scope of reexamination. See the footnotes appearing throughout the request, discussing issues under 35 U.S.C. 112, with respect to the original patent claims; contrary to MPEP 2658.

<sup>8</sup> And which can be found upon a review of the index of MPEP Chapter 2600, which governs *inter partes* reexamination proceedings.

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.

The requester's May 6, 2009 comments submission fails to clearly identify which proposed rejections are being set forth, and fails to provide a clear and complete explanation for every claim for which a rejection is proposed, due to the lumping together of the identification and explanation of multiple proposed rejections. See, for example, the rejection newly proposed on page 11 of the comments: "And, as demonstrated below, claims 1-5, 8-13 and 15-31 of Pietras '744 are obvious over RU '617 **alone, or in combination with one or more of** Gjedebo '322, Krasnov '422, Tessari '279, Brown '244, Delano '968, **and/or** Willis '927" (emphasis added in bold). In addition to a rejection over RU '617 alone, it is not clear over which combination(s) of the cited documents the requester intends to definitively propose a rejection, and which claims are proposed to be rejected over which of the cited documents or combinations of documents.<sup>9</sup>

In addition, the detailed explanation for the multiple, distinct (newly) proposed obviousness rejections are also lumped together. For example, see pages 11-13 of the May 6, 2009 comments. The explanation fails to provide a complete and separate explanation for how *each* distinct combination of documents applies to limitations of claim 1. In other words, the requester fails to provide a separate explanation for each newly proposed rejection. Similar problems exist with the remainder of the newly proposed obviousness rejections. Therefore, the May 6, 2009 comments submission is unclear how the cited documents are applied for each distinct (newly) proposed obviousness rejection identified in the comments.

It is also not clear whether, in some cases, the requester's comments intend to propose a rejection. See, for example, the offhand reference, throughout the footnotes, to GB 2 224 481. It is not clear whether the requester intends to propose a rejection based on this reference. The comments must clearly and definitively set forth each proposed rejection *in the body of the comments*. In addition, any newly proposed rejection must comply with all applicable rules and procedural standards, including, for example, MPEP 2617.

Furthermore, the explanations for the proposed rejections are unclear and incomplete. For example, the explanation on pages 11-13 fails to explain which teachings of Krasnov '422, Tessari '279, and Brown '244 are to be applied, and how they are to be applied, to the limitations

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<sup>9</sup> Examples of multiple distinct combinations of documents, which are lumped together by the above-quoted statement, are:

RU '617 in view of Gjedebo '322.

RU '617 in view of Krasnov '422.

RU '617 in view of Gjedebo '322 and Krasnov '422.

RU '617 in view of Gjedebo '322 and Tessari '279.

RU '617 in view of Gjedebo '322 and Krasnov '422 and Tessari '279.

RU '617 in view of Gjedebo '322 and Krasnov '422 and Brown '244.

RU '617 in view of Gjedebo '322 and Krasnov '422 and Tessari '279 and Brown '244.

RU '617 in view of Krasnov '422 and Tessari '279.

RU '617 in view of Krasnov '422 and Brown '244.

And so on.

of claim 1. In addition, the explanation on pages 11-13 fails to provide at least one basis for combining *each* of the cited documents, including the Krasnov '422, Tessari '279 and Brown '244 references. When documents are combined in a proposed rejection, the combination must be explicitly and clearly set forth by applying *each* of the references to *each* claim limitation, as appropriate, and making the required showing of a reason to combine the documents pursuant to 35 U.S.C. 103(a). See MPEP 2617. Again, similar problems exist with the remainder of the newly proposed obviousness rejections. Therefore, the May 6, 2009 comments submission fails to explain the specifics of each proposed obviousness rejection. Accordingly, the requester has not provided a detailed explanation of how *each* of the cited documents applies to *every* claim which is proposed to be rejected, in *each* of the newly proposed rejections.

Also, the requester's May 6, 2009 comments submission does not clearly specify what new non-cumulative technological teaching, which forms the basis for a substantial new question (SNQ), is taught by at least one of the documents cited for *each* newly proposed rejection. For each rejection newly proposed by the requester, the requester must specify where, in each document cited alone, or in at least one document of each cited combination of documents, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number). For example, the requester, on page 11 of the May 6, 2009 comments, proposes an obviousness rejection over RU '617 alone.<sup>10</sup> The requester, however, fails to specify what new non-cumulative technological teaching, which forms the basis of an SNQ, is taught by RU '617, why the teaching is new and is not cumulative to the prior art of record, and where in RU '617 the new, non-cumulative technological teaching is provided.<sup>11</sup> Again see MPEP 2617. Similar problems exist with the remainder of the newly proposed obviousness rejections.

2. The requester has not specifically explained how patent owner's April 6, 2009 amendment necessitated each proposed new ground of rejection, for each newly proposed rejection citing newly submitted prior art, such as RU '617, or citing a document which was determined, in the order, to fail to raise an SNQ, such as Delano '968 or Willis '927.

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<sup>10</sup> The Office again notes that the examiner correctly objected to the citation of RU '617 under 37 CFR 1.948(a)(3) in the May 6, 2009 comments, for the failure of the requester to explain the circumstances under which the prior art first became known or available to the requester, including the date and manner that the art became known or available, and why it was not available earlier, as set forth in MPEP 2666.05.

<sup>11</sup> If, however, RU '617, which is newly submitted by the May 6, 2009 requester comments in the present proceeding, is one of a combination of documents cited in a newly proposed rejection, the requester would only need to show why the April 6, 2009 patent owner amendment necessitated the inclusion of RU '617 in the newly proposed rejection.

The requester newly submitted, for example, RU '617 with requester's May 6, 2009 comments.<sup>12</sup> Delano '968 and Willis '927, for example, were not found by the examiner to raise an SNQ in the order granting reexamination, mailed on February 6, 2009. Therefore, for *each* of these documents cited alone in a proposed rejection, and for *each* distinct combination of documents citing at least one of these documents in a proposed rejection, the requester must specifically explain how the presence of a teaching in each of these documents, if cited alone, or, if cited as one of the documents in a document combination, how the presence of a teaching in at least one of the documents of the document combination, corresponds to at least one claim limitation newly added by patent owner's amendment. See MPEP 2666.05.

3. The requester's May 6, 2009 comments submission does not clearly and specifically explain, for each newly proposed rejection citing a document that was determined, in the order, to fail to raise an SNQ, such as Delano '968 or Willis '927, how each of these documents raise an SNQ with respect to the newly amended claims.

In the February 6, 2009 order, the examiner determined that Delano '968 and Willis '927, for example, failed to raise an SNQ with respect to the original patent claims. The requester has not *specifically explained*, for each newly proposed rejection citing Delano '968 or Willis '927, how each of these documents *raises an SNQ* with respect to the newly amended claims, i.e., how these two documents address the newly amended part of the claim, in a way that was not addressed in an earlier examination by the Office of the claims.

4. The citation of any document, such as Delano '968 or Willis '927, which was determined, in the order, to fail to raise an SNQ with respect to the original patent claims, for the express purpose of relying on an alleged teaching of a feature originally recited in the patent claims, is deemed to be inappropriate.

In the April 6, 2009 amendment, the independent claims were amended to recite a plurality of a feature originally recited in the patent claims,<sup>13</sup> i.e., a radially movable (or radially displaceable) gripping element for gripping (or engaging) an inner wall, where the gripping element is included in the top drive.

Regarding Delano '968, the examiner expressly determined, in the order, that this document fails to raise a substantial new question (SNQ), particularly with respect to "the feature that the top drive includes radially displaceable gripping element [sic] for engagement with the inner wall"

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<sup>12</sup> The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitations on what newly cited prior art the requester may file in an *inter partes* reexamination as part of, for example, a document entitled "information disclosure statement", which is filed with requester's comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement". To newly propose a rejection based on such prior art, however, the requester must also comply with 37 CFR 1.947. The requester must show how the newly proposed rejection is necessitated by amendment.

<sup>13</sup> See, e.g. original dependent claims 6 and 14, and original independent claim 21.

as recited in original claims 6, 14-16 and 21-31. The examiner further stated that “Delano [‘968 does not] have radially displaceable elements” (plural form of “element” in original).<sup>14</sup>

Patent owner’s April 6, 2009 amendment inserted, in each of the independent claims, a plurality of the same feature recited in the original claims, i.e., a radially movable (or radially displaceable) gripping element for gripping (or engaging) an inner wall, where the gripping elements are included in the top drive. Thus, the examiner’s determination in the order that Delano ‘968 did not raise an SNQ, particularly with respect to this feature, renders inappropriate the citation of Delano ‘968 expressly for the purpose of relying on the same alleged teaching of this feature, as a basis for an SNQ.

The requester, however, appears to be again relying, although not clearly or specifically in the May 6, 2009 comments, on Delano ‘968 for the same alleged teaching of a radially movable (or radially displaceable) gripping element for gripping (or engaging) an inner wall, as the new, non-cumulative teaching which forms the basis of the SNQ for each document combination citing Delano ‘968. See, for example, pages 12, 15, 16, 19, 20, 21, 23, 24, 25, 26, 28, and 30 of the May 6, 2009 comments. For the reasons given above, the citation of Delano ‘968 for the express purpose of relying on an alleged teaching of radially movable (or displaceable) gripping elements for gripping (or engaging) an inner wall, as the basis for an SNQ in each document combination citing Delano ‘968, is deemed to be inappropriate.

Similarly, the requester’s apparent reliance, although not clearly or specifically, on the alleged teaching of Willis ‘927 of a radially movable (or radially displaceable) gripping element for gripping (or engaging) an inner wall, as the basis for an SNQ is deemed to be inappropriate. Although the examiner did not expressly discuss Willis ‘927 with respect to this specific feature, the examiner determined, in the order, that Willis ‘927 failed to raise an SNQ with respect to original patent claims 1-21, which included claims which recited this feature, i.e., claims 6, 14-16, and 21-31. For the same reason, a reliance on the alleged teaching of this feature by any other document, which was determined by the order to fail to raise an SNQ with respect to original patent claims which recited this feature, would also be considered to be inappropriate.

The determination by the examiner of whether a substantial new question is raised by a document cited in the request is final and nonappealable, pursuant to 35 USC 312(c). The Office notes that this determination by the examiner in the February 6, 2009 order was not challenged by the requester in a petition filed under 37 CFR 1.181, as set forth in 37 CFR 1.927. Furthermore, the requester is cautioned that any such petition, if filed at this stage of the proceeding, would be deemed to be untimely, would not be considered, and would be expunged as an improper paper.

Note, however, that **any rejection using Delano ‘968 or Willis ‘927, in combination with another reference that was found to raise an SNQ in the order granting reexamination, would include the requisite SNQ (provided by the other reference), and the question of whether Delano ‘968 and/or Willis ‘927 teaches the amendatory language would be an appealable issue.**

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<sup>14</sup> See page 10 of the February 6, 2009 order.

### ***Requester's February 16, 2010 Comments Are Improper***

Requester's February 16, 2010 comments are improper due to the defective presentation of the newly proposed rejections 2-5, 7, and 10-13, appearing on pages 3-23. Specifically, requester's February 16, 2010 comments are improper for the following reasons, the expanded substance of which is discussed in detail above with respect to requester's May 6, 2009 comments:

1. The newly proposed rejections are not in compliance with MPEP 2617.

See, for example, rejection no. 2, newly proposed on page 3 of the comments: "Claims 1, 3-5, 8, 17, 20, and 29-31 Are Obvious over Gjedebo '322 in View of **One or More of Willis '927, Delano '968 and Brown '675**".

2. The requester has not specifically explained how patent owner's April 6, 2009 amendment necessitated each new ground of rejection, for each newly proposed rejection citing newly submitted prior art, such as RU '617, or citing a document which was determined, in the order, to fail to raise an SNQ, such as Delano '968 or Willis '927. See MPEP 2666.05.

3. The requester has not clearly and *specifically* explained, for each newly proposed rejection citing a document that was determined, in the order, to fail to raise an SNQ, such as Delano '968 or Willis '927, how each of these documents *raise an SNQ* with respect to the newly amended claims.

4. The citation of any document, such as Delano '968 or Willis '927, which was determined, in the order, to fail to raise an SNQ with respect to the original patent claims, for the express purpose of relying on an alleged teaching of a feature originally recited in the patent claims, is deemed to be inappropriate.

### ***Requester's Appellant's, Respondent's, and Rebuttal Briefs, Filed on June 9, 2010, July 14, 2010, and October 22, 2010, Respectively, Are Improper***

The requester's appellant's, respondent's and rebuttal briefs filed on June 9, 2010, July 14, 2010, and October 22, 2010, respectively, are **improper** due to 1) the inappropriate inclusion of proposed rejections which the examiner determined to be improper, and were thus not addressed on the merits (i.e., were not determined by the examiner to be adopted or not adopted); 2) the improper inclusion of issues that are petitionable, and not appealable (such as, for example, the issue of whether the examiner properly refused to address on the merits certain rejections); and 3) the improper presentation of the improperly included rejections, for all of the reasons discussed extensively *supra*. The inclusion of rejections which the examiner determined to be improper, and were thus not addressed on the merits, fails to comply with 37 CFR 41.67(c)(vi), because these proposed rejections in the brief would constitute new grounds of rejection. See also 37 CFR §§ 41.68, and 41.71 and MPEP 2675, 2675.01 and 2678.

The propriety, or, in this case, the lack thereof, of requester's briefs is not being *specifically* addressed in this decision, because the propriety of the briefs can be reviewed by the requester in view of the guidance provided by this decision.

Accordingly, the requester's May 6, 2009 and February 16, 2010 comments, as well as the requester's appellant's, respondent's and rebuttal briefs filed on June 9, 2010, July 14, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

In due course, the examiner should review all papers, which remain pending, for any additional improprieties.

### ***Requester's Recourse***

The requester is given **fifteen (15) days** from the mail date of this decision to submit **one** corrected comments submission in response to this decision, to replace both the May 6, 2009 and February 16, 2010 requester comments, and to serve as requester's comments filed after patent owner's response of April 6, 2009, pursuant to 37 CFR 1.947. Any corrected comments submission submitted in response to this decision must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submissions. No comments that add to those in the expunged comment papers (other than to correct the matters noted above) will be considered for entry. See MPEP 2666.05.

If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be **expunged**, and **no further § 1.947 comments opportunity, pursuant to 35 U.S.C. 314(b)(2),<sup>15</sup> will be provided for the requester to address issues raised by patent owner's amendment of April 6, 2009**, or to address any issues regarding the April 6, 2009 amendment, that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.

### ***Additional Discussion***

As pointed out above, there is no reason given on record why the petitioner did not directly address the basis for the September 23, 2010 dismissal, by supplying facts and circumstances

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<sup>15</sup> 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.

relating to the delay in submitting a petition. There is only a discussion of “putting form over substance”. *The petitioner does not explain why the requester did not follow the standard procedure to timely petition and bring requester’s matter of concern properly before the Office for resolution at an early stage.* The petitioner could have simply filed petitions objecting to the examiner’s failure to separately notify the requester that the May 6, 2009 requester comments and the February 16, 2010 requester comments, respectively, were improper, rather than acquiescing to the examiner’s issuance of the Office action on the merits and the examiner’s failure to give the requester an opportunity to correct the comments submission.<sup>16</sup> Even if there is any merit to the “putting form over substance” position, there is still *no explanation of why the requester did not properly bring the matter to the Office’s attention until after the original briefs were filed*, to thus save substantial delay. The petitioner should be mindful of 37 CFR 11.18, which provides, in pertinent part (emphasis added):

By presenting to the Office ... any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that- ...

(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 ...

## CONCLUSION

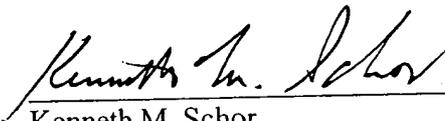
- The October 18, 2010 requester petition is **dismissed**.
- The December 18, 2009 action closing prosecution (ACP), the March 12, 2010 right of appeal notice (RAN), and the September 24, 2010 examiner’s answer, are *sua sponte vacated*.
- The requester’s May 6, 2009 and February 16, 2010 comments and the requester’s appellant’s, respondent’s, and rebuttal briefs filed on June 9, 2010, July 14, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office’s electronic Image File Wrapper (IFW) system, they are being **expunged** from the record

<sup>16</sup> The Office notes, for example, that the petitioner repeatedly argues that MPEP 2617 does not apply to requester comments filed after patent owners’ response, yet insists, in requester’s June 9, 2010 appellant’s brief (see footnote no. 8, page 10), that “the 3<sup>rd</sup> Party should have been afforded a 15 day time period in which to correct the allegedly improper comments in accordance with PTO practice . . . See, e.g., M.P.E.P. §§ 2617 and 2666.05”. Thus, the petitioner appears to have been aware that MPEP 2666.05 expressly requires requester’s comments to comply with MPEP 2617. Yet, the petitioner still has not provided any explanation whatsoever for the delay in filing a petition until July 2, 2010, after all of the initial briefs were filed.

by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

- The requester is given **fifteen (15) days** from the mail date of this decision to submit **one** corrected comments submission in accordance with this decision. If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be **expunged**, and **no further § 1.947 comments opportunity, pursuant to 35 U.S.C. 314(b)(2), will be provided for the requester to address issues raised by patent owner's amendment of April 6, 2009**, or to address any issues regarding the April 6, 2009 amendment that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.
- Any papers going to the merits, including, for example, the Office actions (including the examiner's answer) and all responses, comments, or briefs, filed by the parties subsequent to patent owner's April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits**.
- This proceeding is being referred to the Central Reexamination Unit (CRU) to await the filing of requester's corrected comments submission, or the expiration of the time for filing requester's corrected comments submission. If a corrected comments submission in accordance with this decision is not timely filed by the requester, the CRU examiner will, in due course, issue an Office action in response to patent owner's April 6, 2009 amendment, without consideration of any comments thereon filed by the requester.
- Any further correspondence with respect to this matter should be addressed as follows:
  - By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.
  - By Mail: Mail Stop *Inter Partes* Reexam  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450
  - By Fax: (571) 273-9900
  - By Hand: Customer Service Window  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

- Any inquiry concerning this decision should be directed to Senior Legal Advisors Cynthia L. Nessler, at (571) 272-7724, or Hiram Bernstein, at (571) 272-7707.

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

Kenappeal/decisions/entry issues  
Kenpet8/IP/  
4-13-11



**MAILED**  
**SEP 09 2010**

MORGAN LEWIS & BOCKIUS LLP CENTRAL REEXAMINATION UNIT  
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*In re Bernd-Georg Pietras* : **DECISION**  
*Inter Partes* Reexamination Proceeding : **DISMISSING PETITION**  
Control No. 95/001,115 : **UNDER § 1.182**  
Filed: November 18, 2008 : **AND GRANTING PETITION**  
For: U.S. Patent No. 7,004,259 B2 : **UNDER § 1.183**

This is a decision on the June 24, 2010 patent owner petitions entitled "PETITION FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182," AND "PETITION TO ENTER AMENDMENT FILED AFTER RAN PURSUANT TO 37 C.F.R. § 1.183." This decision also addresses third party requester's comments filed on July 23, 2010, entitled "COMMENTS IN RESPONSE TO THE AMENDMENT AFTER RIGHT OF APPEAL NOTICE FILED ON JUNE 24, 2010."

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

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

The petition under § 1.182 is **dismissed**.

The petition under § 1.183 is **granted to the extent stated below**.

**BACKGROUND**

- On November 18, 2008, a request for *inter partes* reexamination was filed by the third party requester for all claims in the '259 patent, claims 1-38, and the resulting reexamination proceeding was assigned control number 95/001,115 ("the '1115 proceeding").

- Prosecution progressed until, on September 4, 2009, the Office issued an Action Closing Prosecution (ACP) in the proceeding, applying new grounds of rejection and new claim objections to the claims at issue, which were amended by the patent owner on March 30, 2009.
- On October 5, 2009, patent owner filed comments under § 1.951(a) to the September 4, 2009 ACP, including a proposed amendment to the claims.
- On November 2, 2009, third party requester filed comments under § 1.951(b) in response to the ACP and the October 5, 2009 patent owner comments.
- On December 18, 2009, the Office issued a Right of Appeal Notice (RAN), refusing entry of the patent owner's proposed amendment of October 5, 2009 as failing to comply with the standards for entry set forth in § 1.116(b).
- On January 15, 2010, third party requester filed a Notice of Appeal.
- On January 19, 2010, patent owner filed a Notice of Appeal.
- On March 15, 2010, third party requester filed a timely appellant's brief.
- On March 19, 2010, patent owner filed a timely appellant's brief.
- On April 15, 2010, third party requester filed a timely respondent's brief.
- On April 19, 2010, patent owner filed a timely respondent's brief.
- On June 3, 2010, a Notice of defective briefs was issued by the Office, stating that the patent owner appellant's brief of March 19, 2010 was defective as improperly appealing the examiner's refusal to enter the patent owner's proposed amendment of October 5, 2009. The respondent briefs of both parties were also held defective.
- On June 24, 2010, patent owner filed an amended appellant's brief, a corrected respondent's brief, the instant petitions entitled "PETITION FOR CONTINUED REEXAMINATION UNDER 37 CFR § 1.182," AND "PETITION TO ENTER AMENDMENT FILED AFTER RAN PURSUANT TO 37 C.F.R. § 1.183," a proposed amendment to the claims, and a separate amendment cancelling claims 29-36, 39-43, and 45 pursuant to § 1.116(d).
- On July 23, 2010, third party requester filed a corrected respondent's brief and comments in response to patent owner's June 24, 2010 amendment to the claims entitled "COMMENTS IN RESPONSE TO THE AMENDMENT AFTER RIGHT OF APPEAL NOTICE FILED ON JUNE 24, 2010."

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### 37 C.F.R. § 1.182 provides:

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

### 37 C.F.R. § 1.183 states:

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

## DECISION

### 1. Petition Under 37 C.F.R. § 1.182

The June 24, 2010 patent owner petition is filed under 37 C.F.R. § 1.182 requesting continued prosecution for entry and consideration of an amendment filed with the petition. In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."<sup>1</sup> Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after an action closing prosecution in an *inter partes* reexamination proceeding.

The filing of such a § 1.182 petition is strictly controlled by the Office to further the statutory mandate of 35 U.S.C. § 305 that "[a]ll reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office" [emphasis added]. The present proceeding has reached a point where the appeal has been briefed by both parties, and granting continued reexamination at this stage to a non-final action as requested by the patent owner would require drawing the case back from an advanced state of the appeal process to a relatively early stage prior to the action closing prosecution.

Furthermore, the proposed amendment addresses only matters of indefiniteness in a manner that has previously been specified by the examiner to be acceptable. Entry of the amendment would resolve those issues, and would not affect the other outstanding issues in the proceeding. For that reason, entry of the proposed amendment would not require an extended prosecution such

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<sup>1</sup> 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

that the closing of prosecution need be reopened in a general manner. In view of the advanced stage of the proceedings, continued prosecution on the merits does not facilitate handling of the proceeding with special dispatch, and the petition for such relief is dismissed.

It is further noted that the instant petition was filed on June 24, 2010, more than six months after the right of appeal Notice was issued by the Office on December 18, 2009. 37 CFR 1.181(f) states that “[a]ny 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” [emphasis added]. The phrase “under this part” refers to the part of the rules entitled “PETITIONS AND ACTION BY THE DIRECTOR,” and includes §§ 1.181, 1.182, and 1.183. Therefore, any petition filed under § 1.182 not filed within two months of the action or notice from which relief is requested may be dismissed as untimely. In the instant petition, patent owner petitioner seeks to enter an amendment in response to rejections made in the ACP issued by the examiner on September 4, 2009, and further discussed in remarks made by the examiner in the right of appeal Notice issued by the Office on December 18, 2009. The instant petition is well outside of the two month period set in § 1.181(f), and may, for that reason alone, be dismissed as untimely. In the present instance, this is particularly relevant given the statutory mandate for special dispatch.

In view of the above, the petition under § 1.182 is dismissed.

## **2. Petition Under 37 C.F.R. § 1.183**

A petition to waive a rule or regulation under § 1.183 may be granted in “an extraordinary situation, when justice requires.” Therefore, any such petition should set forth reasons why the situation is extraordinary such that justice requires waiver of the rule. Patent owner’s petition does not explicitly refer to this requirement, but appears to address the requirement by stating that the patent owner “has been denied an opportunity to respond to the new grounds of rejection in the ACP” and that “[e]quity requires that the Office afford Patent Owner an opportunity to respond.”<sup>2</sup>

The arguments in the petition are taken as arguing that closure of prosecution in this situation, under these specific facts, has created an extraordinary and inequitable situation requiring remedial action in the interests of justice to enter the proposed amendment to the claims submitted with the instant petition.

In this situation, the proposed amendment is solely directed towards claim rejections under 35 U.S.C. § 112, claim objections, and cancellation of claims. The proposed amendment refers to guidance by the examiner in the RAN for specific language which would overcome the rejections under 35 U.S.C. § 112. Entry of the proposed amendment, which includes the language recommended by the examiner, would resolve those issues, and would not affect any other outstanding issues in the proceeding. As the amendment addresses those issues in accordance with the examiner’s guidance, entry of the amendment would reduce the issues on appeal. For that reason, entry of the proposed amendment through waiver of the regulations §§ 1.953(c) and 1.116(d) would further advancement of the proceeding with special dispatch.

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<sup>2</sup> June 24, 2010 petition at 11-12.

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

The instant reexamination proceeding will be returned to the Central Reexamination Unit (CRU) for entry<sup>3</sup> of the June 24, 2010 response, and subsequently to await submission of any third party comments under 37 C.F.R. § 1.951(b) regarding the June 24, 2010 patent owner amendment. Following the submission of third party requester comments, or the lapse of the thirty day time period for third party comment, the proceeding will be forwarded to the examiner for action consistent with this decision. The examiner will consider the June 24, 2010 amendment and any third party comments that comply with 37 C.F.R. § 1.951(b). The examiner will then issue an Office action which may be a new RAN.

### **3. Third Party Requester Comments Filed on July 23, 2010**

Third party requester filed, on July 23, 2010, a paper entitled "COMMENTS IN RESPONSE TO THE AMENDMENT AFTER RIGHT OF APPEAL NOTICE FILED ON JUNE 24, 2010."

Although third party requester stated that these comments were filed under § 1.951(b), that section only applies to a single filing of patent owner comments after an ACP. That section does not apply once a RAN has been issued in the case, since patent owner comments are not entered as a matter of right. For that reason, the third party requester comments filed on July 23, 2010 have no right of entry, and as such, must be denied entry into the proceeding.

Since the paper has already been entered into the record, the paper cannot be physically returned to the third party requester. Rather, the requester's paper will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

In the interests of equity, a 30 day period has been set for third party requester comments, solely to address the issues (claim objections and rejections under § 112) raised by the patent owner amendment now being entered, and the rules are waived to the following extent. Third party requester comments must be solely responsive to the issues of the amendment being entered through waiver under § 1.183, and should not address any other issues in the proceeding. Any issues newly raised by the RAN favorable to the patentability may be addressed on appeal, since the third party requester has not had a prior opportunity to address them.

## **CONCLUSION**

1. The petition under 37 C.F.R. § 1.182 for a general reopening of prosecution to a pre-ACP stage is **dismissed**.

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<sup>3</sup> This decision takes no position on the propriety of the amendment or whether it introduces new matter. Any issues raised by the amendment will be addressed by the Examiner in the next Office action.

2. The petition under 37 C.F.R. § 1.183 is **granted to the extent set forth herein.**
3. The prohibition against an amendment in response to a RAN, set forth in § 1.953(c), is hereby waived to the extent that the June 24, 2010 amendment will be entered by the CRU.
4. **Third party requester has thirty (30) days from the date of mailing of this decision to submit comments limited to the issues raised in the newly entered amendment.**
5. The CRU will await submission of third party comments, or the expiration of the time for same and then jurisdiction of the proceeding will be transferred to the examiner for consideration of both the amendment and any third party comments.
6. Jurisdiction over the reexamination proceeding is being forwarded to the CRU for further handling and examination not inconsistent with this decision.
7. The July 23, 2010 requester comments paper is refused entry, as it is an improper paper. The paper is not enterable into the record of the present reexamination proceeding for the reasons stated above.
8. Because the requester comments paper was previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.
9. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

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Michael Cygan  
Legal Advisor  
Office of Patent Legal Administration

September 8, 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 28 2011

CENTRAL REEXAMINATION UNIT

Commissioner for Patents  
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MORGAN LEWIS & BOCKIUS LLP :  
1111 PENNSYLVANIA AVENUE NW : FOR PATENT OWNER  
WASHINGTON, D.C. 20004 :

TODD D. MATTINGLY :  
BRACEWELL GIULIANI LLP : FOR THIRD PARTY  
P.O. BOX 61389 : REQUESTER  
HOUSTON, TX 77208-1389 :

*In re Haugen* : DECISION  
Reexamination Proceeding : ON  
Control No. : 95/001,116 : REQUESTER'S  
Filed: November 18, 2008 : PETITION  
Patent No. 7,281,587 : UNDER 37 CFR 1.181

This is a decision addressing Third Party Requester's petition, filed August 17, 2010, under 37 CFR 1.183 to consider and accept the rejections proposed by requester in requester's comments dated 12/31/09, which is treated as a petition requesting supervisory review of the examiner's decision not to accept the proposed rejection, as set forth in the Action Closing Prosecution (ACP).

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

SUMMARY

Third Party Requester's petition is DISMISSED as untimely for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 7,281,587 (the '587 patent) issued on October 16, 2007.
2. A request for reexamination, assigned Control No. 95/001,116 (the '116 proceeding), was filed by a third party Requester on November 18, 2008.
3. Reexamination was ordered in the '116 reexamination proceeding on February 13, 2009.
4. An Office action on the merits was mailed on the same day, February 13, 2009.
5. An Action Closing Prosecution (ACP) was mailed on April 17, 2010. The ACP confirmed the patentability of claims 60-65 and 74-82.
6. On July 30, 2010, a Right of Appeal Notice (RAN) was mailed. The RAN again confirmed the patentability of claims 60-65 and 74-82.
7. On August 17, 2010, the Third Party Requester filed a Notice of Appeal.
7. Also on August 17, 2010, Third Party Requester filed the petition under 37 CFR 1.181.

DISCUSSION

The Third Party Requester (petitioner) requests supervisory review of the examiner's action in issuing the ACP, dated April 17, 2010. The petitioner argues that the examiner did not properly consider and accept the rejections proposed by requester in requester's comments dated 12/31/09, which was requester's response to the first Office action. Since the ACP addressed the requester's comments filed 12/31/09, petitioner's point of contention is with the examiner's decision in the ACP. It should be noted that the examiner repeated his discussion of requester's 12/31/09 comments in the RAN.

The request to review the ACP is dismissed as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

### DECISION

The petitioner brings before the Office a petition under 37 CFR § 1.181 to review the ACP, dated April 17, 2010. The petitioner filed the petition on August 17, 2010. The action from which relief is requested is the ACP, which was mailed on April 17, 2010. Therefore, the petition was filed over **two** months from the mailing date of the action (November 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, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

In other words, this petition is untimely to request relief from the examiner's actions in the ACP. It is noted that even if this petition was deemed timely filed, the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of claim interpretation and application of the prior art to the claims are appealable issues, and therefore, cannot be addressed by petitions.

### CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed August 17, 2010, is **dismissed** as untimely for the reasons discussed above.
2. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



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Irem Yucel  
Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,119	11/18/2008	7353880	069669-0007-09	8440
9629	7590	09/22/2010	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ART UNIT	PAPER NUMBER

DATE MAILED: 09/22/2010

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HOUSTON, TX 77208-1389

Date:

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**SEP 22 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001119  
PATENT NO. : 7353880  
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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Houston, TX 77208-1389

(For Requester)

MAILED

SEP 22 2010

In re Pietras  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,119  
Filed: November 18, 2008  
For: U.S. Patent No. 7,353,880

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

CENTRAL REEXAMINATION UNIT

This decision is in response to the July 26, 2010 requester petition entitled "Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 12/7/09" (the July 26, 2010 requester petition).

The July 26, 2010 requester petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.183 has been received.

**SUMMARY**

The July 26, 2010 requester petition is **dismissed**.

**BACKGROUND**

- On April 8, 2008, U.S. Patent 7,353,880 (the '880 patent) issued to Pietras.
- On November 18, 2008, the requester filed a request for *inter partes* reexamination. The reexamination proceeding was assigned control no. 95/001,119 (the '1119 proceeding).
- On February 6, 2009, the Office mailed an order granting reexamination and a first Office action in the '1119 proceeding.
- Prosecution progressed until, on November 6, 2009, the Office mailed an action closing prosecution (ACP).
- On December 7, 2009, the patent owner timely filed comments to the November 6, 2009 ACP (December 6, 2009 was a Sunday).
- On January 5, 2010, the requester filed comments.

- On March 29, 2010, the Office mailed a right of appeal notice (RAN), in which the examiner refused to address rejections newly proposed by the requester in its January 5, 2010 comments, because the newly proposed rejections were not presented in
- On April 29, 2010, the patent owner filed a notice of appeal.
- Also on April 29, 2010, the requester filed a notice of appeal.
- On June 28, 2010, the requester filed an appellant brief.
- On June 29, 2010, the patent owner filed an appellant brief.
- On July 2, 2010, the requester filed a petition entitled “Petition Under 37 CFR § 1.181, § 1.182, and/or § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester’s Comments Dated 12/7/09[sic]” (the July 2, 2010 requester petition).
- On July 21, 2010, the Office mailed a decision dismissing the July 2, 2010 requester petition as untimely under 37 CFR 1.181(f).
- On July 26, 2010, the requester filed the present petition, entitled “Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester’s Comments Dated 12/7/09” (the July 26, 2010 requester petition).
- On July 27, 2010, the requester filed a respondent brief, in response to patent owner’s June 29, 2010 appellant brief.
- On July 28, 2010, the patent owner filed a respondent brief, in response to requester’s June 28, 2010 appellant brief.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### 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.

\*  
\*

(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 1.183 provides:**

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

**37 CFR 1.903 provides:**

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

**DECISION**

As in requester's (earlier) July 2, 2010 petition under 37 CFR 1.181, the requester again requests "that the rejections proposed in Requester's response filed on 12/7/09 [sic],<sup>1</sup> that were not considered by the Examiner, be considered proper, entered into the record, and considered by the Office". The requester also requests waiver of 37 CFR 1.951, "such that Requester may submit replacement comments that are strictly limited to the contents of the previously filed comments". The requester also essentially states that because petitions under 37 CFR 1.183 (or 37 CFR 1.182) must be filed under separate cover pursuant to 37 CFR 1.4(c), in order for the Office to enter and consider the petitions, "the Requester files this petition under 37 § [sic] C.F.R. § 1.183".

The July 21, 2010 decision by the Office, however, dismissed requester's July 2, 2010 petition because it was untimely pursuant to 37 CFR 1.181(f). To be timely, any petition under 37 CFR 1.181, 1.182, or 1.183 must be filed within two months of the action or notice from which relief is requested. In the present case, any petition under 37 CFR 1.181, 1.182, or 1.183 must have been filed within two months from the mail date of the March 29, 2010 right of appeal notice (RAN), i.e., on or before June 1, 2010.<sup>2</sup> For this reason, the instant petition filed on July 26, 2010 is also untimely, and would have been untimely even if filed at the time the 37 CFR 1.181 was filed. Accordingly, the present petition is treated as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.181(f).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an *extraordinary* situation, *when justice requires*, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests,

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<sup>1</sup> The only requester comments received by the Office, however, were received on January 5, 2010. Patent owner's comments were received on December 7, 2009. The Office assumes that the use of 12/7/09 in requester's petition is a typographical error. If this is not the case, the requester is required to so inform the Office.

<sup>2</sup> May 29, 2010 was a Saturday. Monday, May 31, 2010 was a holiday.

unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

Addressing the instant petition under 37 CFR 1.183, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. The requester has provided no explanation for the delay in filing its initial petition under 37 CFR 1.181 on July 2, 2010. The requester has also failed to provide an explanation as to why it failed to file the July 2, 2010 petition until after the proceeding was on appeal by both parties, *and after the appeal had been briefed by both parties.*

For the reasons given above, the requester has not shown how the facts give rise to *an extraordinary situation, such that justice requires* waiver of the rule. Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

Note that even if the present petition under 37 CFR 1.183 for waiver of 37 CFR 1.181(f) had been granted, the response to any such waiver would have been a petition under 37 CFR 1.181(a), since the entire argument presented by the present petition is challenging the propriety of the examiner's action.

#### CONCLUSION

- The July 26, 2010 requester petition is **dismissed**.
- Jurisdiction over this reexamination proceeding is being returned to Central Reexamination Unit Art Unit 3993 for appropriate action.
- Any inquiry concerning the examination of the reexamination proceeding should be directed to the primary examiner, Matthew Graham, of CRU Art Unit 3993, at (571) 272-7116.
- Any further correspondence with respect to this matter should be addressed as follows:

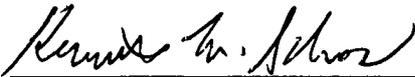
By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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Post Office Box 1450  
Alexandria, VA 22313-1450

By Fax: (571) 273-9900

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

- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



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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.
95/001,119	11/18/2008	7353880	069669-0007-09	8440
9629	7590	04/14/2011	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP (WA) 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001119  
PATENT NO. : 7353880  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

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

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

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

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



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(For Patent Owner)

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(For Requester)

MAILED

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In re Pietras  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,119  
Filed: November 18, 2008  
For: U.S. Patent No. 7,353,880

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: **DECISION DISMISSING**  
: **PETITION, EXPUNGING**  
: **PAPERS, AND *SUA SPONTE***  
: **VACATING OFFICE ACTIONS**

This decision is in response to the October 18, 2010 renewed requester petition entitled "Petition for Consideration of Proposed Rejections" (the October 18, 2010 requester petition).

The October 18, 2010 requester petition and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The petition fee of \$400 set forth in 37 CFR 1.17(f) for the present requester petition under 37 CFR 1.183 has been received.

**SUMMARY**

1. The October 18, 2010 requester petition is **dismissed**.
2. However, in view of certain procedural irregularities noted by the Office in the present proceeding, the November 6, 2009 action closing prosecution (ACP), the March 29, 2010 right of appeal notice (RAN), and the September 24, 2010 examiner's answer, are *sua sponte* **vacated**.
3. The requester's May 6, 2009 and January 5, 2010 comments, and requester's appellant's, respondent's, and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
4. The requester is given **fifteen (15) days** from the mail date of this decision to submit one corrected comments submission in accordance with this decision and its guidance. **If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be expunged, and no further §**

<sup>1</sup> See MPEP 2667.

**1.947 comments opportunity, pursuant to 35 U.S.C. 314(b)(2), will be provided** for the requester to address issues raised by patent owner's amendment of April 6, 2009, or to address any issues regarding the April 6, 2009 amendment that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.

5. Any papers going to the merits, including, for example, the Office actions (including the examiner's answer), and all responses, comments, or briefs, filed by the parties subsequent to patent owner's April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits**, since they are directed to papers that have been vacated.

### BACKGROUND

- On April 8, 2008, U.S. Patent 7,353,880 (the '880 patent) issued to Pietras.
- On November 18, 2008, the requester filed a request for *inter partes* reexamination. The reexamination proceeding was assigned control no. 95/001,119 (the '1119 proceeding).
- On February 6, 2009, the Office mailed an order granting reexamination and a first Office action in the '1119 proceeding.
- On April 6, 2009, the patent owner filed a response, including a first amendment to the claims.
- On May 6, 2009, the requester filed comments, including a first set of newly proposed rejections.
- On November 6, 2009, the Office mailed an action closing prosecution (ACP), in which the examiner refused to adopt certain rejections newly proposed by the requester in its May 6, 2009 comments, because of requester's failure to provide an explanation for the submission of a reference pursuant to 37 CFR 1.948(a)(3),<sup>2</sup> and certain newly proposed rejections citing Willis '927, due to the failure of the requester to explain how Willis' 927 raises a substantial new question (SNQ) with respect to the newly added claims.<sup>3</sup>
- On December 7, 2009, the patent owner filed comments under 37 CFR 1.951(a), including a second amendment to the claims.

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<sup>2</sup> MPEP 2666.05 provides, in pertinent part:

... 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.

<sup>3</sup> In the order mailed on February 6, 2009, the examiner determined that Willis '927 failed to raise a substantial new question (SNQ) with respect to the original patent claims.

- On January 5, 2010, the requester filed comments under 37 CFR 1.951(b), including a second set of newly proposed rejections.
- On March 29, 2010, the Office mailed a right of appeal notice (RAN), in which the examiner refused to address certain rejections newly proposed by the requester in its January 5, 2010 comments, 1) because the newly proposed rejections were not presented in accordance with MPEP 2617; or 2) because, according to the examiner, requester comments after ACP may not include newly proposed rejections. In addition, the examiner refused to adopt certain newly proposed rejections because the newly proposed rejections were based, at least in part, on Willis '927, and the requester failed to explain how Willis' 927 raises a substantial new question (SNQ) with respect to the newly added claims.<sup>4</sup>
- On April 29, 2010, the requester filed a notice of appeal.
- Also on April 29, 2010, the patent owner filed a notice of appeal.
- On June 28, 2010, the requester filed an appellant's brief.
- On June 29, 2010, the patent owner filed an appellant's brief.
- On July 2, 2010, the requester filed a petition entitled "Petition Under 37 CFR § 1.181, 1.182, and/or 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 12/7/09" (the July 2, 2010 requester petition).
- On July 21, 2010, the Office mailed a decision dismissing the July 2, 2010 requester petition as untimely under 37 CFR 1.181(f).
- On July 26, 2010, the requester filed a petition entitled "Petition under 37 CFR § 1.183 to Consider and Accept the Rejections Proposed by Requester in Requester's Comments Dated 12/7/09" (the July 26, 2010 requester petition).
- On July 27, 2010, the requester filed a respondent's brief, in response to patent owner's June 29, 2010 appellant's brief.
- On July 28, 2010, the patent owner filed a respondent's brief, in response to requester's June 28, 2010 appellant's brief.
- On September 22, 2010, the Office mailed a decision dismissing the July 26, 2010 requester petition.
- On September 24, 2010, the Office mailed an examiner's answer.

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<sup>4</sup> See footnote 2.

- On October 18, 2010, the requester filed the present petition, entitled “Petition for Consideration of Proposed Rejections” (the October 18, 2010 requester petition).
- On October 22, 2010, the requester filed a rebuttal brief.
- Also on October 22, 2010, the requester requested an oral hearing.
- On October 25, 2010, the patent owner filed a rebuttal brief.
- On November 4, 2010, the patent owner requested an oral hearing.
- On January 21, 2011, the Office mailed a communication entitled “Remand to Patents”, notifying the parties that the present proceeding was remanded by the Board of Patent Appeals and Interferences (BPAI) for consideration of the present petition, filed by the requester on October 18, 2010.

## DECISION

### *The October 18, 2010 Petition Is Dismissed*

The requester requests a waiver of the requirement of 37 CFR 1.181(f), “that petitions filed under 37 CFR § 1.181, 1.182, or 1.183 must be filed within two months of the action for which relief is sought”. Specifically, requester requests that the Office consider rejections which were newly proposed by the requester in its comments filed on January 5, 2010, and which were refused consideration by the examiner in the March 29, 2010 RAN. **The requester, however, failed to file a petition requesting such relief until July 2, 2010, more than three months after the mail date of the RAN.**

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an *extraordinary* situation, *when justice requires*, on petition of the interested party. The burden is on the petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. General requests, unsubstantiated by specific facts are not sufficient to demonstrate an extraordinary situation in which justice requires suspension of a rule.

The requester argues that an extraordinary situation exists because “[the r]equester may be denied due process if this petition is denied”. The requester asserts that it had “timely” presented the proposed rejections in the April 29, 2010 notice of appeal (filed within two months of the March 29, 2010 RAN),<sup>5</sup> and included detailed arguments in its June 28, 2010 appellant’s brief. The requester argues that, for this reason, the September 22, 2010 dismissal asserting that the

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<sup>5</sup> Exhibit J of the October 18, 2010 petition consists of a copy of the requester’s April 29, 2010 appeal notice. Page 2 of the notice is entitled, in part, as “Grounds of Rejection . . . That Were Not Adopted by the Examiner *Which The 3<sup>rd</sup> Party Intends To Contest*” (emphasis added). The Office also notes that while there are only three sheets, each sheet is paginated to indicate that there are four sheets.

petitions were not filed until well into the appeal process “is not accurate”. The requester admits that “the request was not raised in the form of a petition”. The requester argues, however, that to deny that the issue was raised, even in the absence of a petition, “is putting form over substance”.

35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings be conducted with special dispatch. Accordingly, in an *inter partes* reexamination proceeding, it is especially important that petitions under 37 CFR 1.181, 1.182, and 1.183 be filed within the two-month time period provided by 37 CFR 1.181(f).

The RAN, which refused to address certain rejections newly proposed on January 5, 2010, was mailed on March 29, 2010. **The requester failed to file any petition regarding the issuance of the RAN within two months of the mail date of the RAN.** Furthermore, a review of requester’s April 29, 2010 notice of appeal does not reveal the presence of an accompanying petition under 37 CFR 1.181 requesting review of the RAN, including an explanation of the grounds relied upon to contest the examiner’s refusal to consider the proposed rejections, or the presence, for that matter, of any other accompanying petition in regard to issuance of the RAN. **In addition, requester’s appellant’s brief of June 28, 2010 was not accompanied by a petition under 37 CFR 1.181, seeking review of the RAN, and by a petition under 37 CFR 1.183, seeking waiver of the two-month period set forth in 37 CFR 1.181(f) to permit consideration of the petition under 37 CFR 1.181.**

Additionally, the manner of presentation of the proposed rejections, within the notice of appeal and the appellant brief, did not serve, in the absence of a petition, to promptly alert the Office to any issue which may be the subject of a request for review of the RAN. It is for this reason that *any* such petition **must** be submitted as a separate paper pursuant to 37 CFR 1.4(c).

A petition for relief was eventually filed by the requester on July 2, 2010, well after the March 29, 2010 RAN, the April 29, 2010 notices of appeal, and the June 28 and June 29, 2010 appellant briefs. The July 2, 2010 petition under 37 CFR 1.181 was dismissed on July 21, 2010, and a petition under 37 CFR 1.183, filed on July 26, 2010, was dismissed on September 22, 2010. The September 22, 2010 dismissal was based on timeliness considerations, noting **the failure of the requester to provide any explanation** for waiting until (a) July 2, 2010 to file its initial petition, and in particular, waiting until (b) after the appeal by both parties, and (c) after the appeal had been briefed by both parties.<sup>6</sup>

The requester fails to directly address the basis for the September 22, 2010 dismissal, by supplying any facts and circumstances relating to the delay in submitting a petition. Rather, the requester simply characterizes the lack of a timely filed petition as merely “putting form over substance”. The failure to timely file a petition for relief, however, was a serious omission, which caused a substantial delay; as the proceeding is now well into the appeal stage. Given the statutory mandate for special dispatch in *inter partes* reexamination proceedings, the Office will not accept unexplained delays (a) in moving the proceeding forward on the merits, and (b) in seeking relief from an action or requirement of the Office.

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<sup>6</sup> September 22, 2010 dismissal, page 4.

In summary, the requester has not provided any explanation for the delay in submitting its initial petition.

For the reasons given above, the requester has not met its burden of establishing an extraordinary situation where justice would require waiver of the provisions of 37 CFR 1.181(f). Accordingly, the present petition under 37 CFR 1.183 is **dismissed**.

***The November 6, 2009 ACP, the March 29, 2010 RAN, and the September 24, 2010 Examiner's Answer, Are Sua Sponte Vacated***

Upon further consideration, the Office has noted certain procedural irregularities in this proceeding. Accordingly, the Office is *sua sponte* issuing the following decision. The examiner failed to separately notify the requester that the May 6, 2009 requester comments and the January 5, 2010 requester comments, respectively, were improper. Specifically, the examiner failed to separately provide the requester with a complete analysis of the impropriety of the rejections newly proposed by requester's May 6, 2009 and January 5, 2010 comments, respectively. In addition, the examiner failed to provide the requester, in each instance, with an **opportunity to file a corrected comments submission pursuant to MPEP 2666.05**.

Instead, in the November 6, 2009 ACP, the examiner refused to adopt, without any consideration on the merits (obviousness or anticipation), a) certain rejections newly proposed by the requester in its May 6, 2009 comments, due to requester's failure to provide an explanation for the submission of a reference pursuant to 37 CFR 1.948(a)(3); and b) certain newly proposed rejections citing Willis '927, due to the failure of the requester to explain how Willis' 927 raises a substantial new question (SNQ) with respect to the newly added claims.<sup>7</sup> Furthermore, the examiner failed to object to the newly proposed rejections, due to their failure to comply with MPEP 2617, where appropriate, and further failed to 1) refuse entry of requester's comments with an explanation of their impropriety, and 2) provide the requester with a 15-day time period to file a corrected comments submission, pursuant to MPEP 2666.05.

In the March 29, 2010 RAN, the examiner again refused to adopt, without any consideration on the merits, certain rejections citing Willis '927, newly proposed by the requester in its January 5, 2010 comments, due to the repeated failure of the requester to explain how Willis' 927 raises a substantial new question (SNQ) with respect to the newly added claims. In addition, the examiner objected, for the first time, to certain newly proposed rejections due to their failure to comply with MPEP 2617, and simply refused to address them on the merits.<sup>8</sup> Furthermore, the

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<sup>7</sup> The examiner correctly objected to the citation of RU '617 under 37 CFR 1.948(a)(3) in the May 6, 2009 comments, for the failure of the requester to explain the circumstances under which the prior art first became known or available to the requester, including the date and manner that the art became known or available, and why it was not available earlier, as set forth in MPEP 2666.05. The examiner's objection to the citation of Willis '927 was also correct, because the examiner determined that Willis '927 failed to raise a substantial new question (SNQ) with respect to the original patent claims in the order mailed February 6, 2009.

<sup>8</sup> The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitations on what newly cited prior art the requester may *file* in an *inter partes* reexamination as part of, for example, a document entitled "information disclosure statement", which is filed with requester's comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner's initials on the document entitled "information

examiner also refused to address on the merits one newly proposed rejection, erroneously stating that “the comments allowed by the Third Part[y] Requester after an ACP does not extend to the addition of newly proposed rejections”, contrary to 35 USC 314(b)(2), 37 CFR 1.951(b), and MPEP 2672.<sup>9</sup> Finally, the examiner failed to 1) return requester’s comments with an explanation of their impropriety, and 2) provide the requester with a 15-day time period to file a corrected comments submission, pursuant to MPEP 2666.05.

To remedy these procedural irregularities, the November 6, 2009 ACP, the March 29, 2010 RAN, and the September 24, 2010 examiner’s answer, are hereby **vacated**.

For the reasons given *infra*, requester’s May 6, 2009 and January 5, 2010 comments, and requester’s appellant’s, respondent’s, and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record, due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office’s electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

Any papers going to the merits, including, for example, the Office actions (including the examiner’s answer), and all responses, comments, or briefs, filed by the parties subsequent to patent owner’s April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits**, since they are directed to papers that have been vacated.

### ***Requester’s May 6, 2009 Comments Are Improper***

Requester’s May 6, 2009 comments are improper due to the defective presentation of the newly proposed rejections appearing on pages 13-48.

#### **1. The Newly Proposed Rejections Are Not in Compliance with MPEP 2617.**

The requester has repeatedly argued, in papers filed subsequent to the RAN, that the guidelines set forth in MPEP 2617 do not apply to requester’s comments after patent owner’s response (see, e.g., requester’s July 2, 2010 petition, page 8).<sup>10</sup> See, however, MPEP 2666.05, which is

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disclosure statement”. To newly *propose a rejection* based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by amendment. See MPEP 2666.05.

<sup>9</sup> If the patent owner files an amendment after ACP, the requester, in its comments, may newly propose rejections if the requester can show that the newly proposed rejections were necessitated by patent owner’s amendment after ACP. See MPEP 2672, which provides, in pertinent part (emphasis added):

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner’s comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2).

<sup>10</sup> This decision does not address whether the November 18, 2008 request complies with the Office’s regulatory filing date requirements, such as those explained in MPEP 2614 and 2617 (to the extent that waiver is needed,

expressly entitled “Third Party Comments after Patent Owner’s Response”,<sup>11</sup> and which provides, in pertinent part (emphasis added):

... where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), **the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617**, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

The requester’s May 6, 2009 comments submission fails to clearly identify which proposed rejections are being set forth, and fails to provide a clear and complete explanation for every claim for which a rejection is proposed, due to the lumping together of the identification and explanation of multiple proposed rejections. See, for example, the rejections newly proposed on pages 13 and 32 of the comments, respectively. On page 13, the requester newly proposes a rejection of new claims 25-28 over “Gjedebo ‘322 in view of **one or more of** Krasnov ‘422, Tessari ‘279, and Brown ‘244” (emphasis added in bold). On page 32, the requester newly proposes a rejection of claims 7-10, 20, 22, 23, and 25-28 as obvious over “RU ‘617 **alone, or in combination with one or more of** Stokka ‘799, Tessari ‘279, Krasnov ‘422, Gjedebo ‘322, Brown ‘244, Delano ‘968, **and/or** Willis ‘927” (emphasis added in bold). Regarding the rejection proposed on page 32, for example, it is not clear, in addition to a rejection over RU ‘617 alone, over which combination(s) of the cited documents the requester intends to definitively propose a rejection, and which claims are proposed to be rejected over which of the cited documents or combinations of documents.<sup>12</sup>

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waiver is hereby given). However, the request is accompanied by references which the request fails to identify as raising an SNQ (and fails to provide the corresponding explanation as to how the reference raises an SNQ), or which the request fails to cite as part of a reference combination including at least one reference which the requester has properly identified as providing the basis for an SNQ, in a proposed rejection. See, for example, the Willis ‘814, Delano ‘968 references, and Gjedebo ‘617 references. The request also fails to definitively identify these documents as part of a proposed rejection, and provide the explanation required by 37 CFR 1.915. It is also unclear over which references the requester intends to include in each proposed rejection. For example, see page 81 of the request, which includes a discussion of Willis ‘814. This reference, however, is not identified as part of any proposed rejection. It is also unclear whether the requester intends to propose certain rejections. See, for example, footnote 64 of the request. The request must clearly and definitively set forth each proposed rejection in the body of the request. Furthermore, if the requester intended to propose a rejection in footnote 64, which is unclear, the rejection in any event improperly lumps together multiple alternative proposed rejections, contrary to MPEP 2617.

<sup>11</sup> And which can be found upon a review of the index of MPEP Chapter 2600, which governs *inter partes* reexamination proceedings.

<sup>12</sup> Examples of multiple distinct combinations of documents, which are lumped together by the above-quoted statement, are:

RU ‘617 in view of Stokka ‘799.

RU ‘617 in view of Krasnov ‘422.

RU ‘617 in view of Gjedebo ‘322 and Krasnov ‘422.

RU ‘617 in view of Stokka ‘799 and Gjedebo ‘322 and Tessari ‘279.

RU ‘617 in view of Stokka ‘799 and Gjedebo ‘322 and Krasnov ‘422 and Tessari ‘279.

RU ‘617 in view of Stokka ‘799 and Krasnov ‘422 and Brown ‘244.

In addition, the detailed explanation for the multiple, distinct (newly) proposed obviousness rejections are also lumped together. For example, see pages 32-34 of the May 6, 2009 comments. The explanation fails to provide a complete and separate explanation for how *each* distinct combination of documents applies to limitations of claim 7. In other words, the requester fails to provide a separate explanation for each newly proposed rejection. Similar problems exist with the remainder of the newly proposed obviousness rejections. Therefore, the May 6, 2009 comments submission is unclear how the cited documents are applied for each distinct (newly) proposed obviousness rejection identified in the comments.

It is also not clear whether, in some cases, the requester's comments intend to propose a rejection. See, for example, the offhand reference, throughout the footnotes, to GB 2 224 481. It is not clear whether the requester intends to propose a rejection based on this reference. The comments must clearly and definitively set forth each proposed rejection *in the body of the comments*. In addition, any newly proposed rejection must comply with all applicable rules and procedural standards, including, for example, MPEP 2617.

Furthermore, the explanations for the proposed rejections are unclear and incomplete. For example, the explanation on pages 32-34 fails to explain which teachings of Stokka '799, Krasnov '422, Tessari '279, and Brown '244 are to be applied, and how they are to be applied, to the limitations of claim 7. In addition, the explanation on pages 32-34 fails to provide at least one basis for combining *each* of the cited documents, including the Stokka '799, Krasnov '422, Tessari '279 and Brown '244 references. When documents are combined in a proposed rejection, the combination must be explicitly and clearly set forth by applying *each* of the references to *each* claim limitation, as appropriate, and making the required showing of a reason to combine the documents pursuant to 35 U.S.C. 103(a). See MPEP 2617. Again, similar problems exist with the remainder of the newly proposed obviousness rejections. Therefore, the May 6, 2009 comments submission fails to explain the specifics of each proposed obviousness rejection. Accordingly, the requester has not provided a detailed explanation of how *each* of the cited documents applies to *every* claim which is proposed to be rejected, in *each* of the newly proposed rejections.

Also, the requester's May 6, 2009 comments do not clearly specify what new non-cumulative technological teaching, which forms the basis for a substantial new question (SNQ), is taught by at least one of the documents cited for *each* newly proposed rejection. For each rejection newly proposed by the requester, the requester must specify where, in each document cited alone, or in at least one document of each cited combination of documents, the new, non-cumulative technological teaching is provided within the document, preferably by column and line number (or by page number). For example, the requester, on page 32 of the May 6, 2009 comments, proposes an obviousness rejection over RU '617 alone.<sup>13</sup> The requester, however, fails to

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RU '617 in view of Gjedebø '322 and Krasnov '422 and Tessari '279 and Brown '244.

RU '617 in view of Krasnov '422 and Tessari '279.

RU '617 in view of Krasnov '422 and Brown '244.

And so on.

<sup>13</sup> The Office again notes that the examiner correctly objected to the citation of RU '617 under 37 CFR 1.948(a)(3) in the May 6, 2009 comments, for the failure of the requester to explain the circumstances under which the prior art

specify what new non-cumulative technological teaching, which forms the basis of an SNQ, is taught by RU '617, why the teaching is new and is not cumulative to the prior art of record, and where in RU '617 the new, non-cumulative technological teaching is provided.<sup>14</sup> Similar problems exist with the remainder of the newly proposed obviousness rejections.

2. The requester has not specifically explained how patent owner's April 6, 2009 amendment necessitated each proposed new ground of rejection, for each newly proposed rejection citing newly submitted prior art, such as RU '617, or citing a document which was determined, in the order, to fail to raise an SNQ, such as Willis '927.

The requester newly submitted, for example, RU '617 with requester's May 6, 2009 comments.<sup>15</sup> Willis '927, for example, was not found by the examiner to raise an SNQ in the reexamination order mailed on February 6, 2009. Therefore, for *each* of these documents cited alone in a proposed rejection, and for *each* distinct combination of documents citing at least one of these documents in a proposed rejection, the requester must specifically explain how the presence of a teaching in each of these documents, if cited alone, or, if cited as one of the documents in a document combination, how the presence of a teaching in at least one of the documents of the document combination, corresponds to at least one claim limitation newly added by patent owner's amendment. See MPEP 2666.05.

3. The requester's May 6, 2009 comments do not clearly and specifically explain, for each newly proposed rejection citing a document that was determined, in the order, to fail to raise an SNQ, such as Willis '927, how each of these documents raise an SNQ with respect to the newly amended claims.

In the February 6, 2009 order, the examiner determined that Willis '927, for example, failed to raise an SNQ with respect to the original patent claims. The requester has not *specifically explained*, for each newly proposed rejection citing Willis '927, how this document *raises an SNQ* with respect to the newly amended claims, i.e., how this document addresses the newly amended part of the claim, in a way that was not addressed in an earlier examination by the Office of the claims.

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first became known or available to the requester, including the date and manner that the art became known or available, and why it was not available earlier, as set forth in MPEP 2666.05.

<sup>14</sup> If, however, RU '617, which is newly submitted by the May 6, 2009 requester comments in the present proceeding, is one of a combination of documents cited in a newly proposed rejection, the requester would only need to show why the April 6, 2009 patent owner amendment necessitated the inclusion of RU '617 in the newly proposed rejection.

<sup>15</sup> The requester is reminded that the provisions of 37 CFR 1.948(a)(1)-(3) set forth the limitations on what newly cited prior art the requester may *file* in an *inter partes* reexamination as part of, for example, a document entitled "information disclosure statement", which is filed with requester's comments. If the submission of newly cited prior art meets the rule, then the newly cited prior art is entered into the proceeding, i.e., the reference is made of record, considered, and the consideration is indicated by the examiner's initials on the document entitled "information disclosure statement". To newly *propose a rejection* based on such prior art, however, the requester must also show how the newly proposed rejection is necessitated by amendment. See MPEP 2666.05.

4. The citation of any document, such as Willis '927, which was determined, in the order, to fail to raise an SNQ with respect to the original patent claims, for the express purpose of relying on an alleged teaching of a feature originally recited in the patent claims, is deemed to be inappropriate.

In the April 6, 2009 amendment, the pending independent claims were amended to recite a plurality of a feature originally recited in the patent claims,<sup>16</sup> i.e., a radially movable (or radially displaceable) gripping element for engagement with (or adapted to engage) an inner wall of a casing.

The requester's apparent reliance, although not clearly or specifically in the May 6, 2009 comments, on an alleged teaching of Willis '927 of a radially movable (or radially displaceable) gripping element for engagement with (or adapted to engage) an inner wall of a casing,<sup>17</sup> as the new, non-cumulative teaching which forms the basis of an SNQ for each document combination citing Willis '927, is deemed to be inappropriate. Although the examiner did not expressly discuss Willis '927 with respect to this specific feature, the examiner expressly determined, in the order,<sup>18</sup> that Willis '927 failed to raise an SNQ with respect to original patent claims 1-24, which included claims which recited this feature, such as, for example, claim 7. For the same reason, a reliance on the alleged teaching of this feature by any other document, which was determined by the order to fail to raise an SNQ with respect to original patent claims which recited this feature, would also be considered to be inappropriate.

The determination by the examiner of whether a substantial new question is raised by a document cited in the request is final and nonappealable, pursuant to 35 USC 312(c). The Office notes that this determination by the examiner in the February 6, 2009 order was not challenged by the requester in a petition filed under 37 CFR 1.181, as set forth in 37 CFR 1.927. Furthermore, the requester is cautioned that any such petition, if filed at this stage of the proceeding, would be deemed to be untimely, would not be considered, and would be expunged as an improper paper.

Note, however, that **any rejection using Willis '927 in combination with another reference that was found to raise an SNQ in the order, would include the requisite SNQ (provided by the other reference)**, and the question of whether Willis '927 teaches the amendatory language would be an appealable issue.

#### ***Requester's January 5, 2010 Comments Are Improper***

Requester's January 5, 2010 comments are improper due to the defective presentation of the newly proposed rejections 4-10, appearing on pages 3-15, and of the newly proposed rejections appearing on pages 16-35. Specifically, requester's January 5, 2010 comments are improper for

<sup>16</sup> See, e.g. original claim 7.

<sup>17</sup> The requester's apparent reliance on Willis '927 for this feature appears throughout the May 6, 2009 comments. See, for example, pages 18-19, 21, 23, 25, 26, 28, 30, 31, 33-36, 38, 41, 43, 44, 46, and 47.

<sup>18</sup> See pages 3-6 of the February 6, 2009 order granting reexamination.

the following reasons, the expanded substance of which is discussed in detail above with respect to requester's May 6, 2009 comments:

1. The newly proposed rejections 4-10, appearing on pages 3-15, are not in compliance with MPEP 2617.

See, for example, rejection no. 4, newly proposed on page 3 of the comments: "Claims 7-10, 20, 22, and 23 Are Obvious over Gjedebo '322 in View of **One or More** of Krasnov '422, Tessari '279, and Brown '244, and **Further in View of One or More** of Brown '675, Willis '927, and Delano '968".

It is also not clear whether, in some cases, the requester intends to propose a rejection. See, for example, footnotes 3 and 5, which make an offhand reference to a rejection of the newly amended claims under 35 U.S.C. 112, second paragraph. See also, for example, footnote 19, which makes an offhand reference to an alleged lack of support under 35 U.S.C. 112, for a feature apparently recited in the newly added claims. See also, for example, the offhand reference, throughout the footnotes, to GB 2 224 481. It is not clear whether the requester intends to propose a rejection based on this reference. The comments must clearly and definitively set forth each proposed rejection *in the body of the comments*. In addition, any newly proposed rejection must comply with all applicable rules and procedural standards, including, for example, MPEP 2617.

Regarding newly proposed rejection no. 6, which appears on pages 7-10, the proposed rejection is unclear, because the requester failed to specifically point to the exact words of the patent owner which, as argued by the requester, consists of the alleged admission by the patent owner. The requester must, for example, identify the paper in which the alleged admission appears by title and by filing date of the paper in the present proceeding, and should also refer to the page and line number, if appropriate, where the alleged admission appears in the paper.<sup>19</sup> The requester is also reminded that an alleged admission by the patent owner in a paper filed in the present reexamination proceeding is not "admitted prior art", and it is not, itself, a patent or printed publication. The fact that the patent owner refers to a passage of the patent under reexamination as support for a recited feature may be an alleged admission, but is not "prior art". It is also unclear, in any other newly proposed rejection discussing this alleged admission, such as newly proposed rejection no. 5, for example, whether the requester intends to include the alleged admission in the proposed rejection. Any document discussed in the body of a proposed rejection must be identified in the rejection statement of the proposed rejection, and a detailed explanation must be provided of the manner in which these references are to be applied against each of the claims that are requested to be reexamined. In other words, if a requester proposes a rejection of claim X under 35 U.S.C. 103(a) over reference A in view of reference B, and discusses document C in the body of the proposed rejection, then document C must be included in the rejection statement such as, for example, "claim X is proposed to be rejected under 35 U.S.C. 103(a) over A in view of B and C", and a detailed explanation, of how each

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<sup>19</sup> The examiner will make the determination 1) whether or not to give weight to the alleged admission, and 2) if weight is given, how much weight will be given.

of the documents A, B, and C are specifically to be applied against each of the limitations of claim X, should be provided.

2. The requester has not specifically explained how patent owner's April 6, 2009 amendment necessitated each new ground of rejection, for each newly proposed rejection citing newly submitted prior art, such as RU '617, or citing a document which was determined, in the order, to fail to raise an SNQ, such as Willis '927. See MPEP 2666.05.
3. The requester has not clearly and *specifically* explained, for each newly proposed rejection citing a document that was determined, in the order, to fail to raise an SNQ, such as Willis '927, how each of these documents *raise an SNQ* with respect to the newly amended claims.
4. The citation of any document, such as Willis '927, which was determined, in the order, to fail to raise an SNQ with respect to the original patent claims, for the express purpose of relying on an alleged teaching of a feature originally recited in the patent claims, is deemed to be inappropriate.

***Requester's Appellant's, Respondent's, and Rebuttal Briefs, Filed on June 28, 2010, July 27, 2010, and October 22, 2010, Respectively, Are Improper***

The requester's appellant's, respondent's and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively, are **improper** due to 1) the inappropriate inclusion of proposed rejections which the examiner determined to be improper, and were thus not addressed on the merits (i.e., were not determined by the examiner to be adopted or not adopted); 2) the improper inclusion of issues that are petitionable, and not appealable (such as, for example, the issue of whether the examiner properly refused to address on the merits certain rejections); and 3) the improper presentation of the improperly included rejections, for all of the reasons discussed extensively *supra*. The inclusion of rejections which the examiner determined to be improper, and were thus not addressed on the merits, fails to comply with 37 CFR 41.67(c)(vi), because these proposed rejections in the brief would constitute new grounds of rejection. See also 37 CFR §§ 41.68, and 41.71 and MPEP 2675, 2675.01 and 2678.

The propriety, or, in this case, the lack thereof, of requester's briefs is not being *specifically* addressed in this decision, because the propriety of the briefs can be reviewed by the requester in view of the guidance provided by this decision.

Accordingly, the requester's May 6, 2009 and February 16, 2010 comments, and the requester's appellant's, respondent's and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

In due course, the examiner should review all papers, which remain pending, for any additional improprieties.

### ***Requester's Recourse***

The requester is given **fifteen (15) days** from the mail date of this decision to submit **one** corrected comments submission in response to this decision, to replace both the May 6, 2009 and January 5, 2010 requester comments, and to serve as requester's comments filed after patent owner's response of April 6, 2009, pursuant to 37 CFR 1.947. Any corrected comments submission submitted in response to this decision must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submissions. No comments that add to those in the expunged comment papers (other than to correct the matters noted above) will be considered for entry. See MPEP 2666.05.

If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be **expunged**, and **no further § 1.947 comments opportunity, pursuant to 35 U.S.C. 314(b)(2),<sup>20</sup> opportunity will be provided for the requester to address issues raised by patent owner's amendment of April 6, 2009**, or to address any issues regarding the April 6, 2009 amendment, that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.

### ***Additional Discussion***

As pointed out above, there is no reason given on record why the petitioner did not directly address the basis for the September 22, 2010 dismissal, by supplying facts and circumstances relating to the delay in submitting a petition. There is only a discussion of "putting form over substance". *The petitioner does not explain why the requester did not follow the standard procedure to timely petition and bring requester's matter of concern properly before the Office for resolution at an early stage.* The petitioner could have simply filed petitions objecting to the examiner's failure to separately notify the requester that the May 6, 2009 requester comments and the January 5, 2010 requester comments, respectively, were improper, rather than acquiescing to the examiner's issuance of the Office action on the merits and the examiner's failure to give the requester an opportunity to correct the comments submission.<sup>21</sup> Even if there

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<sup>20</sup> 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.

<sup>21</sup> The Office notes, for example, that the petitioner repeatedly argues that MPEP 2617 does not apply to requester comments filed after patent owners' response, yet insists, in requester's June 28, 2010 appellant's brief (see footnote no. 9, page 11), that "the 3<sup>rd</sup> Party should have been afforded a 15 day time period in which to correct the allegedly improper comments in accordance with PTO practice . . . See, e.g., M.P.E.P. §§ 2617 and 2666.05". Thus, the petitioner appears to have been aware that MPEP 2666.05 expressly requires requester's comments to comply with MPEP 2617. Yet, the petitioner still has not provided any explanation whatsoever for the delay in filing a petition

is any merit to the “putting form over substance” position, there is still *no explanation of why the requester did not properly bring the matter to the Office’s attention until after the original briefs were filed*, to thus save substantial delay. The petitioner should be mindful of 37 CFR 11.18, which provides, in pertinent part (emphasis added):

By presenting to the Office ... any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that- ...

(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 ...

### CONCLUSION

- The October 18, 2010 requester petition is **dismissed**.
- The November 6, 2009 action closing prosecution (ACP), the March 29, 2010 right of appeal notice (RAN), and the September 24, 2010 examiner’s answer, are *sua sponte* **vacated**.
- The requester’s May 6, 2009 and January 5, 2010 comments, and the requester’s appellant’s, respondent’s, and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively, are **improper**, and are being **expunged** from the record due to their failure to comply, at a minimum, with at least one of 37 CFR §§ 41.67(c)(vi), 41.68, and 41.71, MPEP 2617, MPEP 2666.05, and MPEP 2675, as appropriate in each instance. Because these papers have been scanned into the Office’s electronic Image File Wrapper (IFW) system, they are being **expunged** from the record by marking the papers “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

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until July 2, 2010, after all of the initial briefs were filed. Furthermore, the petitioner also argues, for example, in footnote no. 6 appearing on page 8 of the appellant’s brief, that “all of the proposed rejections based upon a combination of references [in the November 11, 2008 request] were presented using the language of ‘... in view of one or more of ...’, and that “the 3<sup>rd</sup> Party Comments filed on 1/5/2010 necessarily build upon and incorporate, explicitly and/or implicitly, the entire prior prosecution history of the reexamination”. However, to the extent that any such use of the language is waived at the beginning of the proceeding, it has not been waived after the examination stage has begun. In any event, contrary to petitioner’s arguments, a more careful review of the November 18, 2008 request reveals that all, or nearly all, of the proposed rejections based upon a combination of references did NOT include the above-quoted language, which shows that the petitioner clearly understood at least the principles of MPEP 2617 with respect to the prohibition of improper alternative language, and yet improperly presented newly proposed rejections in this format, in petitioner’s later-filed papers, such as requester’s May 6, 2009 and January 5, 2010 comments, and the requester’s appellant’s, respondent’s, and rebuttal briefs filed on June 28, 2010, July 27, 2010, and October 22, 2010, respectively.

- The requester is given **fifteen (15) days** from the mail date of this decision to submit **one** corrected comments submission in accordance with this decision. If the requester raises any issues not permitted for requester comments in the corrected comments submission, the corrected comments submission will be **expunged**, and **no further § 1.947 comments opportunity, pursuant to 35 U.S.C. 314(b)(2), will be provided for the requester to address issues raised by patent owner's amendment of April 6, 2009**, or to address any issues regarding the April 6, 2009 amendment that were raised by the Office or by the patent owner in communications that have been mailed or filed, respectively, as of the date of this decision.
- Any papers going to the merits, including, for example, the Office actions (including the examiner's answer), and all responses, comments, or briefs, filed by the parties subsequent to patent owner's April 6, 2009 response and amendment, and prior to the mail date of this decision, **will not be further considered on the merits**, since they are directed to papers that have been vacated.
- This proceeding is being referred to the Central Reexamination Unit (CRU) to await the filing of requester's corrected comments submission, or the expiration of the time for filing requester's corrected comments submission. If a corrected comments submission in accordance with this decision is not timely filed by the requester, the CRU examiner will, in due course, issue an Office action in response to patent owner's April 6, 2009 amendment, without consideration of any comments thereon filed by the requester.
- Any further correspondence with respect to this matter should be addressed as follows:

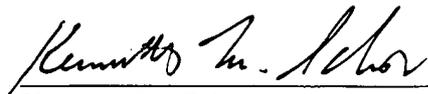
By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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By Fax: (571) 273-9900

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401 Dulany Street  
Alexandria, VA 22314

- Any inquiry concerning this decision should be directed to Senior Legal Advisors Cynthia L. Nessler, at (571) 272-7724, or Hiram Bernstein, at (571) 272-7707.



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

Kenappeal/decisions/entry issues  
Kenpet8/IP/  
4-13-11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,120	11/18/2008	7228901	069669-0007-07	8445
9629	7590	10/21/2010	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
BRACEWELL & GIULIANI LLP  
P.O. BOX 61389  
HOUSTON, TX 77208-1389

Date: **MAILED**  
**OCT 21 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001120  
PATENT NO. : 7228901  
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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WASHINGTON, DC 20004

(For Patent Owner)

MAILED

OCT 2 2010

CENTRAL REEXAMINATION UNIT

BRACEWELL & GIULIANI LLP  
P.O. BOX 61389  
HOUSTON, TX 77208-1389

(For Requester)

*In re Vail, III et al.* :  
Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/001,120 : UNDER 37 CFR 1.181  
Filed: November 18, 2008 :  
For: U.S. Patent No.: 7,228,901 :

This is a decision on a petition filed by the third party requester on May 11, 2010, which is entitled "PETITION UNDER 37 CFR § 1.181 AND/OR § 1.182 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009" [hereinafter "the petition"], and is a request to the Director to exercise her discretion pursuant to 37 CFR 1.181 and review the April 26, 2010 Notice Re Defective Paper in *Inter Partes* Reexamination. The petition is treated as a petition under 37 CFR 1.181. A separate petition under 37 CFR 1.182 must be filed in order for it to be considered by the proper official. See 37 CFR 1.4.

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

The petition under 37 CFR 1.181 is denied, for the reasons set forth herein.

## REVIEW OF RELEVANT FACTS

1. On June 12, 2007, U.S. Patent No. 7,228,901 issued to Vail, III et al. ("the '901 patent").
2. On November 18, 2008, a request for *inter partes* reexamination of the '901 patent was filed by a third party requester, which request was assigned reexamination proceeding control number 95/001,120 ("the '1120 proceeding").
3. On January 30, 2009, the Office mailed an order granting *inter partes* reexamination in the '1120 proceeding, concurrently with a non-final Office action on the merits.
4. On March 30, 2009, patent owner filed a "RESPONSE TO OFFICE ACTION DATED 01/30/2009."
5. On April 29, 2009, third party requester filed "COMMENTS IN RESPONSE TO THE AMENDMENT FILED ON MARCH 30, 2009."
6. On September 23, 2009, the Office mailed an action closing prosecution (ACP) in the '1120 proceeding. The ACP withdrew all previously adopted prior art rejections and set forth new rejections under 35 U.S.C. 112, second paragraph, due to the proposed amendments to the claims. The ACP determined that claims 1-13, 15, 17, 19-23, 25, and 27-31 contain patentable subject matter.
7. On October 23, 2009, patent owner filed a "RESPONSE TO OFFICE ACTION DATED September 23, 2009." The response included proposed further amendments to claims 1, 17, 19, 20, 22, 25, and 28-31 and cancelled claims 14, 16, 18, 24, and 26.
8. On November 20, 2009, third party requester filed "COMMENTS IN RESPONSE TO THE AMENDMENT FILED ON 10/23/2009 IN RESPONSE TO THE OFFICE ACTION CLOSING PROSECUTION MAILED ON 9/23/2009" ("the November 20, 2009 comments").
9. On April 26, 2010, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the Notice of Defective Paper"), stating "[t]he comments filed by the third party requester on 20 November 2009 are improper because they fail to comply with 37 CFR 1.947 and 1.948. Specifically, the written comments are improper because: (1) they are not limited to issues and points covered by the Action Closing Prosecution mailed on 23-September 2009 and the patent owner's response to the ACP filed on 23 October 2009; and (2) the prior art submitted with the comments does not satisfy the provisions of 37 CFR 1.948." The Notice of Defective Paper set a time period of fifteen days from the mailing date of the notice for third party requester to "rectify and re file the improper comments."

10. On May 11, 2010, third party requester filed the instant paper entitled "PETITION UNDER 37 CFR § 1.181 AND/OR 37 CFR § 1.182 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009" ("the instant petition").

11. Concurrently, on May 11, 2010, third party requester filed another petition entitled "PETITION UNDER 37 CFR § 1.183 TO ACCEPT THIRD PARTY REQUESTER COMMENTS SUBMITTED NOVEMBER 20, 2009" ("the petition under 37 CFR 1.183"), which was decided in a separate communication mailed June 23, 2010.

12. Also, on May 11, 2010, third party requester filed "COMMENTS IN RESPONSE TO THE NOTICE OF IMPROPER 3RD PARTY REQUESTOR COMMENTS AND THE AMENDMENT FILED ON 10/23/2009 IN RESPONSE TO THE OFFICE ACTION CLOSING PROSECUTION MAILED ON 9/23/2009."

## DECISION

In the May 11, 2010 instant petition, the third party requester (petitioner) stated that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's decision to hold the November 20, 2009 comments noncompliant with 37 CFR 1.947 and 1.948. The petitioner contends the new proposed rejections should be considered because they comply with 35 U.S.C. 314(b)(2), 37 CFR 1.951 and MPEP 2672. The petitioner also contends that the new citation to a reference must be considered because it complies with 37 CFR 1.948 and MPEP 2656.

### 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.

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.

37 CFR 1.948 states:

- (a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
- (1) which is necessary to rebut a finding of fact by the examiner;
  - (2) which is necessary to rebut a response of the patent owner; or
  - (3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

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.

MPEP 2672 states, in part:

**IV. PATENT OWNER MAKES SUBMISSION AFTER ACP; THIRD PARTY REQUESTER COMMENTS ARE LIMITED \*\***

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2). Such third party requester comments must be filed within 30 days from the **date of service** of the patent owner's comments, and/or proposed amendment, and/or the issues raised in the ACP on the third party requester. If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments. No additional opportunity will be given for the third party requester to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.

**Analysis:**

Turning to the facts in this proceeding, the new proposed rejections and the newly cited reference, introduced in the November 20, 2009 comments, were not included in the request for reexamination. Instead, these proposed rejections and the new reference were not mentioned until after the examiner closed prosecution and indicated allowable subject matter in the claims.

**Issue of Compliance of the November 20, 2009 Comments:**

In the petition, the petitioner states that the November 20, 2009 comments did comply with controlling statutes, rules, and procedures and therefore, must be entered and considered by the examiner. See pages 3-6 of the petition.

The petitioner state that the fact that patent owner amended the claims gives them the right to propose new rejections based on different combinations of art of record and the newly cited reference. Petitioner claims that patent owner's "extensive" amendments were only under the guise of responding to the rejections under 35 U.S.C. 112 and that the amendments "clearly alter the scope of the claims." See pages 4-6 of the petition. Petitioner argues that the examiner's determination that the November 20, 2009 comments were not compliant with 37 CFR 1.947 and 1.948 is in direct contradiction to controlling statutes, regulations, and procedures.

In response, the controlling reexamination statutes and regulations clearly demand presentation of all the issues regarding patentability in the request for reexamination in order for patentability issues to be resolved with special dispatch. In accordance with reexamination laws and policies, the requester must select, identify, and explain the best proposed rejections in the request for reexamination, keeping in mind the requirement for special dispatch in resolving any issues of patentability. In other words, *inter partes* reexamination laws and policies clearly require that the requester to set forth all the proposed rejections by supplying the manner and pertinency of applying the references to the claims for which reexamination is requested, with limited exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve "special dispatch" required in reexamination proceedings. 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. See MPEP 2666, 2672, and 2673. Accordingly, the Office's rules and procedures do not categorically deprive the third party requester of its statutory rights to present proposed rejections in reexamination proceedings. As explained above, the requester did not set forth the new proposed obviousness rejections in the request for reexamination or in response to the first Office action. Therefore, to allow a requester to set forth additional proposed rejections only after the examiner determines that the claims contain allowable subject matter would lengthen reexamination proceedings, which is clearly against the statutory mandate of "special dispatch."

Specifically, the examiner had determined that claims 1-13, 15, 17, 19-23, 25, and 27-31 contain patentable subject matter in the ACP. No prior art rejections were made in the ACP. The ACP only contained rejections under 35 U.S.C. 112, second paragraph, due to the scope of the claims being unclear. In their response, patent owner stated that the amendments addressed the rejections under 35 U.S.C. 112 and the objections to the claims. Some amendments followed the examiner's changes suggested in the ACP (see, e.g., the

amendments to claims 19 and 20). While the patent owner did not follow the examiner's suggested changes for every claim rejected, the record is clear that the amendments further clarified the scope of the claims, and did not broaden the scope of claims that were already determined to have allowable subject matter. Therefore, the examiner properly determined that the introduction of newly proposed rejections after the closing of prosecution was not compliant with the controlling statutes, regulations, and procedures because the November 20, 2009 comments were not limited to issues raised by the ACP and the patent owner's response. The examiner clearly set forth the reasons in the April 26, 2010 notice and his reasons are consistent with reexamination statutes, regulations and procedures. See MPEP 2672.

Accordingly, in this situation, requester's arguments are not persuasive. For the reasons expressed above, 37 CFR 1.947 and MPEP 2666.05 and 2672 authorize the examiner's decision to not enter the November 20, 2009 comments.

**Issue of Compliance of the Newly Cited Reference:**

In the petition, the petitioner states that the Office and the examiner have a duty to provide a thorough determination of patentability, which mandates that the examiner consider the "Lessons in Well Servicing" reference because it was made of record during the prior examination. See pages 6-7 of the petition. In response, the director finds nothing in the record supports the petitioner's allegation that a thorough examination, in accordance with 37 CFR 1.104, has not been performed. The record clearly shows that the examiner considered all the proposed rejections set forth in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination and provided an Office action which either adopted or not adopted these proposed rejections. All the Office actions articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948. See the Office actions dated January 30, 2009 and September 23, 2009. As discussed above, the record also shows that there is nothing that prevented the petitioner from presenting the proposed obviousness rejection based the "Lessons in Well Servicing" reference in the request for reexamination or in response to the first Office action. 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) clearly require that the requester must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. As discussed above, the controlling reexamination statutes and regulations clearly demand presentation of all the issues regarding patentability in the request for reexamination or prior to the close of prosecution in order for patentability issues to be resolved with special dispatch.

Neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must explicitly consider on the record and explain why they are making or not making every possible rejection that is not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Moreover, the petitioner's citation to the "Lessons in Well Servicing" reference was made under 37 CFR 1.948. Petitioner has failed to show how

the citation meets one of the three conditions set forth in 37 CFR 1.948(a)(1)-(3) for consideration of the reference so late in the proceeding. Therefore, the record does not support petitioner's view that a thorough examination of the claims was not performed unless the examiner explicitly considered on the record the "Lessons in Well Servicing" reference. Accordingly, for all these reasons, requester's arguments are not persuasive that the examiner erred in his refusal to consider "Lessons in Well Servicing" reference under 37 CFR 1.948.

In conclusion, the examiner appropriately denied entry of the November 20, 2009 comments. Accordingly, the examiner correctly applied Office policies and procedures in determining that the newly proposed obviousness rejections and the newly cited reference are not appropriately raised. For all the reasons discussed above, the petition for reconsideration is **denied**.

### REQUESTER'S RECOURSE

The third party requester has the following possible courses of action if the third party requester desires to bring the newly presented proposed rejections before the Office:

1. Initiate an *ex parte* reexamination of the '901 patent based on the proposed obviousness rejections by filing a new and complete request for *ex parte* reexamination. This decision is without prejudice to the right of the requester to file a new request for reexamination. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.
2. File a petition under 35 U.S.C. 317(a) to authorize the filing of a new *inter partes* reexamination of the '901 patent based on the proposed obviousness rejections. If granted, the request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the previous examination.

### CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the examiner's refusal to enter the November 20, 2009 is **denied**.
2. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361.

  
Irem Yucel, Director  
Technology Center 1600



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JAN 14 2011

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Haynes and Boone, LLP (For the '166 *inter partes* requester)  
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NOVAK, DRUCE & QUIGG, LLP (For the '1122 *inter partes* requester)  
(NDQ Reexamination Group)  
1000 Louisiana Avenue, 53<sup>rd</sup> Floor  
Houston, TX 77002

*In re Farmwald et al.* :  
*Inter Partes* Reexamination Proceeding :  
Control No.: 95/000,166 :  
Filing Date: August 22, 2007 :  
For: U.S. Patent No.: 6,426,916 : **DECISION**  
: **DISMISSING**  
*In re Farmwald et al.* : **PETITION**  
*Inter Partes* Reexamination Proceeding :  
Control No.: 95/001,122 :  
Filed: November 20, 2008 :  
For: U.S. Patent No.: 6, 426,916 :  
:

This is a decision on the October 15, 2010 patent owner petition entitled "PETITION TO UNMERGE THE MERGED REEXAMINATION PROCEEDINGS."

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is dismissed.

**BACKGROUND**

1. On July 30, 2002, the Office issued U.S. Patent No. 6,426,916 (the '916 patent) to Farmwald *et al.*
2. On August 8, 2006, a first request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/000,166 ("the '166 proceeding"). Samsung Electronics, Co. Ltd. is identified as the real party in interest. After receipt of a corrected request the '166 proceeding was granted a filing date of October 12, 2006. Reexamination was ordered on December 26, 2006, which was then vacated on August 14, 2007. On August 22, 2007, a

redacted/corrected request was filed and granted a new filing date. Reexamination of the '916 patent based on the corrected request was ordered on October 19, 2007.

3. On November 20, 2008, a second request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control no. 95/001,122 ("the '1122 proceeding"). Micron Technology is identified as the real party in interest. Reexamination was ordered on January 16, 2009.
4. On March 9, 2009, the Office *sua sponte* issued a decision merging the '166 and '1122 proceedings ("the merged proceeding").
5. On August 6, 2010, prosecution in the merged proceeding advanced to the point where the Office issued a Right of Appeal Notice (RAN).
6. On September 7, 2010, third party requester Micron filed a Notice of Appeal.
7. On October 15, 2010, patent owner filed the present petition to unmerge the proceeding.
8. On November 8, 2010, third party requester Micron filed an appeal brief.
9. On December 8, 2010, patent owner filed a respondent's brief.

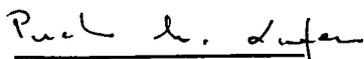
#### DECISION

Patent owner requests demerger of the merged proceeding. Patent owner argues that the request for demerger is not untimely as the petition is not in response to the March 9, 2009 Office merger decision, but instead in response to a recent change in circumstance in the merged proceeding. Patent owner asserts that demerger now instead of retention of merger will better facilitate special dispatch. Specifically, patent owner alleges that demerger will result in immediate issuance of a reexamination certificate in the '166 proceeding. Patent owner also alleges that demerger will streamline the '1122 proceeding's appeal, hence also supporting special dispatch.

Patent owner's position is not persuasive. The reexamination proceeding has progressed as a merged proceeding to the point that an Examiner's determination has been appealed and fully briefed. Thus all that remains is an Examiner's Answer, the rebuttal briefing phase and the rendering of a Board decision. Accordingly, dissolution of the merger at this very late stage of the proceeding does not serve the interests of special dispatch in the Office.

#### CONCLUSION

1. Patent owner's October 15, 2010 petition is **dismissed**.
2. Telephone inquiries related to this decision should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



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

January 13, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,122	11/20/2008	6,426,916	8963.002.916	1557

22852            7590            03/15/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
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EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 03/15/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

---

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

---

DECISION ON PETITION

This is a decision on Patent Owner’s “Petition to Expunge Third-Party Requester’s Appeal Brief,” filed December 8, 2010 (“Petition”); and “Third Party Requester’s Opposition to Patent Owner’s Petition to Expunge Third Party Requester’s Appeal Brief,” filed January 7, 2011 (“Opposition”). In the Petition, Patent Owner “requests that the Office expunge Micron’s appeal brief from the record because it raises issues the Micron did not propose in its reexamination request and that do not pertain to the Micron-initiated reexamination proceeding . . . and because the Examiner never adopted those issues in these reexamination proceedings.” Petition, p. 1.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.
6. On March 9, 2009, the '166 and '122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, confirming claims 1-41.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.
10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.
11. On November 8, 2010, Micron filed an appellant brief for claims 26 and 28.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

12. On December 8, 2010, Rambus filed a respondent brief and the present Petition to expunge Micron's appellant brief.
13. On January 7, 2011, Micron filed the present Opposition.

#### RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

(b) THIRD-PARTY REQUESTER.- A third-party requester- (1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent . . . .*

(emphasis added).

Similarly, 37 C.F.R. § 41.61(a)(2) provides:

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to *any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent* by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 41.20(b)(1).

(emphasis added).

Also relevant is MPEP § 2674(B):

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

(emphasis in original).

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

## ANALYSIS

The relevant statute, rule and MPEP section quoted above are intended to grant a requester the right to appeal any decision by the Examiner favorable to patentability on a proposed rejection irrespective of the origin of such rejection, i.e., whether the rejection was proposed by the Examiner or another requester.

The language in MPEP § 2674(B) is intended to differentiate between issues first raised during prosecution and issues first raised on appeal, and not between multiple requesters in a merged proceeding. This interpretation of § 2674(B) is supported by the language:

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

(emphasis added).

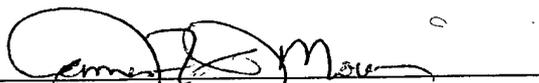
This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See*, MPEP Forward.

Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

DECISION

In view of the forgoing, the Petition is DENIED.



James T. Moore  
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,122	11/20/2008	6,426,916	8963.002.916	1557
22852	7590	03/15/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2011

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Third Party Requester – *Inter partes* Reexamination Control 95/001,122

---

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

---

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed December 8, 2010 ("Petition"). In the Petition, Patent Owner "requests that the Director waive the requirement of 37 C.F.R. § 1.943(c) limiting respondent appeal briefs to fifteen pages or 7,000 words in length. Specifically, Rambus requests that the Office accept its respondent appeal brief, which is 25 pages and 14,904 words in length." Petition, p. 1.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

## FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.
6. On March 9, 2009, the '166 and '122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution ("ACP"), confirming claims 1-41.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.
10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.
11. On November 8, 2010, Micron filed an appellant brief for claims 26 and 28.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

12. On December 8, 2010, Rambus filed a respondent brief and the present Petition.

### RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

### ANALYSIS

Using the above guidelines, Micron's appellant brief is 27 pages in length and Rambus's respondent brief is 25 pages in length.

Rambus represents that it "has made every effort to pare down the arguments in its respondent appeal brief, but a respondent appeal brief limited to 15 pages or 7,000 words in length is inadequate to fully address and comprehensively respond to Micron's arguments." Petition, p. 3.

As indicated above, however, there are only two claims at issue here, claims 26 and 28. Further, Micron's appellant brief of 27 pages is well within the limit of 30 pages specified in 37 C.F.R. § 1.943(c) for appellant briefs.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

Rambus's due process arguments have been carefully considered, including the Federal Circuit decision in *Patlex Corp. v. Mossinghoff*, 771 F.2d 480 (Fed. Cir. 1985), and are not deemed persuasive. Efficiency of administrative processing is a legitimate basis for restricting submissions from participants in reexamination proceedings. *Id.* at 483-86.

#### DECISION

In view of the forgoing, the Petition is DENIED. Rambus is given one month or 30 days, whichever is longer, in which to file a respondent brief that conforms to the requirements of 37 C.F.R. § 1.943(c).



---

James T. Moore  
Acting Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

Counsel for Patent Owner:

Naveen Modi

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22852	7590	05/31/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			05/31/2011	PAPER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,166	08/22/2007	6426916	38512.3	7919

22852                      7590                      05/31/2011  
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EXAMINER

ESCALANTE, OVIDIO

ART UNIT                      PAPER NUMBER

3992

MAIL DATE                      DELIVERY MODE

05/31/2011

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Third Party Requester – *Inter partes* Reexamination Control 95/001,122

---

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

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DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third-Party Requester's Appeal Brief," filed April 15, 2011 ("Petition"); and "Third Party Requester's Opposition to Patent Owner's Petition Seeking Review of Decision Denying Patent Owner's Petition to Expunge Third Party Requester's Appeal Brief," filed May 16, 2011 ("Opposition").

In the Petition, Patent Owner "requests that the Director review and overturn the Office's March 15, 2011 Decision on Petition [denying Patent Owner's] petition in which [Patent Owner] requested that the Office expunge Third-Party Requestor [Micron's] appeal brief because it raised

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

issues that Micron did not propose in its reexamination request and that did not pertain to the Micron-initiated reexamination proceeding.” Petition, p. 1.

#### FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The ‘916 patent is assigned to Patent Owner Rambus, Inc. (“Rambus”).
2. Third Party Requester Samsung Electronics Co., Ltd. (“Samsung”) filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the ‘916 patent in the ‘166 proceeding.
4. Third Party Requester Micron Technology, Inc. (“Micron”) filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the ‘916 patent in the ‘122 proceeding.
6. On March 9, 2009, the ‘166 and ‘122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution (“ACP”) was mailed in the merged proceeding, confirming claims 1-41.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice (“RAN”), confirming claims 1-41.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.
11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28.
12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition to Expunge Micron's Appellant Brief.
13. On January 7, 2011, Micron filed an Opposition to Rambus's Petition to Expunge.
14. On March 15, 2011, the Board entered a Decision on Petition, denying Rambus's Petition to Expunge.
15. On April 15, 2011, Rambus filed the present Petition.
16. On May 16, 2011, Micron filed the present Opposition.

#### RELEVANT AUTHORITY

In respect to the issues that can be raised by a requester on appeal, 35 U.S.C. § 315(b)(1) provides:

(b) **THIRD-PARTY REQUESTER.**- A third-party requester-  
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, *with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent . . . .*

(emphasis added).

Similarly, 37 C.F.R. § 41.61(a)(2) provides:

(2) Upon the issuance of a Right of Appeal Notice under § 1.953 of this title, the requester may appeal to the Board with respect to *any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent* by filing a notice of appeal within the time provided in the Right of Appeal Notice and

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Patent 6,426,916

paying the fee set forth in § 41.20(b)(1).

(emphasis added).

Also relevant is MPEP § 2674(B):

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

(emphasis in original).

## ANALYSIS

The exact same issue posed by Rambus's present Petition recently has been addressed by the Board in response to several similar Rambus petitions. Clearly, the Board has concluded that the relevant statute and rule, quoted above, are intended to grant a requester the right to appeal any decision by the Examiner favorable to patentability on a proposed rejection irrespective of the origin of such rejection, i.e., whether the rejection was proposed by the Examiner or another requester. See, Merged Proceedings 95/001,026 and 95/001,128, February 16, 2011; 95/000,183 and 95/001,112, April 15, 2011; 95/000,250 and 95/001,124, April 27, 2011.

Further, the facially contradictory 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*

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

*must identify each previously proposed rejection to be contested.*  
(emphasis added).

This interpretation of MPEP § 2674(B) renders this provision consistent with the statutory and regulatory provisions cited above, which is necessary to preserve its validity. *See*, MPEP Forward.

### DECISION

In view of the forgoing, the Petition is DENIED.

This Decision constitutes Final Agency Action on this matter.



---

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Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,122	11/20/2008	6,426,916	8963.002.916	1557

22852                      7590                      06/07/2011

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EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 06/07/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

---

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

---

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed April 15, 2011 ("Recon. Petition"). In the Recon. Petition, Patent Owner "requests that the Director overturn the March [15, 2011] Decision and direct the Office to enter Rambus's December 8, 2010 Respondent Brief into the record." Petition, p. 1.

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

2. Third Party Requester Samsung Electronics Co., Ltd. (“Samsung”) filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the ’916 patent in the ’166 proceeding.
4. Third Party Requester Micron Technology, Inc. (“Micron”) filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the ’916 patent in the ’122 proceeding.
6. On March 9, 2009, the ’166 and ’122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution (“ACP”), confirming claims 1-41.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice (“RAN”), confirming claims 1-41.
10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.
11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28.
12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief is 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed the present Recon. Petition. Along with the Recon. Petition, Rambus also filed a Replacement Respondent Brief and an Alternative Replacement Respondent Brief. The Replacement Brief is 15 pages in length and includes citations to expert declarations (Recon. Petition at 8-10), and the Alternative Replacement Brief also is 15 pages in length but does not include citations to expert declarations (Recon. Petition at 10).

#### RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

With respect to waiver of the Rules, 37 C.F.R. § 1.183 provides:

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

### ANALYSIS

In the Recon. Petition, Rambus advances several arguments why application of the page limit specified by Rule 1.943(c) for its respondent brief is unfair and inappropriate, including:

1. In this merged proceeding, in a single respondent brief, Rambus must address issues presented by two third party requesters (Recon. Petition at 2);
2. A respondent brief, having a page limit of 15 pages, is responding to an appellant brief that may be 30 pages in length (Recon. Petition at 2-3); and
3. Limiting a patent owner's ability to address comprehensively issues relating to patentability violates the owner's due process rights (Recon. Petition at 3).

In this merged proceeding, Micron's Appellant Brief is 27 pages in length which is within the 30-page limit prescribed by Rule 1.943(c).

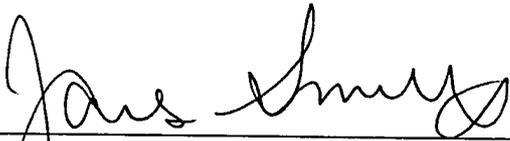
As required by Rule 1.183, waiver of the rules requires presentation of an extraordinary situation for which justice requires a waiver. Here, there is nothing extraordinary about the posture of this appeal. Micron's Appellant Brief is within the 30-page limit prescribed by Rule 1.943(c). Rambus's alleged difficulty in complying with the 15-page limit for its Respondent

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

Brief is with application of the relevant procedures *per se* and not with any circumstance unique to this appeal. In the absence of facts establishing the existence of a unique situation, i.e., not a situation arising out of routine application of a rule, there can be no extraordinary situation for which justice requires waiver of the rule.

### DECISION

In view of the forgoing, the Recon. Petition is DENIED with respect to Rambus's Respondent Brief and Replacement Respondent Brief, and is GRANTED with respect to Rambus's Alternative Replacement Brief. The Office will accept Rambus's Alternative Replacement Brief that is in compliance with Rule 1.943(c).



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James D. Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,122	11/20/2008	6,426,916	8963.002.916	1557

22852 7590 08/18/2011

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

---

Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

---

DECISION ON PETITION

This is a decision on Patent Owner’s “Petition Seeking Reconsideration of June 7, 2011 Decision on Petition,” filed July 7, 2011 (“Second Reconsideration Petition”). The Second Reconsideration Petition “requests that the Office reconsider its June 7, 2011 Decision on Petition . . . denying Rambus’s Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner’s Respondent Brief. . . .” Second Reconsideration Petition, p. 1.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

## FINDINGS

1. Patent 6,426,916 issued on July 30, 2002 with 41 claims. The '916 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics Co., Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008. Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '122 proceeding.
6. On March 9, 2009, the '166 and '122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, the Office mailed an Action Closing Prosecution ("ACP"), confirming claims 1-41.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.
10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.
11. On November 8, 2010, Micron filed an Appellant Brief for claims 26 and 28. Micron's Appellant Brief is 27 pages long.

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37 C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief is 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed a First Reconsideration Petition along with a Replacement Respondent Brief and an Alternative Replacement Respondent Brief. The Replacement Brief is 15 pages in length and includes citations to expert declarations (First Reconsideration Petition at 8-10), and the Alternative Replacement Brief also is 15 pages in length but does not include citations to expert declarations (First Reconsideration Petition at 10).

15. On June 7, 2011, the Office entered a Decision on Petition denying Rambus's First Reconsideration Petition and agreeing to accept the Alternative Replacement Respondent Brief.

16. On July 7, 2011, Rambus filed the Second Reconsideration Petition under consideration here.

#### RELEVANT AUTHORITY

In respect to the length of appeal briefs in *inter partes* reexaminations, 37 C.F.R. § 1.943(c) provides:

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

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

contained in the brief.

In addition to prior art references, reference materials include the information specified in 37 C.F.R. § 41.68(b)(1)(i)-(iv) – real party in interest, related appeals and interferences, status of claims, and status of amendments.

In respect to affidavits and declarations of expert witnesses, MPEP § 2667 (I)(A)(2) specifies:

Any affidavit or declaration (or a clearly defined portion thereof) that contains 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.

In respect to waiver of the Rules, 37 C.F.R. § 1.183 provides:

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

## ANALYSIS

Here, the relevant background facts are undisputed; namely Micron's Appellant Brief places four issues in dispute – three rejections and a priority dispute. Micron presented its position on these issues in its Appellant Brief in 27 pages, within the 30 page limit proscribed by Rule 1.943(c).

In drafting and adopting Rule 1.943(c), with a 2-to-1 ratio of page and word limits between appellant briefs and respondent briefs, the Office was aware that the issues in an appeal are framed and defined by the opening

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

brief – the appellant brief. Rule 41.67(c)(1)(vi). In addition, appellant must explain why the position of the Examiner on the relevant issues as set forth in the RAN is incorrect.

Rambus argues that the refusal of the Office to grant Rambus a waiver from the page/word limits of Rule 1.943(c) for its Respondent Brief is “arbitrary and capricious, and violates Rambus’s due process rights.” Second Reconsideration Petition, p. 3.

The Office will not agree that the application of Rule 1.943(c) to Rambus’s Respondent Brief constitutes a per se violation of Rambus’s due process rights. Other than mentioning that four issues are presented by Micron’s Appellant Brief, Rambus has not described any detail of those issues that would warrant waiving the page/word limits of Rule 1.943(c). Furthermore, 15 pages of text would appear to be more than sufficient to respond to three rejections and a priority issue.

Concerning the citations to statements contained in expert witness affidavits and declarations, Rambus should identify the nature of the statements. If they present expert opinions on patentability issues, they will be treated as countable pages of Rambus’s Respondent Brief. If they present factual technical information, they will not be treated as countable pages of the Brief.

As stated in the Decision on the First Reconsideration Petition, a waiver of the rules under Rule 1.183 requires presentation of an extraordinary situation for which justice requires a waiver. Here, there is nothing extraordinary about the posture of this appeal. Micron’s Appellant Brief is within the 30-page limit prescribed by Rule 1.943(c). Rambus’s alleged difficulty in complying with the 15-page limit for its Respondent

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

Brief appears to be difficulty in complying with the relevant procedures *per se* and not as a result of any particular circumstance unique to this appeal. In the absence of facts establishing the existence of a unique situation, i.e., not a situation arising out of routine application of a rule, there can be no extraordinary situation for which justice requires waiver of the rule.

### DECISION

In view of the forgoing, the Second Reconsideration Petition is DENIED with respect to Rambus's Respondent Brief and Replacement Respondent Brief, and is GRANTED with respect to Rambus's Alternative Replacement Brief. The Office will accept Rambus's Alternative Replacement Brief that is in compliance with Rule 1.943(c). This Decision constitutes final agency action on this matter.

  
\_\_\_\_\_  
James D. Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

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95/001,122	11/20/2008	6,426,916	8963.002.916	1557
22852	7590	09/27/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

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BEFORE THE  
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RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,166

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MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,122

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Merged *Inter partes* Reexamination Control 95/000,166 and 95/001,122  
Patent 6,426,916

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DECISION ON PETITION

This is a decision on Third Party Requester's Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(C), filed June 27, 2011 ("Micron's Petition for Waiver"). Micron requests that it be allowed to submit a Rebuttal Brief of up to 25 pages.

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*Inter partes* Reexamination Control Nos. 95/000,166 and 95/001,122  
Patent 6,426,916

FINDINGS

1. Patent 6,426,916 issued on July 30, 2002, with 41 claims. The '916 patent is assigned to Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 12, 2006. Reexamination Control 95/000,166 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-41 of the '916 patent in the '166 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 20, 2008.  

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Reexamination Control 95/001,122 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26 and 28 of the '916 patent in the '1122 proceeding.
6. On March 9, 2009, the '166 and '1122 proceedings were merged.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on June 19, 2010, an Action Closing Prosecution ("ACP"), which confirmed claims 1-41, was mailed in the merged proceeding.
9. On August 6, 2010, the Office mailed a Right of Appeal Notice ("RAN"), confirming claims 1-41.

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*Inter partes* Reexamination Control Nos. 95/000,166 and 95/001,122  
Patent 6,426,916

10. On September 7, 2010, Micron filed a Notice of Appeal for claims 26 and 28.

11. On November 8, 2010, Micron Filed an Appellant Brief for claims 26 and 28.

12. On December 8, 2010, Rambus filed a Respondent Brief and a Petition seeking waiver of the page and word count limits specified by 37 C.F.R. § 1.193(c) for its Respondent Brief. Rambus's Respondent Brief was 25 pages and 14,904 words in length.

13. On March 15, 2011, the Office entered a Decision on Petition denying Rambus's Petition seeking waiver of the page and word count limits for its Respondent Brief.

14. On April 15, 2011, Rambus filed a First Reconsideration Petition with a Replacement Respondent Brief and an Alternative Replacement Respondent Brief.

15. On June 7, 2011, the Office entered a Decision on Petition denying Rambus's First Reconsideration Petition and agreeing to accept the Alternative Replacement Respondent Brief.

16. On July 7, 2011, Rambus filed a Second Reconsideration Petition requesting that the Office reconsider the original decision to deny waiver of 37 C.F.R. § 1.943.

17. On August 18, 2011, the Office entered a Decision on Petition denying Rambus's Second Reconsideration Petition and, again, agreeing to accept the Alternative Replacement Respondent Brief.

18. On June 27, 2011, Micron filed a Third Party Requester's Rebuttal Brief Pursuant to 37 C.F.R. § 41.71 ("Micron's Rebuttal Brief") of more than 15 pages.

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*Inter partes* Reexamination Control Nos. 95/000,166 and 95/001,122  
Patent 6,426,916

19. On June 27, 2011, Micron filed the Petition for Waiver under consideration here.

RELEVANT AUTHORITY

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

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

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ANALYSIS

Micron requests that 37 C.F.R. § 1.943(c) be waived so that it may submit a rebuttal brief of up to 25 pages.<sup>1</sup> (Micron's Petition for Waiver 1.) In the alternative, Micron submits an Alternative Third Party Requester's Rebuttal Brief in Attachment A, which complies with the rule, but is not presented in 12-point font with double-spaced formatting. (*Id.* at 2.)

Twelve-point font with double-spaced formatting is the preferred format for all documents submitted to the Board of Patent Appeals and Interferences. Nevertheless, in the interest of a speedy and efficient proceeding and because Micron's Alternative Rebuttal Brief is apparently in a font size and spacing format similar to those in Rambus's Alternative

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<sup>1</sup> Micron requests that it be allowed to submit a "respondent" brief on page 1 of its Petition for Waiver, but it is assumed Micron intended to request waiver for its Rebuttal Brief because Micron filed the Appeal Brief in the proceeding and there are no cross-appeals by Rambus.

**Best Available Copy**

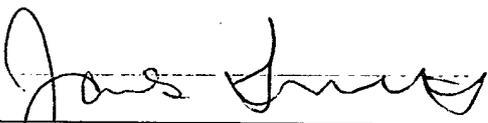
*Inter partes* Reexamination Control Nos. 95/000,166 and 95/001,122  
Patent 6,426,916

Replacement Respondent Brief and meets the page requirements of the Rule,  
Micron's Alternative Third Party Requester's Rebuttal Brief in Attachment  
A is **entered**.

**DECISION**

In view of the foregoing, Micron's Petition for Waiver is **DENIED**,  
but Micron's Alternative Third Party Requester's Rebuttal Brief in  
Attachment A is entered.

Jurisdiction is returned to the Central Reexamination Unit for  
preparation of the next appropriate Office action.



---

James Donald Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner Rambus:  
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*Inter partes* Reexamination Control Nos. 95/000,166 and 95/001,122  
Patent 6,426,916

Counsel for Third Party Requester Micron:

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356
22852	7590	08/06/2010	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 08/06/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,250	06/28/2007	6452863	38512.8	4189
22852	7590	08/06/2010	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

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NOVAK DRUCE & QUIGG LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, 53RD FLOOR  
HOUSTON, TX 77002

Date: **AUG 06 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001124  
PATENT NO. : 6452863  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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2323 VICTORY AVENUE SUITE 700

DALLAS, TX 75219

Date:  
**MAILED**

**AUG 06 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000250

PATENT NO. : 6452863

TECHNOLOGY CENTER : 3999

ART UNIT : 3900

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

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901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

(For Patent Owner)

MAILED

AUG 06 2010

CENTRAL REEXAMINATION UNIT

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(For 95/000,250 Requester)

TRACY W. DRUCE  
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(NDQ REEXAMINATION GROUP)  
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HOUSTON, TX 77002

(For 95/001,124 Requester)

In re Farmwald et al. :  
*Inter partes* Reexamination Proceeding :  
Control No.: 95/000,250 :  
Filed: June 28, 2007 :  
For: U.S. Patent No. 6,452,863 :

**DECISION  
GRANTING  
PETITIONS**

In re Farmwald et al. :  
*Inter partes* Reexamination Proceeding :  
Control No. 95/001,124 :  
Filed: November 24, 2008 :  
For: U.S. Patent No. 6,452,863 :

This is a decision on the June 2, 2010 patent owner petition entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR PATENT OWNER'S APPEAL BRIEF," and on the July 2, 2010 third party requester Micron petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(C)," requesting waiver of 37 CFR 1:943(c) for its respondent brief.

The petitions are before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for each of the petitions under 37 CFR 1.183 has been received.

The petitions are granted.

### REVIEW OF THE RELEVANT FACTS

1. On September 17, 2002, U. S. Patent Number 6,452,863 (the '863 patent) issued with thirty-five claims to Farmwald et al.
2. On April 4, 2007, a request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ("the '250 proceeding"), was initially deposited by a third party requester. A corrected request was then filed, and received a filing date of June 28, 2007. Samsung Electronics, Co. Ltd. ("Samsung") was identified as the real party in interest.
3. On September 5, 2007, an Order was issued by the Office granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 reexamination proceeding.
4. On July 3, 2008, an Office action containing at least one rejection of each of claims 1-35 of the '863 patent was mailed.
5. On November 24, 2008, a request for *inter partes* reexamination of claims 14-16 of the '863 patent, assigned Reexamination Control No. 95/001,124 ("the '1124 proceeding"), was filed by third party requester Micron Technology, Inc. ("Micron").
6. On January 16, 2009, an Order was issued by the Office granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 reexamination proceeding.
7. On March 6, 2009, the '250 and '1124 proceedings were merged.
8. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-35.
9. On September 28, 2009, patent owner filed comments in response to the ACP.
10. On October 28, 2009, third party requesters Micron and Samsung both separately filed comments after ACP.
11. On February 11, 2010, third party requester Samsung filed a notice of non-participation in the present reexamination proceeding.
12. On February 19, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-28 and confirming claims 29-35.
13. On March 19, 2010, patent owner filed a Notice of Appeal for claims 1-28.
14. On April 2, 2010, requester Micron filed a Notice of Cross Appeal for claims 14-16.
15. On June 2, 2010, patent owner filed an appellant's brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

16. On July 2, 2010, third party requester Micron filed a respondent brief, along with the present petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.
17. On July 16, 2010, patent owner filed a petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by third party requester Samsung. This petition is being addressed by a separate decision mailed on even date with the present decision, as will be discussed below.

### RELEVANT AUTHORITY

#### **37 CFR 1.183 provides:**

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

#### **37 CFR 1.943(c) provides:**

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

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

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

#### **MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides (in pertinent part):**

For additional information with respect to the length of papers, see Subsection I.A.2 above.

## DECISION

### I. Patent Owner's Petition of June 2, 2010

In its June 2, 2010 petition, petitioner patent owner requests waiver of 37 CFR 1.943(c), which limits appellant briefs to thirty (30) pages or 14,000 words in length. This waiver is being requested to permit patent owner to file its appellant brief of 59 pages and 24,235 words in length, which has been concurrently submitted with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

In this instance, patent owner has made a showing in support of the request for waiver of the 30-page limit of 37 CFR 1.943(c) by attempting to draft an appellant brief in compliance with the 30-page limit, and submitting the resulting response, which has a length of 59 pages that count toward the limit of 30 pages. Patent owner asserts that it "has made every effort to pare down the arguments in its appeal brief."<sup>1</sup>

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, and the individual facts and circumstances of this case, it is deemed equitable to waive the 30-page limit of 37 CFR 1.943(c) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted to permit patent owner's June 2, 2010 appellant brief to exceed the page limit by 29 pages. This waiver makes patent owner's June 2, 2010 appellant brief page-length compliant.

### II. Third Party Requester Micron's Petition of July 2, 2010

In its July 2, 2010 petition, petitioner third party requester Micron requests waiver of 37 CFR 1.943(c), which limits respondent briefs to fifteen (15) pages or 7,000 words in length. This waiver is being requested to permit third party requester Micron to file a respondent brief of 29 pages or 13,532 words in length. Third party requester concurrently submitted its respondent brief with its petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c).

Waiver is requested only if the Office grants the patent owner's June 2, 2010 petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.943(c) for patent owner's 59 page appellant brief.<sup>2</sup>

In this instance, third party requester Micron has made a showing in support of the request for waiver of the 15-page limit of 37 CFR 1.943(c) by attempting to draft a respondent brief in compliance with the 15-page limit, and submitting the resulting response, which has a length of 29 pages that count toward the limit of 15 pages. And, the proffered respondent brief is half the size of the appellant brief, in keeping with the ratio of respondent brief to appellant brief, in 37 CFR 1.943(c).

Based on the particular circumstances of the present merged proceeding, it is deemed equitable to waive the 15-page limit of 37 CFR 1.943(c) for requester's respondent brief in this instance by an amount proportional to the amount granted for patent owner's appellant brief. Therefore, third party requester's petition under 37 CFR 1.183 is granted to permit third party requester's

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<sup>1</sup> *Id.* at page 4.

<sup>2</sup> Third party requester's July 2, 1010 petition at page 2.

respondent brief to exceed the page limit by 14 pages. This waiver makes third party requester Micron's July 2, 2010 respondent brief page-length compliant.

On even date with this decision, the Office is dismissing patent owner's July 16, 2010 petition under 37 CFR 1.182/1.183 to strike portions of third party requester Micron's July 2, 2010 respondent brief. The Office's dismissal of patent owner's July 16, 2010 petition to strike portions of third party requester Micron's respondent brief will therefore not affect the present determination of the page limit waiver of third party requester Micron's respondent brief.

### III. Appendix

#### What is Included or Excluded from the Page Limit Count

By its terms, 37 CFR 1.943(c) excludes from the count of the pages in an appellant's brief claim appendices and "reference materials such as prior art references." Furthermore, the sections of the appellant brief required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi)<sup>3</sup> 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.

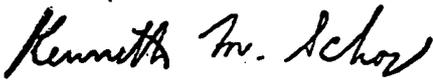
It is to be noted, that the "Related Proceedings" appendices required by 37 CFR 41.67(c)(x) and 37 CFR 41.67(b)(ix) are considered "reference materials," and are excluded from the page count only insofar as they are documents that are formally required in the appendix. Note that this requirement only 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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<sup>3</sup> i.e., (i) *Real Party in Interest*; (ii) *Related Appeals and Interferences*, (iii) *Status of Claims*, (iv) *Status of Amendments*, (ix) *Evidence Appendix*, (x) *Related Proceedings Appendix*, and (xi) *Certificate of Service*. The Claims Appendix is already explicitly included in the rule.

### CONCLUSION

1. Patent owner's and third party requester's petitions under 37 CFR 1.183 are both granted, making the proffered appellant brief and a respondent's brief page length compliant.
2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



---

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

8-5-10  
kenAppeal/length



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

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HOUSTON, TX 77002

Date:

**MAILED**

**AUG 06 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001124  
PATENT NO. : 6452863  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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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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DALLAS, TX 75219

Date: **MAILED**

**AUG 06 2010**

CENTRAL REEXAMINATION UNIT

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

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PATENT NO. : 6452863  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3900

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(For Patent Owner)

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AUG 06 2010

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(For 95/001,124 Requester)

In re Farmwald et al. :  
*Inter partes* Reexamination Proceeding :  
Control No.: 95/000,250 :  
Filed: June 28, 2007 :  
For: U.S. Patent No. 6,452,863 :

**DECISION DISMISSING  
PATENT OWNER'S  
PETITION TO STRIKE  
PORTIONS OF REQUESTER'S  
RESPONDENT BRIEF**

In re Farmwald et al. :  
*Inter partes* Reexamination Proceeding :  
Control No. 95/001,124 :  
Filed: November 24, 2008 :  
For: U.S. Patent No. 6,452,863 :

This is a decision on the July 16, 2010 patent owner petition entitled "PETITION TO STRIKE PORTIONS OF THIRD-PARTY REQUESTER'S RESPONDENT BRIEF." Since the petition is actually on challenging the making of record of the respondent brief by the Central Reexamination Unit (CRU), the petition will be taken and decided as a petition under 37 CFR 1.181 challenging an action taken by the CRU – see the below discussion.

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

The petition is dismissed for the reasons set forth below.

## REVIEW OF THE RELEVANT FACTS

1. On September 17, 2002, U. S. Patent Number 6,452,863 (the '863 patent) issued with thirty-five claims to Farmwald et al.
2. On April 4, 2007, a request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,250 ("the '250 proceeding"), was initially deposited by a third party requester. A corrected request was then filed, and received a filing date of, June 28, 2007. Samsung Electronics, Co. Ltd. ("Samsung") was identified as the real party in interest.
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7. On March 6, 2009, the '250 and '1124 proceedings were merged.
8. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution (ACP) was mailed in the merged proceeding, rejecting claims 1-35.
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12. On February 19, 2010, a Right of Appeal Notice (RAN) was mailed in the merged proceeding, rejecting claims 1-28 and confirming claims 29-35.
13. On March 19, 2010, patent owner filed a Notice of Appeal for claims 1-28.
14. On April 2, 2010, third party requester Micron filed a Notice of Cross Appeal for claims 14-16.
15. On June 2, 2010, patent owner filed an appellant's brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its appellant's brief.

16. On July 2, 2010, third party requester Micron filed a respondent brief, along with a petition under 37 CFR 1.183 requesting waiver of the page limit requirements of 37 CFR 1.943(c) for its respondent brief.
17. On July 16, 2010, patent owner filed the present petition under 37 CFR 1.182/1.183 requesting to strike those portions of third party requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by third party requester Samsung.

### RELEVANT AUTHORITY

#### **35 U.S.C. § 312 (Determination of issue by Director) provides (in pertinent part):**

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

#### **35 U.S.C. § 313 (Inter partes reexamination order by Director) provides:**

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

#### **35 U.S.C. § 314 (Conduct of inter partes reexamination proceedings) provides (in pertinent part):**

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

#### **35 U.S.C. § 315 (Appeal) provides (in pertinent part):**

(b) THIRD-PARTY REQUESTER.— A third-party requester—  
(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and  
(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

**35 U.S.C. § 317 (Inter partes reexamination prohibited) provides (in pertinent part):**

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

**37 CFR 1.181 provides (in pertinent part):**

(a)Petition may be taken to the Director:

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

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

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

**37 CFR 1.182 provides:**

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

**37 CFR 1.183 provides:**

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

**37 CFR 41.68 provides (in pertinent part):**

(a)(1)Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(2)The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(3)The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

(4) A requester's respondent brief may not address any brief of any other requester.

## DECISION

### I. Patent owner's July 16, 2010 Petition

In its present petition, patent owner requests under 37 CFR 1.182 and if necessary, under 37 CFR 1.183, that those portions of Requester Micron's respondent brief filed on July 2, 2010 addressing rejections proposed by Requester Samsung and not raised by Micron in its request for reexamination be stricken. In support of its request that portions of Requester Micron's respondent brief addressing issues raised by another third party requester be stricken, 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."<sup>1</sup>

Patent owner further argues that Rambus's appeal brief addressed rejections raised by both Samsung and Micron because the Office merged the Micron initiated reexamination proceeding (the '1124 proceeding) with the Samsung initiated reexamination proceeding (the '250 proceeding), and that merger of the two proceedings should "neither expand Micron's reexamination rights nor allow Micron to address rejections in its respondent brief that it did not previously propose and that it could not have addressed if the Office had not merged the reexamination proceeding."<sup>2</sup> Patent owner specifically requests that "the Office should strike Sections VII.A-VII.J at pages 1-24 and Section VII.L at pages 30-32 of Micron's Respondent Brief"<sup>3</sup> that address the "eight Samsung-proposed rejections – anticipation rejections based on *iAPX* and *Budde*, obviousness rejections over *iAPX* or *Budde* in view of *Inagaki*, and obviousness rejections of *iAPX* or *Budde* in view of *Lofgren*."<sup>4</sup>

Patent owner further argues that "[b]y appealing and addressing issues not raised in its request, Micron seeks to circumvent the prohibition of § 317(a) and obtain a second *inter partes* reexamination of the '863 patent."<sup>5</sup>

Finally, patent owner cites to two specific Board decisions, to support its present request. Patent owner argues that "[t]he Board had indicated that that [sic] a requester cannot appeal a rejection that is did not propose,"<sup>6</sup> 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).<sup>7</sup>

### II. Analysis and Findings

As pointed out above, patent owner's petition under 37 CFR 1.182/1.183 is taken as a petition under 37 CFR 1.181 to challenge the Central Reexamination Unit's (CRU's) placement of the

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<sup>1</sup> Petition at page 2.

<sup>2</sup> *Id.* at pages 2 and 5.

<sup>3</sup> *Id.* at page 2.

<sup>4</sup> *Id.* at page 6.

<sup>5</sup> *Id.* at page 4.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

requester's respondent brief in the Image File Wrapper (IFW) record of the two merged proceedings, based on the asserted improper content as to portions of the respondent brief. Patent owner is actually asserting that the requester respondent brief was improperly placed of record in the Image File Wrapper (IFW)) for the proceeding, and requesting that it be expunged, with requester being directed to replace the brief by a redacted or revised respondent brief to exclude the portions of the paper argued to be improper.

Patent owner's petition has been fully considered, and not found persuasive. A review of Requester Micron's respondent brief reveals that does address the eight Samsung proposed rejections that Micron did not propose in its initiated reexamination proceeding (the '1124 proceeding). However, these eight 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 '863 patent by addressing issues not raised in its request. This argument is not persuasive. First, the issues addressed by Micron are already part of the present reexamination proceeding, as discussed above. Second, this argument does not relate to the propriety of the issues raised in requester Micron's respondent brief, based on the statute, regulations, and practice.

Since requester Micron's respondent brief is limited to addressing issues raised in the patent owner's appellant brief that have been adopted by the examiner, the issues raised in requester Micron's respondent brief are not improper. Accordingly, patent owner's July 16, 2010 petition is dismissed.

### CONCLUSION

1. Patent owner's July 16, 2010 petition to strike portions of Requester Micron's respondent brief is dismissed.
3. Any questions concerning this communication should be directed to the undersigned at (571) 272-3838.



\_\_\_\_\_  
Gregory Morse  
Director  
Central Reexamination Unit

8-4-10  
KenAppeal/decisions/entry issues



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356
22852	7590	04/27/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 04/27/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

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

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

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

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DECISION ON PETITION

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

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

## FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The '863 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.
3. On September 5, 2007, the Office issued an Order granting Samsung's *inter partes* reexamination request of the '863 patent in the '250 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting Micron's *inter partes* reexamination request of the '863 patent in the '1124 proceeding.
6. On March 6, 2009, the Office merged the '026 and '1124 proceedings.
7. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
8. The merged proceeding progressed to the point where, on February 19, 2010, the Office issued a first Right of Appeal Notice.
9. On September 3, 2010, the Office issued a second Right of Appeal Notice rejecting claims 1-28 and confirming claims 29-35.
10. On October 1, 2010, Rambus filed a Notice of Appeal.
11. On October 15, 2010, Micron filed a Notice of Cross-Appeal.
12. On December 15, 2010, Rambus filed an Appeal Brief.

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

13. Also on December 15, 2010, Micron filed a Cross-Appeal Brief.
14. On January 18, 2011, Rambus filed the present Petition.
15. On January 26, 2011, Micron filed the present Opposition.

### ANALYSIS

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

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

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

DECISION

For the forgoing reason, the Petition is DENIED.

  
James T. Moore  
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,124	11/24/2008	6452863	896.002.863	5356
22852	7590	05/06/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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RAMBUS, INC.  
Patent Owner

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

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

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

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DECISION ON PETITION

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

FINDINGS

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

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007 and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.
3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.
6. On March 6, 2009, the '250 and '1124 proceedings were merged.
7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").
10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.
11. On October 1, 2010, Rambus filed a Notice of Appeal.
12. On October 15, 2010, Micron filed a Notice of Cross-Appeal.
13. On December 15, 2010, Rambus filed an Appeal Brief.

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

14. On December 15, 2010, Micron filed a Cross-Appeal Brief.
15. On January 18, 2011, Rambus filed the Respondent Brief that is the subject of the present Petition, and the present Petition.

#### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

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

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

## ANALYSIS

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

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

Decision, p. 3.

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

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

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

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

DECISION

For the forgoing reason, the Petition is GRANTED.



---

James T. Moore  
Acting Chief Administrative Patent Judge

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

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

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DECISION ON PETITION

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

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002 with 35 claims. The ‘863 patent is assigned to Patent Owner Rambus, Inc. (“Rambus”).
2. Third Party Requester Samsung Electronics, Co. Ltd. (“Samsung”) filed an initial request for *inter partes* reexamination on April 4, 2007 and a

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

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

3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.
5. On January 16, 2009, the Office issued an Order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.
6. On March 6, 2009, the '250 and '1124 proceedings were merged.
7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding, rejecting claims 1-35.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On February 19, 2010, the Office entered a first Right of Appeal Notice ("RAN").
10. On September 3, 2010, the Office entered a second RAN rejecting claims 1-28 and confirming claims 29-35. The length of the second RAN is 137 pages.
11. On October 1, 2010, Rambus filed a Notice of Appeal.
12. On December 15, 2010, Rambus filed an Appeal Brief.
13. On February 4, 2011, the Office entered a Notification of Defective Brief because Rambus's Appeal Brief exceeded the page limit specified by 37 C.F.R. § 1.943(c).

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

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

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

#### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

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

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

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

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

37 C.F.R. § 1.52(b) specifies:

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

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

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

- (i) Lines that are 1 1/2 or double spaced;
- (ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6) . . . .

MPEP § 2667 I.A.2 provides:

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

#### ANALYSIS

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

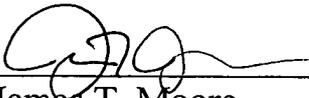
An examination of Rambus's Replacement Appeal Brief, filed March 4, 2011, reveals that the line spacing is single spaced and the font size is in the range of 10-12. The number of pages countable under Rule 1.943(c) appears to be 30.

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

Inter partes Reexamination Control 95/000250 and 95/001,124  
Patent 6,452,863

DECISION

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



---

James T. Moore  
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,124	11/24/2008	6452863	896.002.863	5356
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 09/27/2011

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

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

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

---

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

---

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

---

DECISION ON PETITION

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

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

FINDINGS

1. Patent 6,452,863 issued on September 17, 2002, with 35 claims. The '863 patent is assigned to Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co., Ltd. ("Samsung") filed an initial request for *inter partes* reexamination on April 4, 2007, and a corrected request on June 28, 2007. Reexamination Control 95/000,250 was assigned to this request.
3. On September 5, 2007, the Office issued an Order granting *inter partes* reexamination of claims 1-35 of the '863 patent in the '250 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on November 24, 2008. Reexamination Control 95/001,124 was assigned to this request.
5. On January 16, 2009, the Office issued an order granting *inter partes* reexamination of claims 14-16 of the '863 patent in the '1124 proceeding.
6. On March 6, 2009, the '250 and '1124 proceedings were merged.
7. The merged proceeding progressed to the point where, on August 28, 2009, an Action Closing Prosecution ("ACP") was entered, rejecting claims 1-35.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On February 19, 2010, the Office mailed a first Right of Appeal Notice ("RAN").

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

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

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

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

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

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

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

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

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

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

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

**RELEVANT AUTHORITY**

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

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

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

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

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

§ 1.183:

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

**ANALYSIS**

Micron requests that 37 C.F.R. § 1.943(c) be waived so that it may submit a rebuttal brief of 21 pages. (Micron's Petition for Waiver 1.)

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

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

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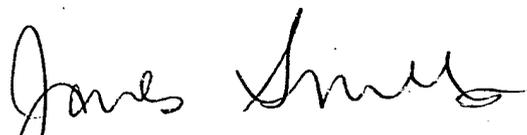
*Inter partes* Reexamination Control Nos. 95/000,250 and 95/001,124  
Patent 6,452,863

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

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

**DECISION**

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



---

James Donald Smith  
Chief Administrative Patent Judge

---

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

#### 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

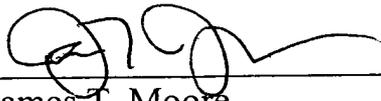
Since Rambus' petition to expunge Micron's Cross-Appellant Brief has been granted in a decision mailed simultaneously herewith, patent owner's petition requesting waiver of 37 CFR § 1.943(c) is moot.

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

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.



---

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Acting Chief Administrative Patent Judge

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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 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

## 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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Third Party Requester – *Inter partes* Reexamination Control 95/001,026

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,128

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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 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

## 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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).

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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).

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

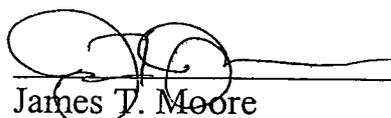
In *Meadwestvaco*, where a first requester attempted to raise in an appellant brief a rejection initially proposed by a second requester, the Board held that only the second requester could raise that rejection on appeal.

*Meadwestvaco* at 81.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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

Counsel for Patent Owner:

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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	02/16/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

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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 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

## 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
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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 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
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Petition, p. 3.

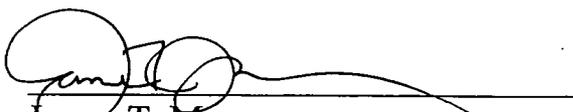
Rambus does not contest that the issues addressed in Micron's Respondent Brief are issues that are addressed in Rambus's Appeal Brief. Further, Rambus does not contest that all such issues were addressed by the Examiner during prosecution and that the Office has considered and taken a position on these 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

Counsel for Patent Owner:

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

DATE MAILED: 02/16/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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*

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
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*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

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
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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.

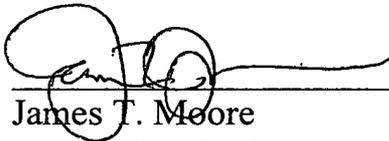
Also relevant to consideration of the expungement issue here is the fact that during prosecution, the Examiner considered all grounds of rejection proposed by both Requesters; i.e., by both Samsung and Micron. Thus, Micron's appeal of issues originally proposed by Samsung, is an appeal of the Examiner's position on those issues.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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22852	7590	06/10/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 06/10/2011

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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

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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

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Patent 6,378,020

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

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Patent 6,378,020

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).

...

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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<sup>1</sup>. 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.

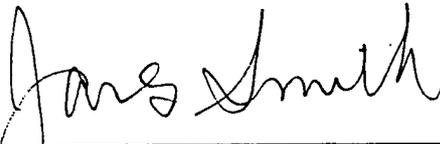
This Decision constitutes Final Agency Action on this matter.

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<sup>1</sup> 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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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

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Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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).

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

**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<sup>1</sup>. 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

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<sup>1</sup> 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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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

Counsel for Patent Owner:  
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901 New York Avenue, NW  
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.
95/001,128	12/15/2008	6378020	8963.002.020	1029

22852          7590          08/30/2011

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

EXAMINER

ART UNIT          PAPER NUMBER

DATE MAILED: 08/30/2011

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.
95/001,026	01/31/2008	6378020	38512.9	1090

22852            7590            08/30/2011

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

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

---

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

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Merged *Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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.

*Inter partes* Reexamination Control 95/001,026 and 95/001,128  
Patent 6,378,020

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,129	12/19/2008	7340506	PA5039REX	9225
22830	7590	08/11/2010	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			ART UNIT	PAPER NUMBER

DATE MAILED: 08/11/2010

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PORTLAND, OR 97204

Date:

**MAILED**  
**AUG 11 2010**  
CENTRAL REEXAMINATION

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

REEXAMINATION CONTROL NO. : 95001129  
PATENT NO. : 7340506  
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 11 2010

CENTRAL REEXAMINATION UNIT

CARR & FERRELL LLP  
2200 GENG ROAD  
PALO ALTO CA 94303

: (For Patent Owner)  
:  
:

Klarquist Sparkman LLP  
One World Trade Center, Suite 1600  
121 S. W. Salmon Street  
Portland, OR 97204

: (For Third-Party Requester)  
:  
:  
:

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,129  
Filed: December 19, 2008  
For: U.S. Patent No. 7,340,506

: DECISION ON PETITION  
: FOR REOPENING  
: PROSECUTION  
: UNDER 37 CFR 1.181  
:

This is a decision on patent owner's petition entitled "Petition to Reopen Prosecution in an *Inter Partes* Reexamination Proceeding Under 37 C.F.R. 1.181" filed May 19, 2010. The petition is before the Director of the Central Reexamination Unit for consideration.

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

**REVIEW OF RELEVANT FACTS**

- On March 4, 2008, United States Patent No. 7,340,506 (the '506 patent) issued to Arunachalam.
- On December 19, 2008, a request for *inter partes* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,129 ("the '1129 proceeding").

Art Unit: 3992

- On March 6, 2009, *inter partes* reexamination was ordered in the '1129 proceeding for claims 1-19 of the '506 patent.
- On March 30, 2009, an Office action was mailed in the '1129 proceeding rejecting claims 1-19 of the '506 patent.
- On June 1, 2009, a response was received from the patent owner (PO).
- On March 11, 2010, a Notice RE Defective Paper was mailed stating that the response filed June 1, 2009, exceeded 50 pages.
- On March 25, 2010, a second response was received from the patent owner.
- On April 30, 2010, a Notice of Intent to Issue *Inter Partes* Reexamination Certificate canceling claims 1-19 was mailed, stating that patent owner's March 25, 2010 response exceeded 50 pages.
- On May 19, 2010, patent owner filed two responses denominated as "Appendix A" and "Appendix B." Concurrently, on May 19, 2010, patent owner filed three petitions, a first petitioned entitled, "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183," a second petition entitled "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)," and a third petition entitled, "PETITION TO REOPEN PROSECUTION IN AN INTER PARTES REEXAMINATION PROCEEDING UNDER 37 C.F.R. § 1.181".

### DECISION

Petitioner requests that prosecution be reopened in the '1129 proceeding and that the response of March 25, 2010 be entered. PO argues that Appendix A of the March 25, 2010 response should not be counted against the page limit requirements of 37 C.F.R. 1.943. Appendix A is entitled "NEW CLAIMS WITH SUPPORT FROM '506 PATENT SPECIFICATION" and consists of a claims chart explaining the alleged support in the '506 patent to proposed new claims 20-128 (as required under 37 CFR 1.530).

37 CFR 1.943(b) provides that 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 provides additional guidance as to material that is excluded from the page limits set forth in 37 CFR 1.943:

"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

Art Unit: 3992

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)...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."

The response of March 25, 2010 contains a declaration from Dr. Arunachalam with hundreds of pages of exhibits. Neither the Arunachalam declaration nor the exhibits to the declaration includes any explicit arguments as to how the rejections are overcome, so they do not count against the page limit per the guidance in MPEP. Also, per the guidance, the table of contents (page 2 of the response) and the pages of the claims (i.e. pages 3-36) do not count either.

The issue of compliance with the page limits set forth in 37 CFR 1.943(b) rests with the 51-page appendix entitled "NEW CLAIMS WITH SUPPORT FROM '506 PATENT SPECIFICATION". Specifically, are claim charts that map the patent at issue to the proposed new claims merely pages of claims or are they claims with additional material that are considered part of the response.

The required claim support is not excluded from the page limit requirement under 37 CFR 1.943, nor does the guidance in the MPEP exclude the required claim support from the page limits. Also, the required claim support must be considered part of the response for compliance with 37 CFR 1.530. Therefore, the additional 51 pages of response counts against the PO's page limit in the response.

It is noted that the decision (mailed July 27, 2010) dismissing the petition for waiver of page limit addressed Appendix B, submitted by PO on May 19, 2010, and found that submission to satisfy the regulatory 50-page limit.

The pending petition under 37 CFR 1.137 to accept the late paper will be addressed in due course.

## CONCLUSION

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

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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  
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Commissioner for Patents  
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Alexandria, VA 22313-1450

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

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

3. Telephone inquiries related to this decision should be directed to Jessica Harrison at (571) 272-4449, Mark Reinhart at (571) 272-1611, or Eric Keasel, at (571) 272-4929.



---

Gregory Morse  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,129	12/19/2008	7340506	PA5039REX	9225
22830	7590	08/13/2010	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2010

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PORTLAND, OR 97204

Date: **MAILED**  
**AUG 13 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001129  
PATENT NO. : 7340506  
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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Carr & Ferrell LLP  
2200 Geng Road  
Palo Alto, CA 94303

(For Patent Owner)

MAILED

AUG 13 2010

Klarquist Sparkman LLP  
One World Trade Center  
121 S.W. Salmon Street  
Suite 1600  
Portland, OR 97204

(For Requester)

CENTRAL REEXAMINATION UNIT

In re Lakshmi Arunachalam  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,129  
Filed: December 19, 2008  
For: U.S. Patent No. 7,340,506

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

This is a decision on the May 19, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response in the above-identified reexamination proceeding ("the May 19, 2009 patent owner petition").

The May 19, 2010 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 19, 2010 patent owner petition is **granted**.

The April 30, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.

**STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

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

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

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

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

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

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

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

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

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

\*  
\*

(d) *Terminal disclaimer*.

\*  
\*

- (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

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

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

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

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed

to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

**37 CFR 1.957(d) provides, in pertinent part:**

When action by the patent owner is a bona fide attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

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

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

**MPEP 2668 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

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

\*  
\*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

**DECISION**

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

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

Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the March 11, 2010 Notice Re Defective Paper In Inter Partes Reexamination.<sup>1</sup> MPEP 2667(I)(A)(2) states that the patent owner will be given a time period of 15 days from the mailing date of the notice to respond. An appropriate response to the March 11, 2010 Notice, in the form of the response denominated as "Appendix B,"<sup>2</sup> was not filed until May 19, 2010, which was untimely. However, for the purpose of evaluating whether the May 19, 2010 patent owner petition is a grantable petition, the submission of the May 19, 2010 "Appendix B" response satisfies item (1).<sup>3</sup>

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the May 19, 2010 patent owner petition, which satisfy items (2) and (3), respectively.

Accordingly, the May 19, 2010 patent owner petition is **granted**.

The April 30, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.

### CONCLUSION

1. The May 19, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response is **granted**.
2. The April 30, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.
3. Patent owner's "Appendix B" response to the March 11, 2010 Notice Re Defective Paper In Inter Partes Reexamination is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947.<sup>4</sup> Accordingly, third party requester may file comments to patent owner's "Appendix B" response, as per 37 CFR 1.947, within 30 days of the mailing date of this decision.

---

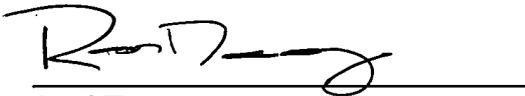
<sup>1</sup> See: MPEP 2667(I)(A)(2).

<sup>2</sup> Of the responses filed by patent owner on May 19, 2010, only the "Appendix B" response satisfies the regulatory 50-page limit requirement. Therefore, the May 19, 2010 "Appendix B" response is the only appropriate response of record.

<sup>3</sup> This decision is not directed to the persuasiveness and propriety of the arguments presented in the May 19, 2010 "Appendix B" response as to each of the rejections set forth in the March 30, 2009 Office action; such is the examiner's province.

<sup>4</sup> See: MPEP 2666.60.

4. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, to await requester's comments under 37 CFR 1.947, or the expiration of the time to file such comments, after which the examiner will issue a new Office action to replace the withdrawn April 30, 2010 NIRC.
5. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.

A handwritten signature in black ink, appearing to read 'R. Tamayo', is written over a horizontal line.

Raul Tamayo  
Legal Advisor  
Office of Patent Legal Administration

August 12, 2010



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John Temple Keller  
Hulsey IP Intellectual Property Lawyers, P.C.  
919 Congress Avenue, Suite 919  
Austin, TX 78701

*In re Lakshmi Arunachalam* :  
*Inter Partes* Reexamination Proceeding :  
Control No.: 95/001,129 : DECISION ON PETITION  
Filed: December 19, 2008 : TO WITHDRAW  
For: U.S. Patent No. 7,340,506 : FROM RECORD  
Attorney Docket No. WEBX003RE :

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 30, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by John Temple Keller (63,099) on behalf of all attorneys of record who are associated with customer No. 48746.

All attorneys/agents associated with the Customer Number 48746 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

Telephone inquiries concerning this decision should be directed to Patricia Volpe at 571-272-6825.

*Patricia Volpe for*

Jessica Harrison  
Supervisory Patent Examiner  
CRU 3992

cc: WebXchange, Inc (For Patent Owner)  
Lakshmi Arunachalam  
222 Stanford Avenue  
Menlo Park, CA 94025

cc: Garth A. Winn (For Requester)  
One World Trade Center  
121 S.W. Salmon Street, Suite 1600  
Portland, OR 97204

Enclosure:

Copy of request for withdrawal as attorney or agent and change of correspondence address filed on November 30, 2010. There is no indication it was served on the Third Party Requester.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,129	12/19/2008	7340506	WEBX003RE	9225

7590 12/10/2010  
WebXchange, Inc.  
Lakshmi Arunachalam  
222 Stanford Avenue  
Menlo Park, CA 94025

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/10/2010

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**DEC 10 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001129  
PATENT NO. : 7340506  
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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WEBXCHANGE, INC.  
LAKSHMI ARUNACHALAM  
222 STANFORD AVENUE  
MENLO PARK, CA 94025

(For Patent Owner)

KLARQUIST SPARKMAN LLP  
ONE WORLD TRADE CENTER, SUITE 1600  
121 S. W. SALMON STREET  
PORTLAND, OR 97204

(For *Inter Partes* Requester)

**MAILED**

**DEC 10 2010**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,129  
Filed: December 19, 2008  
For: U.S. Patent No. 7,340,506

**CENTRAL REEXAMINATION UNIT**  
:  
**DECISION**  
:  
**DISMISSING**  
:  
**PETITION**

This is a decision addressing patent owner's September 7, 2010 petition paper entitled "RENEWED PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183."

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

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

The petition is dismissed for the reasons set forth herein.

**BACKGROUND**

1. On March 4, 2008, U.S. Patent No. 7,340,506 issued to Lakshmi Arunachalam ("the '506 patent") with claims 1-19.
2. On December 19, 2008, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/001,129 ("the '1129 proceeding").
3. On March 6, 2009, the Office issued an order granting *inter partes* reexamination in the '1129 proceeding.
4. On March 30, 2009, the Office issued a non-final Office action in the '1129 proceeding.
5. On June 1, 2009, patent owner filed a response to the March 30, 2009 Office action.
6. On July 1, 2009, third party requester filed comments after patent owner's June 1, 2009 response.

7. On March 11, 2010, the Office mailed a "Notice RE Defective Paper in *Inter Partes* Reexamination" ("the notice of non-compliance"), stating that patent owner's June 1, 2009 response exceeds 50 pages and giving patent owner 15 days to either submit a re-drafted response or file a copy of a supplemental response with pages redacted.<sup>1</sup>
8. On March 25, 2010, patent owner filed a response submission responsive to the March 11, 2010 notice of non-compliance ("the corrected response submission").
9. On April 23, 2010, third party requester filed comments after patent owner's March 25, 2010 corrected response submission.
10. On April 30, 2010, the Office issued an Action Closing Prosecution (ACP) in the '1129 proceeding, stating that patent owner's March 25, 2010 corrected response submission exceeds 50 pages and that the reexamination certificate will indicate that claims 1-19 of the '506 patent are cancelled.
11. On May 19, 2010, patent owner filed three petitions: (1) "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" ("the petition under 37 CFR 1.137(b)"), (2) "PETITION TO REOPEN PROSECUTION IN AN INTER PARTES REEXAMINATION PROCEEDING UNDER 37 C.F.R. § 1.181" ("the petition under 37 CFR 1.181"), and (3) "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183").<sup>2</sup>
12. On July 27, 2010, the Office issued a decision dismissing patent owner's May 19, 2010 petition under 37 CFR 1.183 as premature, and stating that patent owner's response submission designated "Appendix B" is a response to the outstanding Office action that satisfies the regulatory 50-page limit requirement.<sup>3</sup>
13. On August 11, 2010, the Office issued a decision dismissing patent owner's May 19, 2010 petition under 37 CFR 1.181, stating that the additional 51 pages of patent owner's response submission designated "Appendix A" count toward the page limit requirement under 37 CFR 1.943.<sup>4</sup>

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<sup>1</sup> March 11, 2010 notice of defective paper at pages 2-3 (further stating, "Patent Owner filed a response of 108 pages (of which 27 pages of claims do not count toward the page limit) and multiple declarations that contains opinions and arguments of the declarant that count towards the page limit.")

<sup>2</sup> The May 19, 2010 patent owner petition under 37 CFR 1.137(b) was accompanied by two response submissions: (1) "Appendix A," designated "PREVIOUSLY SUBMITTED AND CURRENTLY RE-SUBMITTED RESPONSE TO OFFICE ACTION [[FOR ENTRY IF RE-EXAMINATION REVIVED AND PETITION TO WAIVE PAGE LIMIT GRANTED]]," and (2) "Appendix B," designated "NEWLY SUBMITTED RESPONSE TO OFFICE ACTION [[FOR ENTRY IF RE-EXAMINATION REVIVED AND PETITION TO WAIVE PAGE LIMIT NOT GRANTED]]."

<sup>3</sup> July 27, 2010 decision at page 2.

<sup>4</sup> August 11, 2010 decision at page 3 (stating, "The issue of compliance with the page limits set forth in 37 CFR 1.943(b) rests with the 51-page appendix entitled "NEW CLAIMS WITH SUPPORT FROM '506 PATENT SPECIFICATION". Specifically, are claim charts that map the patent at issue to the proposed new claims merely pages of claims or are they claims with additional material that are considered part of the response. The required claim support is not excluded from the page limit requirement under 37 CFR 1.943, nor does the guidance in the MPEP exclude the required claim support from the page limits. Also, the required claim support must be considered

14. On August 13, 2010, the Office issued a decision granting patent owner's May 19, 2010 petition under 37 CFR 1.137(b), stating that patent owner's May 19, 2010 "Appendix B" response submission satisfies the requirement of 37 CFR 1.137(b) that a grantable petition be accompanied by a response to the outstanding Office action.<sup>5</sup>
15. On September 9, 2010, patent owner filed the instant petition paper entitled "RENEWED PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" ("the renewed petition under 37 CFR 1.183").

### RELEVANT STATUTES, RULES AND EXAMINING PROCEDURES

35 U.S.C. 314(a) provides:

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

37 CFR 1.941 provides:

Amendments by patent owner in inter partes reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943.

37 CFR 1.943(b) provides:

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

37 CFR 1.530(e) provides:

*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

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part of the response for compliance with 37 CFR 1.530. Therefore, the additional 51 pages of response counts against the PO's page limit in the response.")

<sup>5</sup> August 13, 2010 decision at page 4 (further stating, "Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the March 11, 2010 Notice Re Defective Paper In Inter Partes Reexamination. MPEP 2667(I)(A)(2) states that the patent owner will be given a time period of 15 days from the mailing date of the notice to respond. An appropriate response to the March 11, 2010 Notice, in the form of the response denominated as "Appendix B," was not filed until May 19, 2010, which was untimely. However, for the purpose of evaluating whether the May 19, 2010 patent owner petition is a grantable petition, the submission of the May 19, 2010 "Appendix B" response satisfies item (1).")

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.

## DISCUSSION

In the renewed petition under 37 CFR 1.183, petitioner requests waiver of 37 CFR 1.943(b) for patent owner's previously submitted "Appendix A" response submission.<sup>6</sup> The "Appendix A" response submission accompanied patent owner's May 19, 2010 petition under 37 CFR 1.137(b) and is a re-submission of patent owner's March 25, 2010 corrected response submission. The Office has already determined in its August 11, 2010 decision that patent owner's "Appendix A" response submission exceeds the 50-page limit of 37 CFR 1.943(b). Specifically, the Office has determined that the 51-page appendix entitled "NEW CLAIMS WITH SUPPORT FROM '506 PATENT SPECIFICATION" sets forth the required support for the newly added claims and is not excluded from the page limit requirement under 37 CFR 1.943.<sup>7</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. In support of waiver of the rule, petitioner asserts that it "made every effort to draft a response in compliance with the 50-page limit of Rule 943" and asserts that "Appendix A of the Rule 137 Petition did not include any opinion or argument regarding the prior art."<sup>8</sup> Petitioner also asserts that "[w]hen preparing the response, the Patentee also made every effort to limit extraneous material and economize the arrangement of the response without repeating information already of record."<sup>9</sup>

Petitioner further asserts:

Neither the rules or MPEP appear to limit the Patentee's ability to introduce additional claims in response to an office action provided that the Patentee supply an explanation of the support in the disclosure for new or amended claims. See 37 C.F.R. § 1.530, MPEP § 2666. Through Appendix A of the rule 137 Petition, the Patentee proposed new claims, an action that the Patentee is permitted to take pursuant to 35 U.S.C. § 314(a). Also, as required by RULE 530, the Patentee properly provided support in the specification for each new claim. Thus, by adding new claims and supplying claim support, the Patentee was exercising a right in accordance with 35 U.S.C. § 314(a) and RULE 530 without including additional arguments or remarks.

A decision that denies the presently resubmitted petition under RULE 183 would severely limit the Patentee from presenting new claims, an action that the Patentee is clearly permitted to take pursuant to Section 314(a). Since the Patentee has made a good faith effort to minimize the length of the response by limiting

<sup>6</sup> Renewed petition under 37 CFR 1.183 at pages 1-2 and 7.

<sup>7</sup> August 11, 2010 decision at page 3 (contrasting mere pages of claims, such as pages 3-37 of the Appendix A response submission, which are excluded from the page limit requirement under 37 CFR 1.943).

<sup>8</sup> Id. at page 6.

<sup>9</sup> Id.

arguments and remarks to well below the 50-page limit, the Patentee believes that all 87 pages of the previously submitted were required to equitably respond to the MARCH 30, 2009 OFFICE ACTION while exercising its right to propose new claims.<sup>10</sup>

In this instance, petitioner is essentially relying on the availability of a patent statute (35 U.S.C. 314(a)) and rule (37 CFR 1.941), providing for patent owner claim amendments in reexamination, as justification for exceeding the page limit of 37 CFR 1.943(b) with respect to the explanation of the support for the claim amendments pursuant to 37 CFR 1.530(e). While patent owner is permitted to present claim amendments in reexamination, patent owner is not required to present claim amendments. For example, in this instance, had patent owner presented fewer claim amendments, then, presumably fewer pages would have been needed to set forth the explanation of the support for the claim amendments and patent owner may have been able to draft a response in compliance with the 50-page limit. If a patent owner chooses to present a plurality of claims, it is the patent owner that must adjust the remarks section of the response to contain less argument to compensate for what is required to be stated for the new claims. Thus, petitioner has not set forth any persuasive reason why, in this instance, justice requires waiver of the 50-page limit for presentation of an explanation of support pursuant to 37 CFR 1.530(e) to the extent of the claim amendments presented in the May 19, 2010 "Appendix A" response submission. Moreover, patent owner has already submitted a page-length compliant response submission (*i.e.*, the May 19, 2010 "Appendix B" response submission, which does not include the claim amendments or explanation of support), which response submission has been deemed to satisfy the submission requirement for purposes of a grantable petition under 37 CFR 1.137(b). Thus, a page limit compliant response was feasible.

In view of the above, 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 patent owner's May 19, 2010 "Appendix A" response submission. Accordingly, the instant renewed petition under 37 CFR 1.183 is dismissed.

### CONCLUSION

1. The September 7, 2010 renewed petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b) is dismissed.
2. Telephone inquiries with regard to this decision should be directed to Nicole Dretar Haines, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



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

12-9-2010  
kenpet8/IP/length/not grant

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<sup>10</sup> Id. at pages 6-7.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,129	12/19/2008	7340506	WEBX-101REX1	9225

23122            7590            05/12/2011

RATNERPRESTIA  
P.O. BOX 980  
VALLEY FORGE, PA 19482

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 05/12/2011

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



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PORTLAND, OR 97204

Date:

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MAY 12 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001129  
PATENT NO. : 7340506  
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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RATNERPRESTIA  
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VALLEY FORGE, PA 19482

(For Patent Owner)

KLARQUIST SPARKMAN LLP  
ONE WORLD TRADE CENTER, SUITE 1600  
121 S. W. SALMON STREET  
PORTLAND, OR 97204

(For *Inter Partes* Requester)

MAILED

MAY 12 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,129  
Filed: December 19, 2008  
For: U.S. Patent No. 7,340,506

: **DECISION ON**  
: **PETITIONS AND**  
: ***SUA SPONTE* ENTRANCE OF**  
: **REPLACEMENT RESPONSE**

This is a decision addressing (a) patent owner's January 22, 2011 petition paper entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. 1.183 FOR WAIVER OF 37 C.F.R. 1.945(b)" and (b) third party requester's February 22, 2011 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(b)."

The petitions are before the Office of Patent Legal Administration for consideration.

### SUMMARY

The patent owner petition under 37 CFR 1.183 is dismissed, and the Office is *sua sponte* entering patent owner's January 22, 2011 response submission as a replacement response, for the reasons set forth herein.

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

Third party requester is given a time period of one month from the date of this decision entering patent owner's replacement response to file a single comments submission on patent owner's replacement response not to exceed 191 pages.

### BACKGROUND

1. On March 4, 2008, U.S. Patent No. 7,340,506 issued to Lakshmi Arunachalam ("the '506 patent") with claims 1-19.
2. On December 19, 2008, a request for *inter partes* reexamination was filed by a third party requester, which request was assigned control no. 95/001,129 ("the '1129 proceeding").

3. On March 6, 2009, the Office issued an order granting *inter partes* reexamination in the '1129 proceeding.
4. On March 30, 2009, the Office issued a non-final Office action in the '1129 proceeding.
5. On June 1, 2009, patent owner filed a response to the March 30, 2009 Office action.
6. On July 1, 2009, third party requester filed comments after patent owner's June 1, 2009 response.
7. On March 11, 2010, the Office mailed a "Notice RE Defective Paper in *Inter Partes* Reexamination" ("the notice of non-compliance"), stating that patent owner's June 1, 2009 response exceeds 50 pages and giving patent owner 15 days to either submit a re-drafted response or file a copy of a supplemental response with pages redacted.<sup>1</sup>
8. On March 25, 2010, patent owner filed a response submission responsive to the March 11, 2010 notice of non-compliance ("the corrected response submission").
9. On April 23, 2010, third party requester filed comments after patent owner's March 25, 2010 corrected response submission.
10. On April 30, 2010, the Office mailed a "Notice of Intent to Issue *Inter Partes* Reexamination Certificate" (NIRC) in the '1129 proceeding, stating that patent owner's March 25, 2010 corrected response submission exceeds 50 pages and that the reexamination certificate will indicate that claims 1-19 of the '506 patent are cancelled.
11. On May 19, 2010, patent owner filed three petitions: (1) "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" ("the petition under 37 CFR 1.137(b)"), (2) "PETITION TO REOPEN PROSECUTION IN AN INTER PARTES REEXAMINATION PROCEEDING UNDER 37 C.F.R. § 1.181" ("the petition under 37 CFR 1.181"), and (3) "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" ("the petition under 37 CFR 1.183").<sup>2</sup>
12. On July 27, 2010, the Office issued a decision dismissing patent owner's May 19, 2010 petition under 37 CFR 1.183 as premature, and stating that patent owner's response submission designated "Appendix B" is a response to the outstanding Office action that satisfies the regulatory 50-page limit requirement.<sup>3</sup>

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<sup>1</sup> March 11, 2010 notice of defective paper at pages 2-3 (further stating, "Patent Owner filed a response of 108 pages (of which 27 pages of claims do not count toward the page limit) and multiple declarations that contains opinions and arguments of the declarant that count towards the page limit.")

<sup>2</sup> The May 19, 2010 patent owner petition under 37 CFR 1.137(b) was accompanied by two response submissions: (1) "Appendix A," designated "PREVIOUSLY SUBMITTED AND CURRENTLY RE-SUBMITTED RESPONSE TO OFFICE ACTION [[FOR ENTRY IF RE-EXAMINATION REVIVED AND PETITION TO WAIVE PAGE LIMIT GRANTED]]," and (2) "Appendix B," designated "NEWLY SUBMITTED RESPONSE TO OFFICE ACTION [[FOR ENTRY IF RE-EXAMINATION REVIVED AND PETITION TO WAIVE PAGE LIMIT NOT GRANTED]]."

<sup>3</sup> July 27, 2010 decision at page 2.

13. On August 11, 2010, the Office issued a decision dismissing patent owner's May 19, 2010 petition under 37 CFR 1.181, stating that the additional 51 pages of patent owner's response submission designated "Appendix A" count toward the page limit requirement under 37 CFR 1.943.<sup>4</sup>
14. On August 13, 2010, the Office issued a decision granting patent owner's May 19, 2010 petition under 37 CFR 1.137(b), stating that patent owner's May 19, 2010 "Appendix B" response submission satisfies the requirement of 37 CFR 1.137(b) that a grantable petition be accompanied by a response to the outstanding Office action.<sup>5</sup>
15. On September 8, 2010, third party requester filed a comments submission entitled "REQUESTER'S WRITTEN RESPONSE TO PATENTEE'S RESPONSE TO OFFICE ACTION" after entry, on August 13, 2010, of patent owner's "Appendix B" response submission.
16. On September 9, 2010, patent owner filed a petition paper entitled "RENEWED PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183," requesting entry of and waiver of the regulatory page limit for patent owner's May 19, 2010 response submission designated "Appendix A."
17. On December 10, 2010, the Office mailed a decision dismissing patent owner's September 9, 2010 renewed petition.
18. On January 22, 2011, patent owner filed the instant petition paper entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. 1.183 FOR WAIVER OF 37 C.F.R. 1.945(b)" (the petition for waiver of 37 CFR 1.945(b)), concurrently with a response submission entitled "PATENT OWNER'S SUPPLEMENTAL RESPONSE" and accompanying exhibits.
19. On February 22, 2011, third party requester filed the instant petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(b)" (the petition for waiver of 37 CFR 1.943(b)), concurrently with a comments submission entitled "REQUESTER'S WRITTEN COMMENTS TO PATENT OWNER'S

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<sup>4</sup> August 11, 2010 decision at page 3 (stating, "The issue of compliance with the page limits set forth in 37 CFR 1.943(b) rests with the 51-page appendix entitled "NEW CLAIMS WITH SUPPORT FROM '506 PATENT SPECIFICATION". Specifically, are claim charts that map the patent at issue to the proposed new claims merely pages of claims or are they claims with additional material that are considered part of the response. The required claim support is not excluded from the page limit requirement under 37 CFR 1.943, nor does the guidance in the MPEP exclude the required claim support from the page limits. Also, the required claim support must be considered part of the response for compliance with 37 CFR 1.530. Therefore, the additional 51 pages of response counts against the PO's page limit in the response.")

<sup>5</sup> August 13, 2010 decision at page 4 (further stating, "Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the March 11, 2010 Notice Re Defective Paper In *Inter Partes* Reexamination. MPEP 2667(I)(A)(2) states that the patent owner will be given a time period of 15 days from the mailing date of the notice to respond. An appropriate response to the March 11, 2010 Notice, in the form of the response denominated as 'Appendix B,' was not filed until May 19, 2010, which was untimely. However, for the purpose of evaluating whether the May 19, 2010 patent owner petition is a grantable petition, the submission of the May 19, 2010 'Appendix B' response satisfies item (1).")

PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.945(b) AND [PROPOSED] SUPPLEMENTAL RESPONSE” and accompanying exhibits.

### **RELEVANT STATUTES, RULES AND EXAMINING PROCEDURES**

35 U.S.C. 314(a) provides:

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

37 CFR 1.943(b) provides:

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

37 CFR 1.945 provides:

(a) 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.

(b) Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

- (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
- (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
- (3) A compelling reason to enter the supplemental response.

MPEP 2666, Section III provides (in-part):

Pursuant to 37 CFR 1.945(b), any supplemental response to the Office action in an inter partes reexamination proceeding must be accompanied by a showing of sufficient cause why the supplemental response should be entered. If such a showing is not provided, the supplemental response will not be entered, and may be sealed from public view in the Image File Wrapper (IFW), if it has already been scanned into the IFW for the proceeding.

The showing of sufficient cause why the supplemental response should be entered must include:

- (A) an explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied;

- (B) an explanation of why the supplemental response was not presented together with the original response to the Office action; and  
(C) a compelling reason to enter the supplemental response.

\*\*\*\*

Any requester comments filed after a patent owner response to an Office action must be filed “within 30 days after the date of service of the patent owner’s response,” to satisfy 35 U.S.C. 314(b)(2). Thus, where the patent owner files a supplemental response to an Office action, the requester would be well advised to file any comments deemed appropriate within 30 days after the date of service of the patent owner’s supplemental response to preserve requester’s comment right, in the event the Office exercises its discretion to enter the supplemental response. The requester’s comments may address whether the patent owner showing is adequate, in addition to addressing the merits of the supplemental response.

## DISCUSSION

### I. Patent Owner’s January 22, 2011 Petition for Waiver of 37 CFR 1.945(b)

In the January 22, 2011 petition for waiver of 37 CFR 1.945(b), patent owner requests entry of patent owner’s concurrently-filed response submission as a supplemental response. Patent owner asserts that the January 22, 2011 response submission includes a listing of original patent claims 1-19, new claims 20-60, 6 pages of remarks identifying support from the specification for the new claims, 36 pages of remarks previously entered on August 13, 2010 (*i.e.*, as the “Appendix B” response submission), and the previously-submitted declaration under 37 CFR 1.131, with accompanying exhibits labeled A-F.<sup>6</sup>

Pursuant to 37 CFR 1.945(b), any supplemental response to the Office action in an *inter partes* reexamination proceeding must be accompanied by a showing of sufficient cause why the supplemental response should be entered, including: an explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied; an explanation of why the supplemental response was not presented together with the original response to the Office action; and a compelling reason to enter the supplemental response.

In the instant patent owner petition, petitioner asserts reasons why the showing of sufficient cause required by 37 CFR 1.945(b) has been met for entry of patent owner’s January 22, 2011 response submission as a supplemental response.<sup>7</sup> For example, petitioner asserts that, responsive to the guidance set forth in the Office’s December 10, 2010 decision, patent owner limited the number of new claims being added from 109 claims to 41 claims (*i.e.*, adding claims 20-60 instead of claims 20-128 as previously presented in the non-entered May 19, 2010 “Appendix A” response submission).<sup>8</sup> Thus, petitioner asserts that the remarks section setting forth support from the specification for the new claims 20-60 has been reduced to 6 pages such that the total length of patent owner’s response is 42 pages and within the regulatory 50-page limit.<sup>9</sup> Petitioner further asserts that no changes have been made to the 36-page response

<sup>6</sup> See patent owner’s petition for waiver of 37 CFR 1.945(b) at page 8.

<sup>7</sup> *Id.* at page 15.

<sup>8</sup> *Id.* at page 12.

<sup>9</sup> *Id.* at pages 11-12.

previously submitted (*i.e.*, the May 19, 2010 “Appendix B” response submission).<sup>10</sup> Additionally, petitioner asserts that the 41 new claims being presented do not enlarge the scope of the originally granted patent claims and have been narrowed from the version of the new claims previously presented in the non-entered May 19, 2010 “Appendix A” response submission to put them in better condition for allowance.<sup>11</sup>

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. The Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See *Cantello v. Rasmussen*, 220 USPQ 664 (Comm’r Pat. 1982). In this instance, patent owner’s petition seeking waiver of 37 CFR 1.945(b) is premature, because the Central Reexamination Unit (CRU) has not made a determination that patent owner failed to make a satisfactory showing of sufficient cause pursuant to 37 CFR 1.945(b) to permit entry of patent owner’s January 22, 2011 response submission as a supplemental response. Accordingly, the instant petition for waiver of 37 CFR 1.945(a) is dismissed as premature.

However, based on the individual facts and circumstances of this case including, for example, that the remarks portion of patent owner’s January 22, 2011 response submission is the same as the remarks portion of patent owner’s previously entered “Appendix B” response submission, except for 6 additional pages setting forth support from the specification for newly added claims 20-60, and that patent owner’s January 22, 2011 response submission does not exceed the regulatory page limit, it is deemed equitable in this instance to *sua sponte* enter patent owner’s January 22, 2011 response submission as a replacement response for patent owner’s “Appendix B” response submission, which was previously entered on August 13, 2010.

## II. Requester’s February 22, 2011 Petition for Waiver of 37 CFR 1.943(b)

On February 22, 2011, requester filed a comments submission, responsive to patent owner’s January 22, 2011 response submission, in accordance with MPEP § 2666 (III).<sup>12</sup> The February 22, 2011 comments submission includes 18 pages of remarks and 193 pages of claim charts applying the art to new claims 20-60, presented in patent owner’s January 22, 2011 response submission.<sup>13</sup> The February 22, 2011 comments submission has been filed in addition to

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<sup>10</sup> *Id.* at page 13.

<sup>11</sup> *Id.* at pages 11-12.

<sup>12</sup> MPEP § 2666 (III) provides, “Any requester comments filed after a patent owner response to an Office action must be filed ‘within 30 days after the date of service of the patent owner’s response,’ to satisfy 35 U.S.C. 314(b)(2). Thus, where the patent owner files a supplemental response to an Office action, the requester would be well advised to file any comments deemed appropriate within 30 days after the date of service of the patent owner’s supplemental response to preserve requester’s comment right, in the event the Office exercises its discretion to enter the supplemental response. The requester’s comments may address whether the patent owner showing is adequate, in addition to addressing the merits of the supplemental response. If the patent owner’s supplemental response is not entered by the Office, then both the supplemental response, and any comments following that supplemental response, will either be returned to the parties or discarded at the sole discretion of the Office.”

<sup>13</sup> The February 22, 2011 comments submission includes a 119-page claim chart labeled “Appendix D” and a 74-page claim chart labeled “Appendix E.” The additional exhibits filed with the February 22, 2011 comments submission appear to be reference materials that do not count toward the regulatory page limit.

requester's September 8, 2010 comments submission, which includes 32 pages of remarks.<sup>14</sup> 37 CFR 1.943(b) limits written comments by third party requester to 50 pages in length, excluding reference materials such as prior art references. Thus, requester's combined September 8, 2010 and February 22, 2011 comments submissions exceed the regulatory page limit by 193 pages.

Given that patent owner's January 22, 2011 response submission is being entered as a replacement response for patent owner's "Appendix B" response submission, previously entered on August 13, 2010, requester's September 8, 2010 and February 22, 2011 comments submissions will not be considered. Rather, the requester is given a time period of thirty days from the mailing date of this decision to file a single comments submission, responsive to patent owner's January 22, 2011 replacement response.

In the February 22, 2011 petition for waiver of 37 CFR 1.943(b), requester petitions for suspension of the regulatory page limit to permit entry of the additional 193-pages of claim charts applying the art to new claims 20-60.<sup>15</sup> In support of waiver of the rule, petitioner asserts:

It is not realistic that Requester could fairly address the full scope of the Supplemental Response and the Amendments made by the Patent Owner, including explaining the pertinency of the prior art to the rejected claims and to the new claims added in the Amendments--as required by 37 CFR §§ 1.948 and 1.501--within the fifty (50) page limit set forth in 37 CFR § 1.943(b), given that Patent Owner's own papers approach 50 pages in length, even without providing the necessary showings under 37 C.F.R. §§ 1.111(c), 1.530(e) and/or MPEP §§2250 and 2666.01. Therefore, Requester requests one hundred ninety-three (193) additional pages to prepare its response, for a total of two hundred forty-three (243) pages, inclusive of claim charts, but exclusive of any newly added references.<sup>16</sup>

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting the February 22, 2011 comments submission that, together with requester's September 8, 2010 comments submission, is in excess of 50 pages. Based on the individual facts and circumstances of this case including, for example, the 41 new claims presented in patent owner's January 22, 2011 response submission, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to permit requester's single comments submission to exceed the regulatory page limit to the extent necessary for entry of requester's non-duplicative comments, previously set forth in the September 8, 2010 and February 22, 2011 comments submissions, and claim charts applying the art to the 41 new claims.

Accordingly, requester's petition under 37 CFR 1.183 is granted to the extent that, if requester files a single comments submission in response to this decision, requester's single comments submission is permitted to exceed the regulatory page limit by up to 191 pages to accommodate entry of requester's non-duplicative comments, previously set forth in the September 8, 2010 and

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<sup>14</sup> The additional exhibits filed with the September 8, 2010 comments submission appear to be reference materials that do not count toward the regulatory page limit.

<sup>15</sup> It is noted that, in the February 22, 2011 petition for waiver of 37 CFR 1.943(b), requester also opposes patent owner's petition for waiver of 37 CFR 1.945(b).

<sup>16</sup> Requester's February 22, 2011 petition for waiver of 37 CFR 1.943(b) at page 5.

February 22, 2011 comments submissions, and claim charts applying the art to the 41 new claims.<sup>17</sup>

### CONCLUSION

1. The January 22, 2011 patent owner petition under 37 CFR 1.183 to waive 37 CFR 1.945(b) for entry of patent owner's concurrently-filed response submission as a supplemental response is **dismissed as premature**.
2. Patent owner's January 22, 2011 response submission is sua sponte being entered as a replacement response submission for patent owner's "Appendix B" response submission, previously entered on August 13, 2020.
3. Requester's September 8, 2010 and February 22, 2011 comments submissions will **not be considered**. Requester is given a time period of thirty days from the mailing date of this decision to file a single comments submission, responsive to the patent owner's January 22, 2011 replacement response.
4. The February 22, 2011 requester petition under 37 CFR 1.183 to waive the page limit requirement of 37 CFR 1.943(b) is **granted to the extent that**, if requester files a single comments submission in response to this decision, requester's single comments submission is permitted to exceed the regulatory page limit by up to 191 pages to accommodate entry of requester's non-duplicative comments, previously set forth in the September 8, 2010 and February 22, 2011 comments submissions, and the claim charts, previously set forth in the February 22, 2011 comments submission, applying the art to the 41 new claims.
5. Telephone inquiries with regard to this decision should be directed to Nicole Dretar Haines, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



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

05-10-2011  
Kenpet8

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<sup>17</sup> In determining that 191 pages are deemed appropriate for requester's single comments submission in view of the instant facts and circumstances, the September 8, 2010 and February 22, 2011 comments submissions were evaluated for economizing and repetition of arguments. For example, it is anticipated that the single comments submission would not include Sections I-III of the remarks portion of the February 22, 2011 comments submission. Thus, the single comments submission need only include the 32 pages of the remarks portion of the September 8, 2010 comments submission, the 16 pages of Section IV of the remarks portion of the February 22, 2011 comments submission, and the 193 pages of the claim charts applying the art to the new claims.

<b>Doc Code: PET.AUTO</b>		PTO/SB/83
<b>Document Description: Petition automatically granted by EFS-Web</b>		U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	
Application Number	95001129	
Filing Date	19-Dec-2008	
First Named Inventor	7340506	
Art Unit	3992	
Examiner Name	ZOILA CABRERA	
Attorney Docket Number	WEBX-101REX1	
Title	VALUE-ADDED NETWORK SWITCHING AND OBJECT ROUTING	
<input checked="" type="radio"/> Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number:		23122
The reason(s) for this request are those described in 37 CFR:		
10.40(c)(1)(iv)		
Certifications		
<input checked="" type="checkbox"/> I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment		
<input checked="" type="checkbox"/> I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled		
<input checked="" type="checkbox"/> I/We have notified the client of any responses that may be due and the time frame within which the client must respond		
Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:		
Name	Lakshmi Arunachalam	
Address	222 Stanford Avenue	
City	Menlo Park	
State	CA	
Postal Code	94025	
Country	US	

I am authorized to sign on behalf of myself and all withdrawing practitioners.	
Signature	/Stephen J. Weed/
Name	Stephen J. Weed
Registration Number	45202



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Decision Date : July 7,2011

In re Application of :

7340506

Application No : 95001129

Filed : 19-Dec-2008

Attorney Docket No : WEBX-101REX1

DECISION ON REQUEST TO WITHDRAW AS  
ATTORNEY/AGENT OF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed July 7,2011

The request is **APPROVED**.

The request was signed by Stephen J. Weed (registration no. 45202 ) on behalf of all attorneys/agents associated with Customer Number 23122 . All attorneys/agents associated with Customer Number 23122 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name Lakshmi  
Name2 Arunachalam  
Address 1 222 Stanford Avenue  
Address 2  
City Menlo Park  
State CA  
Postal Code 94025  
Country US

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,131	12/31/2008	6,266,285	10314.0018-00000	1154
22852	7590	06/17/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			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 95/001,106

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,131

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Merged *Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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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

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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.

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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.

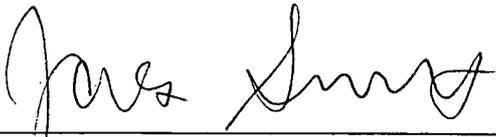
## DISCUSSION

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.

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

DECISION

In view of the forgoing, the Appeal Brief Petition and the Respondent Brief Petition are DENIED.



---

James D. Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner Rambus, Inc.:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,131	12/31/2008	6,266,285	10314.0018-00000	1154

22852 7590 06/22/2011

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/22/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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Merged *Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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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.

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

## 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.

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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 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

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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.

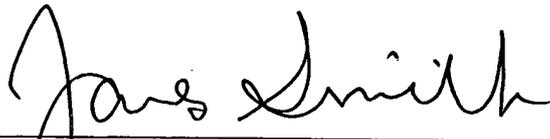
*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

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.



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James D. Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/001,106 and 95/001,131  
Patent 6,266,285

Counsel for Patent Owner Rambus, Inc.:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502
22852	7590	06/30/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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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");

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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.”

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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

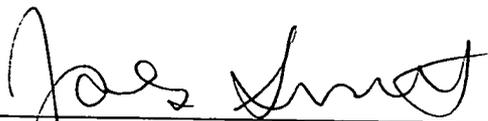
For the forgoing reasons,

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.



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James Donald Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

Counsel for Patent Owner Rambus:

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502
22852	7590	07/13/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 07/13/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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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

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Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132  
Patent 6,314,051

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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”).

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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.

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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**

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

**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.

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,132	12/31/2008	6,314,051	896.002.051	1502
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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

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Merged *Inter partes* Reexamination Control 95/001,107 and 95/001,132  
Patent 6,314,051

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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

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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.”

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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*

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
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*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

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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.
95/001,132	12/31/2008	6,314,051	896.002.051	1502
22852	7590	07/13/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			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

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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 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

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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).

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

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

*Inter partes* Reexamination Control 95/001,107 and 95/001132  
Patent 6,314,051

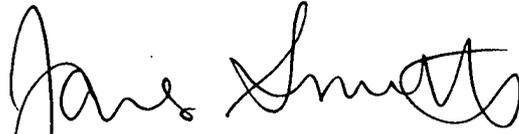
length. Thus, the length of the Brief appears to be within the page limit of 15 and word limit of 7,000, as required by Rule 1.943(c). Rambus expresses concern, however, that the Office will count as part of the Brief, pages from the Declaration of a technical expert, Robert J. Murphy, that are cited 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.



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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.
95/001,133	12/31/2008	6751696	8963.002.285	1711

22852            7590            01/28/2011

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EXAMINER

ART UNIT            PAPER NUMBER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

## 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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

(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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

### 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.

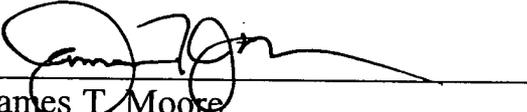
### ANALYSIS

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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

DECISION

In view of the forgoing, the Petition is DENIED.

  
James T. Moore  
Acting Chief Administrative Patent Judge

Counsel for Patent Owner Rambus, Inc.:  
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22852	7590	06/09/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

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BEFORE THE  
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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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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").
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6. On March 9, 2009, the '105 and '133 proceedings were merged.
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11. On November 22, 2010, Micron filed an Appeal Brief.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,133	12/31/2008	6751696	8963.002.285	1711
22852	7590	08/04/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2011

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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 95/001,105

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

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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*,

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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.

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

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

*Inter partes* Reexamination Control 95/001,105 and 95/001,133  
Patent 6,751,696

Counsel for Patent Owner Rambus:

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,134	01/09/2009	6260097	42940.4	8506

86497          7590          08/17/2010

Paul M. Anderson, PLLC  
P.O. Box 160006  
Austin, TX 78716

EXAMINER

ART UNIT          PAPER NUMBER

DATE MAILED: 08/17/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,134	01/09/09	6260097	42940.4

HAYNES AND BOONE, LLP  
IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

EXAMINER  
ESCALANTE, OVIDIO

ART UNIT      PAPER  
3992

DATE MAILED

AUG 17 2010

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



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,134	01/09/09	6260097	42940.4

HAYNES AND BOONE, LLP  
IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

EXAMINER ESCALANTE, OVIDIO
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ART UNIT 3992	PAPER
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DATE MAILED:

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(For Patent Owner)

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DALLAS, TX 75219

MAILED

AUG 17 2010

CENTRAL REEXAMINATION UNIT

*In re: Farmwald et alia*  
Reexamination Proceeding  
Control No. 95/001,134  
Request Deposited: January 9, 2009  
For: U.S. Patent No. 6,260,097

: **DECISION DISMISSING**  
: **PETITION TO**  
: **WITHDRAW ACP**  
:  
:

The *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition filed March 29, 2010 entitled "PETITION TO WITHDRAW THE ACTION CLOSING PROSECUTION OF FEBRUARY 19, 2010".

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181. No fee is required.

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

### BACKGROUND

A non-final office action was mailed on June 5, 2009. Patent Owner responded with arguments and no amendments to the claims on August 14, 2009. After requester's comments of September 11, 2009, the office issued an Action Closing Prosecution (ACP) on February 19, 2010. On March 19, 2010, Patent Owner (PO) filed a petition to withdraw the ACP.

Art Unit: 3992

## DECISION

Petitioner argues the merits of the rejections, alleges that the office fails to construe claim terms, and characterizes points raised by the examiner in the response to arguments section of the ACP as new positions taken by the office.

Arguing the merits of a rejection is subject to appeal to the Board of Patent Appeals and Interferences and is thus not a petitionable issue. This decision takes no position as to the merits of any rejection.

Petitioner argues, “[t]he Office does not address these arguments or the evidence relied on by Rambus. Instead, the Office fails to construe the claim terms and simply asserts, for example, that ‘the Patent Owner is arguing limitations that is [sic, are] not in the claims.’ (Second OA at 47.)” However, the passage on page 47 of the ACP squarely addresses the limitation “periodic”. The next sentences, that petitioner fails to cite in the petition, read, “The term ‘periodic’ is not recited. Thus, this argument is not persuasive for at least the reason that ‘periodic’ is not a claimed term...” The office has addressed the claim terms by applying, or not applying, prior art to the claim terms in the rejections. The examiner’s position that “periodic” does not appear in any claim limitation is correct. Petitioner’s argument that one sentence, that clearly refers to the term “periodic” only, can be read as the examiner not construing other claim terms is not well taken.

Petitioner argues that the examiner has raised “new issues” by responding to some of the arguments presented by PO. Petitioner takes the position that answering arguments presented by the PO should be construed as the examiner not having fully developed the grounds of rejection. For example, petitioner argues that the discussion in the ACP that addresses the block size information citing both Parameters VII and VIII of Bennett is a different position than the original rejection, which only cited Parameter VIII. The section referenced in the petition is a rebuttal of PO’s arguments as to the claim rejections. So, the examiner has not altered the grounds of rejection and has not given a new thrust to the rejections. The position taken in the response to arguments is consistent with the manner in which the examiner applied art against the claim term “block size information” in the non-final rejection. Therefore, closing prosecution in the ACP was not done prematurely.

Therefore, the petition is **dismissed**.

## CONCLUSION

1. Petitioner’s request to withdraw the ACP is **dismissed**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Control Number: 95/001,134

Page 3

Art Unit: 3992

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,134	01/09/2009	6260097	42940.4	8506
86497	7590	03/04/2011	EXAMINER	
Paul M. Anderson, PLLC P.O. Box 160006 Austin, TX 78716			ART UNIT	PAPER NUMBER

DATE MAILED: 03/04/2011

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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RAMBUS, INC.  
Patent Owner  
v.  
NVIDIA CORPORATION  
Third Party Requester

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*Inter partes* Reexamination Control 95/001,134

Patent 6,260,097

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DECISION ON PETITION

This is a decision on patent owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed December 15, 2010 ("present 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 28 pages and 16,296 words in length." The petition fee of \$400 in accordance with 37 C.F.R. § 41.20(a) was paid by check on December 15, 2010, along with the respondent brief fee.

## FINDINGS

1. Patent 6,260,097 issued on July 10, 2001 with 35 claims. The '097 patent is assigned to patent owner Rambus, Inc. ("Rambus").
2. On January 9, 2009, third party requester NVIDIA, filed a request for *inter partes* reexamination of U.S. Patent No. 6,260,097, which was assigned control no. 95/001,134.
3. On March 13, 2009, reexamination was ordered in the *inter partes* reexamination proceeding 95/001,134.
4. A non-final Office action was mailed on June 5, 2009.
5. Patent owner filed a response to the Office action on August 14, 2009, and requester filed comments in reply to the Office action and patent owner's response on September 11, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On February 19, 2010, an Action Closing Prosecution (ACP) was mailed.
7. On March 29, 2010, patent owner filed a response to the ACP, and requester filed comments in reply to the ACP and patent owner's response on April 28, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
8. A Right of Appeal Notice (RAN) was mailed on August 18, 2010.
9. Requester filed a Notice of Appeal on September 17, 2010.
10. On November 17, 2010, requester filed an appellant's brief, exceeding the 30 page limit pursuant to 37 C.F.R. § 1.943(c), but including a certificate stating that the brief contains 13,373 words.
11. Patent owner filed a respondent brief on December 15, 2010, which was accompanied by the present petition.

## DISCUSSION

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 28 pages and 16,296 words.

Waiver is requested for the following reasons stated by petitioner:

- (1) The third party requester NVIDIA submitted a 36 page appellant brief which addresses a priority issue and 27 proposed rejections relying on 14 references. One of the references, U.S. Patent No. 4,734,909 to "Bennett" is more than 400 pages long. Throughout its appellant brief, NVIDIA incorporates portions of its 105 page request for reexamination.
- (2) The limits imposed by 37 C.F.R. § 1.943(c), are arbitrary and violate Rambus's due process rights. The Office has no basis for permitting Rambus only half the amount of pages to respond to NVIDIA's arguments.
- (3) Rambus has made every effort to pare down the arguments in its respondent appeal brief but the page/word limits are inadequate to fully address and comprehensively respond to NVIDIA's arguments.

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

## RELEVANT AUTHORITY

### **37 C.F.R. § 1.183 provides:**

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

### **37 C.F.R. § 1.943(c) provides:**

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

### **37 C.F.R. § 41.67(c)(vii) provides:**

(vii) *Argument*. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

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

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under

reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

## ANALYSIS

With regard to the present petition, upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to this appeal have been within the respective page limit requirements for responses. The rules require that the respondent brief be more limited than pre-appeal responses. Patent owner's respondent brief is 28 pages and 16,296 words, which is far in excess of the limit of 15 pages and 7,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the appellant brief, and the numerous proposed rejections which were not adopted, that are appealed by requester. However, prior to appeal, the examiner included the proposed rejections which were not adopted in the non-final Office action and the Action Closing Prosecution. The non-final Office action and the ACP were addressed within the page limit requirements for responses (*i.e.*, 50 pages) in patent

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

owner's response of August 14, 2009, and the response of March 29, 2010, respectively.

Petitioner asserts that Rambus has made every effort to pare down the arguments in its respondent appeal brief but the page/word limits are inadequate to fully address and comprehensively respond to NVIDIA's arguments.

While these arguments are all true, the present petition does not explain why these are extraordinary circumstances nor how the circumstances prevent compliance with the page limit requirements. The page/word limits are intentionally designed to focus the issues and require a concise presentation of arguments. The present petition provides little or no showing of extraordinary circumstances.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to respondent's brief compared to prior responses and comments submitted in reply to actions issued by the Office.

## DECISION

Petitioner is given one opportunity to file a corrected respondent brief in compliance with of 37 C.F.R. § 1.943(c), within a non-extendable time period of 30 days/one month (whichever is longer) from the mailing date of this decision.

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

In view of the forgoing, the Petition is DENIED.



---

James T. Moore  
Acting Chief Administrative Patent Judge

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Counsel for Third Party Requester:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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86497	7590	04/28/2011	EXAMINER	
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DATE MAILED: 04/28/2011

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RAMBUS, INC.  
Patent Owner

v.

NVIDIA CORPORATION  
Third Party Requester

---

*Inter partes* Reexamination Control 95/001,134

Patent 6,260,097

---

DECISION ON PETITION

This is a decision on patent owner's "Petition Seeking Review of Decision Denying Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Brief," filed April 4, 2011 ("present petition"). In the petition, patent owner requests "that the Director overturn the March Decision and direct the Office to enter Rambus' December 15, 2010 Respondent Brief into the record." The petition fee of \$400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's deposit account on April 4, 2011.

## FINDINGS

1. Patent 6,260,097 issued on July 10, 2001 with 35 claims. The '097 patent is assigned to patent owner Rambus, Inc. ("Rambus").
2. On January 9, 2009, third party requester NVIDIA, filed a request for *inter partes* reexamination of U.S. Patent No. 6,260,097, which was assigned control no. 95/001,134.
3. On March 13, 2009, reexamination was ordered in the *inter partes* reexamination proceeding 95/001,134.
4. A non-final Office action was mailed on June 5, 2009.
5. Patent owner filed a response to the Office action on August 14, 2009, and requester filed comments in reply to the Office action and patent owner's response on September 11, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On February 19, 2010, an Action Closing Prosecution (ACP) was mailed.
7. On March 29, 2010, patent owner filed a response to the ACP, and requester filed comments in reply to the ACP and patent owner's response on April 28, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
8. A Right of Appeal Notice (RAN) was mailed on August 18, 2010.
9. Requester filed a Notice of Appeal on September 17, 2010.
10. On November 17, 2010, requester filed an appellant's brief, exceeding the 30 page limit pursuant to 37 C.F.R. § 1.943(c), but including a certificate stating that the brief contains 13,373 words.
11. Patent owner filed a respondent brief on December 15, 2010, which was accompanied by a petition to waive to 37 C.F.R. § 1.943(c).

12. On March 4, 2011, a decision denying the petition of December 15, 2010, was mailed.
13. Patent owner filed the present petition on April 4, 2011.

## DISCUSSION

In the present petition, Rambus requests three alternative outcomes to the instant petition as follows:

1. That the Director overturn the petition decision of March 4, 2011, and enter the respondent brief of December 15, 2010, into the record; or
2. If the petition decision of March 4, 2011, is not overturned, that the Office accept the attached replacement respondent brief (Attachment A), which is 15 pages long, and complies with the requirements of 37 CFR § 1.943(c), but cites to two expert declarations that were submitted during reexamination and are part of the record; or
3. Should the Office decide to count the two expert declarations of the brief in Attachment A towards the page count of the replacement respondent brief, then the Office accept the attached alternative replacement respondent brief (Attachment B) that does not cite to the expert declarations and is 15 pages in length.

The Office appreciates the filing of a corrected respondent brief in compliance with of 37 C.F.R. § 1.943(c), and accepts the attached alternative replacement respondent brief (Attachment B) that does not cite to the expert declarations and is 15 pages in length. The alternative replacement respondent brief (Attachment B) of April 4, 2011, is entered.

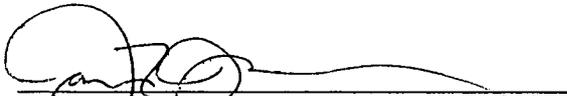
*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

In view of the filing of a compliant respondent brief, the present petition is **dismissed as moot**.

DECISION

In view of the forgoing, the Petition is DISMISSED.

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



James T. Moore  
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:  
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Austin, TX 78716

Counsel for Third Party Requester:  
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HAYNES & BOONE, LLP  
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Dallas, TX 75219



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,134	01/09/2009	6260097	42940.4	8506
86497	7590	05/19/2011	EXAMINER	
Paul M. Anderson, PLLC P.O. Box 160006 Austin, TX 78716			ART UNIT	PAPER NUMBER

DATE MAILED: 05/19/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

v.

NVIDIA CORPORATION  
Third Party Requester

---

*Inter partes* Reexamination Control 95/001,134

Patent 6,260,097

---

DECISION ON PETITION

This is a decision on patent owner's "Petition Seeking Reconsideration of April 28, 2011, Decision on Petition," filed May 12, 2011 ("present petition"). In the petition, patent owner requests that the Office reconsider the April 28, 2011, decision dismissing the April 4, 2011, petition as moot. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on May 12, 2011, as authorized on page 2 of the present petition.

## FINDINGS

1. Patent 6,260,097 issued on July 10, 2001 with 35 claims. The '097 patent is assigned to patent owner Rambus, Inc. ("Rambus").
2. On January 9, 2009, third party requester NVIDIA, filed a request for *inter partes* reexamination of U.S. Patent No. 6,260,097, which was assigned control no. 95/001,134.
3. On March 13, 2009, reexamination was ordered in the *inter partes* reexamination proceeding 95/001,134.
4. A non-final Office action was mailed on June 5, 2009.
5. Patent owner filed a response to the Office action on August 14, 2009, and requester filed comments in reply to the Office action and patent owner's response on September 11, 2009, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On February 19, 2010, an Action Closing Prosecution (ACP) was mailed.
7. On March 29, 2010, patent owner filed a response to the ACP, and requester filed comments in reply to the ACP and patent owner's response on April 28, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
8. A Right of Appeal Notice (RAN) was mailed on August 18, 2010.
9. Requester filed a Notice of Appeal on September 17, 2010.
10. On November 17, 2010, requester filed an appellant's brief, exceeding the 30 page limit pursuant to 37 C.F.R. § 1.943(c), but including a certificate stating that the brief contains 13,373 words.
11. Patent owner filed a respondent brief on December 15, 2010, which was accompanied by a petition to waive to 37 C.F.R. § 1.943(c).

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

12. On March 4, 2011, a decision denying the petition of December 15, 2010, was mailed.
13. Patent owner filed a petition on April 4, 2011, accompanied by three proposed options regarding entry of a respondent brief.
14. On April 28, 2011, a petition decision was mailed that accepted the single compliant respondent brief that was received, and dismissed the petition as moot.
15. On May 6, 2011, an examiner's answer was mailed.
16. Patent owner filed the present petition on May 12, 2011.

## RELEVANT AUTHORITY

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

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

(b) RESPONSE.-

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

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

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

(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 1.183 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.

## DISCUSSION

In the present petition, Rambus complains that the Office's entry of the Alternative Replacement Respondent Brief without first deciding Rambus's request to enter its original Respondent Brief or the Replacement Respondent Brief is an arbitrary and capricious denial of Rambus's due process rights. Petitioner asserts that the failure of the Office to enter Rambus's Respondent Brief as originally filed, deprives Rambus of the ability to respond fully to the issues presented in the appeal. Petitioner indicates that if the entry and consideration of this petition requires suspension of any rules, that suspension is requested pursuant to 37 C.F.R. § 1.183.

35 U.S.C. 314 requires *inter partes* reexamination proceedings to be conducted with special dispatch. Petitioner is reminded that pursuant to

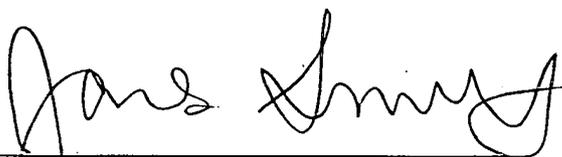
*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

37 C.F.R. § 41.68, "if a respondent brief is filed which does not comply with all the requirements . . . , respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent . . . files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered."

Fortunately, patent owner was able to file a respondent brief in compliance with 37 C.F.R. § 1.943(c), *i.e.*, the Alternative Replacement Respondent Brief of April 4, 2011, and that brief has been entered. This is not an extraordinary situation in which justice requires waiver of 37 C.F.R. § 1.943(c), to permit entry of patent owner's respondent brief of December 15, 2010. Since a compliant respondent brief has been entered and an examiner's answer was mailed, the present petition is **dismissed as moot**.

#### DECISION

In view of the forgoing, the Petition is DISMISSED.



James Donald Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control No. 95/001,134  
Patent No. 6,260,097

Counsel for Patent Owner:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,138	01/21/2009	7363349	339156US91RX	1521
22850	7590	09/29/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,138	01/21/09	7363349	

NOVAK DRUCE & QUIGG LLP  
NDQ REEXAMINATION GROUP  
1000 LOUISIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

EXAMINER	
POKRZYWA, JOSEPH R.	
ART UNIT	PAPER
3992	

DATE MAILED

SEP 29 2010

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COMMUNICATION**

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,138	01/21/09	7363349	

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NDQ REEXAMINATION GROUP  
1000 LOUISIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

EXAMINER	
POKRZYWA, JOSEPH R.	
ART UNIT	PAPER
3992	

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OBLON, SPIVAK, MCCLELLAND, MAIER  
& NEUSTADT, L.L.P  
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ALEXANDRIA, VA 22314

(For Patent Owner)

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FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For Third Party Requester)

MAILED

SEP 29 2010

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,138  
Filed: January 21, 2009  
For: U.S. Patent No. 7,363,349

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

This is a decision on patent owner's "PETITION FOR INTERVIEW UNDER 37 CFR § 1.183," filed on July 1, 2010.

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

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card on July 2, 2010, as authorized on page 4 of the petition.

The petition is dismissed.

**BACKGROUND**

1. U.S. Patent No. 7,363,349 ("the '349 patent") issued to Friedman *et al.* on April 22, 2008.
2. A request for *inter partes* reexamination was filed by a third party requester on January 21, 2009, which request was assigned control no. 95/001,138 ("the '1138 proceeding").
3. Reexamination was ordered in the '1138 proceeding on April 8, 2009.
4. On July 24, 2009, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" in the '1138 proceeding.
5. On March 24, 2010, the Office mailed an Office action on the merits in the '1138 proceeding.

6. On May 24, 2010, patent owner filed an "AMENDMENT IN *INTER PARTES* REEXAMINATION OF U.S. PATENT 7,363,349 UNDER 37 C.F.R. §1.945/1.111," responsive to the March 24, 2010 Office action.
7. On July 1, 2010, patent owner filed the instant petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183."

## 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

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1138 proceeding and asserts that such interview "will advance this reexamination by allowing the Examiner and Patent Holder to identify any specific claim language deemed necessary to terminate these proceedings."<sup>1</sup>

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

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<sup>1</sup> See July 1, 2010 petition under 37 CFR 1.183 at page 1.

request for waiver of 37 CFR 1.955, petitioner asserts that: (1) third party requester has withdrawn from this *inter partes* reexamination of the '349 patent, (2) the interview would advance prosecution of the '1138 proceeding by allowing the examiner and patent owner to identify specific claim language that would terminate the proceeding.<sup>2</sup>

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

In this instance, third party requester has stated on the record that it will not further participate in the '1138 *inter partes* reexamination proceeding.<sup>3</sup> Thus, only a single party (patent owner) will now participate in the '1138 proceeding, and any interview that might be permitted in the proceeding. Accordingly, petitioner asserts in the instant petition that "no harm will come to any party if this Petition is granted since the Third-Party Requestor, and real party in interest, Research In Motion, Ltd., has confirmed that it will no longer participate in this reexamination proceeding."<sup>4</sup>

However, patent owner has not focused upon matters at issue in the proceeding to be discussed at the interview. As pointed out above, patent owner asserts that such interview "will advance this reexamination by allowing the Examiner and Patent Holder to identify any specific claim language deemed necessary to terminate these proceedings." This, however, is a generic statement that does not focus on issues to be addressed at the interview. It merely indicates a basic desire to find some language that will make the claims patentable.

Should patent owner correct the matter identified immediately above, it may be found that permitting a single interview to be conducted at this point in the '1138 *inter partes* proceeding may well assist the Office in expeditiously resolving the proceeding.<sup>5</sup> If patent owner chooses to

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<sup>2</sup> See *id.* at page 3.

<sup>3</sup> See July 24, 2009 "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" (stating that: "Third Party Requester has entered into a settlement agreement with Patent Owner and as such withdraws from continued active participation in the on-going above reexamination," "Third Party Requester will make no further comment in or otherwise actively participate in this *inter partes* reexamination," and "Third Party Requester, consistent with the above, requests to be excluded from further proceedings in *this inter partes* reexamination to the fullest extent allowed under the Patent Laws, Rules and operating procedures of the Patent Office.")

<sup>4</sup> July 1, 2010 petition under 37 CFR 1.183 at page 4.

<sup>5</sup> The '1138 proceeding is ready for examiner action following patent owner's May 24, 2010 amendment, responsive to the March 24, 2010 Office action.

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 July 1, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



---

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

9-28-10



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,138	01/21/2009	7363349	339156US91RX	1521

22850            7590            12/01/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 12/01/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,138	01/21/09	7363349	

NOVAK DRUCE & QUIGG LLP  
NDQ REEXAMINATION GROUP  
1000 LOUISIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

EXAMINER

POKRZYWA, JOSEPH R.

ART UNIT      PAPER

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DEC 01 2010

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COMMUNICATION**

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& NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

(For Patent Owner)

**MAILED**

DEC 01 2010

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NDQ REEXAMINATION GROUP  
1000 LOUISIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,138  
Filed: January 21, 2009  
For: U.S. Patent No. 7,363,349

: **DECISION GRANTING**  
: **RENEWED PETITION FOR**  
: **WAIVER OF 37 CFR 1.955**  
: **FOR ONE-TIME INTERVIEW**

This is a decision on patent owner's "RENEWED PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183," filed on October 8, 2010.

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

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card on October 12, 2010, as authorized on page 4 of the petition.

The petition is granted to the extent set forth herein.

### BACKGROUND

1. U.S. Patent No. 7,363,349 ("the '349 patent") issued to Friedman *et al.* on April 22, 2008.
2. A request for *inter partes* reexamination was filed by a third party requester on January 21, 2009, which request was assigned control no. 95/001,138 ("the '1138 proceeding").
3. Reexamination was ordered in the '1138 proceeding on April 8, 2009.
4. On July 24, 2009, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT" in the '1138 proceeding.
5. On March 24, 2010, the Office mailed an Office action on the merits in the '1138 proceeding.

6. On May 24, 2010, patent owner filed an "AMENDMENT IN *INTER PARTES* REEXAMINATION OF U.S. PATENT 7,363,349 UNDER 37 C.F.R. §1.945/1.111," responsive to the March 24, 2010 Office action.
7. On July 1, 2010, patent owner filed a petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183."
8. On September 29, 2010, the Office mailed a decision dismissing the July 1, 2010 petition.
9. On October 8, 2010, patent owner filed the instant petition paper entitled "RENEWED PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183."

## DECISION

### Patent Owner's Renewed Petition under 37 CFR 1.183

In the September 29, 2010 decision, the Office dismissed patent owner's July 1, 2010 request for a one-time interview in the '1138 proceeding, stating that "patent owner has not focused upon matters at issue in the proceeding to be discussed at the interview."<sup>1</sup> In the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.955 for a one-time interview in the '1138 proceeding, petitioner identified specific matters at issue in the proceeding to be discussed at the interview. For example, petitioner asserts that "[a]t issue in the reexamination proceedings are the descriptions of timing features of the King reference (U.S. Patent No. 5,895,471)" and that "Patent Holder believes that a discussion of these features with the Examiner will advance prosecution as King does not describe the use of a timer to continue a communication instance as recited in amended Claim 1."<sup>2</sup> Further, with respect to added dependent claim 50, petitioner asserts that "Patent Holder believes that a discussion of these features in light of King will also advance prosecution as the King reference does not describe that a timer is used to trigger the forwarding of a message instructing the requesting remote communication device to resubmit the initial data request as defined in new Claim 50."<sup>3</sup>

In this instance, third party requester has stated on the record that it will not further participate in the '1138 *inter partes* reexamination proceeding.<sup>4</sup> Thus, only a single party (patent owner) will now participate in the '1138 proceeding, and any interview that might be permitted in the proceeding. Additionally, patent owner has focused upon specific matters at issue in the proceeding to be discussed at the interview, pointing to particular features to be discussed with respect to the King reference, amended claim 1, and new dependent claim 50. Based on the present facts and circumstances, it is found that permitting a single interview to be conducted at this point in the '1138 *inter partes* proceeding is not anticipated to potentially hinder the ability

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<sup>1</sup> September 29, 2010 decision at pages 3-4.

<sup>2</sup> October 8, 2010 renewed petition under 37 CFR 1.183 at page 3.

<sup>3</sup> *Id.* at pages 3-4.

<sup>4</sup> See July 24, 2009 "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION; NOTICE OF LITIGATION SETTLEMENT."

of the Office to conduct the '1138 proceeding with special dispatch, but rather may well assist the Office in expeditiously resolving the proceeding.<sup>5</sup>

Accordingly, in view of the particular facts and circumstances set forth herein, in this instance and at this point, the record in the '1138 proceeding is deemed to present an extraordinary situation which justifies waiver of 37 CFR 1.955 to further the interests of the patent owner, members of the public who may be interested in the outcome of the proceeding, and the Office. Thus, patent owner's petition under 37 CFR 1.183 is granted to the extent that 37 CFR 1.955 is waived such that a single interview will be permitted, subject to the examiner's approval. It is noted, however, that there are no established regulatory or practice guidelines to govern the manner in which an interview in an *inter partes* reexamination proceeding is to be conducted. Therefore, the waiver of 37 CFR 1.955 so as to permit an interview is granted only to the extent that patent owner satisfies the following preliminary requirements.

## **Requirements and Guidelines for Conducting Interview**

### **A. Preliminary Requirements**

1. Promptly, upon receipt of the present decision, patent owner must contact the examiner in charge of the proceeding to identify the issues that are sought to be discussed, to determine if an interview will be granted with respect to those issues (which determination the examiner is directed to make based on criteria analogous to that of granting *ex parte* reexamination interviews), and to ascertain the examiner's desktop facsimile number.
2. At least three (3) working days prior to the interview, patent owner must file an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless the examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner, or to be hand-carried to the examiner, so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding – as an attachment to an Interview Summary form PTOL-474 (modified as needed for *inter partes* reexamination) to be completed by the examiner after the interview.
3. Patent owner must serve a copy of the papers discussed in item (2) above on the third party requester in accordance with 37 CFR 1.903, and include a copy of the certificate of service of such papers in the papers as filed in item (2) above.

### **B. Guidelines for Conducting the Interview**

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

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<sup>5</sup> The '1138 proceeding is ready for examiner action following patent owner's May 24, 2010 amendment, responsive to the March 24, 2010 Office action.

2. Patent owner must make every effort to conduct the interview in not more than one (1) hour. Patent owner may, however, show cause, at the interview, why more time is needed, and the examiner is also free to extend the interview, at the examiner's sole discretion.
3. The interview should be attended by the conferees who signed the March 24, 2010 Office action, or their substitutes (if the conferees are not reasonably available).
4. At the conclusion of the interview, the examiner will prepare an interview summary, using form PTOL-474, the *Ex Parte* Interview Summary Form, and making appropriate modifications thereto, taking into account that the present proceeding is an *inter partes* reexamination proceeding. A copy of the interview summary form is to be given to patent owner at the conclusion of the interview. A copy of the interview summary form will also be mailed to third party requester, and the original of the form is to be made of record in the Image File Wrapper for the proceeding.

#### C. Prosecution after the Interview

1. Patent owner must file a complete written statement of the reasons presented at the interview as warranting favorable action, to avoid termination or limitation of the proceeding as appropriate under 37 CFR 1.957. The written statement must be filed as a separate paper filed within one month from the date of the interview or with the response to the outstanding Office action (whichever is later).
2. All papers filed by patent owner in the '1138 *inter partes* reexamination proceeding must continue to be served in accordance with 37 CFR 1.903, and service must be reflected by attaching a certificate of service, or consideration of the document may be refused.

#### CONCLUSION

1. Patent owner's October 8, 2010 renewed petition under 37 CFR 1.183 is granted to waive the provisions of 37 CFR 1.955, to the extent that a single interview will be permitted, upon approval by the examiner and compliance with the Preliminary Requirements, as set forth above.
2. The provisions of 37 CFR 1.955 are waived solely on the present facts and circumstances, and solely for the purposes of conducting one interview with respect to the March 24, 2010 Office action and the May 24, 2010 patent owner response submission.
3. Any future petition for waiver of 37 CFR 1.955 will not be granted absent a further strong showing of necessity, including an explanation of why the basis for any further interview could not have been addressed in the first interview.

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

*Kenneth M. Schor*

---

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

11-30-10



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,139      04/06/2009      7085566      2454.1041REX      1785

22850      7590      09/29/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

ART UNIT      PAPER NUMBER

DATE MAILED: 09/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
CRESTRON ELECTRONICS, INC.  
ATTN: PHILIP KIRKPATRICK  
15 VOLVO DRIVE  
ROCKLEIGH, NJ 07647-2507

Date: **MAILED**  
**SEP 29 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001139  
PATENT NO. : 7085566  
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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OBLON, SPIVAK, MCCLELLAND, MAIER  
& NEUSTADT, L.L.P  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

(For Patent Owner)

CRESTRON ELECTRONICS, INC.  
ATTN: PHILIP KIRKPATRICK  
15 VOLVO DRIVE  
ROCKLEIGH, NJ 07647-2507

(For Third Party Requester)

MAILED

SEP 29 2010

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,139  
Filed: April 6, 2009  
For: U.S. Patent No. 7,085,566

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

This is a decision on patent owner's "PETITION FOR INTERVIEW UNDER 37 CFR § 1.183," filed on July 1, 2010.

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

The petition fee of \$400 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was charged to patent owner's credit card, as authorized on page 4 of the petition.

The petition is dismissed.

**BACKGROUND**

1. U.S. Patent No. 7,085,566 ("the '566 patent") issued to Burchard *et al.* on August 1, 2006.
2. A request for *inter partes* reexamination was deposited by a third party requester on January 22, 2009, which request was assigned control no. 95/001,139 ("the '1139 proceeding"). A corrected request for *inter partes* reexamination of the '566 patent was filed by the third party requester on April 6, 2009, and the '1139 proceeding was accorded a filing date of April 6, 2009.
3. On May 12, 2009, the Office mailed an order granting *inter partes* reexamination in the '1139 proceeding was mailed, concurrently with a first action closing prosecution (ACP), confirming the patentability of all of the claims subject to reexamination.
4. On July 24, 2009, the Office mailed a first right of appeal notice (RAN) in the '1139 proceeding.

5. On November 9, 2009, third party requester filed a corrected notice of appeal, to replace a notice of appeal filed on August 24, 2009, and stating that third party request had already filed a corresponding appeal brief on October 19, 2009.
6. On December 9, 2009, patent owner filed a respondent brief in the '1139 proceeding.
7. On April 26, 2010, the Office mailed a second ACP in the '1139 proceeding.
8. On May 21, 2010, third party requester filed a paper entitled "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION NOTICE OF LITIGATION SETTLEMENT" in the '1139 proceeding.
9. On May 26, 2010, patent owner filed a submission under 37 CFR 1.951(a) after the April 26, 2010 ACP.
10. On July 1, 2010, patent owner filed the instant petition paper entitled "PETITION FOR INTERVIEW UNDER 37 C.F.R. § 1.183."
11. On August 2, 2010, the Office mailed a second RAN in the '1139 proceeding.
12. On September 2, 2010, patent owner filed a notice of appeal.

## 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**

The instant petition under 37 CFR 1.183 has been fully considered. In the instant petition, petitioner patent owner requests waiver of 37 CFR 1.955, which prohibits interviews in *inter partes* reexamination. In particular, petitioner requests that it be granted an examiner interview in the '1139 proceeding and asserts that such interview would "serve to advance this reexamination by allowing the Examiner and Patent Holder to identify any specific claim language deemed necessary to terminate these proceedings."<sup>1</sup>

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 37 CFR 1.955, petitioner asserts that: (1) third party requester has withdrawn from the instant *inter partes* reexamination of the '566 patent, and (2) the interview would advance prosecution of the '1139 proceeding by allowing the examiner and patent owner to identify specific claim language that would terminate the proceeding.<sup>2</sup> Further, petitioner states on page 3 of the instant petition under 37 CFR 1.183:

As noted above, the Third-Party Requestor filed an Appeal Brief on October 19, 2009, and the Patent Holder filed a Respondent Brief on December 9, 2009. Both the Appeal Brief and Respondent Brief significantly differ, and often conflict, in claim construction and in the interpretation of the applied art. The Board has issued no decision resolving these differences. A suspension of 37 C.F.R. 1.955 would better serve to advance this reexamination to termination by allowing the Examiner and Patent Holder to efficiently resolve these remaining differences.

In this instance third party requester has stated on the record that it will not further participate in the '1139 *inter partes* reexamination proceeding.<sup>3</sup> Also, petitioner asserts in the instant petition that "no harm will come to any party if this Petition is granted since the Third-Party Requestor, and real party in interest, Crestron Electronics, Inc., has confirmed that it will no longer participate in this reexamination proceeding."<sup>4</sup>

It is to be noted, however, that on April 26, 2010, the Office mailed a second ACP in the '1139 proceeding, and on May 21, 2010, third party requester filed its paper stating that it will not further participate in the '1139 *inter partes* reexamination proceeding. At that point in time, patent owner could have filed a request for waiver of the 37 CFR 1.955 proscription of

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<sup>1</sup> See July 1, 2010 petition under 37 CFR 1.183 at page 3.

<sup>2</sup> *Id.*

<sup>3</sup> See May 21, 2010 "THIRD PARTY REQUESTER NOTICE OF NON-PARTICIPATION NOTICE OF LITIGATION SETTLEMENT" (stating that: "Third Party Requester has entered into a settlement agreement with Patent Owner and as such withdraws from continued active participation in the on-going above reexamination" and that third party requester "requests to be excluded from further proceedings in this *inter partes* reexamination to the fullest extent allowed under the Patent Laws, Rules and operating procedures of the Patent Office.")

<sup>4</sup> Petition under 37 CFR 1.183 at page 4.

interviews in an *inter partes* reexamination proceeding, to clarify matters, prior to filing any submission under 37 CFR 1.951(a). Instead, patent owner, on May 26, 2010, filed a submission under 37 CFR 1.951(a), and did not file the present petition until July 1, 2010. In the meantime, the Central Reexamination Unit was considering the May 26, 2010 submission under 37 CFR 1.951(a), and working on a RAN, which it ultimately issued on August 2, 2010. At this point in time, it is not found equitable to interrupt the proceeding, for an attempted resolution of the asserted “conflict, in claim construction and in the interpretation of the applied art” in the “Appeal Brief on October 19, 2009, and the Patent Holder filed a Respondent Brief on December 9, 2009.” Patent owner could have requested an extension of time for response to the ACP based on a petition to waive the 37 CFR 1.955 proscription of an interview – prior to filing submission under 37 CFR 1.951(a). Instead patent, patent owner delayed filing its petition until July 1, 2010, thereby compromising the Office’s statutory duty to conduct reexamination proceedings with special dispatch.<sup>5</sup> Patent owner’s delay does not represent an extraordinary situation, when justice requires interruption of a proceeding on appeal, with the possibility of backing up of the proceeding based on some complication based on the arranging of the interview, and further new issues that petitioner may choose to present at the interview.

#### CONCLUSION

1. Patent owner’s July 1, 2010 petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.955 is dismissed.
2. The time period for filing patent owner’s appeal brief continues to run following patent owner’s notice of appeal, filed on September 2, 2010.
3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



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

9-28-10

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<sup>5</sup> See 35 U.S.C. 314 (c).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,143	02/11/2009	7343414	4292.01 REX01	4158
24113	7590	02/17/2011	EXAMINER	
PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

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HOUSTON, TX 77002

Date:

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**FEB 17 2011**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001143  
PATENT NO. : 7343414  
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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PEDERSEN, P.A.  
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MINNEAPOLIS, MN 55402-2100

(For Patent Owner)

MAILED

FEB 17 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For Third Party Requester)

*In re:* Lipscomb et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,143  
Request Deposited: February 11, 2009  
For: U.S. Patent No. 7,343,414

: DECISION ON PETITION  
: TO WITHDRAW RIGHT  
: OF APPEAL NOTICE  
: FILED UNDER 37 CFR 1.181  
:

This is a decision on the October 14, 2010 petition from Patent Owner entitled "PETITION UNDER 37 C.F.R. 1.181 FOR WITHDRAWAL OF PENDING RIGHT OF APPEAL NOTICE" and Third Party Requester's October 21, 2010 opposition thereto.

The petition appears to be timely filed and no fee is due. The petition is before the Director of the Central Reexamination Unit for reconsideration.

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

### BACKGROUND

1. On September 16, 2010, an Right of Appeal Notice (RAN) was mailed in the present proceeding.
2. On October 14, 2010, Patent Owner (PO) filed a the instant petition requesting the RAN be withdrawn as premature.

Art Unit: 3992

3. On October 21, 2010, Third Party Requester (TPR) filed comments in opposition to Patent Owner's petition. It is noted TPR filed the opposition under 37 CFR 1.182 and/or 37 CFR 1.183 if necessary.

### RELEVANT AUTHORITY

37 CFR 1.953 states:

**37 CFR 1.953. Examiner's Right of Appeal Notice in inter partes reexamination.**

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

37 CFR 1.181 (f) states:

(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.

MPEP 2671.03 (IV) states:

Should the examiner issue Office action without panel review, the patent owner or the third party requester who wishes to object must promptly file a paper alerting the Office of this fact. (The failure to hold a panel review conference would be noted by the parties where there are no conferees' initials at the end of the Office action.) Any challenge of the failure to hold a panel review conference must be made within two weeks of receipt of the Office action issued, or the challenge will not be considered. In no event will the failure to hold a patentability review conference, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination proceeding.

### DECISION

At the onset it is noted TPR's petition under 37 CFR 1.182 or 37 CFR 1.183 has been construed as an opposition to the PO petition under 37 CFR 1.181 in as much as requester may support the action taken by the Office, since the Office has unequivocal right to enforce its rules and practice and requester may explain why the Office acted within its right.

PO petitions for supervisory review pursuant to 37 CFR 1.181 to withdraw the September 16, 2010 RAN as it was not in compliance with the requirements of a panel consideration as set forth in MPEP 2672,02(III). PO further opines the RAN is premature until the PO's outstanding petition filed under 37 CFR 1.181 filed December 17, 2009 is decided.

Notwithstanding TPR's submission that MPEP 2677.03 (IV) proscribes complaints regarding the sufficiency of the panel review be made within two weeks and notation that the same

Art Unit: 3992

section of the MPEP declares "In no event will the failure to hold a patentability review conference, but itself, be grounds for vacating any Office decisions(s) or actions(s) and "restarting" the reexamination proceeding, the issue appears moot as a second RAN was issued by the Office on October 20, 2010 containing the proper number of conferee signatures.

As to PO's position regarding the RAN was premature as it was issued prior to decision on PO's pending 37 CFR 1.181 petition, the Office is persuaded as 37 CFR 1.181(f) clearly 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". Accordingly, no basis is seen for granting the relief requested by petitioner.

In view of the above, the petition is **DISMISSED**.

### CONCLUSION

Telephone inquiries related to this decision should be directed to Jessica. Harrison, at (571) 272-4449 or, in her absence, to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.



---

Remy Yucel  
Director, Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,143	02/11/2009	7343414	4292.01 REX01	4158

24113                      7590                      02/18/2011

PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A.  
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EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 02/18/2011

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HOUSTON, TX 77002

Date:

MAILED

FEB 18 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001143  
PATENT NO. : 7343414  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For Third Party Requester)

*In re:* Lipscomb et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,143  
Request Deposited: February 11, 2009  
For: U.S. Patent No. 7,343,414

: DECISION ON PETITION  
: TO RECLASSIFY ACTION  
: CLOSING PROSECUTION AS  
: NON FINAL OFFICE ACTION  
: UNDER 37 CFR 1.181

This is a decision on the December 17, 2009 petition from Patent Owner entitled "PETITION UNDER 37 C.F.R. 1.181 FOR RECLASSIFICATION OF THE ACTION CLOSING PROSECUTION AS A NON-FINAL OFFICE ACTION" and Third Party Requester's December 23, 2009 opposition thereto.

The petition appears to be timely filed and no fee is due. The petition is before the Director of the Central Reexamination Unit for reconsideration.

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

### BACKGROUND

1. On November 20, 2009, an Action Closing Prosecution (ACP) was mailed in the present proceeding.
2. On December 17, 2009, Patent Owner (PO) filed a the instant petition requesting the ACP be reclassified as a non-final office action.

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3. On December 23, 2009, Third Party Requester (TPR) filed comments in opposition to Patent Owner's petition as provided for by MPEP 2672 (VI).

### RELEVANT AUTHORITY

37 CFR 1.949 states:

**§ 1.949 Examiner's Office action closing prosecution in inter partes reexamination.** Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the inter partes reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment. [Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

MPEP 2672 (VI) states:

#### VI. ACTION CLOSING PROSECUTION - PREMATURE

If the patent owner is of the opinion that the Office action closing prosecution in the inter partes reexamination proceeding is premature, the patent owner may, in addition to the comments submitted under 37 CFR 1.951(a), file a petition under 37 CFR 1.181 within the time period for filing the comments under 37 CFR 1.951(a). The third party requester may then once file, as a paper separate from any submission under 37 CFR 1.951(b), comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester.

### DECISION

Patent Owner (PO) request reclassification of the November 20, 2009 ACP as a non-final office action apparently on the basis it is premature as provided for under MPEP 2672 (VI). In support for his argument the ACP was premature, two positions are submitted for consideration. First PO submits the examiner failed to fully review PO's secondary consideration evidence. Second PO submits the ACP is premature because equities demand that PO has [be given] the opportunity to present additional evidence before prosecution is cut off.

In support of his first premise, PO takes issue with the fact that the examiner was not persuaded by the evidence presented and argues that the examiner must have only provided a cursory review of the evidence presented. PO opines the examiner dismissed the declarations as lacking sufficient nexus with the claimed invention by simply parroting the TPR's argument. PO argues there is a presumed nexus if the market product "embodies the claimed features and is coextensive with them". Yet, PO also admits that the terms and phrases used in the declarations were a rhetorical tool to conveniently and quickly summarize some of the major differences between the claimed inventions and the prior art. PO, in his own words, "failed to

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regurgitate exact term from the claim language” and concludes therefore the examiner failed to consider the evidence.

As PO correctly states in his petition, evidence of commercial success is probative as a secondary indicia of non-obviousness only when a nexus between the commercial success and the claimed invention is demonstrated [PO citation omitted]. The term “nexus” designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corb. V. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988). Review of the evidence in this proceeding indicate that PO chose to present his evidence of commercial success without regurgitation of the terms from the claim language. Further, there was no explanation provided or attempt to relate the claimed invention to the evidentiary showing. Review of the evidence in this proceeding further indicates the examiner gave a full and fair review of the evidence provided. Neither the Office nor the examiner can infer what PO meant to say when he chose a rhetorical tool for convenience and failed to use the terminology employed in the claim language. The examiner reviewed the evidence for a factually and legally sufficient connection between the claimed invention and the allegedly commercially successful device and found none. That the examiner agrees with TPR in this conclusion in no way reflects any lack of full consideration of the evidence presented. There appears to be no basis for granting PO’s requested relief.

As to PO’s second position that equities demand that PO has [be given] the opportunity to present additional evidence before prosecution is cut off PO offers multiple arguments. While the PO believes that the declarations as originally submitted comply with both the spirit and letter of the legal requirements for establishing nexus in the context submitted, PO opines that he is now limited in his ability to present additional evidence due to the nature of conduct of *inter partes* reexamination proceedings under special dispatch. PO submits it was never assumed that the use of his chosen rhetorical tool would be improperly misconstrued by the examiner as somehow representing claim scope as different from the actual claim language. PO’s position is not persuasive. PO has had available to him the same opportunity to present evidence in support of patentability as has every patent owner in an *inter partes* reexamination proceeding. The intention that the second office action in an *inter partes* reexamination proceeding be an ACP is clear in the MPEP and the intent to conduct the instant proceeding with special dispatch expressly stated in the first Office action. *Inter partes* reexamination is a focused proceeding and not an unlimited prosecution. That PO was unconvincing to the examiner has remedy in the system other than demanding the proceeding be delayed. Additional evidence may be presented in the proceeding provided the requirements of 37 CFR 1.116 are addressed. Alternatively, as the ultimate conclusion of the examiner’s determination the evidence lacks clear nexus to the claims at issue, the propriety of the examiner’s conclusion may be subject to appeal before the Board of Patent Appeals and Interferences. Further, in the instant proceeding it is noted these arguments appear moot in as much as PO presented additional argument to this point in the response filed after November 20, 2009 ACP

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and the Right of Appeal Notice (RAN) of October 20, 2010 treats these arguments on pp 26-27. Accordingly, no basis for the requested relief is seen.

It is noted that TPR's petition in opposition to the 1.181 petition under consideration herein was given consideration: no further comments are deemed necessary.

In summary, it appears the designation of the Office action mailed November 20, 2009 as an Action Closing Prosecution by the examiner was proper. No compelling evidence is seen for altering that designation. Further, it appears Patent Owner has had fair opportunity and has had his evidence fully considered by the examiner. No compelling evidence is seen demonstrating lack of equity. Accordingly, there appears no basis for the requested relief to be granted.

In view of the above, the petition is **DISMISSED**.

#### CONCLUSION

Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.



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Remy Yucel  
Director, Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,143	02/11/2009	7343414	4292.01REX01	4158
24113	7590	02/25/2011	EXAMINER	
PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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**APPLE, INC.**  
Third Party Requester

v.

**ZAPMEDIA SERVICES, INC.**  
Patent Owner

---

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414

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DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)," filed January 26, 2011 ("Petition"). In the Petition, Patent Owner requests "that evidentiary rule 37 C.F.R. § 1.943(c) . . . be waived for the limited purpose of entering Patent Owner's Appeal Brief, which is . . . 53 pages and 16,951 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 7,343,414 issued on March 11, 2008 with 15 claims. The '414 patent was assigned to Patent Owner, ZapMedia Services, Inc. ("ZapMedia").
2. Third Party Requester, Apple, Inc. ("Apple") filed a request for *inter partes* reexamination on February 11, 2009. Reexamination Control 95/001,143 was assigned to this request.
3. On April 8, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
4. On April 16, 2009, the Office issued a Non-Final Office Action in the *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
5. On June 16, 2009, ZapMedia filed a response to the Office Action of April 16, 2009.
6. On July 16, 2009, Apple, filed comments regarding ZapMedia's response to the Non-Final Office Action of April 16, 2009.
7. On November 20, 2009, the Office issued an Action Closing Prosecution ("ACP") rejecting claims 1-15. The length of the ACP was 62 pages.
8. On September 16, 2010, the Office issued a Right of Appeal Notice ("RAN"), rejecting claims 1-15. The length of the RAN was 63 pages.
9. On October 20, 2010, the Office issued a revised RAN, rejecting claims 1-15. The length of the Revised RAN was 63 pages.
10. On November 22, 2010, ZapMedia filed a Notice of Appeal for claims 1-15.

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414

11. On January 26, 2011, Apple filed a Notice of Cross Appeal for claims 1-15.
12. On January 26, 2011, ZapMedia filed an Appellant's 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).

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414

Also, the sections of an appellant's brief that are required under 37 C.F.R. § 41.678(c)(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).

#### ANALYSIS

ZapMedia argues that the requested waiver is needed so that it can comprehensively reply to the Examiner's rejections. Petition, pp. 1-3.

With the exceptions noted above, ZapMedia's Appellant's Brief is 51 pages in length.

It is noted that the ACP of November 20, 2009 was 62 pages in length and the revised RAN of October 20, 2010 was 63 pages in length.

ZapMedia represents that despite its "efforts to condense its arguments to meet the page and word limits[, it] requires additional pages to adequately address each ground of rejection and issue on appeal." Petition, p. 5. The issues on appeal include six prior art rejections, consideration of evidence relating to patentability, and consideration of legal issues.

In view of the number of different issues presented in this appeal, ZapMedia's request to file an Appeal Brief having a length of 51 pages is deemed reasonable.

However, as expressly stated in Rule 1.183, a fee is required for consideration of petitions under this Rule.

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414

DECISION

In view of the forgoing, the Petition is DENIED without prejudice.  
ZapMedia is granted one month in which to pay the requisite fee under Rule  
1.183.



---

James T. Moore  
Acting Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,143	02/11/2009	7343414	4292.01REX01	4158
35856	7590	05/24/2011	EXAMINER	
SMITH RISLEY TEMPEL SANTOS LLC Two Ravinia Drive Suite 700 ATLANTA, GA 30346			ART UNIT	PAPER NUMBER

DATE MAILED: 05/24/2011

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Date:

**MAILED**

**MAY 24 2011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001143  
PATENT NO. : 7343414  
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.
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95/001,143

02/11/2009

7343414

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02/25/2011

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EXAMINER

ART UNIT      PAPER NUMBER

DATE MAILED:

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(Courtesy Copy)

In re Lipscomb et al  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,143  
Filed: February 11, 2009  
For: U.S. Patent No. 7,343,414

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

This decision is in response to the January 26, 2011 patent owner petition, entitled "Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rules 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)" (the January 26, 2011 patent owner petition).

This decision also addresses:

- requester's opposition paper filed on February 28, 2011, entitled "Third Party Requester's Opposition to Patent Owner's Petition Pursuant to 37 C.F.R. § 1.183 For Suspension of Rules" (the February 11, 2011 requester opposition); and
- patent owner's power of attorney and change of correspondence address, filed on June 16, 2009 (the June 16, 2009 power of attorney and change of correspondence address).

The January 26, 2011 petition, the February 28, 2011 requester opposition, the June 16, 2009 power of attorney change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration.

### SUMMARY

The January 26, 2011 patent owner petition under 37 CFR 1.183 is **dismissed**.

The June 16, 2009 power of attorney and change of correspondence address of the patent owner is **ineffective**.

## BACKGROUND

- On March 11, 2008, U.S. Patent 7,343,414 (the '414 patent) issued to Lipcomb et al.
- On February 11, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001,143 (the '1143 proceeding).
- On April 8, 2009, the United States Patent and Trademark Office (the Office) mailed an order granting *inter partes* reexamination in the '1143 proceeding.
- On April 16, 2009, the Office mailed a nonfinal Office action.
- On June 16, 2009 the patent owner filed a change of power of attorney and correspondence address.
- Also on June 16, 2009, the patent owner submitted a response, including an amendment, and declarations under 37 CFR 1.132 of Eric Andersland, Gene Hoffman, Jr., and Eric Hartz.
- On July 16, 2009, the requester filed comments.
- On November 20, 2009, the Office mailed an action closing prosecution (ACP).
- On December 11, 2009, the patent owner filed a request for an extension of time.
- On December 16, 2009, the requester filed an opposition to patent owner's December 11, 2009 request for an extension of time.
- On December 16, 2009, the Office mailed a decision granting-in-part patent owner's December 11, 2009 request for an extension of time, extending the time period for response by one month.
- On December 17, 2009, the patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.181 For Reclassification of the Action Closing Prosecution as a Non-Final Office Action" (the December 17, 2009 patent owner petition).
- On December 23, 2009, the requester filed a paper in opposition to patent owner's December 17, 2009 petition. The opposition paper is entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. 1.181 for Reclassification of the Action Closing Prosecution as a Non-Final Office Action" (the December 23, 2009 requester opposition).
- On January 25, 2010, the patent owner filed § 1.951(a) comments after ACP.

- On February 18, 2010, the requester filed § 1.951(b) comments after ACP.
- On September 16, 2010, the Office mailed a right of appeal notice (RAN).
- On October 14, 2010, the patent owner filed a petition entitled “Petition Under 37 C.F.R. § 1.181 For Withdrawal of Pending Right of Appeal Notice” (the October 14, 2010 patent owner petition).
- On October 20, 2010, the Office re-mailed the right of appeal notice (RAN).
- On October 21, 2010, the requester filed a paper in opposition to patent owner’s October 14, 2010 petition. The opposition paper is entitled “Third Party Requester’s Opposition to Patent Owner’s Petition for Withdrawal of Pending Right of Appeal Notice” (the October 21, 2010 requester opposition).
- Also on October 21, 2010, the requester filed a notice of cross-appeal.
- On November 22, 2010, the patent owner filed a notice of appeal.
- On November 26, 2010, the requester filed a notice of cross-appeal.
- On January 26, 2011, the patent owner filed an appellant’s brief.
- Also on January 26, 2011, the patent owner filed a petition entitled “Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)” (the January 26, 2011 petition for page length waiver).
- Also on January 26, 2011, the patent owner filed the present petition, entitled “Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rules 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)” (the January 26, 2011 patent owner petition for late entry of evidence). The present petition is accompanied by two newly submitted declarations under 37 CFR 1.132, of Justin W. Woo and of Marin Kaliski, Ph.D., respectively.
- On February 17, 2011, the Office mailed a decision dismissing patent owner’s October 14, 2010 petition.
- On February 18, 2011, the Office mailed a decision dismissing patent owner’s December 17, 2009 petition.
- On February 25, 2011, the Office mailed a decision by the Board of Patent Appeals and Interferences (Board) denying patent owner’s January 26, 2011 page length waiver petition for failure to pay the petition fee.

- On February 28, 2011, the requester filed a paper in opposition to patent owner's January 26, 2011 petition for late entry of evidence. The opposition paper is entitled "Third Party Requester's Opposition to Patent Owner's Petition Pursuant to 37 C.F.R. § 1.183 For Suspension of Rules" (the February 28, 2011 requester opposition).
- Also on February 28, 2011, the requester filed a respondent's brief.
- Also on February 28, 2011, the requester filed a petition entitled "Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rules Under 37 C.F.R. § 1.943(c)" (the February 28, 2011 requester petition for page length waiver).
- On March 11, 2011, the patent owner filed a petition entitled "Petition Pursuant to 37 C.F.R. 41.3 for Supervisory Review", requesting review of the Board's February 25, 2011 decision denying requester's petition for failure to pay the petition fee (the patent owner's March 11, 2011 petition).

### DECISION

The patent owner petition under 37 CFR 1.183 requests that the Office waive the following rules and enter evidence newly submitted with patent owner's concurrently-filed appellant's brief:

- 37 CFR 1.116(f) (prohibiting submission of evidence after RAN);
- 37 CFR 1.939(a) (prohibiting submission of unauthorized papers in *inter partes* reexamination); and
- 37 CFR 41.63(c) (limiting the filing of new evidence after the filing of a notice of appeal in *inter partes* reexamination).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on the petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

As an initial matter, the patent owner repeatedly argues that the issuance of the RAN, and of the re-mailed RAN, "precluded [the patent owner] from submitting a Claim Construction Order on the '414 Patent . . . in the Zap Media Lawsuit . . . and a subsequent Order on Objections to Claim Construction Order".<sup>1</sup> There was nothing to prevent the patent owner, however, from submitting these court documents under 37 CFR 1.555 or under 37 CFR 1.985. Thus, contrary to patent owner's arguments, the patent owner at no time was "precluded" by the issuance of the RAN, and of the re-mailed RAN, from filing these court documents in the present reexamination proceeding.

The patent owner asserts that the newly submitted declaration under 37 CFR 1.132 of Martin Kaliski, Ph.D. (the Kaliski declaration) "present[s] the non-confidential opinions of an expert witness retained by Owner in a co-pending litigation", i.e., *ZapMedia Services, Inc. V. Apple*,

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<sup>1</sup> See page 3 of the present petition.

*Inc.*, Civil Action File No: 2:08-cv-00104-DF-CE (the copending litigation), which involves the '414 patent. The patent owner argues that the Kaliski declaration "presents additional evidence of secondary indicia of non-obviousness including evidence of commercial success, addressing a long-felt need and that the disclosed invention went against the conventional wisdom in the art". The patent owner asserts that the Kaliski declaration "relies in part upon a review of the Claim Construction Orders as well as the Original and Amended Expert Reports of Dr. Kelly, expert witness for Requestor, dated August 4, 2010 and September 7, 2010". The patent owner alleges that the Kaliski declaration "could not have been prepared until Owner's expert had an opportunity to review all the documents, which were not available until after the issuance of the ACP and less than 10 days before the issuance of the RAN".

The patent owner, however, has not sufficiently shown why it was necessary to wait until the filing of patent owner's appellant's brief, on January 26, 2011, to file the newly submitted evidence. Specifically, it is not clear why it was necessary to wait for the court's claim construction order, because the Office is not bound by the court's claim construction. As pointed out by the requester in its February 28, 2011 opposition paper, the Office employs the broadest reasonable interpretation standard when interpreting the scope of the claims, which differs from the standard used by the courts. "Claims are given 'their broadest reasonable interpretation, consistent with the specification in reexamination proceedings.'" *In re Trans Texas Holding Corp.*, 498 F.3d 1290, 1298 (Fed. Cir. 2007) (citing *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). Furthermore, the patent owner provides no explanation as to why it was necessary to wait for the original and amended expert reports, which were apparently filed by the requester in the copending litigation, before filing the presently submitted evidence. For example, if the original and amended expert reports solely involve claim construction issues, it has not been explained why the patent owner decided to wait for these opinions, because the Office is not bound by requester's proffered claim construction. In summary, it is not clear why the patent owner decided to wait for the court's claim construction order, the order on the objections to the court's claim construction order, and the requester's expert reports filed in the copending litigation, before filing a declaration which, as admitted by the patent owner, is directed to secondary indicia of non-obviousness, i.e., an alleged showing of commercial success and long-felt need, and an alleged showing that "the disclosed invention went against the conventional wisdom in the art".

Furthermore, the patent owner, by its own admission, intentionally waited until after the issuance of **all** of the above-identified court documents before filing its rebuttal evidence, i.e., the Kaliski declaration. The patent owner asserts that the Kaliski declaration "refut[es] the Examiner's position in the Action Closing Prosecution . . . and both RANs." The patent owner, however, had an opportunity after the ACP to submit evidence rebutting the examiner's position in the ACP, and chose not to do so. The patent owner has not shown that the examiner's position in the RAN differs from the examiner's position in the ACP; in fact, the examiner's position appears, upon brief review, to be substantially the same in each instance. Furthermore, the Office is required to conduct reexamination proceedings with special dispatch, pursuant to 35 USC 314(c). The Office cannot, as a matter of policy, permit a substantial delay caused by patent owner's deliberate decision to wait over one year after the November 20, 2009 mail date of the ACP for the issuance of an entire series of court documents and after the issuance of the RAN

and of the re-mailed RAN, before filing, on January 28, 2011, evidence rebutting the examiner's position in the ACP.

For the reasons given above, the patent owner's bald argument that it was necessary to wait for the issuance of the above-identified court documents and for the issuance of the RAN, and of the re-mailed RAN, before filing the newly submitted declaration does not provide a sufficient showing of extraordinary circumstances, such that justice should require waiver of the rules.

The patent owner repeatedly argues that the examiner's decision to issue a RAN, and a re-mailed RAN, before a decision was rendered on patent owner's petition under 37 CFR 1.181 "to reclassify" the ACP as a nonfinal Office action created an extraordinary situation such that justice requires waiver of 37 CFR §§ 1.116(f), 1.939(a), and 41.63(c). The patent owner submits a declaration under 37 CFR 1.132 of Justin N. Woo as evidence that the patent owner was "unable to find a single other *inter partes* reexamination where a similar situation has occurred in which a RAN was issued while there was an outstanding and undecided petition under Rule 1.181 . . .". However, as argued by the requester in its opposition paper, 37 CFR 1.181(f) unambiguously states that "the mere filing of a petition will not . . . act as a stay of other proceedings", such as reexamination proceedings. There is no rule that precludes the examiner from continuing prosecution in a reexamination proceeding prior to the rendering of a decision on a petition under 37 CFR 1.181. As argued by the requester, if the Office were to stay each reexamination proceeding in order to decide every petition filed by the parties, the Office would be prevented from conducting reexamination proceedings with special dispatch as required by 35 USC 314(c). Furthermore, if the rules permitted a party to delay a reexamination proceeding, including those on appeal, merely by filing a petition under 37 CFR 1.181, then these petitions could be filed at every opportunity by a party attempting to delay the reexamination process.

The patent owner argues that the examiner's decision to close prosecution by issuing the ACP and the RAN violates patent owner's right "to submit rebuttal evidence as guaranteed under the APA [Administrative Procedures Act]". 5 U.S.C. § 556(d) of the APA states that: "[A] party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts". The APA, however, does not authorize the *late submission* of rebuttal evidence, which results in an unwarranted substantial delay of a reexamination proceeding, contrary to a statutory mandate to resolve it with special dispatch, in an instance when the rebuttal evidence could have been prudently submitted earlier.

The patent owner further asserts that there is a "conflict" between the Board's policy, as stated in *Ex parte Frye*,<sup>2</sup> and the policy set forth in the Federal Register notice, *Streamlined Procedure for Appeal Brief Review in Inter Partes Reexamination Proceedings*.<sup>3</sup> In *Ex parte Frye*, the Board explains that the Board does not give deference to the examiner's findings, and instead reviews the entire record to reach its own conclusions on appealed issues. In the Federal Register notice, the Office informs the public that petitions involving the entry of evidence on appeal remain delegated to the patent examining corps. The patent owner alleges that this "conflict" between

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<sup>2</sup> 94 USPQ2d 1072 (BPAI 2010).

<sup>3</sup> 75 Fed. Reg. 50750 (August 17, 2010).

the Board's policy and the Federal Register notice precludes the Board from reviewing the entire record. The policy of the Board, however, is to review the entire record and reach its own conclusions *on appealed issues*. Furthermore, the "entire" record does not include unentered papers. The presently submitted Kaliski declaration has not been entered into the official record, and does not form part of the appeal. The Board's policy does not authorize the late entry of rebuttal evidence in the proceeding, or the unlimited entry of rebuttal evidence on appeal. Furthermore, the Board in any event has access to patent owner's petitions and the Office's decisions on those petitions. Thus, there is no "conflict" between the Board's policy and the policy of the Federal Register notice, as alleged by the patent owner.

The patent owner further argues that any decision to reopen prosecution rendered by the patent examining corps on patent owner's earlier-filed petitions under 37 CFR 1.181 would "overturn any BPAI decision in the present case and render all the resources expended by Owner in appealing the reexamination to BPAI moot". The patent owner's petitions under 37 CFR 1.181, however, request withdrawal of the ACP and of the RAN, respectively, and involve subject matter that is petitionable, but not appealable. Furthermore, jurisdiction of this proceeding does not pass to the Board until "a docketing notice is entered after time period for filing the last rebuttal brief expires or the examiner acknowledges the receipt and entry of the last rebuttal brief".<sup>4</sup> Thus, no decision by the Board would be "overturned" by a decision granting patent owner's request to withdraw the ACP or the RAN and reopen prosecution. In any event, a decision dismissing patent owner's October 14, 2010 petition to withdraw the RAN was mailed on February 17, 2011, and a decision dismissing patent owner's December 17, 2009 petition to withdraw the ACP was mailed on February 18, 2011. Regarding the expenditure of resources, the patent owner chose to wait before filing its rebuttal evidence. Had the patent owner acted with prudence, the appeal may have been avoided.

Finally, the patent owner asserts that it was required to pay a petition fee when filing its petition under 37 CFR 1.181, "which . . . reinforce[d] the reasonable expectation of the Patent Owner that a decision on the petition would be granted". No petition fee, however, is required for filing a petition under 37 CFR 1.181.<sup>5</sup>

For the reasons given above, the patent owner has simply not shown extraordinary circumstances, such that justice requires waiver of 37 CFR §§ 1.116(f), 1.939(a), and 41.63(c).

Accordingly, the December 17, 2010 patent owner petition under 37 CFR 1.183 is **dismissed**.

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<sup>4</sup> *Streamlined Procedure for Appeal Brief Review in Inter Partes Reexamination Proceedings*, 75 Fed. Reg. 50750 (August 17, 2010).

<sup>5</sup> However, even if the patent owner filed a petition which required a fee, such as the present petition under 37 CFR 1.183, the patent owner is reminded that petition fees are required to cover the costs of processing and of treating the petition. The Office does not render a decision on a petition in the absence of the required fee. If a petition is filed and the petition fee is paid, the Office reasonably presumes that the petitioner wishes the Office to treat the petition as to its substance, whether the petition is later granted, dismissed, or denied. If the fee were collected only when the petition is to be granted, then the Office would be addressing the substance of a dismissed petition, contrary to the regulations that require a fee as an element of the petition, and would be expending resources without the cost recovery. For this reason, the mere fact that a petition fee is required cannot reasonably provide the petitioner with an expectation that the petition will be granted.

***The June 16, 2009 Power of Attorney and Change of Correspondence Address is Ineffective***

The power of attorney and change of correspondence address, filed by the patent owner on June 16, 2009, is **ineffective**.

The power of attorney is signed by the assignee; however, **Office records fail to reveal that a statement under 37 CFR 3.73(b) has been filed in this proceeding.** Because the assignee has failed to establish its right to take action pursuant to 37 CFR 3.73(b), the power of attorney, signed by the assignee and filed on June 16, 2009, is ineffective. See 37 CFR 3.71(c). See also MPEP 324 and MPEP 402.07. **For this reason, the patent practitioner who filed this petition, Mr. Brad Pedersen, of Patterson, Thunte Christensen Pedersen, P.A., is not of record in this proceeding.** In the absence of a properly executed change of power of attorney in this proceeding, the law firm of Smith, Risley, Tempel and Santos LLC, of Atlanta, GA, will remain of record in this proceeding.

Furthermore, the address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 11/162,716, 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. Brad Pedersen. **However, in the absence of a proper change of correspondence address in the patent file, application no. 11/162,716, 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 January 28, 2011 patent owner petition under 37 CFR 1.183 is **dismissed**.
- The June 16, 2009 power of attorney and change of correspondence address of the patent owner is **ineffective**.
- The patent practitioner who filed this petition, Mr. Brad Pedersen, of Patterson, Thunte Christensen Pedersen, P.A., is not of record in this proceeding. In the absence of a properly executed change of power of attorney in this proceeding, the law firm of Smith, Risley, Tempel and Santos LLC, of Atlanta, GA, will remain of record in this proceeding.
- A courtesy copy of this decision is being mailed to the practitioner who submitted the present patent owner petition, Mr. Brad Pedersen. **However, in the absence of a proper change of correspondence address in the patent file, application no. 11/162,716, 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

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

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



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

5-23-11  
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,143	02/11/2009	7343414	4292.01REX01	4158
35856	7590	06/07/2011	EXAMINER	
SMITH RISLEY TEMPEL SANTOS LLC Two Ravinia Drive Suite 700 ATLANTA, GA 30346			ART UNIT	PAPER NUMBER

DATE MAILED: 06/07/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

APPLE, INC.  
Third Party Requester

v.

ZAPMEDIA SERVICES, INC.  
Patent Owner

---

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414  
Technology Center 3900

---

DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 37 C.F.R. § 41.3 for Supervisory Review," filed March 11, 2011. In the Petition, Patent Owner seeks reconsideration and grant of the earlier "Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)" filed January 26, 2011, which was denied on February 25, 2011 for failure to pay the appropriate fee. Petition Pursuant to 37 C.F.R. § 41.3, p. 2.

*See* 75 Fed. Reg. 50,750 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge to decide this request.

Reexamination Control 95/001,143  
Patent 7,343,414

## FINDINGS

1. Patent 7,343,414 issued on March 11, 2008 with 15 claims. The '414 patent was assigned to Patent Owner, ZapMedia Services, Inc. ("ZapMedia").
2. Third Party Requester, Apple, Inc. ("Apple") filed a request for *inter partes* reexamination on February 11, 2009. Reexamination Control 95/001,143 was assigned to this request.
3. On April 8, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
4. On April 16, 2009, the Office issued a Non-Final Office Action in the *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
5. On June 16, 2009, ZapMedia filed a response to the Office Action of April 16, 2009.
6. On July 16, 2009, Apple filed comments regarding ZapMedia's response to the Non-Final Office Action of April 16, 2009.
7. On November 20, 2009, the Office issued an Action Closing Prosecution ("ACP") rejecting claims 1-15. The length of the ACP was 62 pages, including coversheet.
8. On September 16, 2010, the Office issued a Right of Appeal Notice ("RAN"), rejecting claims 1-15. The length of the RAN was 63 pages, including coversheet.
9. On October 20, 2010, the Office issued a revised RAN, rejecting claims 1-15. The length of the Revised RAN was 63 pages, including coversheet.

Reexamination Control 95/001,143  
Patent 7,343,414

10. On November 22, 2010, ZapMedia filed a Notice of Appeal for claims 1-15.
11. On November 26, 2011, Apple filed a Notice of Cross Appeal for claims 1-15.
12. On January 26, 2011, ZapMedia also filed an Appellant's Brief along with a "Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)."
13. On February 25, 2011, the Board of Patent Appeals and Interferences (Board) entered a Decision on Petition (Decision) **denying** ZapMedia's Petition Pursuant to 37 C.F.R. § 1.183 for failure to pay the fee required for consideration of petitions under this rule. Decision, p. 4. The Decision, addressing specifically the page length sought, notes that, "[i]n view of the number of different issues presented in this appeal, ZapMedia's request to file an Appeal Brief having a length of 51 pages is deemed reasonable." *Id.*

#### RELEVANT AUTHORITY

37 C.F.R. § 41.3 provides:

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

- (1) Issues committed by statute to a panel, and
- (2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action. (1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

- (i) File the petition within 14 days from the date of the action from which the party is requesting relief, and
- (ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

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.

Reexamination Control 95/001,143  
Patent 7,343,414

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

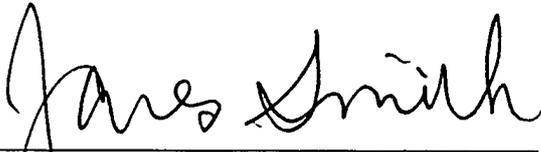
ZapMedia's Petition Pursuant to 37 C.F.R. § 41.3 has been filed timely and no fee is required. In the Petition Pursuant to 37 C.F.R. § 41.3, ZapMedia states that "[t]he Petition under Rule 1.183 was accompanied by the requisite \$400 fee which was paid by credit card as evidenced by the attached filing receipts. (Exhibit A)." Petition Pursuant to 37 C.F.R. § 41.3, p. 2. A search of the Office electronic records also shows that a fee of \$400.00, in fact, was submitted on January 26, 2011 for "Petitions to the Director Not Specifically Provided For." The \$400.00 fee was posted on January 27, 2011. In view of the evidence before the Board, ZapMedia's Petition Pursuant to 37 C.F.R. § 41.3 to reconsider the earlier Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c) filed January 26, 2011 is **granted**. And, having determined already that "[i]n view of the number of different issues presented in this appeal, ZapMedia's request to file an Appeal Brief having a length of 51 pages is deemed reasonable" (Decision, p. 4), ZapMedia's Petition under § 1.183 filed January 26, 2011 also is **granted** and ZapMedia's Appellant Brief filed January 26, 2011 is entered.

Reexamination Control 95/001,143  
Patent 7,343,414

DECISION

In view of the foregoing, the Patent Owner's Petition Pursuant to 37 C.F.R. § 41.3 for Supervisory Review filed March 11, 2011 is GRANTED. Further, the Patent Owner's Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c) filed January 26, 2011 is also GRANTED.

The Patent Owner's Appellant Brief of January 26, 2011, is entered.



---

James Donald Smith  
Chief Administrative Patent Judge

Reexamination Control 95/001,143  
Patent 7,343,414

Counsel for Patent Owner:

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Patterson, Thuente, Christensen, Pedersen, P.A.

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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.
95/001,143	02/11/2009	7343414	4292.01REX01	4158
35856	7590	06/07/2011	EXAMINER	
SMITH RISLEY TEMPEL SANTOS LLC Two Ravinia Drive Suite 700 ATLANTA, GA 30346			ART UNIT	PAPER NUMBER

DATE MAILED: 06/07/2011

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Third Party Requester

v.

ZAPMEDIA SERVICES, INC.  
Patent Owner

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*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414  
Technology Center 3900

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DECISION ON PETITION

This is a decision on Patent Owner's "Petition Pursuant to 37 C.F.R. § 41.3 for Supervisory Review," filed March 11, 2011. In the Petition, Patent Owner seeks reconsideration and grant of the earlier "Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)" filed January 26, 2011, which was denied on February 25, 2011 for failure to pay the appropriate fee. Petition Pursuant to 37 C.F.R. § 41.3, p. 2.

*See* 75 Fed. Reg. 50,750 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge to decide this request.

Reexamination Control 95/001,143  
Patent 7,343,414

## FINDINGS

1. Patent 7,343,414 issued on March 11, 2008 with 15 claims. The '414 patent was assigned to Patent Owner, ZapMedia Services, Inc. ("ZapMedia").
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Reexamination Control 95/001,143  
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- (2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

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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.

Reexamination Control 95/001,143  
Patent 7,343,414

MPEP § 2667 (I)(A)(2) provides:

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### ANALYSIS

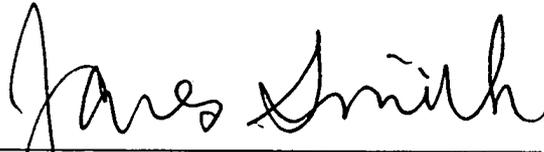
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Reexamination Control 95/001,143  
Patent 7,343,414

DECISION

In view of the foregoing, the Patent Owner's Petition Pursuant to 37 C.F.R. § 41.3 for Supervisory Review filed March 11, 2011 is GRANTED. Further, the Patent Owner's Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c) filed January 26, 2011 is also GRANTED.

The Patent Owner's Appellant Brief of January 26, 2011, is entered.



---

James Donald Smith  
Chief Administrative Patent Judge

Reexamination Control 95/001,143  
Patent 7,343,414

Counsel for Patent Owner:

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Patterson, Thuente, Christensen, Pedersen, P.A.  
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Counsel for Third Party Requester:

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35856                      7590                      06/07/2011

SMITH RISLEY TEMPEL SANTOS LLC  
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Suite 700  
ATLANTA, GA 30346

EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 06/07/2011

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Third Party Requester

v.

ZAPMEDIA SERVICES, INC.  
Patent Owner

---

*Inter partes* Reexamination Control 95/001,143  
Patent 7,343,414  
Technology Center 3900

---

DECISION ON PETITION

This is also a decision on Apple's "Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rules Under 37 C.F.R. § 1.943(c)" filed February 28, 2011 (Petition). Concurrently with this petition, Apple filed a Respondent Brief that is 22 pages and 8,216 words. Petition, p. 1. The Petition will be treated as a Petition to accept the Respondent Brief of February 28, 2011. In the Petition, Apple requests "a limited waiver of 37 C.F.R. § 1.943(c) limiting Respondent's Appeal Brief to 15 pages or 7000 words." *Id.*

*See* 75 Fed. Reg. 50,750 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge to decide this request.

## FINDINGS

1. Patent 7,343,414 issued on March 11, 2008 with 15 claims. The '414 patent was assigned to Patent Owner, ZapMedia Services, Inc. ("ZapMedia").
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3. On April 8, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
4. On April 16, 2009, the Office issued a Non-Final Office Action in the *inter partes* reexamination of claims 1-15 of the '414 patent in the '143 proceeding.
5. On June 16, 2009, ZapMedia filed a response to the Office Action of April 16, 2009.
6. On July 16, 2009, Apple filed comments regarding ZapMedia's response to the Non-Final Office Action of April 16, 2009.
7. On November 20, 2009, the Office issued an Action Closing Prosecution ("ACP") rejecting claims 1-15. The length of the ACP was 62 pages, including coversheet.
8. On September 16, 2010, the Office issued a Right of Appeal Notice ("RAN"), rejecting claims 1-15. The length of the RAN was 63 pages, including coversheet.
9. On October 20, 2010, the Office issued a revised RAN, rejecting claims 1-15. The length of the Revised RAN was 63 pages, including coversheet.

Reexamination Control 95/001,143  
Patent 7,343,414

10. On November 22, 2010, ZapMedia filed a Notice of Appeal for claims 1-15.
11. On November 26, 2011, Apple filed a Notice of Cross Appeal for claims 1-15.
12. On January 26, 2011, ZapMedia also filed an Appellant's Brief along with a "Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)."
13. On February 25, 2011, the Board of Patent Appeals and Interferences (Board) entered a Decision on ZapMedia's Petition Pursuant to 37 C.F.R. § 1.183 (Decision). The Decision **denied** ZapMedia's Petition Pursuant to 37 C.F.R. § 1.183 for failure to pay the fee required for consideration of petitions under this rule. Decision, p. 4. The Decision noted that, "[i]n view of the number of different issues presented in this appeal, ZapMedia's request to file an Appeal Brief having a length of 51 pages is deemed reasonable." *Id.*
14. On February 28, 2011, Apple concurrently filed a "Third Party Requester's Respondent Brief Pursuant to 37 C.F.R. § 41.68." The Respondent Brief concurrently filed is 22 pages long (8,216 words), which exceeds the 15 pages or 7000 words limits for Respondent briefs set in 37 C.F.R. § 1.943(c). Petition, p. 1.
15. On March 11, 2011, ZapMedia filed a "Petition Pursuant to 37 C.F.R. § 41.3 for Supervisory Review." In this Petition, ZapMedia sought reconsideration and grant of the earlier denied "Petition under § 1.183 for Suspension of Rule 37 C.F.R. § 1.943(c)" seeking a limited waiver of the page/word limit for ZapMedia's Appellant Brief of January 26, 2011. Petition Pursuant to 37 C.F.R. § 41.3, p. 2.

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Patent 7,343,414

16. Concurrently with this decision, the Board is entering a Decision on ZapMedia's Petition Pursuant to 37 C.F.R. § 41.3 that favorably reconsiders the earlier filed Petition under § 1.183 for Suspension of 37 C.F.R. § 1.943(c) and grants the requested limited waiver of the page/word limit for ZapMedia's Appellant Brief, thus allowing entry of ZapMedia's Appellant Brief of January 26, 2011.

#### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.943(c) provides:

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

MPEP § 2667 (I)(A)(2) 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

Reexamination Control 95/001,143  
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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

Apple filed a Respondent Brief concurrently with this Petition that is 22 pages long (8,216 words). Petition, p. 1. The Respondent Brief exceeds the 15 pages or 7000 words limits for a Respondent Brief set in 37 C.F.R. § 1.943(c). The Respondent Brief is in response to ZapMedia's Appellant Brief of January 26, 2011.

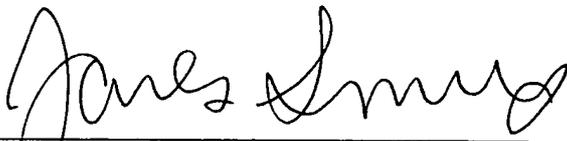
Apple requests waiver of the 15 pages or 7000 words limits for a Respondent Brief set in 37 C.F.R. § 1.943(c). *Id.* Apple's reason provided in support of the waiving the page/word limits is to allow Apple "a fair opportunity to adequately address Appellant's arguments for each ground of rejection in Appellant's Appeal Brief of 53 pages and 16,951 words." Petition, p 2.

Apple made a persuasive showing for that this situation is extraordinary and that justice requires acceptance of the Respondent Brief of February 28, 2011. Accordingly, Apple's Petition to accept the Respondent Brief of February 28, 2011 is **granted**. The Respondent Brief of February 28, 2011 is entered.

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Patent 7,343,414

DECISION

In view of the foregoing and based on the facts of this proceeding, Apple's Third Party Requester's Petition Pursuant to 37 C.F.R. § 1.183 for Suspension of Rules Under 37 C.F.R. § 1.943(c) filed February 28, 2011 is GRANTED. Apple's Respondent Brief of February 28, 2011 is entered.



---

James Donald Smith  
Chief Administrative Patent Judge

Reexamination Control 95/001,143  
Patent 7,343,414

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,144	02/11/2009	7020704	4292.02REX01	4234
24113	7590	02/25/2011	EXAMINER	
PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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HOUSTON, TX 77002

Date:

MAILED

FEB 25 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001144  
PATENT NO. : 7020704  
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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FEB 25 2011

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HOUSTON, TX 77002

(For Third Party Requester)

*In re:* Lipscomb et al. : DECISION ON PETITION  
*Inter Partes* Reexamination Proceeding : TO WITHDRAW RIGHT  
Control No. 95/001,144 : OF APPEAL NOTICE  
Request Deposited: February 11, 2009 : FILED UNDER 37 CFR 1.181  
For: U.S. Patent No. 7,020,704 :

This is a decision on the October 14, 2010 petition from Patent Owner entitled "PETITION UNDER 37 C.F.R. 1.181 FOR WITHDRAWAL OF PENDING RIGHT OF APPEAL NOTICE" and Third Party Requester's October 21, 2010 opposition thereto.

The petition appears to be timely filed and no fee is due. The petition is before the Director of the Central Reexamination Unit for reconsideration.

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

### BACKGROUND

1. On September 24, 2010, an Right of Appeal Notice (RAN) was mailed in the present proceeding.
2. On October 14, 2010, Patent Owner (PO) filed a the instant petition requesting the RAN be withdrawn as premature.

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3. On October 21, 2010, Third Party Requester (TPR) filed comments in opposition to Patent Owner's petition. It is noted TPR filed the opposition under 37 CFR 1.182 and/or 37 CFR 1.183 if necessary.

### RELEVANT AUTHORITY

37 CFR 1.953 states:

**37 CFR 1.953. Examiner's Right of Appeal Notice in inter partes reexamination.**

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

37 CFR 1.181 (f) states:

(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.

MPEP 2671.03 (IV) states:

Should the examiner issue Office action without panel review, the patent owner or the third party requester who wishes to object must promptly file a paper alerting the Office of this fact. (The failure to hold a panel review conference would be noted by the parties where there are no conferees' initials at the end of the Office action.) Any challenge of the failure to hold a panel review conference must be made within two weeks of receipt of the Office action issued, or the challenge will not be considered. In no event will the failure to hold a patentability review conference, by itself, be grounds for vacating any Office decision(s) or action(s) and "restarting" the reexamination proceeding.

### DECISION

At the onset it is noted TPR's petition under 37 CFR 1.182 or 37 CFR 1.183 has been construed as an opposition to the PO petition under 37 CFR 1.181 in as much as requester may support the action taken by the Office, since the Office has unequivocal right to enforce its rules and practice and requester may explain why the Office acted within its right.

PO petitions for supervisory review pursuant to 37 CFR 1.181 to withdraw the September 24, 2010 RAN as it was not in compliance with the requirements of a panel consideration as set forth in MPEP 2672,02(III). PO further opines the RAN is premature until the PO's outstanding petition filed under 37 CFR 1.181 filed December 17, 2009 is decided.

Notwithstanding TPR's submission that MPEP 2677.03 (IV) proscribes complaints regarding the sufficiency of the panel review be made within two weeks and notation that the same

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section of the MPEP declares “In no event will the failure to hold a patentability review conference, but itself, be grounds for vacating any Office decisions(s) or actions(s) and “restarting” the reexamination proceeding, the issue appears moot as a review of the final page of the RAN in question clearly shows three distinct initials/signatures. The office action is properly signed per CRU and MPEP policy. No basis is seen for granting the relief requested by petitioner.

As to PO’s position regarding the RAN was premature as it was issued prior to decision on PO’s pending 37 CFR 1.181 petition, the Office is persuaded as 37 CFR 1.181(f) clearly 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”. Accordingly, no basis is seen for granting the relief requested by petitioner.

In view of the above, the petition is **DISMISSED**.

#### CONCLUSION

Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.



---

Remy Yucel  
Director, Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,144	02/11/2009	7020704	4292.02REX01	4234
24113	7590	02/25/2011	EXAMINER	
PATTERSON THUENTE CHRISTENSEN PEDERSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100			ART UNIT	PAPER NUMBER

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Date:

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FEB 25 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001144  
PATENT NO. : 7020704  
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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MINNEAPOLIS, MN 55402-2100

(For Patent Owner)

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HOUSTON, TX 77002

(For Third Party Requester)

*In re:* Lipscomb et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,144  
Request Deposited: February 11, 2009  
For: U.S. Patent No. 7,020,704

: DECISION ON PETITION  
: TO RECLASSIFY ACTION  
: CLOSING PROSECUTION AS  
: NON FINAL OFFICE ACTION  
: UNDER 37 CFR 1.181

This is a decision on the December 18, 2009 petition from Patent Owner entitled "PETITION UNDER 37 C.F.R. 1.181 FOR RECLASSIFICATION OF THE ACTION CLOSING PROSECUTION AS A NON-FINAL OFFICE ACTION" and Third Party Requester's December 23, 2009 opposition thereto.

The petition appears to be timely filed and no fee is due. The petition is before the Director of the Central Reexamination Unit for reconsideration.

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

### BACKGROUND

1. On December 1, 2009, an Action Closing Prosecution (ACP) was mailed in the present proceeding.
2. On December 18, 2009, Patent Owner (PO) filed a the instant petition requesting the ACP be reclassified as a non-final office action.

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3. On December 23, 2009, Third Party Requester (TPR) filed comments in opposition to Patent Owner's petition as provided for by MPEP 2672 (VI).

### RELEVANT AUTHORITY

37 CFR 1.949 states:

**§ 1.949 Examiner's Office action closing prosecution in inter partes reexamination.**

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the inter partes reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment. [Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

MPEP 2672 (VI) states:

**VI. ACTION CLOSING PROSECUTION - PREMATURE**

If the patent owner is of the opinion that the Office action closing prosecution in the inter partes reexamination proceeding is premature, the patent owner may, in addition to the comments submitted under 37 CFR 1.951(a), file a petition under 37 CFR 1.181 within the time period for filing the comments under 37 CFR 1.951(a). The third party requester may then once file, as a paper separate from any submission under 37 CFR 1.951(b), comments responsive to the patent owner's petition under 37 CFR 1.181 within 30 days from the date of service of the patent owner's petition under 37 CFR 1.181 on the third party requester.

### DECISION

Patent Owner (PO) request reclassification of the December 1, 2009 ACP as a non-final office action apparently on the basis it is premature as provided for under MPEP 2672 (VI). In support for his argument the ACP was premature, two positions are submitted for consideration. First, PO argues the ACP is unclear as to whether or not the examiner rejected the claims as amended. Second, PO submits the examiner failed to fully review PO's secondary consideration evidence. PO concludes because the ACP is premature, equities demand that PO has [be given] the opportunity to present additional evidence before prosecution is cut off.

PO points are not well taken. Review of the record and of the ACP in question, as pointed out by TPR in opposition to the instant petition, reveals the examiner did fully consider the claims as amended by PO and was clear in that he was not persuaded by PO amendments or arguments. While the ACP may contain typographical errors, these errors do not effect PO's ability to determine the substance of the examiner's position in as much as the entire ACP must be considered. For example, the amendatory language of claims 1, 3 and 6 is discussed with respect to Ginter at least at ACP p7 : 16 – 21, p8: 19- 23 and p9 19 – p 10:3. Similarly, the

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amendatory language of claims 1, 3 and 6 is discussed with respect to Stefik in view of Stefik Article at least at ACP p 30 :21-22, p 22:18 – p 23: 2 and p19:27 – 30, p 22:16 – p 23: 2. There is no ambiguity as to the position of the examiner. Accordingly, the requested relief does not appear warranted.

In support of his second premise, PO takes issue with the fact that the examiner was not persuaded by the evidence presented and argues that the examiner must have only provided a cursory review of the evidence presented. PO opines the examiner dismissed the declarations as lacking sufficient nexus with the claimed invention by simply parroting the TPR's argument. PO argues there is a presumed nexus if the market product "embodies the claimed features and is coextensive with them". Yet, PO also admits that the terms and phrases used in the declarations were a rhetorical tool to conveniently and quickly summarize some of the major differences between the claimed inventions and the prior art. PO, in his own words, "failed to regurgitate exact term from the claim language" and concludes therefore the examiner failed to consider the evidence.

As PO correctly states in his petition, evidence of commercial success is probative as a secondary indicia of non-obviousness only when a nexus between the commercial success and the claimed invention is demonstrated [PO citation omitted]. The term "nexus" designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corb. V. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988). Review of the evidence in this proceeding indicate that PO chose to present his evidence of commercial success without regurgitation of the terms from the claim language. Further, there was no explanation provided or attempt to relate the claimed invention to the evidentiary showing. Review of the evidence in this proceeding further indicates the examiner gave a full and fair review of the evidence provided. Neither the Office nor the examiner can infer what PO meant to say when he chose a rhetorical tool for convenience and failed to use the terminology employed in the claim language. The examiner reviewed the evidence for a factually and legally sufficient connection between the claimed invention and the allegedly commercially successful device and found none. That the examiner agrees with TPR in this conclusion in no way reflects any lack of full consideration of the evidence presented. There appears to be no basis for granting PO's requested relief.

As to PO's final position that equities demand that PO has [be given] the opportunity to present additional evidence before prosecution is cut off PO offers multiple arguments. While the PO believes that the declarations as originally submitted comply with both the spirit and letter of the legal requirements for establishing nexus in the context submitted, PO opines that he is now limited in his ability to present additional evidence due to the nature of conduct of *inter partes* reexamination proceedings under special dispatch. PO submits it was never assumed that the use of his chosen rhetorical tool would be improperly misconstrued by the examiner as somehow representing claim scope as different from the actual claim language. PO's position is not persuasive. PO has had available to him the same opportunity to present evidence in

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support of patentability as has every patent owner in an *inter partes* reexamination proceeding. The intention that the second office action in an *inter partes* reexamination proceeding be an ACP is clear in the MPEP and the intent to conduct the instant proceeding with special dispatch expressly stated in the first Office action. *Inter partes* reexamination is a focused proceeding and not an unlimited prosecution. That PO was unconvincing to the examiner has remedy in the system other than demanding the proceeding be delayed. Additional evidence may be presented in the proceeding provided the requirements of 37 CFR 1.116 are addressed. Alternatively, as the ultimate conclusion of the examiner's determination the evidence lacks clear nexus to the claims at issue, the propriety of the examiner's conclusion may be subject to appeal before the Board of Patent Appeals and Interferences. Accordingly, no basis for the requested relief is seen.

It is noted that TPR's petition in opposition to the 1.181 petition under consideration herein was given consideration: no further comments are deemed necessary.

In summary, it appears the designation of the Office action mailed December 1, 2009 as an Action Closing Prosecution by the examiner was proper. No compelling evidence is seen for altering that designation. Further, it appears Patent Owner has had fair opportunity and has had his evidence fully considered by the examiner. No compelling evidence is seen demonstrating lack of equity. Accordingly, there appears no basis for the requested relief to be granted.

In view of the above, the petition is **DISMISSED**.

#### CONCLUSION

Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to Eric Keasel at (571) 272-4929 or to Mark Reinhart at (571) 272-1611.

  
\_\_\_\_\_  
Remy Yucel  
Director, Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,144	02/11/2009	7020704	4292.02REX01	4234

7590 05/24/2011  
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/24/2011

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MAY 24 2011

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001144  
PATENT NO. : 7020704  
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,144

02/11/2009

7020704

4292.02REX01

4234

24113

7590

02/25/2011

EXAMINER

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ART UNIT      PAPER NUMBER

DATE MAILED:

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In re Lipscomb et al :  
*Inter Partes* Reexamination Proceeding : **DECISION**  
Control No. 95/001,144 : **DISMISSING**  
Filed: February 11, 2009 : **PETITION**  
For: U.S. Patent No. 7,020,704 :

This decision is in response to the December 17, 2010 patent owner petition, entitled "Petition Pursuant to 37 C.F.R. §1.183 for Suspension of Rules 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)" (the December 17, 2010 patent owner petition).

This decision also addresses:

- requester's opposition paper filed on January 18, 2011, entitled "Third Party Requester's Opposition to Patent Owner's Petition Pursuant to 37 C.F.R. § 1.183 For Suspension of Rules" (the January 18, 2011 requester opposition); and
- patent owner's power of attorney and change of correspondence address, filed on June 22, 2009 (the June 22, 2009 power of attorney and change of correspondence address).

The December 17, 2010 petition, the January 18, 2011 requester opposition, the June 22, 2009 power of attorney change of correspondence address of the patent owner, and the record as a whole, are before the Office of Patent Legal Administration.

### SUMMARY

The December 17, 2010 patent owner petition under 37 CFR 1.183 is **dismissed**.

The June 22, 2009 power of attorney and change of correspondence address of the patent owner is **ineffective**.

## BACKGROUND

- On March 28, 2006, U.S. Patent 7,020,704 (the '704 patent) issued to Lipcomb et al.
- On February 11, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001,144 (the '1144 proceeding).
- On April 13, 2009, the United States Patent and Trademark Office (the Office) mailed an order granting *inter partes* reexamination in the '1144 proceeding.
- On April 21, 2009, the Office mailed a nonfinal Office action.
- On June 22, 2009 the patent owner filed a change of power of attorney and correspondence address.
- Also on June 22, 2009, the patent owner submitted a response, including an amendment, and declarations under 37 CFR 1.132 of Eric Andersland, Gene Hoffman, Jr., and Eric Hartz.
- On July 13, 2009, the Office mailed a notice *re*: defective paper in *inter partes* reexamination, informing the patent owner that the June 22, 2009 amendment failed to comply with 37 CFR 1.530(f).
- On July 22, 2009, the patent owner filed a corrected response.
- On August 21, 2009, the requester filed comments.
- On December 1, 2009, the Office mailed an action closing prosecution (ACP).
- On December 11, 2009, the patent owner filed a request for an extension of time.
- On December 16, 2009, the requester filed an opposition to patent owner's December 11, 2009 request for an extension of time.
- On December 18, 2009, the Office mailed a decision granting-in-part patent owner's December 11, 2009 request for an extension of time, extending the time period for response by one month.
- Also on December 18, 2009, the patent owner filed a petition entitled "Petition Under 37 C.F.R. 1.181 For Reclassification of the Action Closing Prosecution as a Non-Final Office Action" (the December 18, 2009 patent owner petition).
- On December 23, 2009, the requester filed a paper in opposition to patent owner's December 18, 2009 petition. The opposition paper is entitled "Third Party Requester's

Opposition to Patent Owner's Petition Under 37 C.F.R. 1.181 for Reclassification of the Action Closing Prosecution as a Non-Final Office Action" (the December 23, 2009 requester opposition).

- On December 31, 2009, the Office mailed a corrected decision granting-in-part patent owner's December 11, 2009 request for an extension of time, extending the time period for response by one month.
- On February 4, 2010, the patent owner filed § 1.951(a) comments after ACP.
- On March 3, 2010, the requester filed § 1.951(b) comments after ACP.
- On September 24, 2010, the Office mailed a right of appeal notice (RAN).
- On October 14, 2010, the patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.181 For Withdrawal of Pending Right of Appeal Notice" (the October 14, 2010 patent owner petition).
- Also on October 14, 2010, the patent owner filed a notice of appeal.
- On October 21, 2010, the requester filed a paper in opposition to patent owner's October 14, 2010 petition. The opposition paper is entitled "Third Party Requester's Opposition to Patent Owner's Petition for Withdrawal of Pending Right of Appeal Notice" (the October 21, 2010 requester opposition).
- On October 21, 2010, the requester filed a notice of cross-appeal.
- On December 17, 2010, the patent owner filed the present petition, entitled "Petition Pursuant to 37 C.F.R. §1.183 for Suspension of Rules 37 C.F.R. § 1.116(f), 37 C.F.R. § 41.63(c) and 37 C.F.R. § 1.939(a)" (the December 17, 2010 patent owner petition). The present petition is accompanied by two newly submitted declarations under 37 CFR 1.132, of Justin W. Woo and of Marin Kaliski, Ph.D., respectively.
- Also on December 17, 2010, the patent owner filed an appellant's brief.
- On January 18, 2011, the requester filed a paper in opposition to patent owner's December 17, 2010 petition. The opposition paper is entitled "Third Party Requester's Opposition to Patent Owner's Petition Pursuant to 37 C.F.R. § 1.183 For Suspension of Rules" (the January 18, 2011 requester opposition).
- Also on January 18, 2011, the requester filed a respondent's brief.
- On February 25, 2011, the Office mailed a decision dismissing patent owner's December 18, 2009 petition under 37 CFR 1.181, and addressing requester's December 23, 2009 opposition.

- Also on February 25, 2011, the Office mailed a decision dismissing patent owner's October 14, 2010 petition under 37 CFR 1.181, and addressing requester's October 21, 2010 opposition.

### DECISION

The patent owner petition under 37 CFR 1.183 requests that the Office waive the following rules and enter evidence newly submitted with patent owner's concurrently-filed appellant's brief:

- 37 CFR 1.116(f) (prohibiting submission of evidence after RAN);
- 37 CFR 1.939(a) (prohibiting submission of unauthorized papers in *inter partes* reexamination); and
- 37 CFR 41.63(c) (limiting the filing of new evidence after the filing of a notice of appeal in *inter partes* reexamination).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on the petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

The patent owner states that the newly submitted declaration under 37 CFR 1.132 of Martin Kaliski, Ph.D. (the Kaliski declaration) "present[s] the non-confidential opinions of an expert witness retained by Owner in a co-pending litigation", i.e., *ZapMedia Services, Inc. V. Apple, Inc.*, Civil Action File No: 2:08-cv-00104-DF-CE (the copending litigation), which involves the '704 patent. The patent owner argues that the Kaliski declaration "presents additional evidence of secondary indicia of non-obviousness including addressing a long-felt need and that the disclosed invention went against the conventional wisdom in the art". The patent owner asserts that the Kaliski declaration "relies in part upon a review of certain very recent filings and orders in the ZapMedia lawsuit and could only have [been] prepared after an opportunity to review and consider those, including the Claim Construction Order, dated May 19, 2010, the Order on Objections to the Claim Construction Order dated August 19, 2010, and the Original and Amended Expert Reports of Dr. K lly, expert witness of Apple, Inc. (Third Party Requester), dated August 4, 2010 and September 7, 2010".<sup>1</sup>

The patent owner, however, has not sufficiently shown why it was necessary to wait until the filing of patent owner's appellant's brief, on December 17, 2010, to file the newly submitted evidence. Specifically, it is not clear why it was necessary to wait for the court's claim construction order, because the Office is not bound by the court's claim construction. As pointed out by the requester in its January 18, 2010 opposition paper, the Office employs the broadest reasonable interpretation standard when interpreting the scope of the claims, which differs from the standard used by the courts. "Claims are given 'their broadest reasonable interpretation, consistent with the specification in reexamination proceedings.'" *In re Trans Texas Holding Corp.*, 498 F.3d 1290, 1298 (Fed. Cir. 2007) (citing *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed.

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<sup>1</sup> See the sentence bridging pages 2 and 3, as well as page 3, of the present petition.

Cir. 1984)). Furthermore, the patent owner provides no explanation as to why it was necessary to wait for the original and amended expert reports, which were apparently filed by the requester in the copending litigation, before filing the presently submitted evidence. For example, if the original and amended expert reports solely involve claim construction issues, it has not been explained why the patent owner decided to wait for these opinions, because the Office is not bound by requester's proffered claim construction. In summary, it is not clear why the patent owner decided to wait for the court's claim construction order, the order on the objections to the court's claim construction order, and the requester's expert reports filed in the copending litigation, before filing a declaration which, as admitted by the patent owner, is directed to secondary indicia of non-obviousness, i.e., an alleged showing of long-felt need and an alleged showing that "the disclosed invention went against the conventional wisdom in the art".

Furthermore, the patent owner, by its own admission, intentionally waited until after the issuance of **all** of the above-identified court documents before filing its rebuttal evidence, i.e., the Kaliski declaration. The patent owner asserts that the Kaliski declaration "refut[es] the Examiner's position in the Action Closing Prosecution . . . and RAN." The patent owner, however, had an opportunity after the ACP to submit evidence rebutting the examiner's position in the ACP, and chose not to do so. The patent owner argues that "it was not practical to submit the Declaration until after the . . . issuance of the RAN". The patent owner, however, has not shown that the examiner's position in the RAN differs from the examiner's position in the ACP; in fact, the examiner's position appears, upon brief review, to be substantially the same in each instance. Furthermore, the Office is required to conduct reexamination proceedings with special dispatch, pursuant to 35 USC 314(c). The Office cannot, as a matter of policy, permit a substantial delay caused by patent owner's deliberate decision to wait over one year after the December 1, 2009 mail date of the ACP for the issuance of an entire series of court documents and after the issuance of the RAN before filing, on December 18, 2010, evidence rebutting the examiner's position in the ACP.

For the reasons given above, the patent owner's bald argument that it was necessary to wait for the issuance of the above-identified court documents and for the issuance of the RAN before filing the newly submitted declaration does not provide a sufficient showing of extraordinary circumstances, such that justice should require waiver of the rules.

The patent owner repeatedly argues that the examiner's decision to issue a RAN before a decision was rendered<sup>2</sup> on patent owner's petition under 37 CFR 1.181 "to reclassify" the ACP as a nonfinal Office action created an extraordinary situation such that justice requires waiver of 37 CFR §§ 1.116(f), 1.939(a), and 41.63(c). The patent owner submits a declaration under 37 CFR 1.132 of Justin N. Woo as evidence that the patent owner was "unable to find a single other *inter partes* reexamination where a similar situation has occurred of a RAN being issued while there was an outstanding and undecided petition under Rule 1.181". However, as argued by the requester in its opposition paper, 37 CFR 1.181(f) unambiguously states that "the mere filing of a petition will not . . . act as a stay of other proceedings", such as reexamination proceedings.

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<sup>2</sup> On February 25, 2011, the Office mailed a decision dismissing patent owner's petition under 37 CFR 1.181 "to reclassify" the ACP, and a separate decision dismissing patent owner's petition under 37 CFR 1.181 to withdraw the RAN.

There is no rule that precludes the examiner from continuing prosecution in a reexamination proceeding prior to the rendering of a decision on a petition under 37 CFR 1.181. As argued by the requester, if the Office were to stay each reexamination proceeding in order to decide every petition filed by the parties, the Office could not conduct reexamination proceedings with special dispatch as required by 35 USC 314(c). Furthermore, if the rules permitted a party to delay a reexamination proceeding, including those on appeal, merely by filing a petition under 37 CFR 1.181, then these petitions could be filed at every opportunity by a party attempting to delay the reexamination process.

The patent owner argues that the examiner's decision to close prosecution by issuing the ACP and the RAN violates patent owner's right to submit rebuttal evidence guaranteed by the Administrative Procedures Act (APA). 5 U.S.C. § 556(d) of the APA states that: "[A] party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts". The APA, however, does not authorize the *late submission* of rebuttal evidence, which results in an unwarranted substantial delay of a reexamination proceeding, contrary to a statutory mandate to resolve it with special dispatch, in an instance when the rebuttal evidence could have been prudently submitted earlier.

The patent owner further asserts that there is a "conflict" between the Board's policy, as stated in *Ex parte Frye*<sup>3</sup> and the policy set forth in the Federal Register notice, *Streamlined Procedure for Appeal Brief Review in Inter Partes Reexamination Proceedings*.<sup>4</sup> In *Ex parte Frye*, the Board explains that the Board does not give deference to the examiner's findings, and instead reviews the entire record to reach its own conclusions on appealed issues. In the Federal Register notice, the Office informs the public that petitions involving the entry of evidence on appeal remain delegated to the patent examining corps. The patent owner alleges that this "conflict" between the Board's policy and the Federal Register notice precludes the Board from reviewing the entire record. The policy of the Board, however, is to review the entire record and reach its own conclusions *on appealed issues*. Furthermore, the "entire record" does not include unentered papers. The presently submitted Kaliski declaration has not been entered into the official record, and does not form part of the appeal. The Board's policy does not authorize the late entry of rebuttal evidence in the proceeding, or the unlimited entry of rebuttal evidence on appeal. Furthermore, the Board in any event has access to patent owner's petitions and the Office's decisions on those petitions. Thus, there is no "conflict" between the Board's policy and the policy of the Federal Register notice, as alleged by the patent owner.

Finally, the patent owner asserts that it was required to pay a petition fee when filing its petition under 37 CFR 1.181, "which . . . reinforce[d] the reasonable expectation of the Patent Owner that a decision on the declaration would be granted". No petition fee, however, is required for filing a petition under 37 CFR 1.181.<sup>5</sup>

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<sup>3</sup> 94 USPQ2d 1072 (BPAI 2010).

<sup>4</sup> 75 Fed. Reg. 50750 (August 17, 2010).

<sup>5</sup> Petition fees, however, are required to cover the costs of processing and of treating the petition. The Office does not render a decision on a petition in the absence of the required fee. If a petition is filed and the petition fee is paid, the Office reasonably presumes that the petitioner wishes the Office to treat the petition as to its substance, whether the petition is later granted, dismissed, or denied. If the fee were collected only when the petition is to be granted,

For the reasons given above, the patent owner has simply not shown extraordinary circumstances, such that justice requires waiver of 37 CFR §§ 1.116(f), 1.939(a), and 41.63(c).

Accordingly, the December 17, 2010 patent owner petition under 37 CFR 1.183 is **dismissed**.

***The June 22, 2009 Power of Attorney and Change of Correspondence Address is Ineffective***

The power of attorney and change of correspondence address, filed by the patent owner on June 22, 2009, is **ineffective**.

The power of attorney is signed by the assignee; however, **Office records fail to reveal that a statement under 37 CFR 3.73(b) has been filed in this proceeding.** Because the assignee has failed to establish its right to take action pursuant to 37 CFR 3.73(b), the power of attorney, signed by the assignee and filed on June 22, 2009, is ineffective. See 37 CFR 3.71(c). See also MPEP 324 and MPEP 402.07. **For this reason, the patent practitioner who filed this petition, Mr. Brad Pedersen, of Patterson, Thunte Christensen Pedersen, P.A., is not of record in this proceeding.** In the absence of a properly executed change of power of attorney in this proceeding, Mr. Gregory S. Smith, of Atlanta, GA, will remain of record in this proceeding.

Furthermore, the address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 09/679,688, 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. Brad Pedersen. **However, in the absence of a proper change of correspondence address in the patent file, application no. 09/679,688, 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 December 17, 2010 patent owner petition under 37 CFR 1.183 is **dismissed**.
- The June 22, 2009 power of attorney and change of correspondence address of the patent owner is **ineffective**.
- The patent practitioner who filed this petition, Mr. Brad Pedersen, of Patterson, Thunte Christensen Pedersen, P.A., is not of record in this proceeding. In the absence of a properly executed change of power of attorney in this proceeding, Mr. Gregory S. Smith, of Atlanta, GA, will remain of record in this proceeding.

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then the Office would be addressing the substance of a dismissed petition, contrary to the regulations that require a fee as an element of the petition, and would be expending resources without the cost recovery. For this reason, the mere fact that a petition fee is required cannot reasonably provide the petitioner with an expectation that the petition will be granted.

- A courtesy copy of this decision is being mailed to the practitioner who submitted the present patent owner petition, Mr. Brad Pedersen. **However, in the absence of a proper change of correspondence address in the patent file, application no. 09/679,688, 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

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

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



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

5-23-11  
Kenpet8/

<b>Doc Code: PET.AUTO</b>		PTO/SB/83
<b>Document Description: Petition automatically granted by EFS-Web</b>		U.S. Patent and Trademark Office Department of Commerce
Electronic Petition Request	<b>REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS</b>	
Application Number	95001146	
Filing Date	11-Feb-2009	
First Named Inventor	6974670	
Art Unit	3991	
Examiner Name	BRUCE CAMPELL	
Attorney Docket Number	59046.001004	
Title	Method of Synthesizing Nucleic Acid	
<input checked="" type="radio"/> Please withdraw me as attorney or agent for the above identified patent application and the practitioners of record associated with Customer Number:		25227
The reason(s) for this request are those described in 37 CFR: 10.40(b)(4)		
Certifications		
<input checked="" type="checkbox"/> I/We have given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intend to withdraw from employment		
<input checked="" type="checkbox"/> I/We have delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled		
<input checked="" type="checkbox"/> I/We have notified the client of any responses that may be due and the time frame within which the client must respond		
Change the correspondence address and direct all future correspondence to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71:		
Name	Eiken Kagaku Kabushiki Kaisha	
Address	4-19-9 Taito, Taito-Ku	
City	Tokyo	
State		
Postal Code	110-8408	
Country	JP	

I am authorized to sign on behalf of myself and all withdrawing practitioners.

Signature	/Johnathan Bockman/
Name	Johnathan Bockman
Registration Number	45640



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Decision Date : January 31, 2012

In re Application of :

6974670

Application No : 95001146

Filed : 11-Feb-2009

Attorney Docket No : 59046.001004

DECISION ON REQUEST TO WITHDRAW AS  
ATTORNEY/AGENT OF RECORD

This is an electronic decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed January 31, 2012

The request is **APPROVED**.

The request was signed by Johnathan Bockman (registration no. 45640 ) on behalf of all attorneys/agents associated with Customer Number 25227 . All attorneys/agents associated with Customer Number 25227 have been withdrawn.

Since there are no remaining attorneys of record, all future communications from the Office will be directed to the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71, with correspondence address:

Name Eiken Kagaku Kabushiki Kaisha  
Name2  
Address 1 4-19-9 Taito, Taito-Ku  
Address 2  
City Tokyo  
State  
Postal Code 110-8408  
Country JP

As a reminder, requester is required to inform the first named inventor or assignee that has properly made itself of record pursuant to 37 CFR 3.71 of the electronically processed petition.

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,152	02/27/2009	6,324,120	8963.002.RXUS00	4649
22852	7590	05/12/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

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Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

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DECISION ON PETITION

This is a decision on “Third Party Requester’s Petition Under 37 C.F.R. § 1.183 for Limited Waiver of C.F.R. § 1.943(c),” filed November 22, 2010 (“Petition”). In the Petition, Third Party Requester Micron Technology Inc. requests “that the Office should [] permit Micron to submit a rebuttal brief that is 11,970 words or 30 pages.” Petition, p. 1.<sup>1</sup>

The fee of \$400 for a petition under 37 C.F.R. § 1.183 has been received.

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<sup>1</sup> The Petition at page 1, lines 2 and 3, refers to Requester’s “respondent brief.” As confirmed in a telephone inquiry on May 6, 2011 with a representative of Requester’s counsel, this is a typographical error and should be “rebuttal brief.”

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

## FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.
5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.
6. On July 21, 2009, the '178 and '1152 proceedings were merged.
7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding. The length of the ACP was 118 pages.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39. The length of the RAN was 110 pages.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.
11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.
12. On July 19, 2010, Rambus filed an Appellant Brief.
13. On July 21, 2010, Micron filed an Appellant Brief.
14. On August 23, 2010, Rambus filed a Respondent Brief of 29 pages and 18,777 words along with a Petition seeking waiver of the page and word limits of Rule 1.943(c).
15. On October 21, 2010, the Examiner entered an Answer incorporating the RAN of April 23, 2010.
16. On November 22, 2010, Micron filed a Rebuttal Brief of 30 pages and 11,970 words along with the present Petition.
17. Mailed concurrently herewith is a Decision granting Rambus's Petition for a waiver of the page and word limits specified in Rule 1.943(c) for its Respondent Brief.

#### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

37 C.F.R. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

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

## ANALYSIS

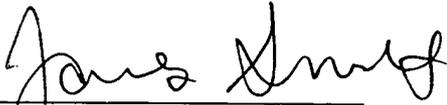
Micron argues that justice requires that in its Rebuttal Brief, it be given an opportunity to respond to Rambus's Respondent Brief on a one-to-one page basis, as inherently specified by Rule 1.943(c). Petition, p. 2. Also, rebuttal briefs may include responses to the Examiner's Answer. Rule 41.71(b)(1) and (c)(1).

In light of Rambus being granted permission to file a Respondent Brief that exceeds the page and word limits of Rule 1.943(c), fairness dictates that Micron be accorded the same treatment for its Rebuttal Brief.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

DECISION

For the forgoing reason, the Petition is GRANTED.



James D. Smith  
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,152	02/27/2009	6,324,120	8963.002.RXUS00	4649
22852	7590	05/12/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

---

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

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DECISION ON PETITION

This is a decision on Patent Owner's "Petition Seeking Waiver of 37 C.F.R. § 1.943 for Patent Owner's Respondent Appeal Brief," filed August 23, 2010 ("Petition"). In the Petition, Patent Owner requests "that the Office accept its respondent appeal brief, which is 29 pages and 18,777 words in length." Petition, p. 1.

The fee of \$400 for a petition under 37 C.F.R. § 1.183 has been received.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

## FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The '120 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.
5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.
6. On July 21, 2009, the '178 and '1152 proceedings were merged.
7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding. The length of the ACP was 118 pages.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39. The length of the RAN was 110 pages.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.
11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.
12. On July 19, 2010, Rambus filed an Appellant Brief.
13. On July 21, 2010, Micron filed an Appellant Brief.
14. On August 23, 2010, Rambus filed a Respondent Brief along with the present Petition.

#### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

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

37 C.F.R. § 1.943(c) provides:

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

MPEP § 2667 I.A.2 provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

## ANALYSIS

Rambus argues that Micron raises 13 issues in its Appellant Brief to which Rambus must respond in its Respondent Brief, and that 15 pages is insufficient to present Rambus's responses. Petition, p.4. Rambus also contends that "the limits imposed by § 1.943(c) are arbitrary and violate Rambus's due process rights." *Id.* at 2.

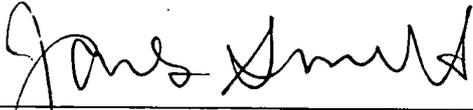
The eleven issues addressed in Rambus's Appeal Brief, as described in the "Issues to be Reviewed on Appeal" section of the Appeal Brief (Appeal Brief, pp. 1-2), are completely different than the nine issues addressed in Rambus's Respondent Brief, as described in the "Issues to be Reviewed on Appeal" section of the Respondent Brief (Respondent Brief, p. 1), reflecting the different rejections proposed by Micron and Samsung. Clearly, the issues presented by each of the two merged reexamination proceedings are distinct from those presented in the other proceeding.

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

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

DECISION

For the forgoing reason, the Petition is GRANTED.



---

James D. Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner:

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,152	02/27/2009	6,324,120	8963.002.RXUS00	4649
22852	7590	06/01/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			06/01/2011	PAPER

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,178	10/06/2006	6,324,120	38512.4	8591
22852	7590	06/01/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ESCALANTE, OVIDIO	
			ART UNIT	PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

---

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

---

DECISION ON PETITIONS

This is a decision on Patent Owner's "Petition to Expunge Third-Party Requester's Respondent Brief," filed October 15, 2010, ("Petition to Expunge"), and "Third Party Requester's Petition Under 37 C.F.R. §§ 1.182 and 1.183 for Limited Waiver of 37 C.F.R. §§ 1.957(A) and 41.66(B)," filed December 15, 2010, ("Waiver Petition").

In the Petition to Expunge, "Rambus requests that the Office expunge Micron's respondent brief because it was filed after the last day on which Micron was allowed to file such a brief." *Id.* at 1.

In the Waiver Petition, Micron seeks a waiver of the one month period specified for filing a respondent brief, as required by 37 § 41.66(b), and the

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

refusal to consider an untimely filed brief, as specified by 37 C.F.R. § 1.957(a), because “Micron’s late filing was due to an unintentional docketing error.” *Id.* at 1.

The fee of \$400 for a petition under 37 C.F.R. § 1.183 has been received from Third Party Requester.

### FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The ‘120 patent is assigned to Patent Owner Rambus, Inc. (“Rambus”).
2. Third Party Requester Samsung Electronics, Co. Ltd. (“Samsung”) filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the ‘120 patent in the ‘178 proceeding.
4. Third Party Requester Micron Technology, Inc. (“Micron”) filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.
5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the ‘120 patent in the ‘1152 proceeding.
6. On July 21, 2009, the ‘178 and ‘1152 proceedings were merged.
7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution (“ACP”) was mailed in the merged proceeding.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On April 23, 2010, the Office mailed a Right of Appeal Notice (“RAN”), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.
10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.
11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.
12. On July 19, 2010, Rambus filed an Appellant Brief.
13. On July 21, 2010, Micron filed an Appellant Brief.
14. On August 23, 2010, Rambus filed a Respondent Brief.
15. Also on August 23, 2010, Micron filed a Respondent Brief.
16. On October 15, 2010, Rambus filed the present Petition to Expunge.
17. On December 15, 2010, Micron filed the present Waiver Petition.

#### RELEVANT AUTHORITY

37 C.F.R. § 1.182 specifies:

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

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*,

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.66(b) provides:

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

37 C.F.R. § 1.957(a) specifies:

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

#### ANALYSIS

In the Petition to Expunge, Rambus argues that Micron's Respondent Brief was due on August 19, 2010 (Thursday) and that it was not filed until August 23, 2010 (Monday). Petition to Expunge, p. 1. Since August 21 and 22, 2010 fell on Saturday and Sunday, Micron's Respondent Brief was filed late by two working days, namely, August 20 and 23, 2010.

With its Waiver Petition, Micron submitted a copy of its relevant "docketing chart" showing that the due date for its Respondent Brief was docketed incorrectly for August 21, 2010 (Saturday) instead of August 19, 2010 (Thursday).

Micron attributes this docketing error as likely the result of using the filing date of Micron's Appellant Brief (July 21, 2010) instead of the filing date of Rambus's Appellant Brief (July 19, 2010) for determining the due date of Micron's Respondent Brief. Waiver Petition, p. 2.

Under 37 C.F.R. §§ 1.957(a) and 41.66(b), if a requester's respondent brief is filed more than one month after the date of filing of

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

patent owner's appellant brief, the untimely filed respondent brief "will be refused consideration." Since this situation expressly is provided for in the rules, 37 C.F.R. § 1.182 is inapplicable. Thus, waiver of the applicable rules is considered only under 37 C.F.R. § 1.183.

By explaining how the docketing error likely occurred, Micron has not established that this is "an extraordinary situation" in which "justice requires" waiver of the rule, as required by 37 C.F.R. § 1.183. For example, Micron has not explained what procedures were in place at the law firm of Micron's attorney for docketing *inters partes* reexamination matters; why those procedures were insufficient in this instance; and why the docketing error was an extraordinary situation for which justice requires waiver of the rule-specified filing deadline.

#### DECISION

In view of the foregoing, Micron's Waiver Petition is DENIED without prejudice to the filing a renewed petition within one month from the mailing date hereof. Action on Rambus's Petition to Expunge will be held in abeyance pending the filing of a renewed petition by Micron.



---

James D. Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

Counsel for Patent Owner:

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Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

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

DATE MAILED: 06/07/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE  
OFFICE OF PATENT LEGAL ADMINISTRATION  
and  
BOARD OF PATENT APPEALS AND INTERFERENCES<sup>1</sup>

---

RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

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Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

---

DECISION ON PETITIONS

This is a decision on:

1. Patent Owner's "Petition to Expunge Third Party Requester's Cross-Appeal Brief," filed August 23, 2010 (Cross-Appeal Brief Petition); and "Third Party Requester's Opposition to Patent Owner's Petition to Expunge Third Party Requester's Cross-

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<sup>1</sup> OPLA has authority to review Requesters Cross-Appeal Brief, filed July 21, 2010, and BPAI has authority to review Requester's Rebuttal Brief, filed November 22, 2010. *See*, 75 Fed. Reg. 50,750-51 (Aug. 17, 2010).

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

Appeal Brief,” filed January 7, 2011 (Cross-Appeal Brief  
Opposition); and

2. Patent Owner’s “Petition to Expunge Third Party Requester’s  
Rebuttal Brief,” filed December 30, 2010 (Rebuttal Brief Petition);  
and “Third Party Requester’s Opposition to Patent Owner’s  
Petition to Expunge Third Party Requester’s Rebuttal Brief,” filed  
January 18, 2011 (Rebuttal Brief Opposition).

#### FINDINGS

1. Patent 6,324,120 issued on November 27, 2001 with 39 claims. The  
‘120 patent is assigned to Patent Owner Rambus, Inc. (“Rambus”).
2. Third Party Requester Samsung Electronics, Co. Ltd. (“Samsung”)  
filed a corrected request for *inter partes* reexamination on October 6, 2006.  
Reexamination Control 95/000,178 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter  
partes* reexamination of claims 1-39 of the ‘120 patent in the ‘178  
proceeding.
4. Third Party Requester Micron Technology, Inc. (“Micron”) filed a  
request for *inter partes* reexamination on February 27, 2009. Reexamination  
Control 95/001,152 was assigned to this request.
5. On April 22, 2009, the Office issued an Order granting *inter partes*  
reexamination of claims 26, 29 and 33 of the ‘120 patent in the ‘1152  
proceeding.
6. On July 21, 2009, the ‘178 and ‘1152 proceedings were merged.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution (“ACP”) was mailed in the merged proceeding.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On April 23, 2010, the Office mailed a Right of Appeal Notice (“RAN”), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.
10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.
11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.
12. On July 19, 2010, Rambus filed an Appeal (Appellant) Brief.
13. On July 21, 2010, Micron filed a Cross-Appeal (Appellant) Brief.
14. On August 23, 2010, Rambus filed a Respondent Brief and the Cross-Appeal Brief Petition.
15. Also on August 23, 2010, Micron filed a Respondent Brief.
16. On October 21, 2010, the Examiner entered an Answer incorporating the RAN of April 23, 2010.
17. On November 22, 2010, Rambus filed a Rebuttal Brief.
18. Also on November 22, 2010, Micron filed a Rebuttal Brief.
19. On December 30, 2010, Rambus filed the Rebuttal Brief Petition.
20. On January 10, 2011, Micron filed the Cross-Appeal Brief Opposition.
21. On January 18, 2011, Micron filed the Rebuttal Brief Opposition.

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

## DISCUSSION

Rambus seeks expungement of Micron's Cross-Appeal and Rebuttal Briefs because those briefs present arguments premised on rejections initially proposed by Samsung and not by Micron. As recently discussed in the Decision on Petition entered April 27, 2011 in merged reexamination proceeding 95/000,250 and 95/001,124, involving the same parties that are involved here, the Office has addressed this issue on several occasions in the past few months and decided that Micron, in its briefs, was permitted to address the rejections and proposed rejections that were before the Office at the time of the RAN. In view of the detailed analysis that the Office has given this issue, as reflected in the prior relevant decisions, further analysis of the same issue is not required.

## DECISION

In view of the foregoing:

The Cross-Appeal Brief Petition is DENIED.



Brian E. Hanlon  
Director, Office of Patent Legal Administration

The Rebuttal Brief Petition is DENIED.



James D. Smith  
Chief Administrative Patent Judge, Board of Patent Appeals and Interferences

*Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

Counsel for Patent Owner:

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DATE MAILED: 09/20/2011

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Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/000,178

MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,152

---

Merged *Inter partes* Reexamination Control 95/000,178 and 95/001,152  
Patent 6,324,120

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DECISION ON PETITIONS

This is a decision on Third Party Requester's Renewed Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 41.66(B), filed June 30, 2011 ("Renewed Waiver Petition").

*Inter partes* Reexamination Control Nos. 95/000,178 and 95/001,152  
Patent 6,324,120

## FINDINGS

1. Patent 6,324,120 issued on November 27, 2001, with 39 claims. The '120 patent is assigned to Rambus, Inc. ("Rambus").
2. Third Party Requester Samsung Electronics, Co. Ltd. ("Samsung") filed a corrected request for *inter partes* reexamination on October 6, 2006. Reexamination Control 95/000,178 was assigned to this request.
3. On December 26, 2006, the Office issued an Order granting *inter partes* reexamination of claims 1-39 of the '120 patent in the '178 proceeding.
4. Third Party Requester Micron Technology, Inc. ("Micron") filed a request for *inter partes* reexamination on February 27, 2009. Reexamination Control 95/001,152 was assigned to this request.
5. On April 22, 2009, the Office issued an Order granting *inter partes* reexamination of claims 26, 29 and 33 of the '120 patent in the '1152 proceeding.
6. On July 21, 2009, the '178 and '1152 proceedings were merged.
7. The merged proceeding progressed to the point where, on January 29, 2010, an Action Closing Prosecution ("ACP") was mailed in the merged proceeding.
8. On February 11, 2010, Samsung filed a notice of non-participation in the merged proceeding.
9. On April 23, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-4, 6, 8-11, 15, 16, 19 and 21-25, and confirming claims 5, 7, 12-14, 17, 18, 20 and 26-39.

*Inter partes* Reexamination Control Nos. 95/000,178 and 95/001,152  
Patent 6,324,120

10. On May 21, 2010, Rambus filed a Notice of Appeal for claims 1-4, 6, 8-11, 15, 16, 19 and 21-25.

11. Also on May 21, 2010, Micron filed a Notice of Appeal for claims 26, 29 and 33.

12. On July 19, 2010, Rambus filed an Appellant Brief.

13. On July 21, 2010, Micron filed an Appellant Brief.

14. On August 23, 2010, Rambus filed a Respondent Brief.

15. Also on August 23, 2010, Micron filed a Respondent Brief.

16. On October 15, 2010, Rambus filed a Petition to Expunge Third-Party Requester's Respondent Brief ("Petition to Expunge").

17. On December 15, 2010, Micron filed a Third Party Requester's Petition Under 37 C.F.R. §§ 1.182 and 1.183 for Limited Waiver of 37 C.F.R. §§ 1.957(A) and 41.66(B) ("Waiver Petition").

18. In a Decision on Petitions, Micron's Waiver Petition was denied without prejudice to the filing of a renewed petition within one month and Rambus's Petition to Expunge was held in abeyance pending the filing of a renewed petition.

19. On June 30, 2011, Micron filed the present Renewed Waiver Petition.

#### RELEVANT AUTHORITY

37 C.F.R. § 41.66(b) states

Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief.

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*Inter partes* Reexamination Control Nos. 95/000,178 and 95/001,152  
Patent 6,324,120

Other rules of the Office may be suspended, as follows:

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

37 C.F.R. § 1.183.

ANALYSIS

Micron's Respondent Brief was due August 19, 2010, but was not filed until August 23, 2010, making it two days late considering that August 21 and 22 fell on Saturday and Sunday in 2010. In its Waiver Petition, Micron sought a waiver of the one month period specified in 37 C.F.R. § 41.66(b) for filing a respondent brief. Micron attributed the late filing to a docketing error in which the filing date of Micron's Appellant Brief (July 21, 2010) was used instead of the filing date of Rambus's Appellant Brief (July 19, 2010) for determining the due date of Micron's Respondent Brief. (See Waiver Petition, 2.) Micron also noted that Rambus's Appellant Brief was not received until five business days after it was served. (See Waiver Petition, 3.) Micron submitted two exhibits in support of its Petition for Waiver: Exhibit A, which is an excerpt of the docketing chart relied upon by the attorney prior to filing of Micron's Respondent Brief, and Exhibit B, which is a statement by James P. Murphy.

Micron's Petition for Waiver was denied in the previous Decision on Petitions because Micron did not establish that an "extraordinary situation" in which "justice requires" waiver of the rule had occurred.

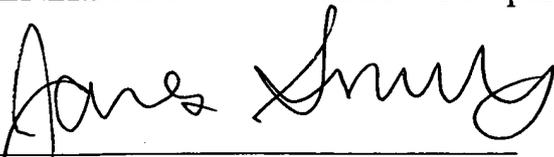
*Inter partes* Reexamination Control Nos. 95/000,178 and 95/001,152  
Patent 6,324,120

Micron now asserts that there was an “unusually long delay” in the receipt of Rambus’s Appellant Brief and that this delay, coupled with the inadvertent docketing error, created an “extraordinary situation,” under 37 C.F.R. § 1.183, warranting acceptance of Rambus’s Respondent Brief two days late. (Renewed Petition, 3.) According to Micron, the docketing error was not noticed because of the early filing by Rambus and the subsequent delay in the mail allowed the docketing error to go unnoticed. (*Id.*)

Rule 41.66 provides the time period for filing a brief by a respondent from “the date of service.” Micron does not dispute that the date Rambus served its Appeal Brief was evident from its Certificate of Service or that Micron could not have known the date of service. Nor does Micron argue that the delay in the U.S. mail was so long that there was not time to prepare a Respondent’s Brief. Thus, the only cause of Micron’s late filing was the error in docketing, which does not rise to the level of an extraordinary situation. Micron has provided no showing that this situation is extraordinary nor that justice requires waiver of the rules. Accordingly, the present request for reconsideration is **denied**. Micron’s respondent brief is **not entered**.

#### DECISION

In view of the foregoing, Micron’s Renewed Waiver Petition is DENIED. Rambus’s Petition to Expunge is GRANTED.

  
\_\_\_\_\_  
James Donald Smith  
Chief Administrative Patent Judge

**Best Available Copy**

*Inter partes* Reexamination Control Nos. 95/000,178 and 95/001,152  
Patent 6,324,120

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,154	03/03/2009	6,584,037	8963.002.RXUS00	7630

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.
95/001,154	03/03/2009	6584037	

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EXAMINER

OVIDIO, ESCALANTE

ART UNIT      PAPER

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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

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

*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

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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.*

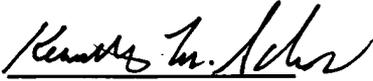
2. On November 7, 2008, a request for *inter partes* reexamination was filed, which was assigned reexamination proceeding control No. 95/001,108 (“the ‘1108 proceeding”), by third party requester Samsung Electronics, Co. Ltd., the real party in interest.
3. On January 9, 2009, the Office issued an order 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.
95/001,154	03/03/2009	6,584,037	8963.002.RXUS00	7630

22852            7590            11/23/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,154	11/07/2008	6584037	38512.15

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT      PAPER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,154	11/07/2008	6584037	38512.15

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ESCALANTE, OVIDIO

ART UNIT      PAPER

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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

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

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,154	03/03/2009	6,584,037	8963.002.RXUS00	7630
22852	7590	07/06/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 07/06/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES<sup>1</sup>

---

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

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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:

---

<sup>1</sup> 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).

*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

- 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

*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

'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.)

*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

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.

*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

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

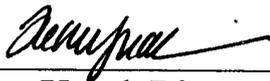
*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

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.



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James Donald Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control Nos. 95/001,108 and 95/001154  
Patent 6,584,037

Counsel for Patent Owner Rambus:

Naveen Modi

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1000 Louisiana Street, 53rd Floor

Houston, TX 77002



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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	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 08/03/2010

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Date:

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NOVAK DRUCE & QUIGG, LLP  
1000 Louisiana Ave., 53rd Floor  
Houston, TX 77002

**MAILED**

**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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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~~95/001,109~~

11/11/2008

6546446

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22852            7590            08/03/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

ART UNIT                      PAPER NUMBER

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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

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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.<sup>1</sup>
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

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<sup>1</sup> 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.<sup>2</sup> 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  
Senior Legal Advisor  
Office of Patent Legal Administration

---

<sup>2</sup> 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.
95/001,155	03/11/2009	6546446	8963.002.446	7688

22852 7590 11/23/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
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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.
95/001,109	11/11/2008	6546446	38512.20	9305
22852	7590	11/23/2010	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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SUITE 700  
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MAILED  
Date: NOV 23 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

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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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1000 Louisiana Ave., 53rd Floor  
Houston, TX 77002

Date:

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**NOV 23 2010**

CENTRAL REEXAMINATION

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

(For patent owner)

MAILED

NOV 23 2010

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Haynes and Boone, LLP  
IP Section  
2323 Victory Avenue, Suite 700  
Dallas, TX 75219

(For the '1109 *inter partes* requester)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Avenue, 53<sup>rd</sup> 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

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

*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

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.<sup>1</sup>
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.

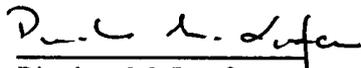
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<sup>1</sup> On March 26, 2009, the Office granted patent owner a one month extension of time to respond to the February 13, 2009 Office action.

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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22852	7590	06/17/2011	EXAMINER	
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DATE MAILED: 06/17/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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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

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Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155  
Patent 6,546,446

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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

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

(“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

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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.

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

(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.

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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

Counsel for Patent Owner Rambus:

Naveen Modi

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

900 New York Ave, N.W.

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EXAMINER

ART UNIT                      PAPER NUMBER

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BEFORE THE  
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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

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Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155  
Patent 6,546,446

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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.

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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).

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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,

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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 exists 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

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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.

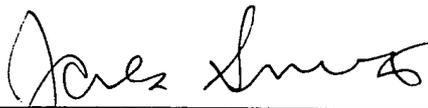
*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

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.



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James Donald Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001155  
Patent 6,546,446

Counsel for Patent Owner Rambus:

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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	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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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	09/15/2011	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 09/15/2011

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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RAMBUS, INC.  
Patent Owner

SAMSUNG ELECTRONICS CO., LTD.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,109

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MICRON TECHNOLOGY, INC.  
Third Party Requester – *Inter partes* Reexamination Control 95/001,155

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Merged *Inter partes* Reexamination Control 95/001,109 and 95/001,155  
Patent 6,546,446

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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.

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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

**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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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

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.  

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*(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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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

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:

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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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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

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* Manual of Patent Examining Procedure § 2667 ("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

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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

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**

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For the forgoing reasons, Rambus's Petition for Review is **DENIED**.



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James Donald Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner Rambus:  
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*Inter partes* Reexamination Control Nos. 95/001,109 and 95/001,155  
Patent 6,546,446

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,158	05/01/2009	7138275	674528-5002	8993
28381	7590	11/23/2010	EXAMINER	
ARNOLD & PORTER LLP ATTN: IP DOCKETING DEPT. 555 TWELFTH STREET, N.W. WASHINGTON, DC 20004-1206			ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,158	05/01/2009	7138275	

VEDDER PRICE, PC  
1633 BROADWAY  
47<sup>th</sup> FLOOR  
NEW YORK, NY 10019

EXAMINER

PONNALURI, SHRI

ART UNIT      PAPER

3991

DATE MAILED:

11/23/10

### **INTER PARTES REEXAMINATION COMMUNICATION**

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

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



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95/001,158	05/01/2009	7138275	

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EXAMINER

PONNALURI, SHRI

ART UNIT      PAPER

3991

DATE MAILED:

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ATTN: IP DOCKETING DEPT.  
555 TWELFTH STREET, N.W.  
WASHINGTON DC 20004-1206

(FOR PATENT OWNER)

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VEDDER PRICE P.C.  
1633 BROADWAY, 47TH FLOOR  
NEW YORK, NY 10019

(FOR THIRD PARTY  
REQUESTER)

*In re Kremer et al.*  
Reexamination Proceeding  
Control No. : 95/001,158  
Filed: May 1, 2009  
Patent No. 7,138,275

DECISION ON  
REQUESTER'S  
PETITION  
UNDER 37 CFR 1.181

This is a decision addressing Requester's petition, filed October 4, 2010, under 37 CFR 1.181 requesting that prosecution be reopened. Although the petition contains statements that an alternative relief sought through granting a request for continued reexamination under 37 CFR 1.182, the petition is being decided solely under 37 CFR 1.181. The Requester's combined petition under 37 CFR 1.181 and 1.182 is deemed improper because it combines two distinct petitions. This is not compliant with 37 CFR 1.4. Requester must file a separate petition for consideration of the issues under 37 CFR 1.182. In summary, this decision solely addresses the issues raised under 37 CFR 1.181, i.e., whether the examiner followed the laws and procedures in issuing the Right of Appeal Notice.

The petition is before the Director of Technology Center 1600, who also oversees the Central Reexamination Unit, for decision.

Patent Owner's petition is DENIED.

## STATEMENT OF FACTS RELEVANT TO THE DECISION

1. Patent No. 7,138,275 (the '275 patent) issued on November 21, 2006.
2. A request for reexamination, assigned Control No. 95/001,158 (the '158 proceeding), was filed by a third party Requester on May 1, 2009.
3. Reexamination was ordered in the '158 reexamination proceeding on July 2, 2009.
4. An Office action on the merits was mailed on the same day, July 2, 2009. The Office action contained rejections of patent claims 1-14. .
5. On September 30, 2009<sup>1</sup>, Patent Owner filed a response to the Office action by the examiner. The response added new claims 15-23.
6. On October 30, 2009, the Requester filed comments on the Patent Owner's response, which supported the rejections set forth in the first Office action.
7. On March 4, 2010, the Office mailed an Action Closing Prosecution (ACP). The ACP confirmed patent claims 1-14 and indicated proposed new claims 15-23 as allowable.
8. Patent Owner did not file a response to the ACP.
9. On September 2, 2010, the Office mailed a Right of Appeal Notice (RAN). The RAN maintained the allowability of claims 1-23.
10. On October 1, 2010, the Requester filed a Notice of Appeal.
11. On October 4, 2010, the Requester filed a petition under 37 CFR 1.181 and/or 1.182. The Requester also filed a petition under 37 CFR 1.183 requesting waiver of the rule to grant an extension of time to file an appeal brief. The 37 CFR 1.183 petition will be addressed in a separate decision in due course.

## DECISION

The Requester (petitioner) states that they are seeking relief under 37 C.F.R. § 1.181 to have prosecution be reopened. Petitioner specifically requests that the director find that the examiner made errors in her determination that the claims are patentable over the cited prior art. Specifically, the petitioner states the examiner erred in her decision to withdraw the rejections, which were applied in the first Office action, in the Action Closing Prosecution (ACP). See, e.g., pages 1-3 of the petition.

Upon review of the record, it is noted that the proposed rejections that were applied in the first Office action were withdrawn in the ACP. The RAN maintained the position set

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<sup>1</sup> A one month extension of time was granted on August 24, 2009.

forth in the ACP. See the stated facts in the background section of this decision. Therefore, the action that the petitioner is requesting relief from is the ACP, dated March 4, 2010. See also page 5 of the petition where it states that the basis of the petition is the examiner's alleged errors in the ACP. Accordingly, a petition under 37 CFR 1.181 must have been filed within two months of March 4, 2010 (no later than May 4, 2010) to be timely filed.

37 CFR 1.181(f) states:

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

In other words, this petition is untimely to request relief from the examiner's actions in the ACP. Even if this petition is deemed timely filed as a petition requesting relief from the RAN (dated September 2, 2010), the grounds of argument presented in the petition only address the merits of the examiner's determinations, which are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issues of whether the examiner incorrectly withdrew the rejections under 35 U.S.C. 102 and/or 103 are appealable issues, and therefore, cannot be addressed by petition. Therefore, the merits of the examiner's decisions will not be addressed in this decision.

In response to petitioner's general arguments for reopening prosecution in this reexamination proceeding, the director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a right of appeal notice (RAN) and/or an action closing prosecution (ACP). The petition does not state that the examiner failed to follow Office policies and procedures, and does not allege that the ACP or RAN was premature. The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP and a RAN, and did not categorically deprive the petitioner of its statutory rights to present comments and proposed rejections in reexamination proceedings.

The examiner appropriately followed Office rules and procedures in deciding to issue the ACP and RAN, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the Requester's petition, as it relates to reopening prosecution of the instant reexamination proceeding, is denied.

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed October 4, 2010, is **DENIED** for the reasons discussed above.
2. The consideration of the petition under 37 CFR 1.183 will be made in due course.
4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.



---

Irem Yucel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,158	05/01/2009	7138275	674528-5002	8993

28381                      7590                      11/23/2010

ARNOLD & PORTER LLP  
ATTN: IP DOCKETING DEPT.  
555 TWELFTH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 11/23/2010

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.
95/001,158	05/01/2009	7138275	

VEDDER PRICE PC  
1633 BROADWAY  
47<sup>th</sup> FLOOR  
NEW YORK, NY 10019

EXAMINER

PONNALURI, SHRI

ART UNIT      PAPER

3991

DATE MAILED:

11/23/10

### **INTER PARTES REEXAMINATION COMMUNICATION**

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

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



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Arnold & Porter LLP  
ATTN: IP Docketing Dept.  
555 Twelfth Street, N.W.  
Washington, DC 20004-1206

MAILED  
NOV 23 2010  
(For Patent Owner) CENTRAL REEXAMINATION UNIT

Attn: Thomas J. Kowalski  
Vedder Price  
1633 Broadway, 47th Floor  
New York, NY 10019

(For Third Party Requester)

*In re* Kremer *et al.* :  
*Inter Partes* Reexamination Proceeding : **DECISION**  
Control No. 95/001,158 : **DISMISSING PETITION**  
Filed: May 1, 2009 : **UNDER 1.183**  
For: U.S. Patent No. 7,138,275 B2 :

This is a decision on the October 4, 2010 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES OF 37 C.F.R. § 41.66."

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

The petition is **dismissed**.

### BACKGROUND

- On March 20, 2009, a request for *inter partes* reexamination of U.S. Patent Number 7,138,275 B2 was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,158 ("the '1158 proceeding"). The filing date requirements of 37 C.F.R. § 1.915 were met on May 1, 2009.
- On July 2, 2009, reexamination was ordered and a first action was mailed in the proceeding.
- Prosecution progressed, until, on September 2, 2010, a Right of Appeal Notice was mailed by the Office, setting a time period for filing of an appellant's brief to run the longer of 1 month or thirty days from the date of the Right of Appeal Notice.
- On October 1, 2010, third party requester filed a Notice of appeal.
- On October 4, 2010, third party requester filed two petitions; the first entitled "PETITION UNDER 37 C.F.R. § 1.182 TO SEEK RELIEF THAT IS NOT

CURRENTLY PROVIDED BY AN EXISTING RULE BY REOPENING PROSECUTION OR IN THE ALTERNATIVE UNDER 37 C.F.R. § 1.181 FOR PREMATURE ACP TO REOPEN PROSECUTION AND TO HAVE NEW OFFICE ACTION;" the second entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OF RULES OF 37 C.F.R. § 41.66." The latter petition, seeking an extension of time to file third party requester's appellant's brief, is the subject of this decision.

- On November 12, 2010, the patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.183."
- On November 23, 2010, the Office dismissed the October 4, 2010 petition filed under 37 C.F.R. § 1.181/ § 1.182.

### **PERTINENT REGULATIONS**

#### **37 C.F.R. § 1.183 provides:**

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

#### **37 C.F.R. § 1.181(f) provides, in pertinent part:**

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

#### **37 C.F.R. § 41.66(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**

Third party requester petitioner filed the instant petition to extend the time to file an appellant's brief "until there is a decision on the Rule 182/181 petition, and if that decision necessitates the filing of an Appeal Brief, then the Appeal Brief be due two (2) months after the decision on the Rule 182/181 petition." Petitioner states that such waiver would prevent the unnecessary

expenditure of resources by the party in briefing the proceeding should the Rule §§ 1.181/1.182 petition be granted. However, on November 23, 2010, the Office dismissed the October 4, 2010 petition filed under §§ 1.181 and 1.182. Therefore, any resources expended in briefing the proceeding will not be mooted by the granting of that petition.

With respect to the request for a two month time period to be granted from the mailing date of the decision on the §§ 1.181 and 1.182 petition, § 1.181(f) states that the mere filing of a petition will not stay any period for reply. Therefore, petitioner has no reasonable basis to expect that, in the event of a dismissal of the §§ 1.181/1.182 petition, the time for filing the appeal brief would be extended in the absence of a showing of extraordinary circumstances under § 1.183. Petitioner has not presented any reasoning supporting a finding of extraordinary situations in this proceeding such that justice would require an additional two months would be required, in the interests of justice for petitioner to file the appellant's brief.

For the foregoing reasons, the instant petition is dismissed. The time period for appellant's brief continues to run as set forth in § 41.66(a); specifically, two months from the latest filing date of the last-filed notice of appeal of October 1, 2001; i.e., through December 1, 2010.<sup>1</sup>

### 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

November 23, 2010

---

<sup>1</sup> Note that the patent owner is not "entitled to file an appeal or cross-appeal," since 37 C.F.R. § 41.61 states that a patent owner may file an appeal or cross-appeal "with respect to the final rejection of any claim of the patent." In the instant proceeding, no claim is under final rejection, as set forth in the September 2, 2010 Right of Appeal Notice.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,159

03/24/2009

7177998

2805.001REX7

2219

26111

7590

09/30/2010

EXAMINER

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

1100 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

ART UNIT

PAPER NUMBER

DATE MAILED: 09/30/2010

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



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2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

Date MAILED  
SEP 30 2010  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001159  
PATENT NO. : 7177998  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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

(For Patent Owner)

MAILED

SEP 30 2010

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2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester) CENTRAL REEXAMINATION UNIT

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,159  
Filed: March 24, 2009  
For: U.S. Patent No. 7,177,998

- :
- : *SUA SPONTE*
- : DECISION MODIFYING
- : ORDER FOR *INTER PARTES*
- : REEXAMINATION:
- : WITHDRAWAL OF A
- : SUBSTANTIAL NEW
- : QUESTION OF
- : PATENTABILITY
- :

*Inter partes* reexamination proceeding No. 95/001,159 is before the Director of the Central ReExamination Unit for *sua sponte* consideration of the propriety of the substantial new questions of patentability (SNQs) ordered in the proceeding.

As a result of further consideration, the Order for *inter partes* reexamination is hereby modified to the extent outlined below.

**REVIEW OF FACTS**

1. On February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to *Ware et al.*
2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous*

*Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards, Docket No. 2637.*

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.
10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9358 proceeding to prevent merger with the '1159 *inter partes* proceeding.
12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1159 *inter partes* and '9358 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

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

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed a response to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>
16. On July 1, 2010, third party requester timely filed responsive comments after the June 1, 2010 response by patent owner.
17. Concurrently herewith, the Office issued a decision granting the January 20, 2010 request for reconsideration resulting in dissolution of the merged proceeding.

## DECISION

### I. Propriety of an SNQ in a Reexamination Proceeding

The Office has *sua sponte* reviewed the underlying SNQ's supporting the '1159 reexamination proceeding in light of the guidance set forth in the Manual of Patent Examining Procedures (MPEP) section 2642 which states (emphasis added):

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 by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination **or pending reexamination** of the patent...

Accordingly, for "a substantial new question of patentability" to be present, it is only necessary that:

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

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

In particular, the later filed '1159 *inter partes* reexamination has been reviewed for the existence of any SNQ's which were also raised in the pending '9358 *ex parte* reexamination proceeding's request.

## II. Discussion of Requests and Orders for *Ex Parte* and *Inter Partes* Reexaminations

The earlier filed *ex parte* reexamination proceeding was granted based on the examiner's determination that there existed a substantial likelihood that a reasonable examiner would consider the teachings of the Coteus patent important in deciding the patentability of claims 7, 13, 21 and 22 of the '998 patent. In the request, it was proposed that Coteus be applied against the requested claims under 35 USC 102 as an anticipatory reference. Thus it was agreed that the technical teachings of Coteus raised a SNQ as to claims 7, 13, 21 and 22 of the '998 patent.

In the later filed *inter partes* reexamination proceeding, the examiner determined that there existed a substantial likelihood that a reasonable examiner would consider the teachings of the Coteus patent important in deciding the patentability of claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 of the '998 patent. In the request, it was proposed that Coteus be applied against the requested claims under 35 USC 102 as an anticipatory reference. Thus it was agreed that the technical teachings of Coteus raised a SNQ as to claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 of the '998 patent.

Both decisions on the requests found that an SNQ was raised by Coteus under 35 USC 102 with respect to claims 7, 13, 21 and 22 due to Coteus providing the new technical teaching of at least "a delay circuit to introduce a phase delay to the receipt of the first and second data signals from the first and second memory devices based on different first and second propagation times, wherein the first and second propagation times [sic] and were required for the read command to propagate on the control path between the respective first and second memory devices and the memory controller".

## III. Findings and Analysis

As the *ex parte* reexamination proceeding was granted first and pending at the time the *inter partes* reexamination proceeding was requested, the later determination that Coteus raised a SNQ to claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 (including claims 7, 13, 21 and 22) of the '998 patent *inter partes* reexamination proceeding is the same question raised in a pending reexam and thus improper for consideration in *inter partes* reexamination proceeding.

Accordingly, the May 26, 2009 *inter partes* reexamination proceeding order is hereby modified and will be limited to issue of Coteus' new technical teaching under 35 USC 102/103 with respect to claims 1, 2, 4, 5, 8, 14, 15, 18, 19, 20, 23 and 24. This is a *sua sponte* withdrawal of the determination that Coteus raised a SNQ with respect to claims 7, 13, 21 and 22 of the '998 patent in the *inter partes* reexamination proceeding order.

The SNQ raised by Coteus with respect to claims 7, 13, 21 and 22 of the '998 patent will be considered **solely** as one raised by the '9358 *ex parte* reexamination proceeding's request.

### CONCLUSION

1. The *inter partes* reexamination proceeding Order is hereby *sua sponte* modified as set forth above.
2. Telephone inquiries related to the present decision should be directed to J. Harrison, SPE Au 3992 Central Reexamination Unit at 571-272-4449.



---

Gregory Morse, Director  
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219

26111 7590 09/30/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/30/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,358	12/08/2008	7177998	2805.001REX5	1953
26111	7590	09/30/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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Date: **MAILED**  
**SEP 30 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001159  
PATENT NO. : 7177998  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ORRICK, HERRINGTON & SUTCLIFFE LLP

ATTN: FABIO E. MARINO

1000 MARSH ROAD

MENLO PARK, CA 94025

MAILED

SEP 30 2010

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90009358

PATENT NO. : 7177998

ART UNIT : 3992

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

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

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

(For Patent Owner)

HAYNES & BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester)

MAILED

SEP 30 2010  
CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
Attn: Fabio E. Marino  
1000 Marsh Road  
Menlo Park, CA 94025

(For *ex parte* Requester)

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,159  
Filed: March 24, 2009  
For: U.S. Patent No. 7,177,998

:  
:  
:  
: DECISION  
: DISSOLVING  
: MERGER OF  
: REEXAMINATION  
: PROCEEDINGS

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

:  
:  
:

This is a decision on patent owner's January 20, 2010 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER AND SET ASIDE MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is \$400, which was charged to Patent Owner's credit card on January 20, 2010, pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

## REVIEW OF FACTS

1. On February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*
2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.
4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.

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

10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9358 proceeding to prevent merger with the '1159 *inter partes* proceeding.
12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1159 *inter partes* and '9358 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed the present petition requesting reconsideration of the Office December 16, 2009 decision.
14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>

## DECISION

### I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner's previous petition.

Patent owner requests as remedies in the now merged proceeding of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner's previous petition.

## II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "ex parte reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed. The merger of the present, concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings.

## III. Findings and Analysis

Reexamination of the '998 patent has been ordered in the '9358 *ex parte* proceeding and '1159 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings, and the statute is silent as to the matter. The determination whether

to merge two reexamination proceedings is an act reserved to the sole discretion of the Office. (See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I,<sup>3</sup> MPEP 2686.01 IV,<sup>4</sup> 2283,<sup>5</sup> MPEP 2286.<sup>6</sup>)

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).<sup>7</sup> To the extent the MPEP states the Office will “normally” merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the “sole discretion” of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.<sup>8</sup> Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.<sup>9,10</sup>

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<sup>3</sup> “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.’”

<sup>4</sup> “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.”

<sup>5</sup> “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.’”

<sup>6</sup> “[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.’”

<sup>7</sup> “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).

<sup>8</sup> *Id.*

<sup>9</sup> 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.”

<sup>10</sup> “[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office.” *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '998 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.<sup>11</sup> Therefore, it was requester that determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

Based upon the specific facts and circumstances of the reexamination proceedings on the '998 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

#### IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.<sup>12</sup> All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public. Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. The examiner will issue an Office action in the '9358 *ex parte* reexamination proceeding taking into account the August 10, 2009 patent owner response having been filed. The examiner will issue an Office action in the '1159 *inter partes* reexamination proceeding taking into account that no responses (and comments) have been filed.
2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.
3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding, so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is

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<sup>11</sup> See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.

<sup>12</sup> This does not include the decisions to order reexamination; they are not deemed Office actions in this context, and they were not issued while the proceedings were merged.

based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133, which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (see MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

## V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.<sup>13</sup> The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.<sup>14</sup> None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

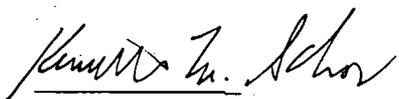
## CONCLUSION

1. The January 20, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

<sup>13</sup> In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, on an as-needed-per-interview basis.

<sup>14</sup> See MPEP §§ 713 *et seq.*, 2281 and 2685.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.<sup>15</sup>
3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.
4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action not inconsistent with this decision.
5. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

6-25-10

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<sup>15</sup> As pointed out above, this does not apply to the decisions to order reexamination.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219

26111                      7590                      01/07/2011

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

EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 01/07/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,358	12/08/2008	7177998	2805.001REX5	1953
26111	7590	01/07/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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

(For Patent Owner)

MAILED

JAN 07 2011

HAYNES & BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester)

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
Attn: Fabio E. Marino  
1000 Marsh Road  
Menlo Park, CA 94025

(For *ex parte* Requester)

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,159  
Filed: March 24, 2009  
For: U.S. Patent No. 7,177,998

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: DECISION  
: ON  
: PETITION

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

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This is a decision on third party requester's October 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on October 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The September 30, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On February 13, 2007, the Office issued U.S. Patent No. 7,177,998 (the '998 patent) to Ware *et al.*
2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '998 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,358 (the '9358 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9358 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9358 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '1159 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9358 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1159 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '998 patent, claims 1-24, would be subject to reexamination.
10. On August 10, 2009, Patent Owner filed a response in the '9358 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9358 proceeding to prevent merger with the '1159 *inter partes* proceeding.
12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1159 *inter partes* and '9358 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office December 16, 2009 decision.

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

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>
16. On July 1, 2010, third party requester timely filed responsive comments.
17. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '1160 and the '9357 proceedings.
18. Also on September 30, 2010, the Office issued a *sua sponte* decision modifying the order for *inter partes* reexamination withdrawing a substantial new question of patentability.
19. On October 21, 2010, third party requester filed the present petition, requesting reconsideration of the September 30, 2010 decision.

## DECISION

### I. Issues Raised and Relief Requested

Third party requester contends that the Office's September 30, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the September 30, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

### II. Discussion of Previous Petitions and Decisions

#### a. The October 14, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

pattern combined with a merger of the two reexamination proceedings denies patent owner of “*ex parte* reexamination rights”; and (3) Requester’s reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester’s *inter partes* rights. Patent owner’s original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No “*ex parte* right” was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party’s rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

**b. The January 20, 2010 Patent Owner Petition and September 30, 2010 Office Decision**

On January 20, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 20, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner’s previous petition. Patent owner’s January 20, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner’s previous petition.

On September 30, 2010, the Office issued a decision granting patent owner's January 20, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

### III. Findings and Analysis

#### a. The September 30, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment<sup>3</sup> and argues that the September 30, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

In response:

The September 30, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>4</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '998 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the October 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>5</sup>

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<sup>3</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

<sup>4</sup> *Id.*

<sup>5</sup> See MPEP 2686.01 IV.

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Coteus reference relative to only a few of the claims in the '998 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of the Coteus reference relative to a substantial number of the claims in the '998 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.

2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>6</sup> 37 CFR 1.989(a),<sup>7</sup> MPEP 2686.01 I,<sup>8</sup> MPEP 2686.01 IV,<sup>9</sup> MPEP 2283,<sup>10</sup> and MPEP 2286.<sup>11</sup> See also "Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge

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<sup>6</sup> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

<sup>7</sup> "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).

<sup>8</sup> "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.'"

<sup>9</sup> "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."

<sup>10</sup> "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.'"

<sup>11</sup> "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

(consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

**b. The September 30, 2010 Office decision is not a violation of Requester’s Rights**

The requester asserts that the September 30, 2010 dissolution decision somehow alters requester’s substantive rights.

The dissolution decision does not alter the requester’s rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester’s rights upon filing of each request for reexamination. The Office’s merger of proceedings does not alter a party’s rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

**c. The September 30, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner’s listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester’s right to comment; and (3) Third party

requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>12</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

#### **d. The September 30, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the September 30, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings

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<sup>12</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>13</sup> In the present instance, as noted in the September 30, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The September 30, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a "quick" request, simply to "get" something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings for the same patent, albeit

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<sup>13</sup> See MPEP 2686.01 IV.

each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The September 30, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.<sup>14</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The September 30, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>15</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### **IV. Summation**

Accordingly, for all the reasons stated above requester's petition to reconsider the September 30, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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<sup>14</sup> See the September 30, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>15</sup> See Petition at page 9, section E.

## CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

1/6/11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219
26111	7590	12/23/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/23/2011

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



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WASHINGTON, DC 20005

(FOR PATENT OWNER)

DEC 23 2011

**CENTRAL REEXAMINATION UNIT**

HAYNES AND BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(FOR THIRD PARTY REQUESTER)

*In re Ware et al.*  
Reexamination Proceeding  
Control No. 95/001,159  
Filed: March 24, 2009  
For: U.S. Patent No. 7,177,998

**DECISION RETURNING  
UNAUTHORIZED PAPER  
AND DISMISSING  
PETITION AS MOOT**

This is a decision on the February 18, 2010 third party requester paper entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS." This decision also addresses the March 2, 2010 patent owner opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

The petitions are before the Director of the Central Reexamination Unit.

The February 18, 2010 petition is returned as an improper paper.

The March 2, 2010 petition is dismissed as moot.

**STATEMENTS OF RELEVANT FACTS**

1. Patent No. 7,177,998 (the '998 patent) issued on February 13, 2007.
2. The '998 patent is subject to litigation in the United States District Court for the District of Northern California, in Rambus Inc. v. Nvidia Corp., {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards, Docket No. 2637.
4. A request for reexamination, assigned Control No. 90/009,358 (the '358 proceeding), was filed by a third party requester on December 8, 2008. Reexamination was requested for claims 7, 13, 21, and 22 of the '998 patent.
5. On January 16, 2009, the Office issued an order granting the '358 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '998 patent, would be subject to reexamination.
6. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '998 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,159 (the '159 proceeding).
7. On May 26, 2009, the Office issued an order granting the '159 request for *inter partes* reexamination.
8. On October 14, 2009, patent owner filed a petition in the '358 *ex parte* proceeding to prevent merger with the '159 *inter partes* proceeding.
9. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '159 *inter partes* and '358 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
10. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.
11. On February 18, 2010, third party requester filed a petition under 37 CFR 1.181 entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS."
12. On March 2, 2010, patent owner filed an opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

13. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '159 and the '358 proceedings.
14. Prosecution has advanced and on October 3, 2011, the Office issued a non-final Office action that set a one month time period for response.
15. On November 3, 2011, the patent owner submitted a response to the October 3, 2011 Office action.
16. On December 1, 2011, the third party requester submitted comments on the October 3, 2011 Office action and the November 3, 2011 patent owner's response.

### **DECISION**

37 CFR 1.4(c) provides as to correspondence with the Office:

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

37 CFR 1.181(a) provides that petitions to the Director may be made:

(a) Petition may be taken to the Director:

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

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.939 provides for treatment for unauthorized papers:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

The petition filed on February 18, 2010 in this reexamination proceeding *will not* be decided on the merits, and is being returned as an improper paper that does not have a right of entry. See MPEP 2667.

Requester's February 18, 2010 petition combined issues under 37 CFR 1.181 and 1.183. The combined petition under 37 CFR 1.181 and 1.183 is deemed improper because it combines two distinct petitions, which is not compliant with 37 CFR 1.4(c). Accordingly, any relief requested under 37 CFR 1.183 is procedurally dismissed under 37 CFR 1.4. In summary, this decision treats the February 18, 2010 petition under 37 CFR 1.181.

The February 18, 2010 petition does not have a right of entry for the following reasons. First, as explained above, the petition was not filed in compliance with the requirements of 37 CFR 1.4(c). Second, the petition is not proper under 37 CFR 1.181. 37 CFR 1.181(a)(1) provides for a petition to be taken from any action or requirement of the examiner. This provision limits petitions to issues that have been raised and does not provide for petitions, such as the instant petition, to challenge future decisions that fall within the Office's discretionary procedural process. 37 CFR 1.181(a)(3) provides for a petition when the Office did not follow its established procedure and policies. The February 18, 2010 does not assert that the Office did not follow its established procedure and policies. Furthermore, this petition is similar to a petition requesting that an extension of time be denied. MPEP 2667 clearly states that such petitions "... will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the re-examination proceeding..." For these reasons, the February 18, 2010 petition does not raise issues permitted in a petition under 37 CFR 1.181. Accordingly, the February 18, 2010 petition is deemed an improper paper and will be returned in accordance with 37 CFR 1.939 and MPEP 2667.

The March 2, 2010 opposition petition is dismissed as moot because the February 18, 2010 petition is deemed an improper paper.

In view of the above, the February 18, 2010 petition in the reexamination proceeding does not have an entry right under the rules. Therefore, the February 18, 2010 petition will not be made of record in the '159 reexamination proceeding, and it is being returned to the third party requester *without consideration of the substance of the petition*. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. The present decision will, however, be made of record in the reexamination proceeding. See MPEP 2667.

## CONCLUSION

1. The February 18, 2010 petition paper filed in the '159 reexamination proceeding is returned to the third party requester with this decision as not having a right of entry.
2. No copy of the petition papers will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.
3. A copy of this decision will be made of record in the reexamination file.

4. The March 2, 2010 petition is dismissed as moot.
5. Telephone inquiries related to this decision should be directed Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611.



Irem Yucel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,159	03/24/2009	7177998	2805.001REX7	2219
26111	7590	04/13/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2012

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DALLAS, TX 75219

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

REEXAMINATION CONTROL NO. : 95001159  
PATENT NO. : 7177998  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



7. On February 8, 2012, the third party requester filed a paper entitled “NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION” (“the notice of non-participation”).
8. On February 17, 2012, the third party requester filed a paper entitled “NOTICE OF WITHDRAWAL OF THIRD-PARTY REQUESTER’S COMMENTS” (“the notice of withdrawal of comments”).
9. On March 7, 2012, patent owner filed the instant petition paper entitled “RESPONSE TO NOTICES AND PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.955” (“the petition under 37 CFR 1.183”).

## 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 March 7, 2012 petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.955, which prohibits interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester’s February 8, 2012 notice of non-participation and February 17, 2012 withdrawal of comments in the ‘1159 proceeding.<sup>1</sup> In the petition under 37 CFR 1.183, patent owner has requested waiver of 37 CFR 1.955 to conduct an in-person interview with the “examining team,” which is taken as a request for a single interview.<sup>2</sup>

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<sup>1</sup> Petition under 37 CFR 1.183 at page 3.

<sup>2</sup> *Id.* at page 2.

In support of its request for waiver of 37 CFR 1.955, patent owner states that an interview “would not prejudice the requester NVIDIA in any way given its complete withdrawal from this case and its consent for Rambus [patent owner] to have substantive *ex parte* communications with the Office.”<sup>3</sup> Patent owner asserts that an in-person interview would (1) enhance and facilitate the understanding of complex technical issues related to “dynamic random access memory (“DRAM”) controllers that use adjustable read data delay settings to coordinate memory operations among diversely-located memory components ... in a way that pure *ex parte* communications cannot accomplish,” (2) efficiently identify the remaining key issues, and (3) allow for timely resolution of the ‘1159 proceeding, which has been pending for nearly three years.<sup>4</sup> Patent owner further asserts that “an in-person interview was important to the parties’ efficient resolution of the related *ex parte* reexamination of this patent (*See* Control No. 90/009,358).”<sup>5</sup> Patent owner also asserts that “[a]n in-person interview will likely enhance the ability of the Office to comply with the statutory mandate of “special dispatch” set forth in 35 U.S.C. § 314(c).”<sup>6</sup>

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

In this instance, third party requester has stated on the record that it is withdrawing from and no longer participating in the ‘1159 *inter partes* reexamination proceeding.<sup>7</sup> Thus, only a single party (patent owner) will now participate in the ‘1159 proceeding, and any interview that might be permitted in the proceeding.

While patent owner has demonstrated that the third party requester would not be prejudiced by conducting an interview at this point in the ‘1159 proceeding, patent owner has not sufficiently focused its request for waiver of 37 CFR 1.955 upon specific matters at issue in the ‘1159 proceeding to be discussed at an interview. For example, patent owner has not identified a specific technical feature(s), specific claim language and/or particular prior art of record at issue

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<sup>3</sup> *Id.* See also *id.* at page 4.

<sup>4</sup> *Id.* at pages 3-4.

<sup>5</sup> *Id.* at page 3.

<sup>6</sup> *Id.* at page 4.

<sup>7</sup> See February 8, 2012 notice of non-participation (stating that “NVIDIA Corporation (“NVIDIA”), the third party requester for *inter partes* reexamination Control No. 95/001,159, hereby gives notice that it no longer intends to participate in the present reexamination.”) See also February 17, 2012 notice of withdrawal of comments (stating that “Third Party Requester, NVIDIA Corporation ... is withdrawing from this proceeding” and “does not object to Patent Owner having substantive *ex parte* communication with the Office for the remainder of this proceeding.”)

in the '1159 proceeding that would be discussed during an interview. Rather, patent owner has made a general request to identify the key issues and discuss unspecified technical issues related to the technology in the '1159 proceeding. Accordingly, for at least these reasons, patent owner's March 7, 2012 petition under 37 CFR 1.183 to waive 37 CFR 1.955 for a one-time interview in the '1159 proceeding is dismissed.

#### CONCLUSION

1. Patent owner's March 7, 2012 petition under 37 CFR 1.183 to waive 37 CFR 1.955 is dismissed.
2. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.



---

Brian E. Hanlon  
Director  
Office of Patent Legal Administration

04-13-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351
26111	7590	09/30/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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SUITE 700  
DALLAS, TX 75219

Date:

**MAILED**  
**SEP 30 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001160  
PATENT NO. : 7210016  
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.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON DC 20005

(For Patent Owner)

SEP 30 2010

CENTRAL REEXAMINATION UNIT

HAYNES & BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester)

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,160  
Filed: March 24, 2009  
For: U.S. Patent No. 7,210,016

:  
: *SUA SPONTE*  
: DECISION MODIFYING  
: ORDER FOR *INTER PARTES*  
: REEXAMINATION:  
: WITHDRAWAL OF A  
: SUBSTANTIAL NEW  
: QUESTION OF  
: PATENTABILITY  
:

*Inter partes* reexamination proceeding No. 95/001,160 is before the Director of the Central ReExamination Unit for *sua sponte* consideration of the propriety of the substantial new questions of patentability (SNQs) ordered in the proceeding.

As a result of further consideration, the Order for *inter partes* reexamination is hereby modified to the extent outlined below.

**REVIEW OF FACTS**

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*
2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous*

*Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards, Docket No. 2637.*

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1160 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 '016 patent, claims 1-24, would be subject to reexamination.
10. On August 10, 2009, Patent Owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9357 *ex parte* proceeding to prevent merger with the '1160 *inter partes* proceeding.
12. On December 16, 2009, the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1160 *inter partes* and '9357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

---

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

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed a response to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>
16. On July 1, 2010 third party requester timely filed responsive comments after the June 1, 2010 response by patent owner.
17. Concurrently herewith, the Office issued a decision granting the January 20, 2010 request for reconsideration resulting in dissolution of the merged proceeding.

## DECISION

### I. Propriety of an SNQ in a Reexamination Proceeding

The Office has *sua sponte* reviewed the underlying SNQ's supporting the '1160 reexamination proceeding in light of the guidance set forth in the Manual of Patent Examining Procedures (MPEP) section 2642 which states (emphasis added):

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 by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or **pending reexamination** of the patent...

Accordingly, for "a substantial new question of patentability" to be present, it is only necessary that:

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

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

In particular, the later filed '1160 *inter partes* reexamination has been reviewed for the existence of any SNQ's which were also raised in the pending '9357 *ex parte* reexamination proceeding's request.

## II. Discussion of Requests and Orders for *Ex Parte* and *Inter Partes* Reexaminations

The earlier filed *ex parte* reexamination proceeding was granted based on the examiner's determination that there existed a substantial likelihood that a reasonable examiner would consider the teachings of the Coteus patent important in deciding the patentability of claims 7, 13, 21 and 22 of the '016 patent. In the request, it was proposed that Coteus be applied against the requested claims under 35 USC 102 as an anticipatory reference. Thus it was agreed that the technical teachings of Coteus raised a SNQ as to claims 7, 13, 21 and 22 of the '016 patent.

In the later filed *inter partes* reexamination proceeding, the examiner determined that there existed a substantial likelihood that a reasonable examiner would consider the teachings of the Coteus patent important in deciding the patentability of claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 of the '016 patent. In the request, it was proposed that Coteus be applied against the requested claims under 35 USC 102 as an anticipatory reference. Thus it was agreed that the technical teachings of Coteus raised a SNQ as to claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 of the '016 patent.

Both decisions on the requests found that an SNQ was raised by Coteus under 35 USC 102 with respect to claims 7, 13, 21 and 22 due to Coteus providing the new technical teaching of at least "a delay circuit to introduce a phase delay to the receipt of the first and second data signals from the first and second memory devices based on different first and second propagation times, wherein the first and second propagation times [sic] and were required for the write command to propagate on the control path between the respective first and second memory devices and the memory controller".

## III. Findings and Analysis

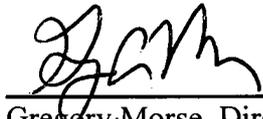
As the *ex parte* reexamination proceeding was granted first and pending at the time the *inter partes* reexamination proceeding was requested, the later determination that Coteus raised a SNQ to claims 1, 2, 4, 5, 7, 8, 13-15 and 18-24 (including claims 7, 13, 21 and 22) of the '016 patent *inter partes* reexamination proceeding is the same question raised in a pending reexam and thus improper for consideration in *inter partes* reexamination proceeding.

Accordingly, the May 26, 2009 *inter partes* reexamination proceeding order is hereby modified and will be limited to issue of Coteus' new technical teaching under 35 USC 102/103 with respect to claims 1, 2, 4, 5, 8, 14, 15, 18, 19, 20, 23 and 24. This is a *sua sponte* withdrawal of the determination that Coteus raised a SNQ with respect to claims 7, 13, 21 and 22 of the '016 patent in the *inter partes* reexamination proceeding order.

The SNQ raised by Coteus with respect to claims 7, 13, 21 and 22 of the '016 patent will be considered **solely** as one raised by the '9357 *ex parte* reexamination proceeding's request.

### CONCLUSION

1. The *inter partes* reexamination proceeding Order is hereby *sua sponte* modified as set forth above.
2. Telephone inquiries related to the present decision should be directed to J. Harrison, SPE Au 3992 Central Reexamination Unit at 571-272-4449.



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Gregory Morse, Director  
Central Reexamination Unit

9-29-10  
Kenpet8/UV



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351
26111	7590	09/30/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/30/2010

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148

26111 7590 09/30/2010

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

ART UNIT PAPER NUMBER

DATE MAILED: 09/30/2010

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SUITE 700  
DALLAS, TX 75219

Date: **MAILED**  
**SEP 30 2010**  
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001160  
PATENT NO. : 7210016  
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  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
ATTN: FABIO E. MARINO  
1000 MARSH ROAD  
MENLO PARK, CA 94025

Date:

MAILED

SEP 30 2010

CENTRAL REEXAMINATION

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90009357  
PATENT NO. : 7210016  
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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1100 NEW YORK AVENUE, N.W.  
WASHINGTON DC 20005

(For Patent Owner)

MAILED

SEP 30 2010

HAYNES & BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester)

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
Attn: Fabio E. Marino  
1000 Marsh Road  
Menlo Park, CA 94025

(For *ex parte* Requester)

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,160  
Filed: March 24, 2009  
For: U.S. Patent No. 7,210,016

:  
:  
:  
: DECISION  
: DISSOLVING  
: MERGER OF  
: REEXAMINATION  
: PROCEEDINGS

*In re Ware et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/009,357  
Filed: December 8, 2008  
For: U.S. Patent No. 7,210,016

:  
:  
:

This is a decision on patent owner's January 20, 2010 petition entitled "PETITION UNDER 37 C.F.R. §§ 1.182 AND 1.183 TO RECONSIDER AND SET ASIDE MERGER OF CO-PENDING REEXAMINATION PROCEEDINGS".

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is \$400, which was charged to Patent Owner's credit card on January 20, 2010, pursuant to the authorization for same in Patent Owner's EFS-WEB fee transmittal.

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

Patent Owner's petition is granted to the extent that the merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

## REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*
2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.
4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1160 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 '016 patent, claims 1-24, would be subject to reexamination.

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

10. On August 10, 2009, Patent Owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9357 *ex parte* proceeding to prevent merger with the '1160 *inter partes* proceeding.
12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1160 *inter partes* and '9357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed the present petition requesting reconsideration of the Office's December 16, 2009 decision.
14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>

## DECISION

### I. Issues Raised and Relief Requested

Patent owner raises issues, asserting as follows: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner's previous petition.

Patent owner requests as remedies in the now merged proceeding of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner's previous petition.

## II. Discussion of Previous Petition and Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "ex parte reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed. The merger of the present, concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives in handling the proceedings.

## III. Findings and Analysis

Reexamination of the '016 patent has been ordered in the '9357 *ex parte* proceeding and '1160 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings, and the statute is silent as to the matter. The determination whether

to merge two reexamination proceedings is an act reserved to the sole discretion of the Office. (See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 I,<sup>3</sup> MPEP 2686.01 IV,<sup>4</sup> 2283,<sup>5</sup> MPEP 2286.<sup>6</sup>)

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).<sup>7</sup> To the extent that the MPEP states the Office will “normally” merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the “sole discretion” of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.<sup>8</sup> Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.<sup>9,10</sup>

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<sup>3</sup> “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]

<sup>4</sup> “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.”

<sup>5</sup> “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.’”

<sup>6</sup> “[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.’”

<sup>7</sup> “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).

<sup>8</sup> *Id.*

<sup>9</sup> 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.”

<sup>10</sup> “[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office.” *Id.* at 18902.

At this juncture, it is noted that it was requester who chose to file two separate reexamination requests, to institute both *ex parte* and *inter partes* reexamination for all claims of the '016 patent, rather than to present all issues in one proceeding (giving requester the participation rights desired for the various issues identified in each request). Requester did so with full knowledge that the Office retains absolute discretion regarding whether or not to merge.<sup>11</sup> Therefore, it was requester that determined that the issues raised in each request need not be together, and the Office, by doing the same and not merging the proceedings, does not impact upon any rights or expectations of the requester.

Based upon the specific facts and circumstances of the reexamination proceedings on the '016 patent, the Office has decided that merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution. However, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

#### IV. Procedural Considerations

1. Any Office action issued and responses submitted by the parties during the merged proceeding is hereby vacated by this decision.<sup>12</sup> All Office actions and party responses from the time of merger, to the present, will be expunged from the Image File Wrapper (IFW) of the proceedings by being closed and marked non-public. Reexamination will restart anew from the point of prosecution just prior to the merger of the two proceedings. The examiner will issue an Office action in the '9357 *ex parte* reexamination proceeding taking into account the August 10, 2009 patent owner response having been filed. The examiner will issue an Office action in the '1160 *inter partes* reexamination proceeding taking into account that no responses (and comments) have been filed.
2. The proceedings will be conducted in a manner that minimizes any overlap of issues between the proceedings by preventing the importation of issues from one proceeding into the other. Specifically, the examiner will not introduce, from one proceeding into the other proceeding, any rejection proposed in the request, requester's reply under 37 CFR 1.535, or requester's comments in the *inter partes* reexamination.
3. All new rejections initiated by the examiner are to be included in the *inter partes* reexamination proceeding, so as to permit the Office to have the benefits of third party requester's comments. The authority for inclusion of rejections initiated by the examiner is

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<sup>11</sup> See the rules, MPEP sections, and Office Notice referred to above in the body of the decision and the footnotes.

<sup>12</sup> This does not include the decisions to order reexamination; they are not deemed Office actions in this context, and they were not issued while the proceedings were merged.

based upon 35 U.S.C. 314(a) which provides for examination in an *inter partes* reexamination proceeding in accordance with 35 U.S.C. 132 and 133; which permit the examiner's introduction of rejections. It should also be noted, that 35 U.S.C. 312 provides for the Office to *sua sponte* add issues to a reexamination proceeding "with... consideration of other patents or printed publications." Of course any modification of the proposed rejections in the *ex parte* reexamination proceeding to add a new reference to address the prosecution and examination of the *ex parte* reexamination proceeding would be made in that proceeding, and not in the *inter partes* reexamination proceeding, since the *ex parte* reexamination proceeding is the exclusive vehicle to address those proposed rejections.

4. As pointed out above, the Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later time should circumstances change such that the situation warrants such action.

5. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (see MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

## V. Discussion Regarding "Interview Rights"

Interview and "Right to Request" an Interview. No statutory or regulatory right to conduct an interview exists. While 37 CFR §§ 1.133 and 1.560 provide the guidelines for conducting and making a record of interviews, 37 CFR §§ 1.133(a) and 1.560 do not confer any right to an interview. *Inter partes* reexamination rule 37 CFR 1.955 states that no interviews on the merits are permitted in an *inter partes* reexamination.<sup>13</sup> The relevant sections of the MPEP provide guidance on the conduct of interviews to include denial of an interview.<sup>14</sup> None of the relevant rules or MPEP sections regarding interviews before the Office creates a right for an interview. While a party may request an interview, there is no requirement that the Office grant that request.

## CONCLUSION

1. The January 20, 2010 patent owner petition is granted to the extent that the merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.

<sup>13</sup> In the extraordinary circumstance where the *inter partes* requester has opted to not participate in the *inter partes* reexamination proceeding, a Patent Owner can petition for a waiver of 37 CFR 1.955 under 37 CFR 1.183 to conduct an interview, on an as-needed-per-interview basis.

<sup>14</sup> See MPEP §§ 713 *et seq.*, 2281 and 2685.

2. Any Office action issued and responses/comments submitted by the parties during the merged proceeding are hereby vacated by this decision.<sup>15</sup>
3. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.
4. Jurisdiction over the two reexamination proceeding is forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner, for action not inconsistent with this decision.
5. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

6-25-10

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<sup>15</sup> As pointed out above, this does not apply to the decisions to order reexamination.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351
26111	7590	01/07/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 01/07/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,357	12/08/2008	7210016	2805.001REX4	2148
26111	7590	01/07/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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

(For Patent Owner)

MAILED

JAN 07 2011

HAYNES & BOONE, LLP IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For *inter partes* Requester)

CENTRAL REEXAMINATION UNIT

ORRICK, HERRINGTON & SUTCLIFFE, LLP  
Attn: Fabio E. Marino  
1000 Marsh Road  
Menlo Park, CA 94025

(For *ex parte* Requester)

*In re Ware et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,160  
Filed: March 24, 2009  
For: U.S. Patent No. 7,210,016

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: DECISION  
: ON  
: PETITION

*In re Ware et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/009,357  
Filed: December 8, 2008  
For: U.S. Patent No. 7,210,016

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This is a decision on third party requester's October 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on October 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The September 30, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On April 24, 2007, the Office issued U.S. Patent No. 7,210,016 (the '016 patent) to Ware *et al.*
2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 8, 2008, a request for *ex parte* reexamination of claims 7, 13, 21 and 22 of the '016 patent was filed by third party requester NVIDIA Corporation. The request was assigned Control No. 90/009,357 (the '9357 proceeding).
5. On January 16, 2009, the Office issued an order granting the '9357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9357 *ex parte* reexamination proceeding expired on March 16, 2009.<sup>1</sup>
7. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '1160 proceeding).
8. On May 8, 2009, the Office issued a first Office action on the merits in the '9357 *ex parte* reexamination proceeding.
9. On May 26, 2009, the Office issued an order granting the '1160 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 '016 patent, claims 1-24, would be subject to reexamination.
10. On August 10, 2009, patent owner filed a response in the '9357 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
11. On October 14, 2009, patent owner filed a petition in the '9357 *ex parte* proceeding to prevent merger with the '1160 *inter partes* proceeding.
12. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '1160 *inter partes* and '9357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
13. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.

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

14. On March 30, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On June 1, 2010, patent owner timely filed responsive comments to the March 30, 2010 Office action, to include an amendment to the claims.<sup>2</sup>
16. On July 1, 2010, third party requester timely filed responsive comments.
17. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '1160 and the '9357 proceedings.
18. Also on September 30, 2010, the Office issued a *sua sponte* decision modifying the order for *inter partes* reexamination withdrawing a substantial new question of patentability.
19. On October 21, 2010, third party requester filed the present petition, requesting reconsideration of the September 30, 2010 decision.

## DECISION

### I. Issues Raised and Relief Requested

Third party requester contends that the Office's September 30, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the September 30, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

### II. Discussion of Previous Petitions and Decisions

#### a. The October 14, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing

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<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the March 30, 2010 Office action. The new due date of May 30, 2010 was a Sunday and May 31, 2010 was a federal holiday, giving patent owner until June 1, 2010 to file a response. See 37 CFR 1.7(a).

pattern combined with a merger of the two reexamination proceedings denies patent owner of “*ex parte* reexamination rights”; and (3) Requester’s reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester’s *inter partes* rights. Patent owner’s original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No “*ex parte* right” was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party’s rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

**b. The January 20, 2010 Patent Owner Petition and September 30, 2010 Office Decision**

On January 20, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 20, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner’s previous petition. Patent owner’s January 20, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner’s previous petition.

On September 30, 2010, the Office issued a decision granting patent owner's January 20, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

### III. Findings and Analysis

#### a. The September 30, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment<sup>3</sup> and argues that the September 30, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

In response:

The September 30, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>4</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '016 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the October 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>5</sup>

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<sup>3</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

<sup>4</sup> Id.

<sup>5</sup> See MPEP 2686.01 IV.

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Coteus reference relative to only a few of the claims in the '016 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of the Coteus reference relative to a substantial number of the claims in the '016 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.

2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>6</sup> 37 CFR 1.989(a),<sup>7</sup> MPEP 2686.01 I,<sup>8</sup> MPEP 2686.01 IV,<sup>9</sup> MPEP 2283,<sup>10</sup> and MPEP 2286.<sup>11</sup> See also "Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination," 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - "As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge

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<sup>6</sup> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

<sup>7</sup> "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).

<sup>8</sup> "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.'"

<sup>9</sup> "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."

<sup>10</sup> "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.'"

<sup>11</sup> "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with 'special dispatch.'"

(consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

**b. The September 30, 2010 Office decision is not a violation of Requester’s Rights**

The requester asserts that the September 30, 2010 dissolution decision somehow alters requester’s substantive rights.

The dissolution decision does not alter the requester’s rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester’s rights upon filing of each request for reexamination. The Office’s merger of proceedings does not alter a party’s rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

**c. The September 30, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner’s listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester’s right to comment; and (3) Third party

requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>12</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

#### **d. The September 30, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the September 30, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings

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<sup>12</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>13</sup> In the present instance, as noted in the September 30, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The September 30, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the September 30, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a "quick" request, simply to "get" something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings for the same patent, albeit

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<sup>13</sup> See MPEP 2686.01 IV.

each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The September 30, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.<sup>14</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The September 30, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>15</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the September 30, 2010 Office decision is dismissed. Despite the request the Office issue a final agency action, this decision is not made final.

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<sup>14</sup> See the September 30, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>15</sup> See Petition at page 9, section E.

## CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



---

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

1/6/11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351

26111            7590            12/23/2011

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

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 12/23/2011

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**CENTRAL REEXAMINATION UNIT**

STERNE, KESSLER, GOLDSTEIN  
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1100 NEW YORK AVENUE, N.W.  
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(FOR PATENT OWNER)

HAYNES AND BOONE, LLP IP SECTION  
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SUITE 700  
DALLAS, TX 75219

(FOR THIRD PARTY REQUESTER)

*In re Ware et al.*  
Reexamination Proceeding  
Control No. 95/001,160  
Filed: March 24, 2009  
For: U.S. Patent No. 7,210,016

**DECISION RETURNING  
UNAUTHORIZED PAPER  
AND DISMISSING  
PETITION AS MOOT**

This is a decision on the February 18, 2010 third party requester paper entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS." This decision also addresses the March 2, 2010 patent owner opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

The petitions are before the Director of the Central Reexamination Unit.

The February 18, 2010 petition is returned as an improper paper.

The March 2, 2010 petition is dismissed as moot.

**STATEMENTS OF RELEVANT FACTS**

1. Patent No. 7,210,016 (the '016 patent) issued on April 24, 2007.
2. The '016 patent is subject to litigation in the United States District Court for the District of Northern California, in Rambus Inc. v. Nvidia Corp., {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-24 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards, Docket No. 2637.
4. A request for reexamination, assigned Control No. 90/009,357 (the '357 proceeding), was filed by a third party requester on December 8, 2008. Reexamination was requested for claims 7, 13, 21, and 22 of the '016 patent.
5. On January 16, 2009, the Office issued an order granting the '357 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 7, 13, 21 and 22 of the '016 patent, would be subject to reexamination.
6. On March 24, 2009, a request for *inter partes* reexamination of all the claims (claims 1-24) of the '016 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,160 (the '160 proceeding).
7. On May 26, 2009, the Office issued an order granting the '160 request for *inter partes* reexamination.
8. On October 14, 2009, patent owner filed a petition in the '357 *ex parte* proceeding to prevent merger with the '160 *inter partes* proceeding.
9. On December 16, 2009 the Office issued a decision dismissing patent owner's October 14, 2009 petition requesting prevention of merger of the '160 *inter partes* and '357 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
10. On January 20, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.
11. On February 18, 2010, third party requester filed a petition under 37 CFR 1.181 entitled "PETITION TO REQUEST A SHORTENED PERIOD TO RESPONSE TO OFFICE ACTIONS."
12. On March 2, 2010, patent owner filed an opposition petition under 37 CFR 1.182 to the requester's February 18, 2010 petition.

13. On September 30, 2010, the Office issued a decision granted patent owner's January 20, 2010 petition and dissolved the merger of the '160 and the '357 proceedings.
14. Prosecution has advanced and on October 3, 2011, the Office issued a non-final Office action that set a one month time period for response.
15. On November 3, 2011, the patent owner submitted a response to the October 3, 2011 Office action.
16. On December 1, 2011, the third party requester submitted comments on the October 3, 2011 Office action and the November 3, 2011 patent owner's response.

### **DECISION**

37 CFR 1.4(c) provides as to correspondence with the Office:

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

37 CFR 1.181(a) provides that petitions to the Director may be made:

(a) Petition may be taken to the Director:

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

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

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.939 provides for treatment for unauthorized papers:

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

The petition filed on February 18, 2010 in this reexamination proceeding **will not** be decided on the merits, and is being returned as an improper paper that does not have a right of entry. See MPEP 2667.

Requester's February 18, 2010 petition combined issues under 37 CFR 1.181 and 1.183. The combined petition under 37 CFR 1.181 and 1.183 is deemed improper because it combines two distinct petitions, which is not compliant with 37 CFR 1.4(c). Accordingly, any relief requested under 37 CFR 1.183 is procedurally dismissed under 37 CFR 1.4. In summary, this decision treats the February 18, 2010 petition under 37 CFR 1.181.

The February 18, 2010 petition does not have a right of entry for the following reasons. First, as explained above, the petition was not filed in compliance with the requirements of 37 CFR 1.4(c). Second, the petition is not proper under 37 CFR 1.181. 37 CFR 1.181(a)(1) provides for a petition to be taken from any action or requirement of the examiner. This provision limits petitions to issues that have been raised and does not provide for petitions, such as the instant petition, to challenge future decisions that fall within the Office's discretionary procedural process. 37 CFR 1.181(a)(3) provides for a petition when the Office did not follow its established procedure and policies. The February 18, 2010 does not assert that the Office did not follow its established procedure and policies. Furthermore, this petition is similar to a petition requesting that an extension of time be denied. MPEP 2667 clearly states that such petitions "... will be returned, since a requester does not have a statutory right to challenge this discretionary procedural process in the re-examination proceeding...." For these reasons, the February 18, 2010 petition does not raise issues permitted in a petition under 37 CFR 1.181. Accordingly, the February 18, 2010 petition is deemed an improper paper and will be returned in accordance with 37 CFR 1.939 and MPEP 2667.

The March 2, 2010 opposition petition is dismissed as moot because the February 18, 2010 petition is deemed an improper paper.

In view of the above, the February 18, 2010 petition in the reexamination proceeding does not have an entry right under the rules. Therefore, the February 18, 2010 petition will not be made of record in the '160 reexamination proceeding, and it is being returned to the third party requester ***without consideration of the substance of the petition***. As the paper has been entered into the electronic Image File Wrapper (IFW) record, the paper will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. The present decision will, however, be made of record in the reexamination proceeding. See also MPEP 2667.

## CONCLUSION

1. The February 18, 2010 petition paper filed in the '160 reexamination proceeding is returned to the third party requester with this decision as not having a right of entry.
2. No copy of the petition papers will be maintained in the electronic Image File Wrapper for the proceedings, or elsewhere in the Office.
3. A copy of this decision will be made of record in the reexamination file.

4. The March 2, 2010 petition is dismissed as moot.
5. Telephone inquiries related to this decision should be directed Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611.

  
\_\_\_\_\_  
Irem Yucel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,160	03/24/2009	7210016	2805.001REX6	2351
26111	7590	04/13/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2012

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Date: **MAILED**  
**APR 13 2012**  
**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001160  
PATENT NO. : 7210016  
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)

HAYNES AND BOONE, LLP  
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DALLAS, TX 75219

(For Third Party Requester)

**MAILED**

**APR 13 2012**

*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,160  
Filed: March 24, 2009  
For: U.S. Patent No. 7,210,016

: **CENTRAL REEXAMINATION UNIT**  
: **DECISION DISMISSING**  
: **PETITION FOR WAIVER**  
: **OF 37 CFR 1.955 FOR**  
: **ONE-TIME INTERVIEW**  
:

This is a decision on patent owner's "RESPONSE TO NOTICES AND PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.955," filed on March 7, 2012.

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

The petition is dismissed.

**BACKGROUND**

1. On April 24, 2007, U.S. Patent No. 7,210,016 ("the '016 patent") issued to Ware *et al.*
2. On March 24, 2009, a request for *inter partes* reexamination of the '016 patent was filed by a third party requester, which request was assigned control no. 95/001,160 ("the '1160 proceeding").
3. On May 26, 2009, reexamination was ordered in the '1160 proceeding.
4. The '1160 proceeding progressed to the point where, on October 3, 2011, the Office issued a second non-final Office action.
5. On November 3, 2011, patent owner submitted a response to the October 3, 2011 Office action.
6. On December 1, 2011, the third party requester submitted comments after the October 3, 2011 Office action and the November 3, 2011 patent owner's response.

7. On February 8, 2012, the third party requester filed a paper entitled “NOTICE OF NON-PARTICIPATION IN *INTER PARTES* REEXAMINATION” (“the notice of non-participation”).
8. On February 17, 2012, the third party requester filed a paper entitled “NOTICE OF WITHDRAWAL OF THIRD-PARTY REQUESTER’S COMMENTS” (“the notice of withdrawal of comments”).
9. On March 7, 2012, patent owner filed the instant petition paper entitled “RESPONSE TO NOTICES AND PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.955” (“the petition under 37 CFR 1.183”).

## 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 March 7, 2012 petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.955, which prohibits interviews on the merits in an *inter partes* reexamination proceeding, in view of third party requester’s February 8, 2012 notice of non-participation and February 17, 2012 withdrawal of comments in the ‘1160 proceeding.<sup>1</sup> In the petition under 37 CFR 1.183, patent owner has requested waiver of 37 CFR 1.955 to conduct an in-person interview with the “examining team,” which is taken as a request for a single interview.<sup>2</sup>

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<sup>1</sup> Petition under 37 CFR 1.183 at page 3.

<sup>2</sup> *Id.* at page 2.

In support of its request for waiver of 37 CFR 1.955, patent owner states that an interview “would not prejudice the requester NVIDIA in any way given its complete withdrawal from this case and its consent for Rambus [patent owner] to have substantive *ex parte* communications with the Office.”<sup>3</sup> Patent owner asserts that an in-person interview would (1) enhance and facilitate the understanding of complex technical issues related to “dynamic random access memory (“DRAM”) controllers that use adjustable write data delay settings to coordinate memory operations among diversely-located memory components ... in a way that pure *ex parte* communications cannot accomplish,” (2) efficiently identify the remaining key issues, and (3) allow for timely resolution of the ‘1160 proceeding, which has been pending for nearly three years.<sup>4</sup> Patent owner further asserts that “an in-person interview was important to the parties’ efficient resolution of the related *ex parte* reexamination of this patent (*See* Control No. 90/009,357).”<sup>5</sup> Patent owner also asserts that “[a]n in-person interview will likely enhance the ability of the Office to comply with the statutory mandate of “special dispatch” set forth in 35 U.S.C. § 314(c).”<sup>6</sup>

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

In this instance, third party requester has stated on the record that it is withdrawing from and no longer participating in the ‘1160 *inter partes* reexamination proceeding.<sup>7</sup> Thus, only a single party (patent owner) will now participate in the ‘1160 proceeding, and any interview that might be permitted in the proceeding.

While patent owner has demonstrated that the third party requester would not be prejudiced by conducting an interview at this point in the ‘1160 proceeding, patent owner has not sufficiently focused its request for waiver of 37 CFR 1.955 upon specific matters at issue in the ‘1160 proceeding to be discussed at an interview. For example, patent owner has not identified a specific technical feature(s), specific claim language and/or particular prior art of record at issue

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<sup>3</sup> *Id.* See also *id.* at page 4.

<sup>4</sup> *Id.* at pages 3-4.

<sup>5</sup> *Id.* at page 3.

<sup>6</sup> *Id.* at page 4.

<sup>7</sup> See February 8, 2012 notice of non-participation (stating that “NVIDIA Corporation (“NVIDIA”), the third party requester for *inter partes* reexamination Control No. 95/001,160, hereby gives notice that it no longer intends to participate in the present reexamination.”) See also February 17, 2012 notice of withdrawal of comments (stating that “Third Party Requester, NVIDIA Corporation ... is withdrawing from this proceeding” and “does not object to Patent Owner having substantive *ex parte* communication with the Office for the remainder of this proceeding.”)

in the '1160 proceeding that would be discussed during an interview. Rather, patent owner has made a general request to identify the key issues and discuss unspecified technical issues related to the technology in the '1160 proceeding. Accordingly, for at least these reasons, patent owner's March 7, 2012 petition under 37 CFR 1.183 to waive 37 CFR 1.955 for a one-time interview in the '1160 proceeding is dismissed.

#### CONCLUSION

1. Patent owner's March 7, 2012 petition under 37 CFR 1.183 to waive 37 CFR 1.955 is dismissed.
2. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.



Brian E. Hanlon  
Director  
Office of Patent Legal Administration

04-13-2012



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*In re* Patent No. 6,435,279  
Issue Date: August 20, 2002  
Appl No.: 95/001,161  
Filed: April 09, 2009  
For: Method And Apparatus For Sampling Fluids From A  
Wellbore

:  
:  
: **DECISION GRANTING**  
: **PETITION**  
: *37 CFR 1.324*  
:  
: **MAILED**  
:  
:  
: **JUL 22 2011**

**GENERAL REEXAMINATION UNIT**

This is a decision on the petition filed November 30, 2010, to correct inventorship under 37 CFR 1.324.

The petition is granted.

Accordingly, Mr. Michael Fowkes has been added as an inventor.

The reexamination certificate that will ultimately issue as a result of this proceeding will contain the appropriate change of inventorship information consistent with the petition and this decision.

Andy Kashnikow  
Supervisory Patent Examiner  
Art Unit 3993  
Technology Center 3999

FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

for Patent Owner

DUANE MORRIS LLP – HOUSTON  
3200 SOUTHWEST FREEWAY  
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HOUSTON, TX 77027

for Third Party Requester



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

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IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

: (For Requester)

**MAILED**

**OCT 29 2010**

**CENTRAL REEXAMINATION UNIT**

*In re Barth et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,166  
Filed: April 3, 2009  
For: U.S. Patent No. 7,287,109 B2

:  
: **DECISION**  
: **DISMISSING PETITION**  
: **UNDER 1.183**  
:

This is a decision on the October 15, 2010 patent owner petition entitled "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 41.66(d) and Extend the Time to File a Rebuttal Brief by Thirteen (13) Days."

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

The petition fee of \$400.00 under 37 C.F.R. § 1.17(f) has been charged as authorized at page 1 of the petition.

The petition is **dismissed**.

**BACKGROUND**

1. On April 3, 2009, a request for *inter partes* reexamination of all of the claims (1-25) of U.S. Patent Number 7,287,109 B2 ("the '109 patent") was filed by the third party requester; the resulting reexamination proceeding was given a filing date and assigned control number 95/001,166 ("the '1166 proceeding").
2. On May 15, 2009, an order granting reexamination of all the claims of the '109 patent was mailed in the '1166 proceeding, and a non-final Office action, in which all pending claims were rejected, was mailed in the '1166 proceeding.
3. Prosecution continued until, on March 29, 2010, patent owner filed a notice of appeal.
4. On April 7, 2010, third party requester filed a notice of cross-appeal.

5. On May 27, 2010, third party requester filed its Appellant's Brief.
6. On June 7, 2010, patent owner filed its Appellant's Brief.
7. On June 28, 2010, a Respondent's Brief was filed by patent owner; on the same date, patent owner also filed a petition under § 1.182.
8. On July 7, 2010, a Respondent's Brief was filed by third party requester.
9. On July 22, 2010, third party requester filed an opposition to patent owner's June 28, 2010 petition under § 1.182.
10. On September 30, 2010, the Office mailed an Examiner's Answer.
11. On October 15, 2010, patent owner filed the instant petition entitled "Petition Under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 41.66(d) and Extend the Time to File a Rebuttal Brief by Thirteen (13) Days."

#### **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(d) provides:**

Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

## DECISION

A petition for waiver of the rules under § 1.183 to permit an extension of time to file a rebuttal brief must show the existence of an extraordinary situation such that justice requires relief from the rule. Petitioner provides two separate bases for relief in the instant petition:

- 1) That the USPTO's mailing and posting procedures delayed receipt of the Examiner's Answer by the petitioner, and
- 2) That the petitioner has additional deadlines unrelated to this reexamination.

With respect to the USPTO's mailing and posting procedures, it has long been the policy that the date for reply runs from the mailing date of USPTO correspondence. The time periods in the rules are designed to take into account the time for mail to be received by a party. The posting of Office actions on electronic databases is provided merely as a courtesy, and the timeliness of such postings is not relevant to the periods for which a party may respond to the Office communications.

With respect to the petitioner's additional deadlines, petitioner has not established the existence of an "extraordinary situation" such that "justice requires" relief. To the extent that the petition describes the high workload of the petitioners, this does not establish, by itself, an extraordinary situation. Petitioners have not, for example, alleged that (and why) the law firm is incapable of handling the workload, such that no other personnel in the firm could be found to competently represent their client in the allotted time. The increase in workload has not even been alleged and shown to be unforeseeable and dramatic. Also, it has not been explained why auxiliary council cannot be retained in an unforeseeable situation. Moreover, the statute provides that reexamination proceedings are to be handled in the Office with special dispatch, and that should place responding to a reexamination deadline, at least on equal footing with a deadline "unrelated to this reexamination."

Therefore, the requirements of § 1.183 have not been met, and the petition stands dismissed.

In the interest of equity, however, the rule is *sua sponte* waived to the extent that the time is extended seven (7) calendar days from the date of the mailing of this decision.

## CONCLUSION

- The petition is **dismissed**.
- The rule is *sua sponte* waived to the extent that the time is extended, however, to run seven (7) calendar days from the date of the mailing of this decision.

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Kenneth M. Schor/

---

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

October 29, 2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,166	04/03/2009	7287109	2805.003REX8	7774
26111	7590	01/13/2011		
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				

EXAMINER

ESCALANTE, OVIDIO

ART UNIT      PAPER NUMBER

3992

MAIL DATE      DELIVERY MODE

01/13/2011

PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

NVIDIA Corp.  
Third Party Requester

---

*Inter partes* Reexamination Control 95/001,166  
Patent 7,287,109

---

DECISION ON PETITION

This is a decision on “Patent Owner’s Petition Under 37 C.F.R. § 1.182 to Strike Portions of the Third Party Requester’s Brief on Appeal,” filed June 28, 2010 (“Petition”), and on “Third Party Requester’s Opposition to Patent Owner’s Petition Under 37 C.F.R. § 1.182 to Strike Portions of the Third Party Requester’s Brief on Appeal,” filed July 27, 2010 (Opposition”). In the Petition, Patent Owner seeks to have the Director “strike Issue 1 from third-party requester NVIDIA Corp.’s brief on cross-appeal.” Petition, p. 1.

FINDINGS

1. Patent 7,287,109 issued on October 23, 2007 with 25 claims. The ‘109 patent is assigned to Patent Owner Rambus, Inc. (“Rambus”).

*Inter partes* Reexamination Control 95/001,166  
Patent 7,287,109

2. Third Party Requester NVIDIA Corp. (“NVIDIA”) filed a request for *inter partes* reexamination of the ‘109 patent on April 3, 2009. Reexamination Control 95/001,166 was assigned to this request.
3. On May 15, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-25 of the ‘109 patent in the ‘166 proceeding.
4. On November 14, 2009, the Examiner entered an Action Closing Prosecution, rejecting claims 1-25.
5. On February 26, 2010, the Examiner entered a Right of Appeal Notice, rejecting claims 1-25.
6. On March 29, 2010, Rambus filed a Notice of Appeal.
7. On April 7, 2010, NVIDIA filed a Notice of Cross-Appeal.
8. On May 27, 2010, NVIDIA filed a Cross-Appeal Brief.
9. On June 7, 2010, Rambus filed an Appeal Brief.
10. On June 28, 2010, Rambus filed a Respondent’s Brief.
11. Also on June 28, 2010, Rambus filed the present Petition.
12. On July 7, 2010, NVIDIA filed a Respondent’s Brief.
13. On July 22, 2010, NVIDIA filed the present Opposition.

#### RELEVANT AUTHORITY

Concerning the contents of appeal briefs, 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.

## ANALYSIS

Rambus argues that:

In its cross-appeal brief for the reexamination of the '109 patent, NVIDIA proposed [as Issue 1 a] ground of rejection that it only raised in the separate reexamination of U.S. Patent No. 6,591,353.

Specifically, it borrows a completely new claim interpretation of "memory device" that it proposed in the '353 patent reexamination but never proposed in this reexamination of the '109 patent.

Petition, p. 1.

NVIDIA contends that:

Specifically, the '109 patent is a continuation of U.S. Patent 6,591,353 (the '353 patent), which is under reexamination (Cntrl. No. 95/001,169). Both reexaminations are currently on appeal; both have the same Examiner; and both use the claim term "memory device."

The Examiner has construed that term in the '353 patent reexamination (Cntrl. No. 95/001,169, RAN dated Feb. 26, 2010 at pgs. 2-3), but not in the '109 patent reexamination. The Cross-Appeal Brief for the '109 patent reexamination references the Examiner's claim construction in the '353 patent reexamination; the Patent Owner takes issue with this reference. Reference to '353 patent reexamination provides evidence that the Office is being inconsistent in its claim construction, and making a legal error by examining the claims of the '109 patent without applying the broadest reasonable interpretation of the terms in the claims.

Opposition, pp. 3-4.

Thus, NVIDIA admits that the interpretation of the claim term "memory device" from the '353 patent reexamination, which is the basis for the rejection proposed in its Cross-Appeal Brief in the present reexamination, has not previously been considered in the present reexamination. Clearly, any rejection premised on this new claim term

*Inter partes* Reexamination Control 95/001,166  
Patent 7,287,109

interpretation is a new ground of rejection, and is prohibited by Rule 41.67(c)(1)(vi).

Notwithstanding the foregoing, should the panel to which this appeal is assigned conclude that this new ground of rejection is meritorious, it has the authority to make a new ground of rejection in its decision on appeal. *See*, 37 C.F.R. § 41.77(b).

#### DECISION

In view of the foregoing, the Petition is GRANTED to the extent that the panel to which this appeal is assigned need not consider Issue 1 in NVIDIA's Cross-Appeal Brief.



---

James T. Moore  
Acting Chief Administrative Patent Judge

Counsel for Patent Owner Rambus Inc.:  
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1100 New York Avenue, NW  
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Counsel for Third Party Requester NVIDIA Corp.:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,169	04/21/2009	6591353	2805.003REX9	7283
26111	7590	09/28/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2010

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Date:

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**SEP 28 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001169  
PATENT NO. : 6591353  
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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1100 NEW YORK AVENUE, N.W.  
WASHINGTON DC 20005

MAILED  
SEP 28 2010

(For Requester) CENTRAL REEXAMINATION UNIT

HAYNES AND BOONE, LLP  
IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

*In re: Barth et alia*  
Reexamination Proceeding  
Control No. 95/001,169  
Request Deposited: April 21, 2009  
For: U.S. Patent No. 6,591,353

: **DECISION DENYING**  
: **PETITION TO**  
: **REOPEN AFTER RAN**  
:  
:

The *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the third party requester petition filed March 12, 2010 entitled "PETITION BY THIRD PARTY REQUESTER TO REOPEN PROSECUTION AFTER RAN" and a patent owner paper filed March 23, 2010 entitled "PATENT OWNER'S PETITION OPPOSING THIRD PARTY REQUESTER'S PETITION TO REOPEN PROSECUTION AFTER RAN".

The third party requester petition is timely filed and considered pursuant to 37 CFR §1.181.

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

### BACKGROUND

In the Action Closing Prosecution (ACP) mailed November 14, 2009, the office rejected all claims of the '353 patent. After a Patent Owner (PO) response and comments by the Third Party Requester (3PR), the office issued a Right of Appeal Notice (RAN) that maintained one ground of rejection from the ACP and withdrew other rejections.

Art Unit: 3992

### DECISION

Petitioner argues the merits of the examiner's decision not to maintain certain rejections. Arguing the merits of a decision favorable to patentability is subject to appeal to the Board of Patent Appeals and Interferences and it thus not a petitionable issue. This decision takes no position as to the merits of any decision favorable to patentability.

Petitioner also argues that a new finding of patentability is a new position and that a RAN is improper with the examiner's new position. MPEP 2673.01(I) states, in part:

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened.

Therefore, the petition is **denied**.

The PO paper filed March 23, 2010 entitled "PATENT OWNER'S PETITION OPPOSING THIRD PARTY REQUESTER'S PETITION TO REOPEN PROSECUTION AFTER RAN" is acknowledged, but the arguments are moot in view of the decision in the underlying petition.

### CONCLUSION

1. Petitioner's request to reopen prosecution after RAN is **denied**.
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,169	04/21/2009	6591353	2805.003REX9	7283
26111	7590	02/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

RAMBUS, INC.  
Patent Owner

v.

NVIDIA CORPORATION  
Third Party Requester

---

*Inter partes* Reexamination Control No. 95/001,169

Patent 6,591,353

---

DECISION ON PETITION

This is a decision on Patent Owner's "Petition under 37 C.F.R. § 1.183 to Suspend 37 C.F.R. § 41.66(d) and Extend the Time to File a Rebuttal Brief by Thirteen (13) Days," filed October 15, 2010 ("Petition"). In the Petition, Patent Owner requests a thirteen day extension of time to file its rebuttal brief in reply to the examiner's answer issued on September 30, 2010. The petition fee of \$400 in accordance with 37 C.F.R. § 41.20(a) was paid by credit card on October 15, 2010.

*Inter partes* Reexamination Control No. 95/001,169  
Patent No. 6,591,353

### FINDINGS

1. Patent 6,591,353 issued on July 8, 2003. The '353 patent is assigned to Patent Owner Rambus, Inc. ("Rambus").
2. On April 21, 2009, third party requester NVIDIA, filed a request for *inter partes* reexamination of U.S. Patent No. 6,591,353, which was assigned control no. 95/001,169.
3. On July 6, 2009, reexamination was ordered and a non-final Office action was mailed.
4. Prosecution was conducted and a Right of Appeal Notice was mailed on February 26, 2010.
5. On March 26, 2010, NVIDIA filed a notice of appeal; and on April 9, 2010, Rambus filed a Notice of Cross-appeal.
6. On May 26, 2010, NVIDIA filed an appellant's brief; and on June 9, 2010, Rambus filed an appellant's brief.
7. Rambus filed a respondent's brief on June 28, 2010; and NVIDIA filed a respondent's brief on July 9, 2010.
8. An examiner's answer was mailed on September 30, 2010.
9. On October 15, 2010, the present petition was filed by Rambus, requesting a 13 day extension of time to file a rebuttal brief.
10. On October 29, 2010, Rambus filed a rebuttal brief, and NVIDIA also filed a rebuttal brief.

### DECISION

In the present Petition, Rambus requests suspension of 37 C.F.R. § 41.66(d), and requests a 13 day extension of time to file a rebuttal brief.

*Inter partes* Reexamination Control No. 95/001,169  
Patent No. 6,591,353

Since a rebuttal brief was received from Rambus on October 29, 2010, the present petition is **dismissed as moot**.

DECISION

In view of the forgoing, the Petition is DISMISSED.



James T. Moore  
Acting Chief Administrative Patent Judge

Counsel for Patent Owner:

Jon E. Wright  
STERNE KESSLER GOLDSTEIN & FOX PLLC  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934

Counsel for Third Party Requester:

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HAYNES & BOONE, LLP, IP Section  
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Dallas, TX 75219



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,169	04/21/2009	6591353	2805.003REX9	7283

26111 7590 03/01/2011

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/01/2011

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**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001169  
PATENT NO. : 6591353  
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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Robert G. Sterne  
STERNE KESSLER GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, D.C. 2005-3934

(Patent Owner)

**MAILED**

**MAR 01 2011**

**CENTRAL REEXAMINATION UNIT**

David M. O'Dell  
HAYNES & BOONE, LLP  
IP SECTION  
2323 VICTORY LANE  
SUITE 700  
DALLAS, TEXAS 75219

(Requester)

In re Barth et al  
*Inter partes* Reexamination Proceeding  
Control No. 95/001,169  
Filed: April 21, 2009  
For: U.S. Patent 6,591,353  
Title: Protocol for Communication with  
Dynamic Memory

: **DECISION DISSMISSING**  
: **PETITION UNDER**  
: **37 CFR 1.183**

This is a decision on a Patent Owner October 29, 2010 petition under 37 CFR 1.183 to waive 37 CFR 41.63 and admit evidence after the mailing of an examiner's answer.

The petition is Dismissed

Brief Review of Facts

1. On July 8, 2003, U.S. Patent No. 6,591,169 issued to Barth et al.
2. On April 21, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001,169 (the '169 proceeding).
3. On July 6, 2009, an order granting reexamination was issued along with an Office action, and prosecution progressed.
4. On November 14, 2009 the Office issued an action closing prosecution (ACP).
5. On December 22, 2010 Patent Owner filed comments in reply to the ACP, which comments were accompanied by:
  - a. a Supplemental Declaration of Murphy under § 1.132, and
  - b. an excerpt from a Commission Investigative Staff's Pre-Hearing Statement and Brief.

6. On January 15, 2010, the Requester filed comments in reply to the December 22, 2010 Patent Owner's reply to the ACP, which comments were accompanied by:
  - an IEEE Dictionary definition from 1988.
7. On February 26, 2010, the Office issued a right of appeal notice (RAN).
8. On March 26, 2010, the Requester filed a notice of appeal.
9. On April 9, 2010, the Patent Owner filed a notice of cross-appeal.
10. On May 26, 2010, the Requester filed an appellant brief.
11. On June 9, 2010, the Patent Owner filed an appellant brief on cross-appeal.<sup>1</sup>
12. On June 9, 2010, the Patent Owner also filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and enter as evidence in support of the Patent Owner's cross-appeal brief<sup>2</sup>:
  - a. a second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy, and
  - b. a reference identified as "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface).
13. On June 28, 2010, the Patent Owner filed:
  - a. a respondent brief to the May 26, 2010 Requester brief, and
  - b. a petition to strike portions of the Requester's brief.
14. On July 9, 2010, the Requester filed a respondent brief to the June 9, 2010 Patent Owner brief.
15. On July 22, 2010, requester filed an opposition to the June 28, 2010 Patent Owner petition to strike a portion's of Requester's brief.
16. On July 23, 2010, the Office issued a decision dismissing the June 9, 2010 Patent Owner Petition under § 1.183, to waive § 41.63 barring the admission of evidence after appeal, as premature based on the need to first decide a March 12, 2010 Requester petition to reopen prosecution after RAN to which the Patent Owner had filed an opposition on March 23, 2010.

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<sup>1</sup> The evidence appendix of the brief lists two items of evidence, items 15 and 16, that are the subject of an accompanying § 1.183 petition requesting their entry. The presence in the evidence appendix of the un-entered items (items 15 and 16) is contrary to § 41.37(c)(1)(ix), which requires a statement setting forth where the evidence listed in the appendix was entered in the record by the examiner, and which prohibits reference to unentered evidence. However, as the Board of Patent Appeals and Interferences forwarded the appeal to the examiner for review that resulted in an examiner's answer, the Brief has been accepted as compliant.

<sup>2</sup> As identified in items 15 and 16 of the evidence appendix in the Patent Owner cross-appeal brief.

17. On September 28, 2010 the Office issued a decision denying the March 12, 2010 requester petition to reopen prosecution.

18. On September 30, 2010, the Office mailed an examiner's answer.

19. On October 15, 2010 the Patent Owner filed a petition under 37 CFR 1.183 to extend the time to file a rebuttal brief (to November 12, 2010 from October 30, 2010<sup>3</sup>), although the patent owner's rebuttal brief was submitted on October 29, 2010.

20. On October 29, 2010 Patent Owner again filed a petition under 37 CFR 1.183, the instant petition, to permit entry of additional evidence, which evidence was filed with the Patent Owner's October 29, 2010 rebuttal brief. The additional evidence is the same as submitted with the June 9, 2010 37 CFR 1.183 petition.

21. On November 5, 2010, Requester filed a request for an oral hearing.

22. On November 30, 2010, Patent Owner filed a request for an oral hearing.

#### Petition Under 37 CFR 1.183

The instant petition by the Patent Owner requests waiver of 37 CFR 41.63(c) to permit entry of rebuttal evidence at the current appeal stage of the proceeding.

Petitioner seeks to have admitted into the record a second supplemental declaration by Murphy, and IEEE Standard 696 Device Standard to rebut evidence submitted by Requester after an ACP that was entered by the examiner.

The January 15, 2010 evidentiary submission by Requester after the ACP is argued to have been improperly accepted by the examiner as submissions after ACP need to be supported by a showing of "good and sufficient reasons" why the evidence is necessary and was not submitted earlier, as required by 37 CFR 1.116(e). In addition to permitting entry of the evidence, the examiner relied upon the evidence in issuing the RAN.<sup>4</sup>

Petitioner argues that waiver at this point in the prosecution is appropriate as Petitioner did not have an opportunity to submit this evidence during prosecution of the reexamination with an earlier attempt after issuance of the RAN dismissed by the Office as premature in view of a pending petition by Requester to reopen prosecution, which petition to reopen has since been dismissed.

The evidence sought to be submitted by Patent Owner is stated to be narrowly confined to addressing the newly submitted evidence by Requester.<sup>5</sup> Having accepted the late evidentiary submission by Requester, denying Patent Owner the ability to present rebuttal evidence is stated to be manifestly unjust and would deprive patent owner of its statutorily and constitutionally guaranteed due process of law.<sup>6</sup>

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<sup>3</sup> Petition, footnote 1.

<sup>4</sup> At page 8.

<sup>5</sup> Petition, page 3.

<sup>6</sup> *Id.*

### Decision on Petition

37 CFR 41.63(c) does not permit evidence to be filed after the date of the filing of appeal. A notice of appeal by the Requester was filed on March 26, 2010, and a notice of cross-appeal was filed by the Patent Owner on April 9, 2010. The evidence sought to be admitted by Patent Owner was initially filed on June 9, 2010 and again on October 29, 2010. Consequently, the admission of the evidence in the record at this stage in the prosecution is barred by § 41.63(c).

37 CFR 1.183 permits suspension or waiver of any requirement of the rules that is not a requirement of the statutes in an extraordinary situation when justice requires. The prohibition of evidence after a notice of appeal is not a requirement of the statutes and petition for waiver of such requirement may be sought.

Preliminarily, it is noted that Patent Owner's earlier attempt to submit the rebuttal evidence, which was previously dismissed as premature, was also submitted after the notices of appeals had been submitted.

The RAN was issued on February 26, 2010. The appeals were filed on March 26, 2010, and on April 9, 2010, by Requester and Patent Owner respectively. The evidence to be rebutted was submitted on January 15, 2010, subsequent to an ACP of November 14, 2009. Patent Owner could have made an attempt to submit the rebuttal evidence prior to the February 26, 2010 RAN. Petitioner's argument - that the Office should have not entered the January 15, 2010 evidence as it was not accompanied by good and sufficient reasons why the evidence is necessary and was not submitted earlier - is based on an improper assumption by Patent Owner. The requirement for good and sufficient reasons is necessary only to provide Requester with a right of entry of the evidence. The examiner has discretion to enter evidence without such a showing and therefore entry of the Requester evidence was proper. Patent Owner could have made an effort to file the rebuttal evidence prior to the RAN, with a petition to waive the rules, in order to at least proffer the rebuttal evidence before the Office earlier in the proceeding (and let the Office decide whether to grant the petition or not).

Additionally, Patent Owner had in front of it the January 15, 2010 evidentiary submission by Requester, yet on March 23, 2010 Patent Owner opposed Requester's March 12, 2010 request to reopen prosecution after the RAN. Reopening of prosecution could have permitted Patent Owner to have its rebuttal evidence entered.

It is further noted that the § 1.183 petition was submitted more than two months from the mail date of the RAN that Patent Owner argues to have generated the need for the rebuttal evidence (based on the examiner's treatment of the Requester evidence in the RAN). Yet, 37 CFR 1.181(f) provides for dismissal of any petition, such as a § 1.183 petition, as untimely if not filed within two months from the mail date of the Office action from which relief is requested. Patent Owner's June 9, 2010 and October 29, 2010 petition seeking relief from the February 26, 2010 RAN's entry into the record of Requester evidence was thus subject to dismissal based on 37 CFR 1.181(f). The Office insists on the two-month period in view of (1) the statutory mandate for conducting *inter partes* reexamination proceedings with "special dispatch," 35 U.S.C. 314(c), and (2) Patent Owner's lack of timely effort as discussed above.

As to the evidence that is to be rebutted: The Requester submitted an IEEE Dictionary definition of "device."<sup>7</sup> The examiner in issuing the RAN discussed a claim construction of "memory device" for seven pages.<sup>8</sup> On the last page of the discussion, the examiner spends one sentence noting that the Requester agrees with the examiner in how a memory array board can be construed as a memory device based on the IEE dictionary definition of device. In other words, the definition sought to be rebutted by Patent Owner, is not used to provide the *prima facie* case underlying the rejections, but merely represents supportive evidence supplied by the Requester. On balance, given the statutory mandate for "special dispatch" of *inter partes* reexamination proceedings, entry of the evidence to rebut what amounts to no more than an after thought of the examiner, and the consequent need for an additional opportunity for the Requester to respond to the rebuttal evidence along with the need for a new examiner's answer, would not be a justified delay in the proceedings.

Accordingly, petitioner has not met its burden of establishing an extraordinary situation where justice would require entry of the rebuttal evidence.

#### CONCLUSION

1. The October 29, 2010 patent owner petition under § 1.183 is dismissed.
2. Further action on the appeal will be taken in due course.
3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707.



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

<sup>7</sup> Requester Comments For ACP, page 5.

<sup>8</sup> RAN, pages 2-8.

Appendix

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

\* \* \* \* \*

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

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

**§ 1.181 Petition to the Director.**

\* \* \* \* \*

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

**§ 1.183 Suspension of rules.**

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).

**§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.**

\* \* \* \* \*

(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.

**§ 41.63 Amendments and affidavits or other evidence after appeal.**

(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).

(c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,169	04/21/2009	6591353	2805.003REX9	7283

22852                      7590                      02/13/2012

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

EXAMINER

ART UNIT                      PAPER NUMBER

DATE MAILED: 02/13/2012

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**MAILED**

Date: FEB 13 2012

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001169  
PATENT NO. : 6591353  
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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ARRETT & DUNNER LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

(For Patent Owner)

**MAILED**

**FEB 13 2012**

**CENTRAL REEXAMINATION UNIT**

HAYNES AND BOONE, LLP  
IP SECTION  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

(For Third Party Requester)

*In re Barth et al.*  
Control No. 95/001,169  
Filed: April 21, 2009  
For: U.S. Patent No. 6,591,353

:  
: **DECISION**  
: **DISMISSING**  
: **PETITIONS**

This decision is in response to Patent Owner's petition, filed on June 28, 2010, which requests that the Director strike the Requester's Appeal Brief submitted on May 26, 2010 for failure to comply with 37 CFR 41.67. This decision is also in response to Requester's petition, filed on July 22, 2010, requesting that the Director deny Patent Owner's petition filed on June 28, 2010. The petitions are before the Director of the Central Reexamination Unit. Both petitions are being treated as petitions filed under 37 CFR 1.181.

The Patent Owner's Petition is dismissed as moot.

The Requester's Petition is dismissed as moot.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,591,353 (the '353 patent) issued on July 8, 2003.
2. A request for reexamination of the '353 patent was filed on April 21, 2009. The request was assigned control No. 95/001,169 (the '169 proceeding).
3. On July 6, 2009, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1-26 of '353 patent. On the same day, the Office mailed an Office action in the '169 proceeding.
4. Prosecution advanced and on February 26, 2010, the Office issued a Right of Appeal Notice, which confirmed claims 2-4, 6, 8-10, 12, 13, 15-18, 20-22, and 24-26 and rejected claims 1, 5, 7, 11, 14, 19, and 23.
5. On March 26, 2010, the Requester filed a notice of appeal.
6. On May 26, 2010, the Requester filed an appeal brief.
7. On June 28, 2010, the Patent Owner filed the instant petition under 37 C.F.R. § 1.182 requesting that Issues 1 through 4 in the Requester's Appeal Brief be stricken from the file for failure to comply with 37 C.F.R. § 41.67.
8. On July 22, 2010, the Requester filed a petition requesting that the Director suspend the rules and allow for entry of Requester's Opposition to Patent Owner's petition filed on June 28, 2010.
9. The appeal proceeded and on January 24, 2011, the Office mailed Decision affirming-in-part the examiner's determination. The Decision issued new five grounds of rejections, which resulted in claims 1-26 being rejected.

DISCUSSION

Although the petitions contain statements that the relief sought is under 37 CFR 1.182 or 1.183, the petitions are being decided solely under 37 CFR 1.181. It is noted that a petition under 37 CFR 1.182 or 1.183 is not proper because the petitions address issues that are properly raised under 37 CFR 1.181. Therefore, the petitions are being addressed under 37 CFR 1.181. In other words, a petition under 37 CFR 1.182 or 1.183 is not the proper means to seek relief for the issues raised in the June 28, 2010 and July 22, 2010 petitions. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182 or 1.183, the petitions being addressed as petitions under 37 CFR 1.181.

The relief sought by Patent Owner that is being addressed by this decision is for supervisory review to expunge the Requester's Appeal Brief as improper for failure to comply

with 37 CFR 41.67. In their opposition, Requester states that the Appeal Brief did not introduce any new proposed obviousness rejections.

The relief requested by the Patent Owner and opposed by the third party Requester has, in essence, been rendered moot by the Decision mailed January 24, 2012. Specifically, the Board, under 37 CFR 41.77(b), has the authority and the discretion to set forth new grounds of rejection, whether or not the grounds were raised in the appeal. In other words, the Board is not bound to issues presented in the Appeal Brief. Therefore, the issue of whether or not the third party Requester's Appeal Brief included new grounds of rejection is irrelevant due to the January 24, 2012 Decision in this proceeding.

Because the relief request was, in essence, rendered moot by the January 24, 2012 Decision, and in the interest of the statutory mandate of special dispatch, Patent Owner's request to expunge the Requester's Appeal brief is dismissed as moot.

#### CONCLUSION

1. The Patent Owner's petition, which is treated as a petition under 37 CFR 1.181, filed June 28, 2010, is DISMISSED as moot for the reasons discussed above.
2. The Requester's petition, which is treated as a petition under 37 CFR 1.181, filed July 22, 2010, is DISMISSED as moot for the reasons discussed above.
3. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Daniel Ryman, at (571) 272-3152.



---

Irem Yucel, Director  
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,169	04/21/2009	6591353	2805.003REX9	7283
22852	7590	02/23/2012	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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Date:

**MAILED**

**FEB 23 2012**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001169  
PATENT NO. : 6591353  
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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GARRETT & DUNNER LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON DC 20001-4413

(Patent Owner)

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**CENTRAL REEXAMINATION UNIT**

David M. O'Dell  
HAYNES & BOONE, LLP  
IP SECTION  
2323 VICTORY LANE  
SUITE 700  
DALLAS, TEXAS 75219

(Requester)

In re Barth et al  
*Inter partes* Reexamination Proceeding  
Control No. 95/001,169  
Filed: April 21, 2009  
For: U.S. Patent 6,591,353  
Title: Protocol for Communication with  
Dynamic Memory

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

This is a decision on patent owner's March 31, 2011 petition entitled, "Petition Under 37 C.F.R. § 1.181(a)(3) To Seek Supervisory Review of Dismissal of Petition to Admit Evidence."

The petition is **dismissed as moot.**

Brief Review of Facts

1. On July 8, 2003, U.S. Patent No. 6,591,353 issued to Barth et al.
2. On April 21, 2009, a request for *inter partes* reexamination was filed, and the resulting reexamination proceeding was assigned control number 95/001,169 (the '1169 proceeding).
3. On July 6, 2009, an order granting reexamination was issued along with an Office action, and prosecution progressed to the point that on November 14, 2009 the Office issued an action closing prosecution (ACP).
4. On December 22, 2010, patent owner filed comments in reply to the ACP, which comments were accompanied by:
  - a. a Supplemental Declaration of Murphy under § 1.132, and
  - b. an excerpt from an International Trade Commission (ITC) Investigative Staff's Pre-Hearing Statement and Brief.

5. On January 15, 2010, requester filed comments in reply to the December 22, 2010 patent owner's reply to the ACP, which comments were accompanied by an excerpt from the IEEE Standard Dictionary of Electrical and Electronic Terms, 4<sup>th</sup> edition, dated 1988.
6. On February 26, 2010, the Office issued a right of appeal notice (RAN).
7. On March 12, 2010, requester filed a petition requesting a reopening of prosecution after RAN.
8. On March 23, 2010, patent owner filed an opposition to requester's March 12, 2010 petition requesting reopening after RAN.
9. On March 26, 2010, the requester filed a notice of appeal.
10. On April 9, 2010, the patent owner filed a notice of cross-appeal.
11. On May 26, 2010, the requester filed an appellant brief.
12. On June 9, 2010, the patent owner filed an appellant brief on cross-appeal.<sup>1</sup>
13. On June 9, 2010, the patent owner also filed a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 41.63(c) and enter as evidence in support of the patent owner's cross-appeal brief<sup>2</sup>:
  - a. a second supplemental declaration under 37 CFR 1.132 of Robert J. Murphy, and
  - b. a reference identified as "An American National Standard IEEE Standard 696 Interface Devices" (696 Device Interface).
14. On June 28, 2010, the patent owner filed:
  - a. a respondent brief to the May 26, 2010 requester brief, and
  - b. a petition to strike portions of the requester's brief.
15. On July 9, 2010, requester filed a respondent brief to the June 9, 2010 patent owner brief.
16. On July 22, 2010, requester filed an opposition to the June 28, 2010 patent owner petition to strike a portion of requester's brief.

---

<sup>1</sup> The evidence appendix of the brief lists two items of evidence, Exhibits 15 (second supplemental declaration of Murphy) and 16 (IEEE 696 Device Interface Standard), that were the subject of an accompanying § 1.183 petition requesting their entry. The presence in the evidence appendix of the un-entered items (Exhibits 15 and 16) is contrary to § 41.37(c)(1)(ix), which requires a statement setting forth where the evidence listed in the appendix was entered in the record by the examiner, and which prohibits reference to unentered evidence. However, as the Board of Patent Appeals and Interferences forwarded the appeal to the examiner for review that resulted in an examiner's answer, the Brief has been accepted as compliant.

<sup>2</sup> As identified in Exhibits 15 and 16 of the evidence appendix in the patent owner cross-appeal brief.

17. On July 23, 2010, the Office issued a decision dismissing the June 9, 2010 patent owner petition under § 1.183, to waive § 41.63 barring the admission of evidence after appeal, as premature based on the need to first decide a March 12, 2010 requester petition to reopen prosecution after RAN to which patent owner had filed an opposition on March 23, 2010.
18. On September 28, 2010 the Office issued a decision denying the March 12, 2010 requester petition to reopen prosecution.
19. On September 30, 2010, the Office mailed an examiner's answer.
20. On October 15, 2010, patent owner filed a petition under 37 CFR 1.183 to extend the time to file a rebuttal brief (to November 12, 2010 from October 30, 2010), although the patent owner's rebuttal brief was submitted on October 29, 2010.
21. On October 29, 2010, patent owner again filed a petition under 37 CFR 1.183, to permit entry of additional evidence, which evidence was filed with the Patent Owner's October 29, 2010 rebuttal brief. The additional evidence is the same as submitted with the June 9, 2010 37 CFR 1.183 petition.
22. On November 5, 2010, requester filed a request for an oral hearing.
23. On November 30, 2010, patent owner filed a request for an oral hearing.
24. On March 1, 2011, the Office issued a decision dismissing patent owner's October 29, 2010 to permit entry of additional evidence.
25. On March 31, 2011, patent owner filed the instant petition under 37 CFR 1.181(a)(3) requesting supervisory review of the March 1, 2011 Office decision.
26. On October 19, 2011, the Board of Patent Appeals and Interferences (BPAI) conducted an oral hearing in the '1169 proceeding.
27. On January 24, 2012, the BPAI issued a decision in the '1169 proceeding.

Decision on Petition  
Under 37 CFR 1.181(a)(3)

The instant petition by the patent owner requests supervisory review of the March 1, 2011 decision dismissing patent owner's request for waiver of 37 CFR 41.63(c) to permit entry of rebuttal evidence on appeal.

Petitioner requested entry into the record a second supplemental declaration by Murphy, and the IEEE 696 Device Interface Standard to rebut evidence submitted by requester after an ACP that was entered by the examiner. Petitioner argues that denial of the waiver was inappropriate as petitioner did not have an opportunity to submit this evidence during prosecution of the '1169 proceeding.

The evidence sought to be submitted by patent owner is stated to be narrowly confined to addressing the newly submitted evidence by requester. Having accepted the late evidentiary submission by requester, denying patent owner the ability to present rebuttal evidence is stated to be manifestly unjust and would deprive patent owner of its statutorily and constitutionally guaranteed due process of law.

37 CFR 41.63(c) does not permit evidence to be filed after the date of the filing of appeal. A notice of appeal by the requester was filed on March 26, 2010, and a notice of cross-appeal was filed by the patent owner on April 9, 2010. The evidence sought to be admitted by patent owner was initially filed on June 9, 2010 (in both patent owner's brief and petition both filed on the same day) and again on October 29, 2010. The admission of the evidence in the record at this stage in the prosecution was barred by § 41.63(c). The March 1, 2011 decision found no equitable basis upon which to grant a waiver of § 41.63(c) and consequently dismissed patent owner's March 1, 2011 petition.

The BPAI forwarded patent owner's June 9, 2010 brief, with Exhibits 15 and 16, for consideration by the examiner. Exhibits 15 (the second supplemental declaration of Murphy) and 16 (the IEEE 696 Device Interface Standard) contain the evidence for which patent owner concurrently filed a petition requesting entry, which was ultimately dismissed by the Office in the March 1, 2011 decision. However, the brief was accepted as compliant by the BPAI and the evidence provided in Exhibits 15 and 16, was made of record. Further, on January 24, 2012, the BPAI issued a decision that explicitly considered the evidence patent owner had petitioned for entry on appeal.<sup>3</sup> Therefore, the record reflects that Exhibits 15 (the second supplemental declaration of Murphy) and 16 (the IEEE 696 Device Interface Standard) were made of record and considered by the panel rendering the decision on appeal.

Accordingly, as all the proffered evidence has been entered and considered, the petition requesting entry of that evidence is **dismissed as moot**.

#### CONCLUSION

1. The March 31, 2011 patent owner petition under § 1.181 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.



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

February 22, 2012

<sup>3</sup> See footnote 1 on pages 13-14 of the January 24, 2012 BPAI decision which makes specific reference to paragraphs 7-10 of the 2<sup>nd</sup> supplemental declaration of Murphy.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

BAXTER INTERNATIONAL, INC.  
Patent Owner

FRESENIUS MEDICAL CARE NORTH AMERICA  
Third Party Requester

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*Inter partes* Reexamination Control 95/001,170  
Patent 7,303,680

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DECISION ON PETITIONS

This is a decision on Third Party Requester's "Petition Under 37 CFR § 1.182 Regarding Patent Owner's Appeal Brief dated November 16, 2010," filed December 6, 2010 ("Petition #1"). In Petition #1, Third Party Requester requests the Director "to strike portions of Patent Owner's appeal brief as improperly presenting new arguments that were never presented to the CRU, or in the alternative, to reopen prosecution on the merits to address Patent Owner's new arguments and allow the Requester the opportunity to present rebuttal evidence and/or argument." Petition #1, p. 1.

This is also a decision on Third Party Requester's Petition Under 37 CFR § 1.183 for a One-month Extension of Time to respond to Patent Owner's Appeal Brief," filed December 8, 2010 ("Petition #2"). In Petition #2, Third Party Requester requests the Director to waive 37 CFR § 41.66(b)

*Inter partes* Reexamination Control 95/001,170  
Patent 7,303,680

and extend the time period for filing Requester's Respondent Brief by one month to January 16, 2011.

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

## FINDINGS

1. Patent 7,303,680 issued on December 4, 2007 with 19 claims. The '680 patent is assigned to Patent Owner Baxter International, Inc. ("Baxter").
2. Third Party Requester Fresenius Medical Care North America ("Fresenius") filed a request for *inter partes* reexamination on April 21, 2009. Reexamination Control 95/001,170 was assigned to this request.
3. On June 19, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-19 of the '680 patent in the '1170 proceeding.
4. Baxter filed a response with an amendment on August 19, 2009, amending claims 1 and 11 and adding new claims 20-40.
5. Fresenius filed comments on September 18, 2009, in reply to the Office action and Baxter's response.
6. The *inter partes* reexamination proceeding progressed to the point where, on March 26, 2010, an Action Closing Prosecution ("ACP") was mailed in the proceeding, rejecting claims 1-40.
7. On August 17, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-40.
8. On September 16, 2010, Baxter filed a Notice of Appeal for claims 1-40; and on November 16, 2010, Baxter filed an Appellant Brief.

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9. On December 6, 2010, Fresenius filed Petition #1, and on December 8, 2010, Fresenius filed Petition #2.

## RELEVANT AUTHORITY

### **Concerning the time for filing briefs, 37 C.F.R. § 41.66 states:**

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner's answer under § 41.69.

(d) Any appellant may file a rebuttal brief under § 41.71 within one month of the date of the examiner's answer. The time for filing a rebuttal brief or an amended rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939 of this title.

### **Concerning the contents of appellant briefs, 37 C.F.R. § 41.67(c)(1)(vii) states:**

(vii) *Argument*. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may

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select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

**It is noted that 37 C.F.R. § 41.67(c)(2) states:**

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

**Concerning the contents of respondent briefs, 37 C.F.R. § 41.68(a) states:**

(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.

...

**It is noted that 37 C.F.R. § 41.68(b) states (in pertinent parts):**

(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(vi) *Issues to be reviewed on appeal.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must

be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) *Argument*. A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

(b)(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

## ANALYSIS

Fresenius argues that Baxter's appellant brief raises for the very first time objections to the prior art status of several references applied by the Central Reexam Unit (CRU). Fresenius points out that at no prior point in the proceeding had Baxter objected to the examiner's treatment of these references as prior art, as Patent Owner presented arguments against the references on the merits. Fresenius asserts that by electing to stay silent about this issue during prosecution, and then raising the issue for the first time in the appellant brief, Baxter has prejudiced Fresenius by depriving the requester the opportunity to present rebuttal evidence and/or argument to the

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the CRU, and has deprived the Board of an opportunity to review a fully developed record.

Fresenius' arguments have been fully considered, but are not persuasive because 37 C.F.R. § 41.67 does not preclude the presentation of new arguments in an Appellant's Brief. Fresenius' contentions are also not persuasive because a respondent brief may address issues raised in the appellant brief, irrespective of *when* those issues originated.

MPEP § 2675.01 states regarding 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.

However, Fresenius is correct in that the requester would not be able to present rebuttal evidence because 37 C.F.R. § 41.68(b)(2) states:

(b)(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

It is noted that if Baxter had presented the contentions concerning the prior art status of several references earlier in prosecution, then Fresenius would have had an opportunity to present arguments and evidence to rebut such contentions. Therefore, it appears that the requester may be at least partially prejudiced by the newly presented arguments of the appellant, since

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37 C.F.R. § 41.68(b)(2) precludes the requester from presenting a new affidavit or other evidence to rebut the new contentions of appellant.

Fresenius requests the Office to expunge Baxter's appellant brief, however, there is no basis in the rules to grant such requested relief. Fresenius alternatively proposes that prosecution should be reopened. However, such relief will not be granted because the Office is required to proceed with special dispatch in *inter partes* reexamination pursuant to 35 U.S.C. 314(c). Petition #1 is DENIED.

Third party requester Fresenius is *sua sponte* granted relief as follows. The Chief Judge waives in-part 37 C.F.R. § 41.68(b)(2), only to the extent necessary to permit Fresenius to submit arguments and evidence that directly pertain to Baxter's new objections to the prior art status of several references as part of the respondent brief. The references are identified on page 7 of appellant's brief as follows:

1. HD –Secura Operating Manual, 1989.
2. HD-Secura Operating Manual, 1991.
3. HD-Secura Service Manual.

The respondent brief must otherwise comply with 37 C.F.R. § 41.68 and 37 C.F.R. § 1.943(c).

A persuasive showing has been made that this situation is extraordinary and that justice requires that Fresenius be given an opportunity

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to respond to the new arguments presented by Baxter for the first time in the appellant brief.

Petition #2 is GRANTED. 37 C.F.R. § 41.66(b) is waived, and the time period for filing Requester's Respondent Brief is extended one month to January 16, 2011.

### DECISION

In view of the forgoing, the Petition #1 is DENIED; Petition #2 is GRANTED.

A handwritten signature in black ink, appearing to read "James T. Moore", written over a horizontal line.

James T. Moore  
Acting Chief Administrative Patent Judge

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Patent 7,303,680

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,170	04/21/2009	7303680	18196-0020RX6	7395
24395	7590	03/09/2011	EXAMINER	
WILMERHALE/DC 1875 PENNSYLVANIA AVE., NW WASHINGTON, DC 20006			ART UNIT	PAPER NUMBER

DATE MAILED: 03/09/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

BAXTER INTERNATIONAL, INC.  
Patent Owner

v.

FRESENIUS MEDICAL CARE NORTH AMERICA  
Third Party Requester

---

*Inter partes* Reexamination Control 95/001,170  
Patent 7,303,680

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DECISION ON PETITION

This is a decision on “Requester’s Petition under 37 C.F.R. § 1.183 Seeking Waiver of the 7000 Word Limit Imposed by 37 C.F.R. § 1.943(c),” filed January 18, 2011 (“present petition”). Petitioner requests that the Director “waive 37 C.F.R. § 1.943(c) and thereby accept Requester’s concurrently filed Respondent Brief under 37 C.F.R. § 41.68, which exceeds the 7,000 word limit.” The petition fee of \$400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner’s deposit account on January 18, 2011, along with the respondent brief fee.

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

## FINDINGS

1. Patent 7,303,680 issued on December 4, 2007, with 19 claims. The '680 patent is assigned to patent owner Baxter International, Inc. ("Baxter").
2. Third party requester Fresenius Medical Care North America ("Fresenius") filed a request for *inter partes* reexamination on April 21, 2009, which was assigned Reexamination Control No. 95/001,170.
3. On June 19, 2009, the Office issued an Order granting *inter partes* reexamination of claims 1-19 of the '680 patent in the '1170 proceeding, and a non-final Office action was mailed rejecting claims 1-19.
4. Baxter filed a response on August 19, 2009, amending claims 1 and 11 and adding new claims 20-40.
5. Fresenius filed comments in reply to the Office action and Baxter's response, on September 18, 2009.
6. On March 26, 2010, an Action Closing Prosecution ("ACP") was mailed in the proceeding, rejecting claims 1-40.
7. On August 17, 2010, the Office mailed a Right of Appeal Notice ("RAN"), rejecting claims 1-40.
8. Baxter filed a Notice of Appeal on September 16, 2010, appealing the rejection of claims 1-40; and on November 16, 2010, Baxter filed an appellant brief.
9. Fresenius filed a petition under 37 C.F.R. § 1.182 on December 6, 2010, requesting that portions of patent owner's appellant brief of November 16, 2010, be expunged, or that prosecution be reopened.
10. Fresenius also filed a petition under 37 CFR § 1.183 on December 8, 2010, requesting a one-month extension of time to respond to patent owner's appellant brief.

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11. On December 14, 2010, a decision on the petitions was mailed, which denied the petition to expunge or reopen, but granted the petition for a one month extension of time to file a respondent brief.

12. Fresenius filed a respondent brief on January 18, 2011, accompanied by the present petition.

### DISCUSSION

In the present petition, Fresenius requests waiver of 37 C.F.R. § 1.943(c), which limits requester's respondent brief to fifteen pages or 7,000 words in length. The requester's respondent brief is stated to be 11,426 words.

Waiver is requested for the following reasons stated by petitioner:

- (1) Patent Owner raised a new issue in its appellant brief of November 16, 2010, namely, whether several of the prior art references over which the claims are rejected are in fact prior art; and the Office permitted entry of the appellant brief, rather than re-opening prosecution to fully consider these issues.
- (2) Such action is forcing requester to defend against this procedurally improper argument for the first time in its respondent brief on appeal to the Board.

Fresenius argues that at a bare minimum justice requires waiver of the 7,000 word limit for the respondent brief to enable requester to attempt to respond to the new prior art status issue raised by the patent owner for the first time on appeal. Fresenius asserts that at no prior point in the proceeding had Baxter objected to the examiner's treatment of these references as prior art. Instead, patent owner presented arguments against the references on the merits. Petitioner points out that the Office has already

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decided that “justice requires that [requester] be given an opportunity to respond to the new arguments presented by [patent owner] for the first time in the appellant brief.” Fresenius contends that requester must be given a meaningful opportunity to respond, i.e., the words used for such response should not be counted toward the 7,000 word limit. Petitioner asserts that since Baxter has been permitted to raise an issue for the first time on appeal, this has prejudiced Fresenius by depriving the requester the opportunity to present rebuttal evidence and/or argument to the Central Reexam Unit (CRU), and has deprived the Board of an opportunity to review a fully developed record.

#### RELEVANT AUTHORITY

**37 C.F.R. § 1.183 provides:**

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

**37 C.F.R. § 1.943(c) provides:**

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

**37 C.F.R. § 41.67(c)(1)(vii) provides:**

(vii) Argument. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

**37 C.F.R. § 41.67(c)(2) states:**

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

**37 C.F.R. § 41.68(a) states:**

(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.

...

**37 C.F.R. § 41.68(b) states (in pertinent parts):**

(b)(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

...

(vi) Issues to be reviewed on appeal. A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) Argument. A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument

must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

(b)(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

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

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the

patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

**MPEP § 2667 I.B.2 (Response Filed by Third Party Requester that is too long) provides:**

Where the length of the third party requester submission exceeds that permitted by 37 CFR 1.943, the submission is improper. Accordingly, a Notice will be issued by the examiner and mailed to the third party requester permitting the third party requester 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.

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The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper third party requester submission will not be considered.

For additional information with respect to the length of the papers, see subsection I.A.2. above.

### ANALYSIS

With regard to the present petition, upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to this appeal have been within the respective page limit requirements for responses. The rules require that the respondent brief be more limited than pre-appeal responses. Requester's respondent brief is stated to be 11,426 words, which is in excess of the limit of 7,000 words.

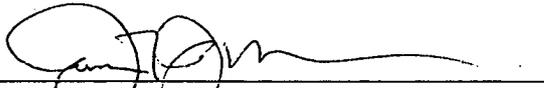
Petitioner's reasons provided in support of waiving the page/word limits focus on the new arguments included in the appellant brief. Fresenius argues that this waiver is needed to address, at least in part, the admittedly exceptional situation caused by the Office's previous petition decision of December 14, 2010, which denied the requester's petition to expunge portions of the appellant brief or reopen prosecution. A persuasive showing has been made that this is an extraordinary situation in which justice requires waiver of 37 C.F.R. § 1.943(c), to permit entry of requester's respondent brief of January 18, 2011.

The present petition is **granted**. The requester's respondent brief of January 18, 2011, is entered.

*Inter partes* Reexamination Control No. 95/001,170  
Patent No. 7,303,680

DECISION

In view of the forgoing, the Petition is GRANTED. Jurisdiction of the instant *inter partes* reexamination proceeding is returned to the Central Reexam Unit (CRU) for preparation of the next appropriate Office action.



James T. Moore  
Acting Chief Administrative Patent Judge

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.
95/001,172	04/23/2009	6,725,427	8157.012.427	1247
23432	7590	01/26/2012	EXAMINER	
COOPER & DUNHAM, LLP 30 Rockefeller Plaza 20th Floor NEW YORK, NY 10112			ART UNIT	PAPER NUMBER

DATE MAILED: 01/26/2012

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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: | - 26-12

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

REEXAMINATION CONTROL NO. : 95001172  
PATENT NO. : 6725427  
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.



**MAILED**

**JAN 26 2012**

Ivan Kavrukov **CENTRAL REEXAMINATION UNIT** (For Patent Owner)  
COOPER & DUNHAM LLP :  
30 Rockefeller Plaza :  
20<sup>th</sup>, Floor :  
New York, NY. 10112 :

Tracy W. Druce :  
NOVAK, DRUCE & QUIGG LLP : (For Third Party  
1000 Louisiana St. : Requester)  
53<sup>rd</sup>, Floor :  
Houston, TX. 77002 :

*In re:* Freeman et al. :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITIONS  
Control No.: 95/001,172 :  
For: U.S. Patent No.: 6,725,427 :

This is a decision on two petitions filed by the Third Party Requestor: a petition filed on October 15<sup>th</sup>, 2010, entitled "PETITION UNDER 37 CFR § 1.181 TO VACATE *ACTION CLOSING PROSECUTION*" [hereinafter "petition 1"], and a petition filed by Patent Owner on November 22<sup>nd</sup>, 2010, entitled "PETITION FOR LEAVE TO RESPOND TO THIRD PARTY REQUESTOR'S PETITION TO UNDER 37 CFR 1.181 IN *INTER PARTES* REEXAMINATION" [hereinafter "petition 2"].

Petition 1 is treated as a petition under 37 CFR § 1.181. Petition 2 is treated also as a petition under 37 CFR § 1.181 as a submission in opposition to Petition 1.

The petitions are before the Director of the Central Reexamination Unit. The petition 1 is denied and petition 2 is dismissed as moot.

**REVIEW OF RELEVANT FACTS**

- U.S. Patent No. 6,725,427 issued on April 20<sup>th</sup>, 2004.
- A request for *inter partes* reexamination was filed on April 23<sup>rd</sup>, 2009 and assigned control no. 95/001,172.

- *Inter partes* reexamination was ordered on July 1<sup>st</sup>, 2009.
- A Non-Final Office Action was mailed on September 28<sup>th</sup>, 2009.
- Patent Owner's Response to the Non-Final Office Action was received on November 2<sup>nd</sup>, 2009.
- The Third Party Requestor's Comments to the Patent Owner Response and the Non-Final Office Action were received on November 27<sup>th</sup>, 2009.
- An Action Closing Prosecution (ACP) Office Action was mailed on September 28<sup>th</sup>, 2010.
- Petition 1 was filed October 15<sup>th</sup>, 2010, and petition 2 was filed October 22<sup>nd</sup>, 2010.

## **STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

### **37 C.F.R. § 1.181 Petition to the Director**

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

### **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 indicates. 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.

**MPEP 2673.01 states, in part:**

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding until the appeal stage, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond).

**DECISION**

The Third Part Requestor ["petitioner"] argues in petition 1, dated October 15, 2010, that the Office vacate the Action closing Prosecution Office Action dated September 28<sup>th</sup>, 2010 based on the failure of the Examiner to follow the requirements of the MPEP. Specifically, in the ACP, the Examiner expressly refused to consider the obviousness of all claims in view of Mander alone or in combination with Lucas - despite the prior art already being cited in this reexamination - because this specific combination was not raised in the original reexamination request.

The Patent Owner ["petitioner"] argues in petition 2, dated October 22, 2010, that the Theird Party Requester's October 15, 2010 Petition (petition 1) is improper (and unauthorized) under 37 CFR § 1.939(a) and should be denied consideration. Furthermore, the Third Party Requestor's petition should be denied on the merits since the examiner did consider the references throughout the prosecution of the proceedings.

Petition 1

As a procedural matter, the petition was filed under 37 CFR § 1.181, which is reserved for 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.

In the petition, petitioner states , that in the ACP, the Examiner expressly refused to consider the obviousness of all claims in view of Mander alone or in combination with Lucas - despite the

prior art already being cited in this reexamination - because this specific combination was not raised in the original reexamination request.

However, the record of the proceedings clearly indicates that the examiner considered all the proposed rejections (based on the prior art cited in the Request) as set forth in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination and provided an Office action which either adopted or not adopted these proposed rejections (See Non-Final Office Action dated September 28, 2009). The Office action clearly articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948. In addition, the record also indicates that there is nothing that prevented the requester from presenting this new viewpoint (rejection) based on obviousness in view of Mander and in view of Mander in combination of Lucas. The petitioner offers no reasons why their viewpoint on Mander and Lucas has now changed and why it could not have been earlier presented. 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) clearly requires that the requester must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. In this case, the petitioner (third party requester) decided to provide the pertinency and manner of applying the Mander reference to Claim 39 (See Request, Page 44), wherein the request clearly states that the Claim is anticipated by the Mander reference. The Request does not provide the Claim to be rendered obvious over the Mander reference alone or in combination with the Lucas reference. Furthermore, the record indicates that claim 39 has been determined to be patentable over the prior art of record i.e. Mander and Lucas. The Office action (See Action Closing Prosecution Office Action dated September 28, 2010, Page 5) contains explicit reasons why the claimed are deemed patentable over the art of record.

Furthermore, neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must explicitly consider on the record and explain why they are making or not making every possible rejection that is not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Reexamination laws and policies are clear that examiners are only required to consider whether the claims define a novel and nonobvious invention over the prior art of record in order to answer the issues of patentability raised by the request, and to articulate any grounds of rejection, or reasons for patentability that meets the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), so that the patent owner and the third party requester can understand the grounds and appropriately reply to the Office action. See MPEP 706 and 2660. Therefore, the record does not support petitioner's view that a thorough examination of the claims was not performed unless the examiner explicitly considered on the record requester's changed viewpoint of the Mander reference, which did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination.

The petitioner further states that there is no impropriety in changing their viewpoint on the grounds of rejection based on the Mander alone or in combination with Lucas. However, 37 CFR 1.947 and 1.948 and MPEP 2666.05 authorizes the examiner to **not** consider the new proposed obviousness rejection in the interest of “special dispatch.” Furthermore, as explained above, the request for reexamination did **not** raise the issue of obviousness by Mander alone or in combination with Lucas in regards to Claim 39 because the request failed to provide the detailed explanation in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) for the proposed obviousness rejection. Furthermore, as explained above, the record does not support petitioner’s view that a thorough examination of the claims was not performed because the examiner did not explicitly considered on the record the requester’s new viewpoint on the teachings of Mander and Lucas. The examiner has the discretion to not consider the newly proposed obviousness rejection because it did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), 1.947 and 1.948. The fact that petitioner does not agree with the examiner’s determination is not grounds for vacating the ACP, which would result in delay in the reexamination proceedings. As stated above, *inter partes* reexamination laws and policies clearly require the requester to set forth **all** the proposed rejections by supplying the **manner** and pertinency of applying the references to the claims for which reexamination is requested, with **limited** exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve “special dispatch” required in reexamination proceedings.

Furthermore, 37CFR 1.947 clearly states that the Third Party Requester may only file comments once **after** the patent owner files a response to an Office action on the merits, in this instant the patent owner did not respond to the Action Closing Prosecution, and the Third Party Requester has **no right** to comment on and address a finding of patentability **unless** the patent owner responds (MPEP § 2673.01). Thus the instant petition (petition 1), is **improper**.

In conclusion, the examiner appropriately denied consideration of the new proposed obviousness rejection of claims 39-40 over Mander alone or in combination with Lucas in the interest of “special dispatch.” Accordingly, the examiner correctly applied Office policies and procedures in determining that the new proposed obviousness rejection is not appropriately raised. For the reasons set forth above, it is deemed that the examiner properly determined that the new proposed rejections did not have a right of entry and did not abuse his discretion in deciding to not consider the new proposed anticipation rejection. Furthermore, the Office considers petitions to vacate the Action Closing Prosecution (ACP) as not being properly filed under 37 CFR § 1.181. For all the reasons discussed above, the petition is **denied**.

Petition 2

The Patent Owner [“petitioner”] argues in petition 2, dated October 22, 2010, that the Third Party Requester’s October 15, 2010 Petition (petition 1) is improper (and unauthorized) under 37 CFR § 1.939(a) and should be denied consideration. Furthermore, the Third Party Requestor’s petition should be denied on the merits since the examiner did consider the references throughout the prosecution of the proceedings. In light of the Office’s decision with regards to Petition 1 (see above), the petition 2 is **dismissed as moot**.

**CONCLUSION**

1. The petition filed October 15<sup>th</sup>, 2010 is denied and the petition filed October 22<sup>nd</sup>, 2011 is dismissed as moot.
2. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Examiner, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.



\_\_\_\_\_  
Irem Yuce  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,173	04/24/2009	6959112	M2058-6000	1578
23459	7590	04/27/2011	EXAMINER	
COGNEX CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 1 VISION DRIVE NATICK, MA 01760-2077			ART UNIT	PAPER NUMBER

DATE MAILED: 04/27/2011

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
FOLEY & LARDNER LLP  
111 HUNTINGTON AVENUE  
26TH FLOOR  
BOSTON, MA 02199-7610

Date:

**MAILED**

**APR 27 2011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001173  
PATENT NO. : 6959112  
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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NATICK MA 01760-2077

(For Patent Owner)

**MAILED**

**APR 27 2011**

**CENTRAL REEXAMINATION UNIT**

FOLEY & LARDNER LLP  
111 HUNTINGTON AVENUE  
26TH FLOOR  
BOSTON, MA 02199-7610

(For Requester)

*In re:* Wagman  
Reexamination Proceeding  
Control No. 95/001,173  
Request Deposited: April 24, 2009  
For: U.S. Patent No. 6,959,112

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

This is a decision on the July 10, 2009 paper entitled "PETITION TO RECONSIDER, IN PART, ORDER GRANTING REQUEST FOR INTER PARTES REEXAMINATION OF U.S. PATENT NO. 6,959,112".

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

The order granting reexamination found that the request raised a substantial new question (SNQ) of patentability as to claims 1-4, 6-8, 10, and 11, but did not raise an SNQ as to claims 5 and 9.

In a subsequent non-final office action, mailed March 31, 2010, the Office examined all claims.

Petitioner requests the Office reconsider the order granting reexamination as to all proposed SNQs.

Art Unit: 3992

MPEP 2648 states, in part:

Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

Therefore, at the time of the filing of the petition, requester may have filed a request to review the decision granting reexamination only for the partial denial as to claims 5 and 9. In view of the subsequent office action finding an SNQ and rejected all pending claims, the petition is **dismissed as moot**.

#### CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries with regard to this decision should be directed to Eric Keasel, at (571) 272-4929 or Mark Reinhart, at (571) 272-1611



Eric Keasel  
SPE, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,174	04/24/2009	6804416	M2058-6000	1594
23459	7590	02/17/2012	EXAMINER	
COGNEX CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 1 VISION DRIVE NATICK, MA 01760-2077			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FOLEY & LARDNER LLP  
111 HUNTINGTON AVENUE  
26TH FLOOR  
BOSTON, MA 02199-7610

Date:

**MAILED**

**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001174  
PATENT NO. : 6804416  
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**

**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

FOLEY & LARDNER LLP  
111 HUNTINGTON AVENUE  
16TH FLOOR  
BOSTON, MA 02199-7610

(For Requester)

*In re Bachelder et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,174  
Filed: April 24, 2009  
For: U.S. Patent No. 6,804,416

**DECISION ON  
PETITIONS  
UNDER  
37 CFR 1.181**

This is a decision on third party requester's October 27, 2010 petition under 37 CFR 1.181 entitled "PETITION TO REQUIRE THE EXAMINER TO CONDUCT A SUBSTANTIVE EVALUATION OF NEW CLAIMS 26-41" (hereinafter "petition"), which is requesting supervisory review of the Action Closing Prosecution (ACP) mailed on September 14, 2010. This decision also addresses the patent owner's November 23, 2010 opposition petition to the requester's October 27, 2010 petition.

The petitions under 37 CFR 1.181 are before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The requester's petition under 37 CFR 1.181 is granted, for the reasons set forth herein, to the extent that requester is given 15 days to file corrected comments.

The patent owner's opposition petition is dismissed as untimely.

**REVIEW OF THE RELEVANT FACTS**

1. United States Patent Number 6,804,416 (the '416 patent) issued on October 12, 2004.
2. On April 24, 2009, a request for *inter partes* reexamination of claims 1-25 of the '416 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,174 (the '174 proceeding).
3. On July 13, 2009, the Office issued an order granting *inter partes* reexamination of claims 1-25 in the '174 proceeding.
4. On December 22, 2009, the Office mailed a non-final Office action which included rejections of claims 1-25.
5. On February 22, 2010, patent owner filed a response to the December 22, 2009 Office action. The response included proposed amendments to patent claims 7 and 17-19 and added proposed new claims 26-41, all of which are dependent claims.
6. On March 24, 2010, third party requester (hereinafter "requester") filed comments, which included a three page discussion on the proposed new claims 26-41.
7. On September 14, 2010, the Office mailed an Action Closing Prosecution (ACP), which contained rejections of claims 1-25 and indicated proposed new claims 26-41 as patentable. The ACP stated, on page 14, that requester's comments failed to raise proper rejections for proposed new claims 26-41 in compliance with the procedures of MPEP 2666.05, and therefore, any new proposed rejections raised by the requester's comments are deemed improper and not considered.
8. On October 27, 2010, the requester filed the instant petition under 37 CFR 1.181.
9. On October 28, 2010, the Office mailed a Right of Appeal Notice (RAN), which maintained the determinations made in the ACP.
10. On November 23, 2010, patent owner filed an opposition petition to requester's October 27, 2010 petition.
11. On November 24, 2010, the requester filed a notice of appeal on the examiner's determination that proposed new claims 26-41 are patentable.
12. On December 6, 2010, the patent owner filed a notice of cross appeal on the rejections of claims 1-25.
13. On February 7, 2011, the requester filed their appeal brief. The grounds to be reviewed on appeal contain rejections on proposed new claims 26-41. See page 4 of the brief. The brief discussed the examiner's determination in the ACP regarding any new proposed rejections raised by the requester's comments. See pages 10-17 of the brief.
14. On March 7, 2011, the patent owner filed their respondent brief. The sole issue to be reviewed on appeal is whether it is proper for requester to raise proposed rejections for

proposed new claims 26-41. See, e.g., page 2 of the brief. Exhibit A of the brief contained a copy of the October 27, 2010 petition.

15. On October 4, 2011, the Office mailed an Examiner's Answer.
16. On November 4, 2011, the requester filed a rebuttal brief, which also discusses the issue of whether it is proper for requester to raise proposed rejections for proposed new claims 26-41.
17. On December 2, 2011, the requester filed a request for oral hearing.
18. Jurisdiction of the proceeding has not been transferred to the Board to decide the appeal.

### DISCUSSION

The requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of September 14, 2010 ACP. The petitioner contends the examiner's determination in the ACP concerning proposed new claims 26-41 was improper because:

- (1) The new proposed rejections for claims 26-41 were properly submitted;
- (2) Even if the new proposed rejections were improper, Petitioner should have been given an opportunity to cure in accordance with procedures set forth in MPEP 2666.05; and
- (4) Even without consideration of the new proposed rejections, it was an error to allow claims 26-41 without any substantive examination.

See pages 6-7 of the petition.

#### 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.

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.

37 CFR 1.948 states, in part:

- (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
- (1) which is necessary to rebut a finding of fact by the examiner;
  - (2) which is necessary to rebut a response of the patent owner; or
  - (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

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. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

The above practice of giving the third party requester a time period of 15 days to rectify and refile comments that are responsive but go beyond the regulatory requirements to the extent discussed above should not be confused with the situation where the third party requester files comments that are late (untimely), or such comments are "inappropriate" within the meaning of 37 CFR 1.957(a) and the time for response has expired. Where the comments are late or inappropriate, an additional 30 days is not given; rather, the comments must be refused consideration pursuant to 37 CFR 1.957(a).

### **Analysis:**

Turning to the facts in this merged proceeding, the new proposed rejections were first mentioned in the third party requester comments submitted after the first Office action on the merits. See, e.g., subsection P on pages 46-48 of the March 24, 2010 comments. Subsection P generally discusses the limitations in the proposed new claims and broadly states that the limitations are not patentable. For example, for claim 27, the comments mentions the limitations and states that "... in light of the references of record, whether an 'alignment model' is 'trained' or 'generated' makes no patentable difference." See page 46 of the March 24, 2010 comments. Without further explanation, the comments conclude that claims 27, 33, and 28 "... are invalid as anticipated by the references of record." See page 47 of the March 24, 2010 comments. Subsection P contains a similar general discussion for the other new claims. Upon review of the record, the March 24, 2010 comments did not clearly identify and explain the new proposed rejections for claims 26-41 in compliance with the requirements stated in MPEP 2666.05 that the requester must present the newly proposed rejections in compliance with the guidelines set forth in MPEP § 2617. In other words, the March 24, 2010 comments did not explicitly identify which references apply to which claims and under what grounds (e.g., anticipation or

obviousness). In addition, the comments also did not provide a detailed explanation for each new proposed rejection by applying the references to every limitation in each claim identified for the proposed rejection. Accordingly, in the ACP, the examiner correctly stated that the newly proposed rejections are not entitled to consideration. See page 14 in the ACP.

37 CFR 1.947 requires that a third party requester's comments must be limited to issues covered by the Office action or the patent owner's response. 37 CFR 1.948(a)(2) and MPEP 2666.05 only permits a third party requester to introduce new proposed rejections if necessitated by the patent owner's amendment to the claims. See MPEP 2666.05.

The new proposed rejections in the comments of March 24, 2010 were caused by the patent owner's paper of February 22, 2010, which presented proposed new claims 26-41. Therefore, it was appropriate for the March 24, 2010 comments to include newly proposed rejections for these claims. Accordingly, the proposed rejections did have a right of entry under 37 CFR 1.947 and 1.948 if the proposed rejections were presented in accordance with the procedures set forth in MPEP 2666.05. As discussed above, the ACP correctly determined that the newly proposed rejections are not entitled to consideration. However, under the facts present in this proceeding, the ACP was issued prematurely because the requester was not notified of the defects in the March 24, 2010 comments and given a 15 day time period to submit corrected comments in accordance with the policies and procedures set forth in MPEP 2666.05. Therefore, the October 27, 2010 petition is granted to the extent that requester is given 15 days from the mailing date of this decision to file corrected comments. Requester is reminded that any corrected comments must fully comply with all regulations and policies, including the 50 page limit of 37 CFR 1.943(b) and a proper certificate of service on the patent owner at the correspondence address of record (37 CFR 1.33), in order to be entered and considered in the record. If, upon the second submission, the comments are still not proper for any reason, the comments will be returned to requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted.

In summary, the September 14, 2010 ACP correctly determined that the March 24, 2010 comments were improper papers because the papers raised asserted new grounds of rejection that failed to comply with the requirements set forth in MPEP 2666.05. Because the March 24, 2010 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments will be "returned" by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. In addition, as outlined in further detail below, this decision either vacates or expunges numerous papers in the proceeding record dated on or after March 24, 2010. To the extent that the grounds of argument presented in the petition are also presented in the appeal briefs, this decision notes that such issues are petitionable (and not appealable) issues. See MPEP 1201 and 1002. Specifically, the issue of whether the examiner correctly followed Office procedures in issuing the ACP is a petitionable issue, and therefore, cannot be addressed by way of appeal.

Because the requester was not given an opportunity to submit corrected comments in accordance with the policy set forth in MPEP 2666.05, the ACP was premature. Accordingly, this decision grants the October 27, 2010 petition to the extent that the requester is given fifteen (15) days to rectify and file replacement comments.

In regard to patent owner's petition, the November 23, 2010 opposition petition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within

two weeks of the date upon which the original petition was served to the opposing party. In this case, the November 23, 2010 opposition was filed more than two weeks from October 27, 2010, the date of service for the requester's petition. Therefore, patent owner's November 23, 2010 opposition petition is dismissed as untimely. Even if the opposition petition was deemed timely submitted, the petition would be dismissed for the reasons discussed above. For example, the policies of MPEP 2666.05, which provides for a 15 day time period for the requester to file rectified comments, apply to this situation. In other words, the March 24, 2010 comments are not deemed "inappropriate" papers as argued by the patent owner on pages 10-12 of the petition, but instead were improper papers, e.g., papers that did have a right of entry under 37 CFR 1.947 and 1.948 if the proposed rejections were presented in accordance with the procedures set forth in MPEP 2666.05. In regard to patent owner's arguments that the March 24, 2010 comments were not compliant, this decision agrees with patent owner that the comments were not compliant. With respect to the arguments that the claims have been twice examined, this argument is not determinative or relevant to the issue of whether the ACP was properly issued in accordance with the procedures set forth in MPEP 2666.05. With respect to the argument that the requester waived its argument, this argument is not persuasive because 37 CFR 1.951(b) precludes the requester from filing comments, including a request for reconsideration, if the patent owner does not file a response as was the case in this proceeding. For all these reasons, patent owner's opposition petition is dismissed.

In summary, the following papers are either vacated or closed and expunged from the record:

- The March 24, 2010 comments and supporting documents are closed and expunged from the record;
- The ACP, mailed September 14, 2010, is vacated;
- The RAN, mailed October 28, 2010, is vacated;
- The November 24, 2010 Notice of Appeal is closed and expunged;
- The December 6, 2010 Notice of Cross Appeal is closed and expunged;
- The February 7, 2011 appeal brief and supporting documents are closed and expunged;
- The Examiner's Answer, mailed October 4, 2011, is vacated;
- The November 4, 2011 rebuttal brief is closed and expunged; and
- The December 2, 2011 request for oral hearing.

The papers will be removed from the record by closing the paper in the IFW, and marking the paper nonpublic to expunge it from the record. This decision will remain of record.

## CONCLUSION

1. The October 27, 2010, the requester's petition under 37 CFR 1.181 seeking the Director's review of the September 14, 2010 ACP is granted to the extent of granting the requester 15 days from the mailing date of this decision to file corrected comments.
2. The third party requester comments, dated March 24, 2010, are improper papers and are being expunged from the record, as indicated above.
3. The patent owner's November 23, 2010 opposition petition is dismissed.

4. The examiner will issue a new Office action, as appropriate, after the filing of any rectified third party comments filed.
5. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Sudhanshu Pathak, at (571) 272-5509.



Robert J. Oberleitner,  
Assistant Deputy Commissioner for Patent Operations and  
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,175	04/24/2009	6415082	29776.184	1652
20786	7590	08/04/2010	EXAMINER	
KING & SPALDING 1180 PEACHTREE STREET, NE ATLANTA, GA 30309-3521			ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David L. McCombs

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2323 Victory Avenue, Suite 700

Dallas, TX 75219

Date:

**MAILED**

**AUG 04 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001175

PATENT NO. : 6415082

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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KING & SPALDING  
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ATLANTA, GA 30309-3521

(For Patent Owner)

DAVID L. MCCOMBS  
HAYNES AND BOONE, LLP, IP SECTION  
2323 VICTORY AVENUE, SUITE 700  
DALLAS, TX 75219

(For Third Party Requester)

**MAILED**

**AUG 04 2010**

**GENERAL REEXAMINATION UNIT**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,175  
Filed: April 24, 2009  
For: U.S. Patent No. 6,415,082

: **DECISION**  
: **GRANTING**  
: **PETITION**  
: **UNDER 37 CFR 1.183**

This is a decision on the requester paper entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)," filed on May 28, 2010 ("the renewed petition").

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

Pursuant the "Decision Dismissing Petition Under 37 CFR 1.183," mailed on May 21, 2010 in the 95/001,175 proceeding, no fee is required for requester's renewed petition.<sup>1</sup>

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

**BACKGROUND**

1. On July 2, 2002, United States Patent No. 6,415,082 ("the '082 patent") issued to Michael L. Wach.
2. On April 24, 2009, a request for *inter partes* reexamination of the '082 patent was filed by a third party requester ("requester"), which request was assigned Reexamination Control No. 95/001,175 ("the '1175 proceeding").
3. On July 2, 2009, the Office mailed an order granting *inter partes* reexamination in the '1175 proceeding.

<sup>1</sup> See "Decision Dismissing Petition Under 37 CFR 1.183," mailed May 21, 2010, at page 4.

4. On November 6, 2009, the Office mailed a non-final Office action on the merits in the '1175 proceeding.
5. On December 11, 2009, patent owner filed a request for extension of time to respond to the November 6, 2009 Office action.
6. On December 23, 2009, the Office mailed a decision granting the patent owner's December 11, 2009 request for extension of time, extending the time period for responding to the November 6, 2009 office action by one month.
7. On February 8, 2010, patent owner filed a response to the November 6, 2009 Office action.
8. On March 10, 2010, requester filed "COMMENTS BY THIRD PARTY REQUESTER PURSUANT TO 37 C.F.R. §1.947" responsive to patent owner's February 8, 2010 response and the November 6, 2009 Office action ("the March 10, 2010 comments submission").
9. Concurrently on March 10, 2010, requester filed a petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)" ("the petition under 37 CFR 1.183").
10. On May 21, 2010, the Office mailed a decision dismissing requester's March 10, 2010 petition under 37 CFR 1.183.
11. On May 28, 2010, requester filed the instant renewed petition entitled "RENEWED PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)" ("the renewed petition under 37 CFR 1.183").
12. Concurrently on May 28, 2010, further to the May 21, 2010 decision dismissing requester's March 10, 2010 petition under 37 CFR 1.183, requester filed a re-formatted version of its March 10, 2010 comments submission ("the reformatted comments submission").

## DECISION

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

On May 21, 2010, the Office mailed a decision dismissing requester's March 10, 2010 petition under 37 CFR 1.183, stating that "[i]n this instance, the 42 pages of comments, and the entire Tomlinson declaration, submitted as part of requester's March 10, 2010 comments submission, do not satisfy the formatting guidelines set forth above [in the decision] for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b)."<sup>2</sup> Requester was given a time period of fifteen (15) days from the mailing date of the May 21, 2010 decision to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines which were set forth in that decision.<sup>3</sup>

The May 21, 2010 decision further stated (emphasis added):

It is noted that, in the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission, the content of which is identical to that of the presently submitted comments submission, with the exception that the (currently, 42) pages of comments and the entire Tomlinson declaration also comply with the formatting guidelines set forth herein, such renewed petition would be grantable.<sup>4</sup>

On May 28, 2010, concurrently with the renewed petition under 37 CFR 1.183, requester filed a re-formatted comments submission, including the Exhibit A Tomlinson declaration and the Exhibit I claim chart, addressing the 87 new claims added by patent owner's February 8, 2010 response. Requester asserts that the May 28, 2010 re-formatted comments submission "conform[s] to the prescribed formatting requirements" and that "[t]he content of the comments submission and declaration are identical to that of the documents filed on March 10, 2010."<sup>5</sup> Requester further asserts that the May 28, 2010 re-formatted comments submission includes "76 pages of comments directed to issues raised by the Office action or the Patent Owner's Reply," and that the Tomlinson declaration "includes 5 pages directed to issues raised by the Office action or the Patent Owner's Reply," for a combined total of 81 pages.<sup>6</sup> The re-formatted comments submission further includes the 41-page claim chart exhibit (Exhibit I), which the May 21, 2010 decision already deemed format-compliant.<sup>7</sup>

<sup>2</sup> See May 21, 2010 decision at page 4.

<sup>3</sup> *Id.* (requiring a comments submission that is 1) is double-spaced; 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier); 3) has a font size no smaller than 12-point; 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.)

<sup>4</sup> *Id.*

<sup>5</sup> See the renewed petition under 37 CFR 1.183 at page 2.

<sup>6</sup> *Id.*

<sup>7</sup> See May 21, 2010 decision at page 4, FN 7.

Thus, based on requester's assertions and the Office's determination, requester's re-formatted comments submission, including the Exhibit A Tomlinson declaration and the Exhibit I claim chart, exceeds the 50-page limit set forth in 37 CFR 1.943(b) by 73 pages.<sup>8</sup> In the renewed petition under 37 CFR 1.183, requester requests waiver of the 50-page limit of 37 CFR 1.943(b) with respect to the May 28, 2010 re-formatted comments submission.<sup>9</sup>

Requester has filed a comments submission with content identical to that of the May 10, 2010 comments submission and formatted in compliance with the guidelines set forth in the May 21, 2010 decision. Accordingly, as set forth in the May 21, 2010 decision, in this instance, the specific facts set forth in requester's March 10, 2010 petition under 37 CFR 1.183 (and set forth again in the renewed petition under 37 CFR 1.183) and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, in the November 6, 2009 Office action, of approximately 276 pages of claim charts from the April 24, 2009 request for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b).<sup>10</sup> Accordingly, requester's renewed 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 73 pages of requester's May 28, 2010 re-formatted comments submission that exceed the 50-page limit. This decision makes requester's May 28, 2010 re-formatted submission page-length compliant.

#### CONCLUSION

1. Requester's May 28, 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 73 pages of requester's May 28, 2010 re-formatted comments submission that exceed the 50-page limit. This decision makes requester's May 28, 2010 re-formatted submission page-length compliant.
2. Jurisdiction for the '1175 proceeding is being returned to the Central Reexamination Unit (CRU).
3. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717.



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

8-3-10 kenpet8

<sup>8</sup> Only those pages of requester's comments submission upon which arguments appear are included against the page limit count. *See* MPEP 2667(I)(A)(2). It has been determined that 76 pages of the comments portion, 6 pages (*i.e.*, pages 3-8) of Exhibit A (the Tomlinson Declaration), and 41 pages of Exhibit I (the claim chart) of the re-formatted comments submission count toward the page limit. The pages of Exhibits B-H do not include any pages that are included against the page limit count.

<sup>9</sup> *See* renewed petition under 37 CFR 1.183 at page 2. Although requester determined that the re-formatted comments submission exceeds the page limit by 72 pages, as noted in FN 7 above, the re-formatted comments submission has been determined to exceed the page limit by 73 pages.

<sup>10</sup> *See* May 21, 2010 decision at page 4.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,175	04/24/2009	6415082	29776.184	1652
20786	7590	09/13/2011	EXAMINER	
KING & SPALDING 1180 PEACHTREE STREET, NE ATLANTA, GA 30309-3521			ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

REEXAMINATION CONTROL NUMBER 95/001,175.

PATENT NUMBER 6415082.

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

King & Spalding  
1180 Peachtree Street, NE  
Atlanta, GA 30309-3521

(For Patent Owner)

Haynes and Boone, LLP  
IP Section  
2323 Victory Avenue  
Suite 700  
Dallas, TX 75219

(For Requester)

In re Wach  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,175  
Filed: April 24, 2009  
For: U.S. Patent No. 6,415,082

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

This is a decision on:

- The July 8, 2011 requester petition entitled "Petition under 37 CFR 1.183 for Entry of Replacement Third Party Comments" (requester's July 8, 2011 petition); and
- The July 26, 2011 requester petition entitled "Supplemental Petition under 37 CFR 1.183 for Entry of Replacement Third Party Comments" (requester's July 26, 2011 supplemental petition).

Requester's July 8, 2011 petition and July 26, 2011 supplemental petition under 37 CFR 1.183 request the entry of requester's replacement comments submission filed on July 8, 2011, in lieu of requester's comments submission filed on May 20, 2011, which has been expunged from the record. However, the June 24, 2011 Right of Appeal Notice (RAN) has been withdrawn, and requester's July 8, 2011 replacement comments submission has been entered and considered by the examiner. See the RAN mailed on September 9, 2011, which replaces the June 24, 2011 RAN. For this reason, requester's July 8, 2011 petition and July 26, 2011 supplemental petition under 37 CFR 1.183 are **dismissed as moot**.

**CONCLUSION**

The July 8, 2011 requester petition and the July 26, 2011 supplemental requester petition under 37 CFR 1.183 are **dismissed as moot**.

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

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

9/09/2011



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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	EXAMINER	
Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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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.
95/001,080	09/09/2008	7321783	RIK107440A	9118
40401	7590	08/04/2010	EXAMINER	
Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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.
90/010,623	07/28/2009	7321783	RK107440C	2837
40401	7590	08/04/2010	EXAMINER	
Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 08/04/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG LLP  
(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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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.<sup>1</sup>
  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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<sup>1</sup> 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:**

Ex parte Reexamination. The *ex parte* reexamination provisions, 35 U.S.C. 302 *et seq.*, permits any member of the public to file a request for reexamination.<sup>2</sup> 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.<sup>3</sup> The Director, by statutory mandate, is required to make a determination that a request raises an SNQ.<sup>4</sup> The Director conducts examination of the ordered *ex parte*

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<sup>2</sup> See 35 U.S.C. 302.

<sup>3</sup> See 35 U.S.C. 303.

<sup>4</sup> *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.<sup>5</sup> The Director has the discretion to consolidate, i.e., merge, the ordered *ex parte* reexamination proceedings with other ordered *ex parte* reexamination proceedings.<sup>6</sup> 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.<sup>7</sup>

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.<sup>8</sup> 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.<sup>9</sup> 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.<sup>10</sup>

#### 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.

<sup>5</sup> See 35 U.S.C. 305; See also Ethicon v. Quigg, 849 F.2d 1422 (Fed. Cir. 1998).

<sup>6</sup> See 37 CFR 1.565(c).

<sup>7</sup> See 35 U.S.C. 306.

<sup>8</sup> See 37 CFR 1.989(a).

<sup>9</sup> Sony, Inc. v. Dudas, 2006 U.S. Dist. LEXIS 36856, 12-13 (E.D. VA 2006); See also 35 U.S.C. 315(b).

<sup>10</sup> 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,<sup>11</sup> MPEP 2686.01 IV,<sup>12</sup> MPEP 2283,<sup>13</sup> and MPEP 2286.<sup>14</sup>)

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).<sup>15</sup> 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.<sup>16</sup> 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.<sup>17,18</sup>

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.

<sup>11</sup> “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.”

<sup>12</sup> “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.”

<sup>13</sup> “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.’”

<sup>14</sup> “[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.’”

<sup>15</sup> “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).

<sup>16</sup> Id.

<sup>17</sup> 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.”

<sup>18</sup> “[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).<sup>19</sup>

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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<sup>19</sup> 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 statutes, 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



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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	02/18/2011	EXAMINER	
HersHKovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2011

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Date: FEB 25 8 20 11

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.

PTOL-2070(Rev.07-04)



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HOUSTON, TX 77002

Date  
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FEB 18 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.

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PTOL-2070(Rev.07-04)



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HOUSTON, TX 77002

Date:

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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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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 II 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.<sup>1</sup>
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), 102(/39), and 103(/39) are not subject to reexamination.

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<sup>1</sup> 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:**

\*\*\*\*\*

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.<sup>2</sup> 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.<sup>3</sup> 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.<sup>4</sup>

### 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.<sup>5</sup>

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.<sup>6</sup> 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)."<sup>7</sup>

### 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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<sup>2</sup> Patent owner petition at 2.

<sup>3</sup> *Id.* at 3.

<sup>4</sup> *Id.* at 2.

<sup>5</sup> Third party requester petition at 2.

<sup>6</sup> *Id.* at 2.

<sup>7</sup> *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 ALLTEL'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  
Senior Legal Advisor  
Office of Patent Legal Administration

2/14/11  
Kenpet8/



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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	EXAMINER	
Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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95/001,080	09/09/2008	7321783	RIK107440A	9118
40401	7590	01/24/2012	EXAMINER	
Herskovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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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	EXAMINER	
HersHKovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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Date:

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**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)).

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**JAN 24 2012**

**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

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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

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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Hershkovitz & Associates, LLC  
2845 Duke Street  
Alexandria, VA 22314

(For Patent Owner)

**MAILED**

**JAN 24 2012**

Novak, Druce & Quigg LLP  
1000 Louisiana Avenue  
53<sup>rd</sup> Floor  
Houston, TX 77002

(For '1080 *Inter Partes* Requester) **CENTRAL REEXAMINATION UNIT**

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

DECISION ON PETITIONS

*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

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 II 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  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,185	04/30/2009	7486667	17750/002005	9310

22511            7590            06/17/2011

OSHA LIANG L.L.P.  
TWO HOUSTON CENTER  
909 FANNIN, SUITE 3500  
HOUSTON, TX 77010

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 06/17/2011

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 6-17-11

Andrea G. Reister  
COVINGTON & BURLING, LLP, ATTN: PATENT DOCKETING  
1201 Pennsylvania Avenue, N.W.  
Washington, DC 20004-2401

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

REEXAMINATION CONTROL NO. : 95001185  
PATENT NO. : 7486667  
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.



**MAILED**

**JUN 17 2011**

(For Patent Owner)

Osha Liang L.L.P.  
Two Houston Center **CENTRAL REEXAMINATION UNIT**  
909 Fannin  
Suite 3500  
Houston, TX 77010

Andrea G. Reister (For Requester)  
Covington & Burling LLP  
Attn: Patent Docketing  
1201 Pennsylvania Avenue, N.W.  
Washington, DC 20004-2401

In re Donald S. Feuer :  
*Inter Partes* Reexamination Proceeding : **DECISION DISMISSING**  
Control No. 95/001,185 : **PETITION UNDER**  
Filed: April 30, 2009 : **37 CFR 1.137(b)**  
For: U.S. Patent No. 7,486,667 :

This is a decision on the June 7, 2011 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late Appellant's Brief Under 37 C.F.R. § 41.37 in the above-identified reexamination proceeding ("the June 7, 2011 patent owner petition").

The June 7, 2011 patent owner petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The June 7, 2011 patent owner petition is **dismissed**.

**STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

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

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

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

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

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

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

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

**37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.**

\*

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

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

(c) *Reply*. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and ***abandoned for failure to prosecute***, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

[Bold and italicized emphasis added; italicized emphasis in the original.]

**37 CFR 1.953(c) provides:**

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

**37 CFR 1.957. Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.**

\*

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

\*

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

**MPEP 711.03(c)(II)(A)(2) provides, in pertinent part:**

(b) A reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

\*  
\*  
\*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

\*

(c) In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

**MPEP 2668 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

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

\*

\*

IV. PETITION REQUIREMENTS

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

**MPEP 2675 provides, in pertinent part:**

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

**DECISION**

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

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the June 7, 2011 petition does not require a terminal disclaimer.<sup>1</sup>

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<sup>1</sup> See: 37 CFR 1.137(d)(3).

The June 7, 2011 petition satisfies only two of the three criteria required under 37 CFR 1.137(b).

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the June 7, 2011 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Regarding item (1), however, the criterion of submitting the requisite response required by the October 1, 2010 Right of Appeal Notice (RAN) has not been satisfied.

Specifically, the prosecution of the instant *inter partes* reexamination proceeding was terminated due to patent owner's failure to timely submit a proper response under 37 CFR 1.953(c) to the October 1, 2010 RAN. Although patent owner timely filed a Notice of Appeal on October 28, 2010, patent owner failed to timely file an appellant's brief.

In an *inter partes* reexamination proceeding terminated for failure to timely file an appellant brief, the response required for consideration of a petition to revive must be the appellant brief. Patent owner submitted a paper titled "Appellant's Brief Under 37 C.F.R. § 41.37" on June 7, 2011. The Board of Patent Appeals and Interferences (BPAI) has confirmed that the June 7, 2011 brief is defective. A notice of non-compliance regarding the June 7, 2011 brief is being issued by the BPAI concurrently with this decision. Therefore, the June 7, 2011 petition is incomplete.

For the foregoing reasons, the June 7, 2011 patent owner petition to revive is **dismissed**.

### ADDITIONAL DISCUSSION

The filing of a proper appellant brief is the required "reply" within the meaning of 37 CFR 1.137. In this regard, 35 U.S.C. 133 provides that an application becomes abandoned (terminated) for "failure ... to prosecute the application ...." 37 CFR 1.137 is the regulation that provides a remedy for a failure to prosecute.<sup>2</sup> 35 U.S.C. 314(a) incorporates the provisions of 35 U.S.C. 133 into the *inter partes* reexamination statute, to apply those provisions to *inter partes* reexamination proceedings. The instant *inter partes* reexamination proceeding has become terminated for failure to timely file an appellant brief,<sup>3</sup> and this has resulted in termination of the prosecution for failure to prosecute; thus, it is clear from 35 U.S.C. 133 that a petition for revival may be filed, to remedy that failure to prosecute. 37 CFR 1.137 provides the regulatory procedure to

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<sup>2</sup> See: MPEP 711.03(c)(II)(A)(2)(b) and (c).

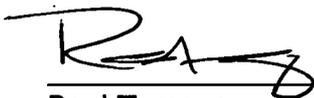
<sup>3</sup> MPEP 2675 establishes that the failure to timely file an appellant brief leads to termination of the prosecution.

revive. 37 CFR 1.137(c) defines the reply (termed a "response" in reexamination) required for a petition to revive as an element of the 37 CFR 1.137 remedy "for a failure to prosecute." A proper appellant brief provides the required response (reply) that addresses the failure to prosecute, since it was the patent owner's failure to timely file a proper appellant brief that was the failure to prosecute.

Accordingly, the Office has authority and jurisdiction to apply 37 CFR 1.137 in instances where the required reply under 37 CFR 1.137(b)(1) is patent owner's appellant brief in an *inter partes* reexamination proceeding.

### CONCLUSION

1. The June 7, 2011 patent owner petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Appellant's Brief Under 37 C.F.R. § 41.37 is **dismissed**.
2. For a grantable petition under 37 CFR 1.137(b), it is required that patent owner provide a compliant appellant brief. Any such submission(s) should include a cover letter titled "Renewed Petition Under 37 CFR 1.137(b)."
3. Any request for reconsideration of this decision must be submitted within **ONE (1) MONTH** from the mail date of this decision. An extension of time to file a request for reconsideration may be requested only under 37 CFR 1.956; extensions of time under 37 CFR 1.136 are not available in reexamination proceedings. The reconsideration request should include a cover letter titled "Renewed Petition under 37 CFR 1.137(b)." Failure to timely file a request for reconsideration will result in the issuance of a reexamination certificate based on the May 31, 2011 Notice of Intent To Issue *Inter Partes* Reexamination Certificate.
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

June 16, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,185	04/30/2009	7486667	17750/002005	9310

22511      7590      08/18/2011

OSHA LIANG L.L.P.  
TWO HOUSTON CENTER  
909 FANNIN, SUITE 3500  
HOUSTON, TX 77010

EXAMINER

ART UNIT      PAPER NUMBER

DATE MAILED: 08/18/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Covington & Burling LLP

Attn: Patent Docketing

1201 Pennsylvania Avenue N. W.

Washington DC 20004-2401

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

REEXAMINATION CONTROL NUMBER 95/001,185.

PATENT NUMBER 7,486,667.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

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

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

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



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

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

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

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

**37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.**

\*

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

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

(c) *Reply*. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and ***abandoned for failure to prosecute***, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

[Bold and italicized emphasis added; italicized emphasis in the original.]

**37 CFR 1.953(c) provides:**

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the

Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, prosecution in the *inter partes* reexamination proceeding will be terminated, and the Director will proceed to issue and publish a certificate under § 1.997 in accordance with the Right of Appeal Notice.

**37 CFR 1.957. Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.**

\*

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

\*

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

**37 CFR 41.66(a) provides:**

(a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

**MPEP 711.03(c)(II)(A)(2) provides, in pertinent part:**

(b) A reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

\*  
\*  
\*

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 41.37 for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

\*

(c) In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR 41.37(c) and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

**MPEP 2668 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

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

\*

\*

IV. PETITION REQUIREMENTS

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

**MPEP 2675 provides, in pertinent part:**

Where all parties who filed an appeal or cross appeal fail to timely file an appellant brief and fee within the time allowed, the prosecution of the reexamination proceeding is terminated by a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), and a certificate is issued indicating the status of the claims at the time of appeal.

## DECISION

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

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The present proceeding is a reexamination proceeding; thus, the June 22, 2011 renewed petition does not require a terminal disclaimer.<sup>1</sup>

Regarding item (1), the prosecution of the instant *inter partes* reexamination proceeding was terminated within the meaning of 37 CFR 1.957(c) due to patent owner's failure to timely submit a proper response under 37 CFR 1.953(c) to the October 1, 2010 RAN. Although patent owner timely filed a Notice of Appeal on October 28, 2010, patent owner has until now failed to timely file a compliant appellant's brief.

However, the Appellant's Brief Under 37 C.F.R. § 41.37 submitted by patent owner on June 22, 2011, has been found to be in compliance with the regulations. Further, patent owner was charged the \$270.00 37 CFR 41.20(b)(2) fee for filing a brief in support of an appeal on May 26, 2011. Item (1) has thus been satisfied.

A petition fee and a proper statement under 37 CFR 1.137(b)(3) were submitted as part of the June 7, 2011 patent owner petition to revive. In addition, patent owner renewed the required statement under 37 CFR 1.137(b)(3) as part of the June 22, 2011 patent owner renewed petition to revive. Items (2) and (3) have thus been satisfied.

Accordingly, the June 22, 2011 patent owner renewed petition to revive is **granted**.

The May 31, 2011 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appellant's Brief is **withdrawn**.

## ADDITIONAL DISCUSSION

The filing of a proper appellant brief is the required "reply" within the meaning of 37 CFR 1.137. In this regard, 35 U.S.C. 133 provides that an application becomes abandoned (terminated) for "failure ... to prosecute the application ...." 37 CFR 1.137 is the regulation that provides a remedy for a failure to prosecute.<sup>2</sup> 35 U.S.C. 314(a)

<sup>1</sup> See: 37 CFR 1.137(d)(3).

<sup>2</sup> See: MPEP 711.03(c)(II)(A)(2)(b) and (c).

incorporates the provisions of 35 U.S.C. 133 into the *inter partes* reexamination statute, to apply those provisions to *inter partes* reexamination proceedings. The instant *inter partes* reexamination proceeding has become terminated for failure to timely file an appellant brief,<sup>3</sup> and this has resulted in termination of the prosecution for failure to prosecute; thus, it is clear from 35 U.S.C. 133 that a petition for revival may be filed, to remedy that failure to prosecute. 37 CFR 1.137 provides the regulatory procedure to revive. 37 CFR 1.137(c) defines the reply (termed a "response" in reexamination) required for a petition to revive as an element of the 37 CFR 1.137 remedy "for a failure to prosecute." A proper appellant brief provides the required response (reply) that addresses the failure to prosecute, since it was the patent owner's failure to timely file a proper appellant brief that was the failure to prosecute.

Accordingly, the Office has authority and jurisdiction to apply 37 CFR 1.137 in instances where the required reply under 37 CFR 1.137(b)(1) is patent owner's appellant brief in an *inter partes* reexamination proceeding.

### CONCLUSION

1. The June 22, 2011 patent owner renewed petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Appellant's Brief Under 37 C.F.R. § 41.37 is **granted**.
2. The May 31, 2011 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to timely file an Appellant's Brief is **withdrawn**.
3. Patent owner's June 22, 2011 appellant's brief is hereby entered in the record, thus triggering a respondent's brief right for third party requester under 37 CFR 41.68. Accordingly, third party requester may file a respondent's brief as per 37 CFR 41.66(b) within one month of the mailing date of this decision.
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

August 15, 2011

<sup>3</sup> MPEP 2675 establishes that the failure to timely file an appellant brief leads to termination of the prosecution.



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THE WEBB LAW FIRM, P.C.  
ONE GATEWAY CENTER  
420 FT. DUQUESNE BLVD, SUITE 1200  
PITTSBURGH, PA 15222

(For Patent Owner)

**MAILED**

**JAN 17 2012**

**CENTRAL REEXAMINATION UNIT**

FOLEY & LARDNER LLP  
321 NORTH CLARK STREET  
SUITE 2800  
CHICAGO, IL 60654-5313

(For Requester)

*In re Funari*  
Reexamination Proceeding  
Control No.: 95/001,187  
Filing Date: July 10, 2009  
For: U.S. Patent No.: 7,481,413

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

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a December 9, 2011 patent owner petition, which is treated as a petition under 37 CFR 1.181, to invoke supervisory authority to enter the proposed amendments in the patent owner's response to Action Closing Prosecution, dated October 28, 2011.

The patent owner petition is dismissed.

### BACKGROUND

1. U.S. Patent No. 7,481,413 (hereinafter, the '413 patent) issued on January 27, 2009.
2. A request for reexamination, assigned control No. 90/001,187 (the '187 proceeding), was deposited by a third party Requester on July 10, 2009.
3. On August 21, 2009, the Central Reexamination Unit (CRU) issued an order granting re-examination and a first Office action on the merits.
4. Prosecution continued and on October 28, 2011, the Office mailed an Action Closing Prosecution (ACP).
5. On December 9, 2011, the patent owner filed a response to the ACP and the present petition, which is treated as a petition to invoke supervisory authority to enter the proposed amendments, dated December 9, 2011.

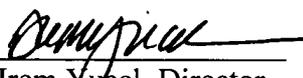
### DECISION

As pointed out, the patent owner filed a December 9, 2011 petition under 37 CFR 1.182 to enter their December 9, 2011 amendments. The petition addresses issues that are properly raised under 37 CFR 1.181 and therefore, are not properly raised under 37 CFR 1.182. In other words, a petition under 37 CFR 1.182 is not the proper means to seek relief for the issues raised in the December 9, 2011 petition. Accordingly, although the petition contains statements that relief sought is under 37 CFR 1.182, the petition is being addressed as a petition under 37 CFR 1.181.

The present petition requests to invoke supervisory authority to enter the proposed amendments of patent owner's response dated December 9, 2011. However, there has been no decision by the examiner regarding entry of the proposed amendment of December 9, 2011. Accordingly, it is premature to invoke supervisory authority regarding refusal to enter the proposed amendment because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed.

### CONCLUSION

1. The patent owner's December 9, 2011 petition is dismissed.
2. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program 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.
95/001,188	05/12/2009	6304937	9278.002.937	2299

86497            7590            09/02/2010

Paul M. Anderson, PLLC  
P.O. Box 160006  
Austin, TX 78716

EXAMINER

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,188	05/12/09	6304937	9278.002.937

TRACY DRUCE  
NOVAK DRUCE & QUIGG LLP  
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HOUSTON, TX 77002

EXAMINER  
ESCALANTE, OVIDIO

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3992

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Paul M. Anderson, PLLC  
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Austin TX 78716

(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Avenue  
Fifty-Third Floor  
Houston, TX 77002

(For Third Party Requester)

MAILED

SEP 02 2010

CENTRAL REEXAMINATION UNIT

*In re Farmwald et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,188  
Filed: May 12, 2009  
For: U.S. Patent No. 6,304,937

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: DECISION  
: ON  
: PETITION

*In re Farmwald et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/010,537  
Filed: May 13, 2009  
For: U.S. Patent No. 6,304,937

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This is a decision on patent owner's May 13, 2010 petition entitled "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS." The third party requester, on June 14, 2010, filed an opposition to patent owner's May 13, 2010 petition.

The fee set forth in 37 CFR 1.17(f) for the patent owner petition is \$400, which was charged to Patent Owner's credit card on May 13, 2010, pursuant to the authorization for same in patent owner's EFS-WEB fee transmittal.

The patent owner petition and requester opposition are before the Office of Patent Legal Administration for consideration.

Patent owner's May 13, 2010 petition is dismissed.

**REVIEW OF FACTS**

1. On October 16, 2001, the Office issued U.S. Patent No. 6,304,937 (the '937 patent) to Farmwald *et al.*
2. On May 12, 2009, a request for *inter partes* reexamination of all the claims (claims 1-40)

of the '937 patent was filed by third party requester (requester) NVIDIA Corporation. The request was assigned Control No. 95/001,188 (the '1188 proceeding).

3. On May 13, 2009, a request for *ex parte* reexamination of all the claims (claims 1-40) of the '937 patent was filed by the same Requester (NVIDIA Corporation). The request was assigned Control No. 90/010,537 (the '10537 proceeding).
4. The '937 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the initial complaint, patent owner appears to be enforcing at least one of claims 1-40 against the requester in the litigation.
5. On July 7, 2009, the Office issued an order granting the '1188 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 '937 patent, claims 1-40, would be subject to reexamination.
6. Also on July 7, 2009, the Office issued an order granting the '10537 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.
7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10537 *ex parte* reexamination proceeding expired after September 7, 2009.<sup>1</sup>
8. On October 6, 2009, patent owner filed a petition to prevent merger, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition. Concurrently, patent owner filed a petition requesting suspension of the '1188 *inter partes* reexamination proceeding.
9. On November 5, 2009, third party requester filed an opposition petition to patent owner's October 6, 2009 petition to prevent merger. Concurrently, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition to suspend.
10. On December 11, 2009 the Office issued a decision dismissing patent owner's October 6, 2009 petition to prevent merger and merged the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings ("the merged proceeding").

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<sup>1</sup> There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

11. Also on December 11, 2009, the Office issued a decision dismissing patent owner's October 6, 2009 petition to suspend the '1188 *inter partes* reexamination proceeding.
12. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.
13. On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 11, 2009 decision dismissing patent owner's October 6, 2009 petition and merging the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
14. On January 29, 2010, third party requester filed the present opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 11, 2009 decision.
15. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".
16. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.
17. On July 7, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
18. On July 13, 2010, third party requester filed a petition requesting reconsideration of the July 7, 2010 Office decision dissolving the merger of the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
19. On August 6, 2010, the Office issued a non-final Office action in the '1188 *inter partes* reexamination proceeding.
20. On August 12, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10537 *ex parte* reexamination proceeding.

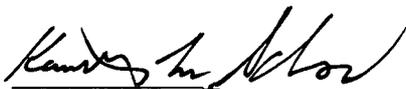
### DECISION

As pointed out, on July 13, 2010, requester filed a petition requesting reconsideration of the July 7, 2010 Office decision dissolving the merger of the '1188 and '10537 reexamination proceedings. Until the reconsideration of the July 7, 2010 decision is concluded, patent owner's May 13, 2010 petition to strike third party comments from previously merged proceedings is premature, and will only be necessary if the Office reverses its current position. The status of all papers made of record during the period when the proceedings were merged is subject to requester's merger challenge, until the petition for reconsideration of the issue of merger is

decided. Should the merger be reinstated, then patent owner may renew the present petition, but under 37 CFR 1.181, as a petition challenging entry of the papers.

### CONCLUSION

1. Patent owner's May 13, 2010 petition is dismissed.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,188	05/12/2009	6304937	9278.002.937	2299

86497            7590            10/28/2010

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EXAMINER

ART UNIT            PAPER NUMBER

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ESCALANTE, OVIDIO

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1000 Louisiana Avenue  
Fifty-Third Floor  
Houston, TX 77002

(For Third Party Requester)

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*In re* Farmwald *et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,188  
Filed: May 12, 2009  
For: U.S. Patent No. 6,304,937

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: DECISION  
: ON  
: PETITION  
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JUL 28 2010  
CENTRAL REEXAMINATION UNIT

This is a decision on third party requester's September 20, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION TO HALT PUBLICATION OF REEXAMINATION CERTIFICATE".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's credit card on September 20, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

The petition is **dismissed**.

**REVIEW OF FACTS**

1. On October 16, 2001, the Office issued U.S. Patent No. 6,304,937 (the '937 patent) to Farmwald *et al.*
2. On May 12, 2009, a request for *inter partes* reexamination of all the claims (claims 1-40) of the '937 patent was filed by third party requester (requester) NVIDIA Corporation. The request was assigned Control No. 95/001,188 (the '1188 proceeding).
3. On May 13, 2009, a request for *ex parte* reexamination of all the claims (claims 1-40) of the '937 patent was filed by the same Requester (NVIDIA Corporation). The request was assigned Control No. 90/010,537 (the '10537 proceeding).

4. The '937 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the initial complaint, patent owner appears to be enforcing at least one of claims 1-40 against the requester in the litigation.
5. On July 7, 2009, the Office issued an order granting the '1188 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 '937 patent, claims 1-40, would be subject to reexamination.
6. Also on July 7, 2009, the Office issued an order granting the '10537 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.
7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10537 *ex parte* reexamination proceeding expired after September 7, 2009.<sup>1</sup>
8. On October 6, 2009, patent owner filed a petition to prevent merger, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition. Concurrently, patent owner filed a petition requesting suspension of the '1188 *inter partes* reexamination proceeding.
9. On November 5, 2009, third party requester filed an opposition petition to patent owner's October 6, 2009 petition to prevent merger. Concurrently, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition to suspend.
10. On December 11, 2009 the Office issued a decision dismissing patent owner's October 6, 2009 petition to prevent merger and merged the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings ("the merged proceeding").
11. Also on December 11, 2009, the Office issued a decision dismissing patent owner's October 6, 2009 petition to suspend the '1188 *inter partes* reexamination proceeding.
12. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.
13. On January 19, 2010, patent owner filed a petition requesting reconsideration of the

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<sup>1</sup> There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

- December 11, 2009 decision dismissing patent owner's October 6, 2009 petition and merging the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
14. On January 29, 2010, third party requester filed the present opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 11, 2009 decision.
  15. On May 13, 2010, patent owner filed petition entitled, "PETITION TO STRIKE THIRD PARTY REQUESTER COMMENTS".
  16. On June 14, 2010, third party requester filed an opposition to patent owner's May 13, 2010 petition.
  17. On July 7, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition and dissolving the merger of the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
  18. On July 13, 2010, third party requester filed a petition requesting reconsideration of the July 7, 2010 Office decision dissolving the merger of the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
  19. On August 6, 2010, the Office issued a non-final Office action in the '1188 *inter partes* reexamination proceeding.
  20. On August 12, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10537 *ex parte* reexamination proceeding.
  21. On September 20, 2010, third party requester filed the present petition in the '1188 proceeding requesting that publication of the '10537 proceeding's *ex parte* reexamination certificate be halted.
  22. Also on September 20, 2010, third party requester concurrently filed a petition in the '10537 proceeding requesting that publication of the '10537 proceeding's *ex parte* reexamination certificate be halted.
  23. On October 6, 2010, patent owner filed a response to the August 6, 2010 non-final Office action in the '1188 proceeding.
  24. On October 13, 2010, the Office issued a decision on the September 20, 2010 requester petition filed in the '10537 proceeding stating that it was an improper paper and had been returned/destroyed.

### DECISION

Third party requester is petitioning in the present '1188 proceeding that publication of the reexamination certificate in the in the '10537 proceeding be halted. The requested relief cannot be granted. Third party requester is petitioning in the present '1188 proceeding for relief to be provided in a different proceeding - the '10537 proceeding. Accordingly, the petition is dismissed.

### CONCLUSION

1. The petition is dismissed.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

10-26-10  
Kimpropa/IP



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,188	05/12/2009	6304937	9278.002.937	2299

86497            7590            01/11/2011  
Paul M. Anderson, PLLC  
P.O. Box 160006  
Austin, TX 78716

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 01/11/2011

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP  
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HOUSTON, TX 77002

Date:

**MAILED****JAN 11 2011**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001188

PATENT NO. : 6304937

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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(For Third Party Requester)

MAILED  
JAN 11 2011  
CENTRAL REEXAMINATION UNIT

*In re Farmwald et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,188  
Filed: May 12, 2009  
For: U.S. Patent No. 6,304,937

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: DECISION  
: ON  
: PETITION

*In re Farmwald et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/010,537  
Filed: May 13, 2009  
For: U.S. Patent No. 6,304,937

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This is a decision on third party requester's July 13, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's credit card on July 14, 2010 pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

**SUMMARY**

The petition is **dismissed**.

The examiner is directed to supplement the record by providing the rationale discussed in part III.B. of this decision. This is to be carried out by reissuing the November 24, 2010 Action Closing Prosecution (ACP) in the '1188 proceeding, with the supplemental information.

As discussed below, the requester was not precluded from filing another *inter partes* reexamination request on the next day after requester filed the '1188 *inter partes* reexamination request (or even shortly thereafter). Further, requester could have filed a single *inter partes* request that including all the SNQs and proposed rejections contained in the two separate requests filed one day apart. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either a single *inter partes* request with all issues, or a second *inter partes* request raising the issues presented in the *ex parte* request, concurrently or before the '1188 *inter partes* request was ordered. In short, requester has made the conscious choice to present the issues in the *ex parte* reexamination request in a manner that does not provide requester *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, so now has no basis to complain that *inter partes* rights are not being afforded.

The July 7, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as of the order date of the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further the Office's ability to conduct the reexamination proceedings with special dispatch.

Finally, in order to address a point made in the third party requester petition, the present decision instructs the examiner of record to supplement the record by providing the rationale discussed in part III.B. of this decision. As pointed out, this is to be carried out by reissuing the November 24, 2010 Action Closing Prosecution (ACP) in the '1188 proceeding, with the supplemental information. This is for the purpose of addressing petitioner's concern as to all party rights being preserved.

#### REVIEW OF FACTS

1. On October 16, 2001, the Office issued U.S. Patent No. 6,304,937 (the '937 patent) to Farmwald *et al.*
2. On May 12, 2009, a request for *inter partes* reexamination of all the claims (claims 1-40) of the '937 patent was filed by third party requester (requester) NVIDIA Corporation. The request was assigned Control No. 95/001,188 (the '1188 proceeding).
3. On May 13, 2009, a request for *ex parte* reexamination of all the claims (claims 1-40) of the '937 patent was filed by the same requester (NVIDIA Corporation). The request was assigned Control No. 90/010,537 (the '10537 proceeding).

4. The '937 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343}. The initial complaint was filed July 10, 2008. Based upon the initial complaint, patent owner appears to be enforcing at least one of claims 1-40 against the requester in the litigation.
5. On July 7, 2009, the Office issued an order granting the '1188 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 '937 patent, claims 1-40, would be subject to reexamination.
6. Also on July 7, 2009, the Office issued an order granting the '10537 request for *ex parte* reexamination and setting a two month time period for a Patent Owner's Statement. The order stated that all the claims of the '937 patent, claims 1-40, would be subject to reexamination.
7. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10537 *ex parte* reexamination proceeding expired September 7, 2009.<sup>1</sup>
8. On October 6, 2009, patent owner filed a petition to prevent merger, citing 35 U.S.C. §§ 305 and 317(a), and requesting waiver of any rule that prevents consideration of the petition. Concurrently, patent owner filed a petition requesting suspension of the '1188 *inter partes* reexamination proceeding.
9. On November 5, 2009, third party requester filed an opposition petition to patent owner's October 6, 2009 petition to prevent merger. Concurrently, third party Requester filed an opposition to Patent Owner's October 6, 2009 petition to suspend.
10. On December 11, 2009 the Office issued a decision dismissing patent owner's October 6, 2009 petition to prevent merger and merged the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings ("the merged proceeding").
11. Also on December 11, 2009, the Office issued a decision dismissing patent owner's October 6, 2009 petition to suspend the '1188 *inter partes* reexamination proceeding.
12. On December 18, 2009, the Office issued a first Office action on the merits in the merged proceeding.
13. On January 19, 2010, patent owner filed a petition requesting reconsideration of the

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<sup>1</sup> There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties.

- December 11, 2009 decision dismissing patent owner's October 6, 2009 petition and merging the '1188 *inter partes* and '10537 *ex parte* reexamination proceedings.
14. On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 11, 2009 decision.
  15. On March 17, 2010, patent owner timely filed a response to the December 17, 2009 Office action.<sup>2</sup>
  16. On April 16, 2010, third party requester timely filed comments after the response.
  17. On July 7, 2010, the Office issued a decision dissolving the merger of the '1188 and the '10537 proceedings.
  18. On July 13, 2010, third party requester filed the present petition, requesting reconsideration of the July 7, 2010 decision.
  19. On August 6, 2010, the Office issued a non-final Office action in the '1188 proceeding.
  20. On August 12, 2010, the Office issued a Notice of an Intent to Issue a Reexamination Certificate (NIRC) in the '10537 proceeding.
  21. On October 6, 2010, patent owner timely filed a response to the August 6, 2010 Office action.
  22. On November 5, 2010, third party requester timely filed comments after the response.
  23. On November 24, 2010, the Office issued an Action Closing Prosecution (ACP) in the '1188 proceeding.
  24. On November 30, 2010, the Office issued an *Ex Parte* Reexamination Certificate (7896<sup>th</sup>) for US Patent No. 6,304,937 C1 the '10537 proceeding. The certificate stated that the '1188 proceeding was still pending with respect to the '937 patent.
  25. On December 27, 2010, patent owner timely filed a response to the November 24, 2010 ACP.<sup>3</sup>

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<sup>2</sup> On January 21, 2010, the Office granted patent owner a one month extension of time.

<sup>3</sup> December 24, 2010 was a federal holiday and December 25-26, 2010 was a weekend, hence due date for the response was December 27, 2010, the next business day in accordance with 37 CFR 1.7(a).

## DECISION

### I. Issues Raised and Relief Requested

Third party requester contends that the Office's July 7, 2010 decision is: (1) Arbitrary, Capricious and an Abuse of Discretion; (2) A violation of Third Party Requester's Appeal Rights; (3) Impermissible Substantive Rule Making; (4) Contrary to Public and Office policy; and (5) Contrary to Special Dispatch.

Third party requester requests the relief of vacatur of the July 7, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

### II. Discussion of Previous Petitions and Decisions

#### a. The October 6, 2009 Patent Owner Petition and December 11, 2009 Office Decision

In the original petition challenging merger, patent owner asserted that: (1) Requester's reexamination filing pattern constituted harassment and a gaming of the system that frustrates the Office's statutory mandate of special dispatch; (2) Merger of *ex parte* and *inter partes* reexamination proceedings frustrates the statutory mandate of special dispatch; (3) Merger of co-pending *ex parte* and *inter partes* reexamination proceedings filed by the same third party requester violates the statutory prohibition against the filing of a second *inter partes* reexamination request on the same patent by the same requester before the first *inter partes* reexamination proceeding concludes; and (4) Merger of *ex parte* and *inter partes* reexamination proceedings denies patent owner the right to conduct an interview regarding the issues raised in the *ex parte* reexamination proceeding.

The Office issued a decision on December 11, 2009, dismissing patent owner's original petition. That decision pointed out that patent owner produced no evidence that the requester's filing of two requests for reexamination on consecutive days were filed with an "intent to harass" and that the finding of a substantial new question of patentability in each request precluded a finding of harassment. Merger of the present concurrent *ex parte* and *inter partes* reexamination proceedings was done as an initial attempt to further special dispatch, as both proceedings were at an early stage and did not, at that time, appear to *per se* frustrate special dispatch as compared to patent owner's suggested alternatives for handling the proceedings. The decision pointed out that the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding. Furthermore, the decision noted that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the

member of the public is the requester in an *inter partes* proceeding for the same patent. Finally, the decision noted that no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist. Accordingly, the decision identified that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

**b. The January 19, 2010 Patent Owner Petition, January 29, 2010 Requester Opposition, and July 7, 2010 Office Decision**

On January 19, 2010, patent owner filed a petition requesting reconsideration of the December 11, 2009 decision refusing to dissolve the merger. Patent owner asserted in the January 19, 2010 petition: (1) The Office's manner of merging *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. §§ 1.555 (g) and 1.989(b) when the two proceedings have a common requester; (2) The current merger of *ex parte* and *inter partes* reexamination proceedings violates the statutory prohibition of *ex parte* requester participation and must either be modified or dissolved to remove the violation and facilitate the statutory mandate of special dispatch; (3) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (4) Requester's filing of multiple voluminous requests for reexamination on the same patent, and upon related patents, on consecutive days, constitutes a harassment of patent owner.

On January 29, 2010, third party requester filed an opposition to patent owner's January 19, 2010 petition requesting reconsideration of the December 11, 2009 decision. The requester argued (1) Merger of the reexamination proceedings was proper and in accordance with statute and policy; (2) An *ex parte* requester that is also an *inter partes* requester in a merged proceeding is subject to the estoppel provisions of 35 U.S.C. 315(c) as to the *ex parte* issues; (3) Waiver of 37 CFR 1.989(b) should not be granted as no interview right exists; and (4) No intent to harass exists.

On July 7, 2010, the Office issued a decision granting patent owner's January 19, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

**III. Findings and Analysis**

**a. The July 7, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion**

Requester, citing Office's Federal Register rulemaking commentary,<sup>4</sup> argues that the July 7,

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<sup>4</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

The July 7, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy commentary is based upon.<sup>5</sup> The present circumstance involves the same third party requester filing on consecutive days an *inter partes* reexamination proceeding and an *ex parte* reexamination proceeding on the same patent. The cited comment by requester in the July 13, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was already ordered and under active examination and a requester had discovered relevant information that could not be admitted via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. As pointed out, both reexamination requests under consideration *were filed on consecutive days*. Under such circumstances, the requester was not precluded from filing another *inter partes* reexamination request on day after requester filed the '1188 *inter partes* reexamination request (or even shortly thereafter). More significantly, requester could have filed a single *inter partes* request on that date including all the SNQs and proposed rejections contained in the two separate requests filed on that date. If requester wanted full *inter partes* rights for the issues raised in the *ex parte* proceeding, then requester should have filed either: (1) A single *inter partes* request with all issues; or (2) A second *inter partes* request raising the issues presented in the *ex parte* request. Requester could have either concurrently filed two *inter partes* requests or filed the second request before the '1188 *inter partes* request was ordered. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon the merger of two different types of proceedings as a vehicle to obtain *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>6</sup> 37 CFR 1.989(a),<sup>7</sup> MPEP 2686.01 I,<sup>8</sup> MPEP 2686.01 IV,<sup>9</sup> MPEP 2283,<sup>10</sup> and MPEP 2286.<sup>11</sup> See also "Revisions

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<sup>5</sup> Id.

<sup>6</sup> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

<sup>7</sup> "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).

<sup>8</sup> "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.'"

<sup>9</sup> "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."

and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the *ex parte* reexamination request, which does not provide a requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights beyond what an *ex parte* request would accord, and therefore now has no basis to complain.

Requester’s citation to *inter partes* reexamination proceeding 95/000,050 (the ’50 proceeding) in support of requester’s position, fails to acknowledge the significant differences between the ’50 proceeding and the present proceeding. In the ’50 proceeding, the request for *inter partes* reexamination antedated the filing of the 90/007,885 *ex parte* request (the ’7885 proceeding) by over a year. Thus the circumstances of the ’50 proceeding in terms of prosecution stage, unlike the circumstances of the present proceeding, were in accord with Office policy and procedure commented upon with regard to 37 CFR 1.948. Furthermore, the ’7885 proceeding was filed by the patent owner and not by the same third party requester (as in the present instance). Significant prosecution had taken place in the ’50 proceeding and unlike a third party requester, a patent owner in an *inter partes* proceeding, was not bound by 37 CFR 1.948 in order to submit relevant prior art into the *inter partes* proceeding. The facts and circumstances of the ’50 proceeding differ significantly from the facts and circumstances of the present proceeding. Therefore the ’50 proceeding cannot serve as a basis to establish that the Office has acted in an arbitrary and capricious manner. If anything, the contrast of the present proceedings with the cited ’50 proceeding illustrates how unforeseeable, disparate sets of circumstances can arise with regard to merger, thus bolstering the soundness of the policy of giving the Office sole discretion to merge, not-merge or demerge on a case-by-case basis.

#### **b. The July 7, 2010 Office decision is not a violation of Requester’s Appeal Rights**

The requester asserts that the July 7, 2010 dissolution decision somehow alters requester’s substantive appeal rights.

The dissolution decision does not alter the requester’s appeal rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status*

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<sup>10</sup> “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.’”

<sup>11</sup> “[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.’”

*quo* of requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's appeal rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. Even after merger, the third party requester had no expectation of any *inter partes* appeal rights as to the *ex parte* request issues. As pointed out in MPEP 2674, "[a] notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested." Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi): "No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection."

In any event, if third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have filed a second *inter partes* request raising the issues presented, instead of filing an *ex parte* request. In this instance, the filing of a second *inter partes* request was clearly permissible under the statute. The *ex parte* proceeding request was filed prior to the issue of an order for reexamination in the *inter partes* reexamination; thus, a second *inter partes* request could have been filed instead of the *ex parte* request, and it should have been filed if requester desired *inter partes* reexamination treatment for the proposed rejections. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation.

Requester states the examiner has cited prior art that was not in the original request and that removal of party comments has removed from the record the basis for why the examiner has made changes in position regarding the issues of patentability from when the proceedings were merged to when they were demerged.

Regarding the first issue, it is noted that the examiner did not provide additional prior art references to serve as a basis for a rejection of the claims. The examiner did cite one reference that was not in the original request, U.S. 4,338,569 to Petrich.<sup>12</sup> The examiner cited the Petrich reference as evidence as part of a rationale to establishment support for the teaching of a "Delay Locked Loop" in the application-specification disclosure. The examiner provided this same reference and rationale for the same purpose during the merged proceeding. Therefore, no

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<sup>12</sup> August 6, 2010 Office action at pages 12-17

inconsistency exists in the record between the merged proceeding and the present proceeding with regard to the citation and usage of art. Accordingly, no requester right could be derogated with regard to inconsistent citation and usage of art, as no such inconsistency in citation and usage has occurred between the merged and present proceeding.

#### CORRECTION OF THE PRESENT RECORD:

In regard to the asserted absence of a full and proper rationale for any changes in examiner position as to issue of patentability between the present proceeding during the period that it was merged (with the '10537 proceeding) and action on the present proceeding after the merger was severed, petitioner requester has identified a matter in the record that is asserted to need clarification. The matter identified is an asserted inconsistency with regard to changes in the examiner's positions on issues of patentability raised in *inter partes* request between the present proceeding during the period that it was merged (with the '10537 proceeding) and action on the present proceeding after the merger was severed.

After the July 7, 2010 merger dissolution decision, the examiner issued a NIRC in the '10537 *ex parte* reexamination proceeding confirming all the claims and issued a non-final action in the '1188 *inter partes* reexamination proceeding. The confirmation of the claims in the '10537 *ex parte* proceeding's NIRC was solely based upon issues of patentability raised in the *ex parte* request for reexamination. In the '1188 *inter partes* proceeding's August 6, 2010 Office action the examiner took positions (of adopting, adopting-as-modified, and not adopting) with respect to each of the eighty-three different issues of patentability raised by third party requester in the *inter partes* request for reexamination of the '937 patent. However, the examiner's positions (of adopting, adopting-as-modified and non-adopting) on some of the eighty-three different issues of patentability in the August 6, 2010 Office action differed from the positions the examiner took during the period the proceedings were merged. Thus, the examiner's rationale for the changes in position taken on several issues of patentability between the merged proceeding and the present proceeding are not fully developed on the record. Therefore a need for clarification of the examiner's changes in position exists to provide a complete and comprehensive record.

Accordingly, the examiner of record is directed to supplement the record in the '1188 proceeding by reissuing the ACP. The reissued ACP should provide a rationale for each change in position that occurred regarding an issue of patentability raised in the *inter partes* reexamination request between the present proceeding during the period that it was merged (with the '10537 proceeding) and action on the present proceeding after the merger was severed. This is to be done without reference to any paper that is not of record.

#### **c. The July 7, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. *Requester's counsel has explicitly recognized the Office's authority and discretion extending to demerge in accordance with special dispatch in previous proceedings.*<sup>13</sup> Additionally, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the administrative act of a consolidation of cases does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before the issuance of the merger and dissolution of the merger decisions.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>14</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

#### **d. The July 7, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

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<sup>13</sup> See e.g. Petition to Demerge 95/000283 and 90/008,170 filed August 16, 2008.

<sup>14</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decisions on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. The '10537 proceeding has advanced to issuance of a reexamination certificate and the '1188 proceeding has advanced to ACP. Issuance of a new ACP in the '1188 proceeding, correcting the record therefore best serves special dispatch. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the July 7, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As the '1188 proceeding has advanced to ACP and a reexamination certificate has issued in the '10537 proceeding, special dispatch would not be served by remerging the proceedings and re-opening prosecution back to the point in prosecution just prior to the initial merger of the proceedings.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merge. Regarding previous Office decisions, to include the '50 *inter partes* reexamination proceeding cited by requester, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>15</sup> Furthermore, as noted in section III a. of this decision, the facts and circumstances of the '50 proceeding significantly differ from the facts and circumstances of the present proceeding. In the present instance, as noted in the July 7, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The July 7, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Policy considerations that requester asserts

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<sup>15</sup> See MPEP 2686.01 IV.

dictate that merger must occur when multiple, co-pending proceedings on the same patent exist.

In response, the July 7, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the July 7, 2010 dissolution decision is in accord with and not contrary to public policy, as the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings on consecutive days for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Requester asked for separate proceedings for separate issues of patentability on the same patent. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The July 7, 2010 dissolution decision, the MPEP, and Office practice and procedure provides a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.<sup>16</sup> As of November 30, 2010 a certificate has issued in the '10537 proceeding containing an appropriate notice regarding the existence of an outstanding reexamination proceeding.<sup>17</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The July 7, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte*

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<sup>16</sup> See the July 7, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See e.g. *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>17</sup> *Ex Parte* Reexamination Certificate (7896<sup>th</sup>) No. 6304937 C1, right column notice under the abstract.

requests for reexamination to achieve merger.<sup>18</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### IV. Summation

Accordingly, for all the reasons stated above requester's petition to reconsider the July 7, 2010 Office decision is dismissed. Despite the requests the Office issue a final agency action, this decision is not made final, as the examiner of record is being directed to correct the record by issuing an appropriate Office action explaining all changes in position regarding issues of patentability appropriate for the '1188 proceeding. The record is being correct to preserve all party participation rights, to thereby address the requester petition.

#### CONCLUSION

1. The petition is **dismissed**.
2. The examiner is directed to supplement the record by providing the rationale discussed above in part III.B. of this decision. This is to be carried out by reissuing the November 24, 2010 Action Closing Prosecution (ACP) in the '1188 proceeding, with the supplemental information.
3. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

1-7-11  
kenpetmerger/reexreex/...

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<sup>18</sup> See Petition at page 9, section C.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,188	05/12/2009	6304937	9278.002.937	2299
86497	7590	01/06/2012	EXAMINER	
Paul M. Anderson, PLLC P.O. Box 160006 Austin, TX 78716			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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NVIDIA Corp.  
*Third Party Requester*

v.

Rambus Inc.  
*Patent Owner*

---

*Inter partes* Reexamination Control 95/001,188  
Patent 6,304,937 B1

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DECISION ON PETITION

This is a decision on:

1. “Third Party Requester’s Petition Under 37 C.F.R. § 1.183 for Limited Waiver of 37 C.F.R. § 1.943(c),” filed November 23, 2011. (“Appellant Brief Petition”). The Appellant Brief Petition requests that NVIDIA be permitted to “submit a Cross-Appeal Brief up to 16,390 words or 40 pages.” Appellant Brief Petition, 1; and
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 November 28, 2011. (“Respondent Brief Petition”). The Respondent Brief Petition requests that

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*Inter partes* Reexamination Control 95/001,188  
Patent 6,304,937 B1

NVIDIA be permitted to “submit a Respondent Brief up to 7,591 words or 19 pages.” Respondent Brief Petition, 1.

#### FINDINGS

1. On October 16, 2001, the Office issued Patent 6,304,937 (“’937 patent”), which presently is assigned to Rambus Inc. (“Rambus”).
2. On May 12, 2009, Third Party Requester NVIDIA Corp. (“NVIDIA”) filed a request for *inter partes* reexamination of the ‘937 patent.
3. On July 7, 2009, the Office granted NVIDIA’s request and ordered reexamination, finding a substantial new question of patentability affecting claims 1-40 of the ‘937 patent, and assigned reexamination control proceeding 95/001,188.
4. The proceeding progressed to a point where, on August 26, 2011, the Office issued a Right of Appeal Notice (RAN), rejecting claims 1-3, 8, 10-16, 18, 23-30, 36-38 and 40, and confirming claims 4-7, 9, 17, 19-22, 31-35 and 39. The RAN is 197 pages in length.
5. On October 28, 2011, Rambus filed Patent Owner’s Appeal Brief (Appellant Brief).
6. On November 23, 2011, NVIDIA filed Third Party Requester’s Cross-Appeal Brief (Appellant Brief) having 40 countable pages and 16,390 countable words.
7. On November 28, 2011, NVIDIA filed Third Party Requester’s Respondent Brief (Respondent Brief) having 19 countable pages and 7,591 countable words.

## RELEVANT LEGAL AUTHORITY

With respect to the length of briefs filed in *inter partes* reexamination appeals, 37 C.F.R. § 1.943(c) specifies that:

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

With respect to waiver of the rules, 37 C.F.R. § 1.183 provides:

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

## ANALYSIS

### *NVIDIA's Appellant Brief*

In the Appellant Brief Petition, NVIDIA seeks a waiver of the page/word limits of 37 C.F.R. § 1.943(c) for its Appellant Brief having 40 countable pages and 16,390 countable words. The Appellant Brief presents arguments urging the non-patentability of 40 claims based on combinations of 16 prior art references, and a further argument of non-entitlement to a particular filing date. For many claims, the Appellant Brief presents multiple rejections, e.g., at least six rejections are presented for claim 17. Appellant Brief, 16, 18, 19, 24, 39, 40.

37 C.F.R. § 1.943(c) compels a party to economize in its presentations even when it might wish to present many cumulative and lengthy arguments.

*Inter partes* Reexamination Control 95/001,188  
Patent 6,304,937 B1

Thus, a party must limit its presentations to no more pages than allowed under the Rule unless it can demonstrate that a truly extraordinary situation exists. Here NVIDIA has not demonstrated that any such circumstance exists. The number of claims and rejections proposed by NVIDIA do not themselves create an extraordinary situation.

*NVIDIA'S Respondent Brief*

In the Respondent Brief Petition, NVIDIA seeks a waiver of the page/word limits of 37 C.F.R. § 1.943(c) for its Respondent's Brief having 19 countable pages and 7,591 countable words. The Respondent Brief addresses two grounds of rejection, including, e.g., seven pages of argument on "Response to 'The Claimed Memory Device Is a Chip.'" Respondent Brief, 3-10. Unnecessarily lengthy arguments do not constitute an extraordinary situation for which justice requires waiver of Rule 1.943(c) for the Respondent Brief.

DECISION

In view of the foregoing:

1. NVIDIA'S Appellant Brief Petition is DENIED; and
2. NVIDIA'S Respondent Brief Petition is DENIED.

NVIDIA is given one month from the date hereof to submit an appellant brief and a respondent brief in compliance with 37 C.F.R. § 1.943(c).



James Donald Smith  
Chief Administrative Patent Judge

*Inter partes* Reexamination Control 95/001,188  
Patent 6,304,937 B1

Attorney for Third Party Requester:

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Attorney for Patent Owner:

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nlk



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,189	05/18/2009	7287119	2805.002REX8	8867

26111 7590 09/08/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/08/2010

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CENTRAL REEXAMINATION UNIT

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

HAYNES & BOONE, LLP IP SECTION :  
2322 VICTORY AVENUE : (For *inter partes* Requester)  
SUITE &)) :  
DALLAS, TX 75219 :

*In re* Barth *et al.* : DECISION DISMISSING  
*Inter partes* Reexamination Proceeding : PETITION FOR EXTENSION  
Control No.: 95/001189 : OF TIME  
Filed: May 18, 2009 : [37 CFR § 1.956]

This is a decision on the September 1, 2010 patent owner "Petition for an Extension of Time Pursuant to 37 CFR § 1.956," requesting that the time for responding to the Office action mailed August 9, 2010 to be extended by one-month.

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

The petition is Dismissed for the reasons set forth below.

**Statement of Relevant Facts**

1. On May 18, 2009 a request was deposited for *inter partes* reexamination with the Office requesting all claims (claims 1 – 23) of US Patent 7,287, 119 (the '119 patent) be reexamined. The request was assigned Control No. 95/001,189. The '119 patent claims 21 and 22 were subject to reexamination in *ex parte* proceeding 90/010,365 when the *inter partes* request was filed.
2. On August 3, 2009 the Office issued an order granting the '1189 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that claims 1 – 23 (all claims of the patent) would be subject to reexamination.
3. On October 2, 2009, the Office, *sua sponte* issued a decision merging the '1189 *inter partes* reexamination proceeding with the 90/010,365 *ex parte* reexamination proceeding (the merged proceeding).

4. On October 21, 2009, patent owner filed a petition requesting reconsideration of the merger of the ' 10365 *ex parte* proceeding, with the ' 1189 *inter partes* proceeding.
5. On November 14, 2009, the Office issued a first Office action on the merits in the merged proceeding, setting a two month period for response.
6. Patent owner requested a two month extension of time on December 7, 2009 to respond to the merged office action on the merits. A one month extension was granted on December 11, 2009.
7. On December 16, 2009 the Office issued a decision dismissing patent owner's October 21, 2009 petition requesting reconsideration of the October 2, 2009 decision to merge the ' 1189 *inter partes* and ' 10365 *ex parte* reexamination proceedings.
8. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 16, 2009 decision.
9. On February 16, 2010, patent owner timely filed responsive comments to the November 14, 2009 Office action, to include an amendment to some of the claims.
10. On March 17, 2010, third party requester timely filed responsive comments.
11. On June 23, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.
12. On June 28, 2010 the Office granted owners requested relief and dissolved the merger of the '1189 *inter partes* proceeding and the '10365 *ex parte* proceeding.
13. On August 9, 2010 the Office issued a non final rejection in the '1189 proceeding. The office action set a one month period for response.
14. On September 1, 2010 owner filed the instant petition requesting a one month extension of time in the '1189 proceeding.

### Discussion

The Patent Owner requested a one (1) month extension of time on September 1, 2010 in which to file a response to the non-final Office action was mailed August 9, 2010. The non-final Office action provided a one (1) month period for response. The petition request included payment for the \$200 petition fee under 37 CFR §1.17 (g). This is the second request for reconsideration for the extension of time in this *inter partes* proceeding.

*37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination. The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

*petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of “sufficient cause” to grant an extension request, MPEP § 2665 states, in pertinent part:

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...

Evaluation of whether “sufficient cause” has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

### **Decision**

In the petition patent owner’s representative requests a one-month extension of time to (i) perfect the patent owner’s declaration under 37 CFR 1.131, (ii) fully respond to newly adopted rejections over the JEDEC reference (iii) because patent owner has three other responses to office actions in other related cases due on the same day.

In further support of the request for additional time, patent owner’s representative submits 1) patent owner requires additional time to further investigate the details behind its actual reduction to practice, 2) patent owner may seek additional declaratory evidence pursuant to 37 CFR 1.132 and 3) patent owner has seven additional responses due in related proceedings that will benefit from additional time being granted in the instant proceeding.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner’s representative has conducted various ‘reviews’. The outlined behavior includes reviewing the outstanding office action and making a contact regarding further investigation and preparing responses and perfecting declarations for other related reexamination proceedings. See page 7 of the petition for details.

With respect to point 1) it must be noted that the review of the record reveals the failings of the proffered 37 CFR 1.131 declaration as outlined in the August 9, 2010 office action are not new to patent owner. While the decision dissolving merger of June 28, 2010 does vacate the prior office actions and responses, it does not erase the record. Patent owner has been fairly noticed in the prior first office action and in the prior action closing prosecution of the merged proceeding as to the Office position regarding the submitted evidence. No explanation is offered in the instant petition as

to why the required "additional investigations" are needed presently when they were not needed prior, or why they were not earlier conducted in as much as the same rejections were set forth in the prior Office actions. The issues regarding the evidence have been fairly notice to patent owner for over ten months while the only diligent behavior directed to this point discussed in the petition is establishing an initial contact regarding further investigations.

As to point 2), similarly the petition fails to address why at this point in time new evidence is under consideration for presentation. That the proposed declarant had limited availability during the month of August does not address why the declarations are necessary at this time.

Finally with respect to point 3) the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Absent sufficient cause, the mere number of related proceedings fails to override the requirement of the statute.

The petition fails to demonstrate sufficient cause to warrant the requested extension of time. It is further noted prosecution of the instant *inter partes* reexamination proceeding has been pending over one year and the underlying patent is subject to concurrent litigation. Even a modest extension of one month at this point in the proceeding, absent sufficient cause, would impact the mandate for special dispatch.

On balance, it does not appear patent owners reasoning as to why additional time is needed, in light of the review actions taken thus far outweigh the need for special dispatch given the prolonged prosecution in the instant proceeding. Sufficient cause has not been shown. Therefore, the request fails to meet the requirements as outlined in MPEP 2665 for granting of a request for extension of time under 37 CFR 1.956.

The petition for extension of time is hereby dismissed.

### Conclusion

1. The Patent Owner's petition for reconsideration of the extension of time filed on September 1, 2010 is dismissed.
2. The period for response is not extended beyond the shortened statutory period for response of one (1) month as recited in the outstanding Office action mailed August 9, 2010.
3. All correspondence involving this proceeding may be addressed to the following:

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

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

By Hand: Customer Service Window  
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Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are “soft scanned” (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the “soft scanning” process is complete.

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

/J. Harrison/

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J. Harrison  
Supervisory Patent Examiner AU 3992  
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,189	05/18/2009	7287119	2805.002REX8	8867
26111	7590	01/06/2011	EXAMINER	
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,365	12/18/2008	7287119	2805.002REX4	6415
26111	7590	01/06/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

Date: **MAILED**  
**JAN 06 2011**  
**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001189  
PATENT NO. : 7287119  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
ORRICK, HERRINGTON, & SUTCLIFFE, LLP  
IP PROSECUTION DEPT.  
4 Park Plaza, Suite 1600  
Irvine, CA 92614-2558

Date: **MAILED**

**JAN 06 2011**

CENTRAL REEXAMINATION UNIT

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90010365  
PATENT NO. : 7287119  
ART UNIT : 3992

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

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

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(For Patent Owner)

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(For *inter partes* Requester)

CENTRAL EXAMINATION UNIT

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(For *ex parte* Requester)

*In re Barth et al.*  
*Inter partes* Reexamination Proceeding  
Control No.: 95/001,189  
Filed: May 18, 2009  
For: U.S. Patent No. 7,287,119

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: DECISION  
: ON  
: PETITION

*In re Barth et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/010,365  
Filed: December 18, 2008  
For: U.S. Patent No. 7,287,119

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This is a decision on third party requester's July 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on July 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The June 28, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On October 23, 2007, the Office issued U.S. Patent No. 7,287,119 (the '119 patent) to Barth *et al.*
2. The '119 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-23 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 18, 2008, a request for *ex parte* reexamination of claims 21 and 22 of the '119 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/010,365 (the '10365 proceeding).<sup>1</sup>
5. On February 20, 2009, the Office issued an order granting the '10365 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 21 and 22 of the '119 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '10365 *ex parte* reexamination proceeding expired on April 20, 2009.<sup>2</sup>
7. On April 29, 2009, the Office issued a first Office action on the merits in the '10365 *ex parte* reexamination proceeding.
8. On May 18, 2009, a request for *inter partes* reexamination of all the claims (claims 1-23) of the '119 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,189 (the '1189 proceeding).<sup>3</sup>
9. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '119 patent. Therefore, the present '119 patent is no longer involved in the ITC investigation.
10. On July 29, 2009, patent owner filed a response in the '10365 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.<sup>4</sup>
11. On August 3, 2009, the Office issued an order granting the '1189 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '119 patent, claims 1-23, would be subject to reexamination.
12. On August 23, 2009, patent owner filed a supplemental response in the '10365 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
13. On October 2, 2009, the Office, *sua sponte*, issued a decision merging the '1189 *inter*

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<sup>1</sup> The request cited and used a single reference to Gillingham as a basis for requesting reexamination on two claims, the Gillingham reference claimed benefit to U.S. provisional applications to Gillingham, Ryan et al. and Gustavson et al. under 35 U.S.C. 119(e). Requester cited these U.S. provisional applications in the request.

<sup>2</sup> There is no provision for filing a patent owner's statement in an *inter partes* reexamination proceeding; instead, an Office action on the merits is issued prior to any input from the parties (other than that of the request).

<sup>3</sup> The *inter partes* reexamination request used the same Gillingham reference as in the '10365 proceeding, but in a more expansive manner against more of the claims in the '119 patent as a basis for requesting reexamination.

<sup>4</sup> Patent owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

- partes* reexamination proceeding with the ‘10365 *ex parte* reexamination proceeding (the merged proceeding).
14. On October 21, 2009, patent owner filed a petition requesting reconsideration of the merger of the ‘10365 *ex parte* proceeding with the ‘1189 *inter partes* proceeding.
  15. On November 14, 2009, the Office issued a first Office action on the merits in the merged proceeding.
  16. On December 16, 2009 the Office issued a decision dismissing patent owner’s October 21, 2009 petition requesting reconsideration of the October 2, 2009 decision to merge the ‘1189 *inter partes* and ‘10365 *ex parte* reexamination proceedings.
  17. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office’s December 16, 2009 decision.
  18. On February 16, 2010, patent owner timely filed a response to the November 14, 2009 Office action, including amendments to the claims.<sup>5</sup>
  19. On March 17, 2010, third party requester timely filed comments after the patent owner response.
  20. On June 23, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding.
  21. On June 28, 2010, the Office issued a decision dissolving the merger of the ‘1189 and the ‘10365 proceedings.
  22. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.
  23. On August 9, 2010, the Office issued a non-final Office Action in the ‘1189 proceeding.
  24. Also on August 9, 2010, the Office issued a final Office Action in the ‘10365 proceeding.
  25. On September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the ‘1189 proceeding.

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<sup>5</sup> Patent Owner petitioned for a two month extension of time and was granted a one month extension of time to respond to the November 14, 2009 Office action. The due date of February 14, 2010 was a Sunday and February 15, 2010 was a federal holiday, giving patent owner until February 16, 2010 to file a response. See 37 CFR 1.7(a).

26. Also on September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '10365 proceeding.
27. On October 8, 2010, third party requester timely filed its comments in the '1189 proceeding.

## DECISION

### I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the June 28, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

### II. Discussion of Previous Petitions and Decisions

#### a. The October 21, 2009 Patent Owner Petition and December 16, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "*ex parte* reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No "*ex parte*

right” was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party’s rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

**b. The February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision**

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 16, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner’s previous petition. Patent owner’s February 5, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner’s previous petition.

On June 28, 2010, the Office issued a decision granting patent owner’s February 5, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

**III. Findings and Analysis**

**a. The June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion**

Requester cites to an Office Federal Register rulemaking preamble comment<sup>6</sup> and argues that the June 28, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

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<sup>6</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

In response:

The June 28, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>7</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '119 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the July 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>8</sup>

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '119 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '119 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

- 1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.
- 2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully

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<sup>7</sup> Id.

<sup>8</sup> See MPEP 2686.01 IV.

developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>9</sup> 37 CFR 1.989(a),<sup>10</sup> MPEP 2686.01 I,<sup>11</sup> MPEP 2686.01 IV,<sup>12</sup> MPEP 2283,<sup>13</sup> and MPEP 2286.<sup>14</sup> See also “Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

#### **b. The June 28, 2010 Office decision is not a violation of Requester’s Rights**

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

The dissolution decision does not alter the requester’s rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of

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<sup>9</sup> “If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. . . .” (Emphasis added).

<sup>10</sup> “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).

<sup>11</sup> “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.’”

<sup>12</sup> “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.”

<sup>13</sup> “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.’”

<sup>14</sup> “[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with ‘special dispatch.’”

requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

### **c. The June 28, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would

also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>15</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

#### **d. The June 28, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 28, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>16</sup> In the present instance, as noted in

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<sup>15</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

<sup>16</sup> See MPEP 2686.01 IV.

the June 28, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The June 28, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a "quick" request, simply to "get" something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The June 28, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged

pending Office proceedings on the same patent when a reexamination certificate issues.<sup>17</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 28, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>18</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### IV. Summation

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

#### CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.

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

1/5/11

<sup>17</sup> See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>18</sup> See Petition at page 9, section E.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,189	05/18/2009	7287119	2805.002REX8	8867
26111	7590	08/05/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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



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AUG 05 2011

CENTRAL REEXAMINATION

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

REEXAMINATION CONTROL NO. : 95001189  
PATENT NO. : 7287119  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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Sterne Kessler, Goldstein, & Fox, PLLC  
1100 New York Avenue, N.W.  
Washington, DC 20005

:  
: (For Patent Owner)  
:

MAILED

AUG 05 2011

Haynes & Boone, LLP IP Section  
2323 Victory Avenue  
Suite 700  
Dallas, TX 75219

:  
: (For Requester)  
: CENTRAL REEXAMINATION UNIT  
:

*In re Barth et al.*  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,189  
Filed: May 18, 2009  
For: U.S. Patent No.: 7,287,119

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

This is a decision on the June 3, 2011 third party requester petition entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.183 To Waive § 1.116(f) and Admit Evidence."

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

The petition is dismissed.

### PERTINENT BACKGROUND<sup>1</sup>

1. On May 18, 2009, a request for *inter partes* reexamination of all of the claims (claims 1-23) of U.S. Patent Number 7,287,119 to Barth *et al.* was filed by a third party requester. The real party in interest was identified as NVIDIA Corporation. This request was assigned Control No. 95/001,189 ("the '1189 proceeding").
2. On August 3, 2009, the Office issued an order granting the '1189 request for *inter partes* reexamination on claims 1-23.
3. Prosecution continued, until on April 22, 2011, the Office issued a right of appeal notice ("RAN").

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<sup>1</sup> See the reexamination file for the full history.



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AJG 042011

CENTRAL REEXAMINATION UNIT

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2323 Victory Avenue  
Suite 700  
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: (For Requester)  
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*In re Barth et al.*  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/0001,189  
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For: U.S. Patent No.: 7,287,119

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

The petition is **dismissed**.

**PERTINENT BACKGROUND<sup>1</sup>**

1. On May 18, 2009, a request for *inter partes* reexamination of all of the claims (claims 1-23) of U.S. Patent Number 7,287,119 to *Barth et al.* was filed by a third party requester. The real party in interest was identified as NVIDIA Corporation. This request was assigned Control No. 95/001,189 ("the '1189 proceeding").
2. On August 3, 2009, the Office issued an order granting the '1189 request for *inter partes* reexamination on claims 1-23.
3. Prosecution continued, until on April 22, 2011, the Office issued a right of appeal notice ("RAN").

<sup>1</sup> See the reexamination file for the full history.

4. On May 23, 2011, patent owner filed a notice of appeal and a petition entitled "Petition Under 37 CFR 1.183 to Waive § 1.116(f) and Admit Evidence."
5. On May 26, 2011, third party requester filed an notice of cross-appeal.
6. On June 3, 2011, third party requester filed the instant paper entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.183 To Waive § 1.116(f) and Admit Evidence."

### APPLICABLE RULE(S)

#### 37 C.F.R. § 1.183 provides:

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

### DECISION

The instant third party requester petition filed on June 3, 2011, to request that the Office deny patent owner's May 23, 2011 petition requesting waiver of the rules. Third party requester provides no authority for the entry of such a petition filed merely to oppose another party's petition to waive the rules. The present opposition petition is not provided for by statute or rule, and is being expunged as will now be explained.

The involvement of a third party requester in an *inter partes* reexamination proceeding is limited to that provided for by statute. Pursuant to 35 U.S.C. 314(b)(2), an *inter partes* reexamination proceeding shall be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133."

With respect to the June 3, 2011 third party requester paper opposing patent owner's May 23, 2011 petition under 37 C.F.R. § 1.183, neither the laws nor the regulations provide any right for the requester to file an opposition to, or comment on, a patent owner's petition to request waiver of the rules for the purpose of entering an evidence submission. A request for waiver of the rules governing entry of an evidence submission goes to an issue that is directed solely to formal requirements and is a matter within the jurisdiction and discretion of the Office.

Stated differently, the requester's submission is directed neither towards the merits of the initial examination nor towards the merits of the appeal, but is instead commenting on whether the Office should grant a petition for waiver of one of its rules. Such waiver is clearly a matter within the discretion of the USPTO Director, for which parties to the reexamination were not

granted a comment right by statute. There is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that either party was granted any right to challenge the granting of another party's petition that requests waiver of the rules for the purpose of entering an evidence submission. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress. In addition, entry and consideration of oppositions to such discretionary actions of the Office would not further the statutory mandate of special dispatch pursuant to 35 U.S.C. 314(c). Requester's opposition to patent owner's petition for waiver of the rules (for the purpose of entering an evidence submission) is therefore not enterable into the record.

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

Pursuant to 37 CFR 1.939(a), "[I]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned. For the reasons discussed above, the requester's opposition filed on June 3, 2011, to the patent owner's petition for waiver of the rules for the purpose of entering an evidence submission, does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the patent owner. Rather, the patent owner's petition will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

## CONCLUSION

1. The June 3, 2011 third party requester petition to oppose the granting of patent owner's May 23, 2011 petition is refused entry, as it is an improper paper. The opposition petition paper is not enterable into the record of the present reexamination proceeding, because such a submission is not authorized by the reexamination statute or the regulations promulgated under the statute.
2. Because the opposition petition paper was previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.
3. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or to the undersigned at (571) 272-7726.

*Pinchus M. Laufer*

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

August 3, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,189	05/18/2009	7287119	2805.002REX8	8867
26111	7590	08/16/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2011

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



4. On February 16, 2010, patent owner submitted a response to the first Office action of November 14, 2009, having numerous “exhibits” attached thereto, including “exhibit CD,” which is discussed in the instant petition.
5. On August 9, 2010, the Office issued a non-final Office action.<sup>3</sup>
6. On December 12, 2010, the Office issued an action closing prosecution (“ACP”).
7. On April 22, 2011, the Office issued a right of appeal notice (“RAN”).
8. On May 23, 2011, patent owner filed a notice of appeal and a petition entitled “Petition Under 37 CFR 1.183 to Waive § 1.116(f) and Admit Evidence,” the subject of the instant decision.

### APPLICABLE RULE(S)

#### 37 C.F.R. § 1.183 provides:

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

### DECISION

Patent owner petitions for waiver of the provision of rule 1.116(f) which states that “no affidavit or other evidence can be made in an *inter partes* reexamination after the right of appeal notice.” In the instant proceeding, the right of appeal notice (“RAN”) was issued on April 22, 2011. Patent owner petitions to enter a submission filed with the petition, on May 23, 2011, which submission includes evidence. The submission is barred under rule 1.116(f), and patent owner petitions for waiver of the relevant provisions of that rule.

Patent owner’s petition is submitted under § 1.183, which permits waiver of a rule, which is not a requirement of the statutes, in an “extraordinary situation, when justice requires” the requested relief. Relief may be granted, therefore, if the existence of an extraordinary situation such that justice requires relief can be found in the current instance.

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<sup>2</sup> Prior to this action, on October 2, 2009, the Office issued a decision merging the ‘1189 proceeding with *ex parte* reexamination no. 90/010,365.

<sup>3</sup> Prior to this action, on June 28, 2010, the Office issued a decision dissolving the merger with the ‘10365 proceeding.

Patent owner sets forth the following rationale for entry of the evidence submission: (1) to complete the file record, (2) to ensure consistency with other reexamination proceedings, (3) that there is no prejudice to third party requester, and (4) entry would not impact the Office's mandate for special dispatch.

With respect to these rationales, it is instructive to first explore the Office's balance between entering additional evidence after a RAN and ensuring a timely reexamination. This balance can be seen in the provisions of 37 C.F.R. § 1.116, which set forth the requirements for entry of amendments and evidence after close of prosecution in applications and reexaminations. Where an *inter partes* reexamination has proceeded to a post-ACP stage, entry of an evidence submission requires good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Where an *inter partes* reexamination has proceeded to a post-RAN stage, the Office permits no entry of an evidence submission, regardless whether the evidence is necessary and/or whether there are good and sufficient reasons why the evidence was not earlier presented.

With respect to petitioner's first rationale, ensuring completeness of the file record, the balance set forth in § 1.116 illustrates that entry of the proffered evidence is outweighed by administrability considerations where the proceeding has advanced past the RAN stage. If each new item of evidence proffered to accomplish what petitioner terms as completing the record, a reexamination proceeding could go on indefinitely to "add" information; but this is clearly contradictory to the Office's statutory mandate for special dispatch in resolution of the substantial new question of patentability raised in reexamination. Looking to the facts of this case, petitioner desires entry of the instant affidavit to "describe ... in more detail the content of Exhibit CD." Exhibit CD was submitted by the patent owner petitioner, who could have included the "more detail" at the point of submission. Furthermore, Exhibit CD was submitted on February 16, 2010. Since that submission, the Office has mailed actions on August 9, 2010 (non-final), December 21, 2010 (ACP), and April 22, 2011 (RAN), and petitioner has had ample time to submit the "more detail" within the dictates of the rules.

Patent owner could have entered the instant evidence submission as a matter of right at any point prior to the December 21, 2010 ACP; alternatively, patent owner could have entered the instant evidence submission upon a showing of good and sufficient reasons why the submission was necessary and not earlier presented at any point up to the issuance of the April 22, 2011 RAN. Such would not have required a revisiting of a RAN, which is a final Office action setting up appeal rights.

With respect to petitioner's second rationale - consistency between related reexamination proceedings - the petition alleges only that the evidence has been submitted in related proceedings, it has not been entered in any related proceedings. It is also noted that is noted that each proceeding is decided on its own merits, and even if the same evidence is entered in other proceedings, it does not necessitate entry of that same evidence in the instant proceeding. Petitioner's second rationale would lead to the conclusion that evidence can be entered at the appeal stage of the proceeding ready for decision after the matter has been briefed, simply

because such evidence was entered after a first Office action in a different proceeding; this is clearly untenable.

With respect to petitioner's third rationale - lack of prejudice to the third party requester - it is noted that it is not a persuasive argument to state that the actual delay is harmless. As stated in *Myers v. Feigelman*, 455 F.2d 586, 601, "the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules."<sup>4</sup> Moreover, the public and the third party requester would be damaged by virtue of the delay in resolution of the substantial new question of patentability raised in the reexamination request.

With respect to petitioner's fourth and final rationale - impact on the Office's mandate for special dispatch - this is duly noted. However, the default balance between entry of evidence and administrability of Office reexamination proceedings, as discussed above, disfavors entry of evidence submissions after issuance of a RAN. Further, the impact on the Office's mandate for special dispatch has been discussed above in this decision.

Having weighed all of the facts and circumstances pertinent to the petition, third party requester has failed to establish the existence of an extraordinary circumstance such that justice requires entry of the evidence submission filed with the petition. For that reason, relief may not be provided under § 1.183, and third party requester's May 23, 2011 petition under § 1.183 is **dismissed**.

## CONCLUSION

- The petition is **dismissed**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.

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<sup>4</sup> *Myers v. Feigelman*, 455 F.2d 586, 601, 172 USPQ 580, 584 (CCPA 1972). *Accord B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d at 1908 (stating "the mistake was the result of counsel's failure to review the rule. Similarly rejected is petitioner's argument that the lack of substantive injury or harm to respondent is a basis for granting an extension of time. As indicated in *In re Sivertz*, *supra*, 227 USPQ at 256, lack of injury to another party or to the public is not recognized as a sufficient basis for waiving provisions of the rules. "To do otherwise would defeat the purpose of the rule." *Id.*")

- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



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

August 17, 2011  
Kenfinal rej+ACP -after it/...



UNITED STATES PATENT AND TRADEMARK OFFICE

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JOHN S. PRATT, ESQ  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA GA 30309

(For Patent Owner)

MAILED

AUG 01 2011

CENTRAL REEXAMINATION UNIT

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

(For Requester)

*In re: Vollmer et alia*  
Reexamination Proceeding  
Control No. 95/001,192  
Request Deposited: May 28, 2009  
For: U.S. Patent No. 6,879,830

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

This is a decision on the December 14, 2009 paper entitled "UNDER 37 C.F.R. § 1.182 PETITION TO STRIKE IMPROPER ARGUMENT IN THIRD PARTY REQUESTOR'S COMMENTS".

Petitioner requests the Office strike portions of the October 21, 2009 comments. However, the Notifications of Defective Papers mailed December 18, 2009 and March 2, 2010 mooted the October 21, 2009 comments and the subsequent Action Closing Prosecution of September 20, 2010 treated the response of April 1, 2010 and the third-party comments of April 29, 2010. Therefore, petitioner's requested relief is **dismissed as moot**.

**CONCLUSION**

1. Petitioner's request is **dismissed as moot**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Control Number: 95/001,192

Page 2

Art Unit: 3992

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

A handwritten signature in cursive script, appearing to read "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,193	05/28/2009	7043751	60851-379769	1919

23370            7590            10/19/2010  
JOHN S. PRATT, ESQ  
KILPATRICK STOCKTON, LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER

ART UNIT            PAPER NUMBER

DATE MAILED: 10/19/2010

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
PERKINS COIE LLP  
PATENT - SEA  
P.O. BOX 1247  
SEATTLE, WA 98111-1247

Date:

**MAILED**

**OCT 19 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001193  
PATENT NO. : 7043751  
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

Date:

JEFFREY E. YOUNG

ALSTON & BIRD, LLP

101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

**MAILED**

**OCT 19 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001193

PATENT NO. : 7043751

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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**OCT 19 2010**

JOHN S. PRATT, ESQ  
KILPATRICK STOCKTON, LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA GA 30309

**CENTRAL REEXAMINATION UNIT**  
(For Patent Owner)

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

(For Third Party Requester)

JEFFREY E. YOUNG  
ALSTON & BIRD, LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET  
SUITE 4000  
CHARLOTTE, NC 28280-4000

(For Petitioner)

*In re Fisher et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,193  
Filed: May 28, 2009  
For: U.S. Patent No. 7,043,751

: **DECISION**  
: **DISMISSING PETITIONS**  
: **UNDER § 1.183 AND § 1.182**  
: **AND ORDER *RE* SHOWING**  
: **CAUSE TO UNSEAL**

This is a decision on the August 18, 2010 petitions by Nokia Corporation, not a party to the instant reexamination proceeding, entitled “PETITION TO SUSPEND THE RULES UNDER 37 CFR 1.183 TO ALLOW PROTECTION OF CONFIDENTIAL INFORMATION,” and “PETITION UNDER 37 C.F.R. 1.182 TO PROVISIONALLY SEAL A DOCUMENT AND TO EXPUNGE CONFIDENTIAL PORTIONS THEROF.”

The non-party petitions are before the Office of Patent Legal Administration.

The \$400 fees for each petition under 37 C.F.R. § 1.17(f) have been charged to Deposit Account No. 16-0605 as authorized in each petition.

The petitions under 37 C.F.R. § 1.183 and § 1.182 are **dismissed**. The Office is, however, *sua sponte* taking the following action:

- (a) The Office is placing the documents identified by the petitioner at least temporarily under seal.
- (b) The patent owner is being provided with an opportunity to show cause why the documents identified by the petitioner should be unsealed and entered into the record for consideration.
- (c) The non-party petition under § 1.182 is being expunged from the record, as impermissibly containing arguments as to the materiality of information in a document to the instant reexamination proceeding.

### BACKGROUND

- On August 25, 2009, the Office ordered *inter partes* reexamination of all of the claims of U.S. Patent Number 7,043,751, following a May 5, 2008 request by third party requester HTC Corporation. On the same date, the Office mailed an action rejecting claims 1-13, i.e., all of the claims subject to reexamination.
- On November 25, 2009, patent owner IPCom GMBH filed a response to the August 25, 2009 Office action.
- On December 23, 2009, third party requester filed comments after the November 25, 2009 patent owner response.
- On February 18, 2010, patent owner filed an Information Disclosure Statement (IDS).
- On February 25, 2010, an Order was entered in the High Court of Justice of Great Britain, setting forth a judgment on certain European patents that included a listing of confidential material.<sup>1</sup> The listing included a document entitled “The First and Second Confidential Appendices to the Judgment of the Court handed down on 18th January 2010.”
- On July 1, 2010, patent owner filed another IDS.
- On August 2, 2010, patent owner filed another IDS. This IDS contained a document entitled “Approved Judgment (with Confidential Appendices).”

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<sup>1</sup> *Nokia GMBH v. IPCom GMBH & CO KG*, case numbers HC08 C02525 & HC08 C03143, High court of Justice, Chancery Division, Patents Court.

- On August 18, 2010, Nokia Corporation, an entity that is not a party to this reexamination, filed two petitions accompanied by supporting documentation. The documentation included documents from the High Court of Justice in Great Britain, as well as documents representing communications between parties allegedly representing Nokia Corporation and IPCom GmbH. The instant petitions were submitted to:
  - Suspend the rules to enter papers by independent non-parties through a petition entitled “Petition to Suspend the Rules Under 37 C.F.R. 1.183 to Allow Protection of Confidential Information,” and
  - To seal information through a petition entitled “Petition Under 37 C.F.R. 1.182 to Provisionally Seal a Document and to Expunge Confidential Portions Thereof.”

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### 37 C.F.R. § 1.11(d) provides:

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, and copies may be furnished upon paying the fee therefor.

### 37 C.F.R. § 1.182 provides:

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

### 37 C.F.R. § 1.183 states:

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

## DECISION

### 1. Sua Sponte Consideration of Protective Order Material

Both petitions are dismissed, as the papers were not signed in compliance with 37 CFR 1.4. The signature does not appear to be a proper handwritten signature in compliance with 37 CFR

1.4(d)(1) or a S-signature in compliance with 37 CFR 1.4(d)(2).<sup>2</sup> The signature appears to be an electronically applied image of the signature which does not comply with 37 CFR 1.4(d). From experience with s-signatures or electronic signatures, the signature appears to be an image of the signature, as the signature is blurry and exhibits little dots around the signatures typical of electronic images. While a practitioner may ratify a submission containing an improper signature, through submission of a subsequent properly signed submission, such ratification is unnecessary, as the Office is *sua sponte* addressing the matter as set forth below.

In undertaking *sua sponte* consideration of this matter, the Office recognizes the legitimate issues surrounding the submission of protective order information in an effort to discharge the duty to disclose to the Office information that is material to patentability.<sup>3</sup> In this instance, the instant petition to seal is akin to entry of bare notice of prior or concurrent litigation in a reexamination proceeding (pursuant to MPEP 2282), as both serve a legitimate interest, and both do not go to the merits of the proceeding such that consideration of the matter would involve prohibited participation in the proceeding.

A party submitting information believed to be protected by a protective order may follow the procedures set forth at MPEP 724.02, including the use of a sealed, clearly labelled envelope to isolate the information. Treatment by the Office of such information in reexamination proceedings is set forth at MPEP 724.04(c), which states that information properly submitted under MPEP 724.02 will be sealed from public view until a determination has been made as to whether or not the information is material to patentability.

Nokia Corporation alleges that the document entitled “Approved Judgment (with Confidential Appendices)” is subject to confidential treatment pursuant to an Order by the UK Patents Court. Nokia Corporation has provided that Order, which identifies the document as information which “shall remain confidential.”<sup>4</sup> Nokia Corporation has further identified communications between parties alleged to represent Nokia Corporation and patent owner ICom, discussing the potential confidential status of the abovementioned document in relation to submission in reexamination proceedings at the Office.

Based upon these submissions, a reasonable basis is present upon which to conclude that the “Approved Judgment (with Confidential Appendices)” may be subject to a court Order of confidentiality. Therefore, the provision of 37 C.F.R. 1.11(d) providing for public inspection of papers relating to a reexamination proceeding, is *sua sponte* waived subject to the right of the patent owner to show cause why the information should remain public, as per the next section of this decision. The “Approved Judgment (with Confidential Appendices)” will be sealed from public view. Such sealing furthers the interest in mitigation of any damage which may have occurred through the exposure of the above-mentioned document, which appears to be subject to a protective court order as detailed above.

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<sup>2</sup> See 37 CFR 1.4(d) and Changes to Facilitate Electronic Filing of Patent Correspondence, 72 FR 2770 (Jan. 23, 2007), 1315, Off. Gaz. Pat. Office Notices 63 (Feb. 13, 2007) (final rule).

<sup>3</sup> See MPEP 724 *et. seq.*

<sup>4</sup> Order of February 25, 2010, at 3, in *Nokia GMBH v. ICom GMBH & CO KG*, case numbers HC08 C02525 & HC08 C03143, High court of Justice, Chancery Division, Patents Court.

It is to be noted, however, that, although the information which is the subject of this decision will now be at least temporarily sealed, that information has already been made available to the public. Accordingly, the Office cannot guarantee that the information being sealed as a result of this decision were not previously accessed and copied by the public.

## 2. Order Providing Opportunity to Show Cause

Patent owner IPCom GmbH is hereby provided with an opportunity to show cause why the materials sealed in accordance with this decision should be unsealed. If IPCom believes that public access to the documents is appropriate and the seal should be lifted, IPCom must explain why this is the case, in view of the documents on record. Such an explanation may include:

- (i) A certification that the patent owner has 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 sanctioned such submission, or
- (ii) A copy of the consent by the entity whose information is being submitted waiving the confidentiality and protection of the protective order as to the information (which in this instance would require obtaining the consent of petitioner Nokia), or
- (iii) An explanation of why the submitted information is not covered by the Order that was entered in the High Court of Justice of Great Britain, setting forth a judgment that included a listing of confidential material (which included a document entitled "The First and Second Confidential Appendices to the Judgment of the Court handed down on 18th January 2010").

IPCom is given a **one month time period from the date of this decision** to respond to this Order. If no response to this Order is received within one month, or if sufficient cause is not shown in the response to unseal the Order that was entered in the High Court of Justice of Great Britain, the Office will make the seal permanent, thereby expunging the information from the record. Expungement would be effected by marking the protected papers "closed" and "not public" in the Image File Wrapper (IFW).

There is no indication in the record that the "Approved Judgment (with Confidential Appendices)" was submitted to comply with the patent owner's duty of disclosure.<sup>5</sup> Should a situation arise where patent owner's duty to disclose is in conflict with the protective order (i.e. if

---

<sup>5</sup> Pursuant to 37 CFR 1.555(a), "[e]ach individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. Pursuant to 37 CFR 1.555(b), "[u]nder this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in: (i) Opposing an argument of unpatentability relied on by the Office, or (ii) Asserting an argument of patentability."

Patent owner has not provided any indication that the "Approved Judgment (with Confidential Appendices)" does either item (1) or item (2), which would bring into play the duty of disclosure.

the disclosure of protected information would be needed in order to comply with applicant's duty), applicant should approach the court for relief from the protective order.

### 3. The § 1.182 Petition is Expunged

The petition under §1.182 addresses the additional issue of whether information in a document is material to the reexamination proceeding, and as such, goes beyond "bare notice" of proceedings as discussed above. Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned. As the petition cannot be considered to merely be analogous to a notification of litigation proceedings, the petition cannot be considered to be an authorized paper.

Because the § 1.182 petition was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original petition cannot be physically returned to the petitioner. Rather, the petition under § 1.182 will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

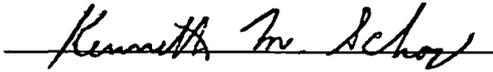
### 4. Courtesy Copy of Petition

Since the present application has been published, a courtesy copy of this decision is being sent to petitioner Nokia Corporation.

## CONCLUSION

1. The petitions by Nokia Corporation, a non-party to this reexamination proceeding, are dismissed.
2. The Office is placing the documents identified by the petitioner at least temporarily under seal.
3. The patent owner is being provided with an opportunity to show cause why the documents identified by the petitioner should be unsealed and entered into the record for consideration. Patent owner is given a **one month time period from the date of this decision** to respond to this Order.
4. The non-party petition under § 1.182 is being expunged from the record as impermissibly containing arguments as to the materiality of information in a document to the instant reexamination proceeding.
5. A copy of this decision will be made of record in the reexamination file.

6. Telephone inquiries related to this decision should be directed to Michael Cygan, at (571) 272-7700.

A handwritten signature in cursive script that reads "Kenneth M. Schor". The signature is written in black ink and is positioned above a horizontal line.

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

October 17, 2010  
Kenpet8/



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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.
95/001,194	05/29/2009	7400858	8282-83120-01	3014

7590 09/23/2010  
D. N. HALGREN  
35 CENTRAL ST.  
MANCHESTER, MA 01944

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/23/2010

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PORTLAND, OR 97204

Date:

**MAILED**

**SEP 23 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001194

PATENT NO. : 7400858

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)

RICHARD D. MC LEOD  
KLARQUIST SPARKMAN, LLP  
121 SW SALMON STREET, SUITE 1600  
PORTLAND, OR 97204

(For *Inter Partes* Requester)

**MAILED**

**SEP 23 2010**

**CENTRAL REEXAMINATION UNIT**

*In re* Crowley, *et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,194  
Filed: May 29, 2009  
For: U.S. Patent No. 7,400,858

: **DECISION**  
: **DISMISSING**  
: **PETITIONS AND**  
: **EXPUNGING**  
: **IMPROPER PAPERS**

This is a decision on patent owner's June 17, 2010 petition paper entitled "PETITION TO EXPUNGE UNDER 37 CFR 1.59(b) BY PATENT OWNER AMBIT CORPORATION" (hereinafter "the petition under 37 CFR 1.59") and patent owner's concurrently-filed June 17, 2010 petition paper entitled "PETITION TO UNDER 37 CFR 1.182 TO DECIDE A QUESTION NOT SPECIFICALLY PROVIDED FOR UNDER THE RULES OR IN THE ALTERNATIVE UNDER 37 CFR 1.183 TO SUSPEND ONE OF THE REQUIREMENTS SET FORTH IN MPEP §724.05" (hereinafter "the petition under 37 CFR 1.182/1.183").

The petition under 37 CFR 1.59 and the petition under 37 CFR 1.181/1.183 are before the Office of Patent Legal Administration for consideration. The petition fee of \$200 for the petition under 37 CFR 1.59 pursuant to 37 CFR 1.17(g) was charged to patent owner's credit card on June 18, 2010. The petition fee of \$400 for the petition under 37 CFR 1.182/1.183 pursuant to 37 CFR 1.17(f) was charged to patent owner's credit card on June 18, 2010.

The petitions under 37 CFR 1.59 and 37 CFR 1.182/1.183 are dismissed.

**BACKGROUND**

1. On July 15, 2008, the Office issued United States Patent Number 7,400,858 ("the '858 patent") to Crowley, *et al.*
2. On May 29, 2009, a request for *inter partes* reexamination of the '858 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,194 ("the '1194 proceeding").

3. On August 20, 2009, the Office issued an order granting *inter partes* reexamination in the '1194 proceeding.
4. On March 25, 2010, patent owner filed an Information Disclosure Statement in the '1194 proceeding under 37 CFR 1.555, listing a document entitled "EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03."
5. On June 17, 2010, patent owner filed the instant petitions under 37 CFR 1.59 and under 37 CFR 1.182/1.183.
6. Concurrently, on June 17, 2010, patent owner filed an Information Disclosure Statement, listing a document entitled "D.I. 144-17 submitted in case 1:09-cv-10217-WGY, filed February 5, 2010; 8 pages."

## DISCUSSION

### I. Relevant Statutes, Regulations and Procedures

CFR 1.59(b) provides:

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.

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).

MPEP 724.05(II) provides (in-part):

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(g) is included.

## II. The Petition under 37 CFR 1.59

### A. Request to Expunge Information

On March 25, 2010, petitioner patent owner submitted an Information Disclosure Statement (IDS), listing a 92-page document (pages DL 0002238 – DL 0002329) entitled “EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03” and labeled “CONFIDENTIAL - ATTORNEY'S EYES ONLY.” In the June 17, 2010 petition under 37 CFR 1.59, petitioner requests that this information (hereinafter “the protected information”) be expunged because it “is understood by the Petitioner to be proprietary information of Delta Air Lines, Inc. and is subject to a Protective Order....”<sup>1</sup>

Petitioner states that “[t]he information to be expunged was unintentionally submitted by the Petitioner as part of the Information Disclosure Statement filed on March 25, 2010” and that “the failure to obtain the return of this information (EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03, DL 0002238 - DL 0002329) would cause irreparable harm to Delta Air Lines, Inc. and/or AMBIT Corporation.”<sup>2</sup> Petitioner further states: that “Delta Air Lines, Inc. commits to retain the information to be expunged for the period of any patent which issues from this application;”<sup>3</sup> that other than selected pages of the protected information which have been resubmitted in the June 17, 2010 IDS, the remaining protected

<sup>1</sup> Petition under 37 CFR 1.59 at page 3. *See also*, Exhibit #1 to the petition under 37 CFR 1.59, Stipulation and Protective Order, dated May 4, 2009 (pertaining to civil litigation 1:09-cv-10217-WGY involving the ‘858 patent) and Exhibit #2 to the petition under 37 CFR 1.59, Order to Modify Protective Order, dated April 4, 2010 (pertaining to civil litigation 1:09-cv-11408-WGY involving U.S. Patent No. 7,580,733).

<sup>2</sup> *Id.* The March 25, 2010 IDS submission also included information that is not subject to a protective order.

<sup>3</sup> Pursuant to its request in the concurrently-filed petition under 37 CFR 1.182/1.183, petitioner requests that Delta Airlines, Inc., and not petitioner, be permitted to retain the information for the period of the ‘858 patent.

information submitted with the March 25, 2010 IDS “has not otherwise been made public, other than through any presentation that may have been made by the United States Patent and Trademark Office on PAIR;” and that “[i]t is the Petitioner's belief that the information to be expunged is not material information under 37 C.F.R. 1.56.”<sup>4</sup>

In this instance, petitioner has established that the protected information submitted with the March 25, 2010 IDS is covered by the Stipulation and Protective Order dated May 4, 2009 (“the protective order”).<sup>5</sup> Under MPEP § 724.05(II), a petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that items (A)-(F) of that paragraph are satisfied. However, pursuant to item (E), protected information inadvertently submitted in an IDS will only be expunged from the record if it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56. Thus, if the examiner determines that the inadvertently submitted protected information is material to patentability, such information would be made part of the public record.

In this instance, petitioner has not provided any evidence that Delta Airlines, Inc. has consented to waiver of the May 4, 2009 protective order in the event the examiner determines that the protected information inadvertently submitted on March 25, 2010 is material to patentability, and has also not provided any evidence that Office personnel are permitted to review the protected information under the terms of the protective order. Thus, the submission of the protected information is inappropriate and could result in a potential violation of the protective order; therefore, the entire March 25, 2010 IDS submission is being expunged from the record of the ‘1194 proceeding as an improper paper by marking the papers “closed” and “not public” in the Image File Wrapper (IFW).<sup>6</sup> Accordingly, the June 17, 2010 petition under 37 CFR 1.59 is dismissed as moot.

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the “material” information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order.<sup>7</sup> MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as “material” information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose. Should a situation arise where the duty to disclose is in conflict with the protective order, patent owner should approach the court for relief from the protective order as the Office can not prosecute an application or conduct a reexamination when information material to patentability is withheld.

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<sup>4</sup> *Id.* See also, Exhibit #5 to the petition under 37 CFR 1.59, letter from Delta Airlines, Inc., dated June 11, 2010 (stating “Delta Airlines, Inc. hereby agrees to retain a copy of the document titled “EA Current Revision Previous Revision(s) Flow Charts Substantiation Sheets, Last Updated 6/2/03” for the period of U.S. Patent No. 7,400,858 and U.S. Patent No. 7,580,733.”)

<sup>5</sup> *E.g.*, see paragraphs 2 and 8 of the protective order.

<sup>6</sup> The Office will not expunge portions of papers. Thus, even though portions of the March 25, 2010 IDS submission include information that is not covered by the protective order, the entire March 25, 2010 submission is being expunged as an improper paper.

<sup>7</sup> See MPEP § 724.

Further filings that include information covered by the protective order will be expunged until evidence that permission has been granted for public disclosure of the information has been provided in this proceeding. Thus, as to portions of the March 25, 2010 IDS submission that include protected information, the protected information may be resubmitted for consideration pursuant to the procedures set forth in MPEP § 724 when permission for its submission is obtained despite the fact that such information will become part of the public record should the examiner find the information to be material information under 37 CFR 1.56.<sup>8</sup>

As to portions of the March 25, 2010 IDS submission that did not include protected information, petitioner may file a replacement IDS, via a petition under 37 CFR 1.182, listing only those documents identified in the March 25, 2010 IDS that are not subject to the protective order for consideration by the examiner.

#### **B. IDS Submitted June 17, 2010**

On June 17, 2010, concurrently with the petition under 37 CFR 1.59, patent owner filed an IDS, listing a document entitled "D.I. 144-17 submitted in case 1:09-cv-10217-WGY, filed February 5, 2010; 8 pages." The document submitted with the June 17, 2010 IDS contains eight pages of the protected information submitted with the March 25, 2010 IDS.<sup>9</sup> Regarding the subset of protected information submitted with the June 17, 2010 IDS, patent owner states on page 3 of the petition under 37 CFR 1.59:

Delta Air Lines has previously submitted certain pages of the same document (DL 0002252, DL 0002259, DL 0002263, DL 0002265, DL 0002267, DL 0002269, DL 0002296 and DL 0002303) on the public record despite the "Confidential - Attorneys Eyes Only" designation printed thereon. *See* D.I. #144 and 144-16 in Civil Action No. 1:09-CV-10217-WGY in the United States District Court for the District of Massachusetts.

These selected pages may therefore remain on the public record at the Patent Office and have been resubmitted in an Information Disclosure Statement filed concurrently with this Petition.

Patent owner asserts that despite the protected information being designated "Confidential - Attorneys Eyes Only" and falling within paragraph 8(c) of the protective order,<sup>10</sup> eight pages of such information are not protected information covered by the protective order because those pages of information were filed by Delta Airlines, Inc. in the related litigation proceedings.

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<sup>8</sup> It is noted that on page 3 of the petition under 37 CFR 1.59, petitioner states "[i]t is Petitioner's belief that the information to be expunged is not material information under 37 C.F.R. 1.56." Accordingly, resubmission of such information for consideration by the examiner appears unnecessary.

<sup>9</sup> The information submitted with the June 17, 2010 IDS contains a subset of the protected information submitted with the March 25, 2010 IDS, which information petitioner seeks to expunge and believes is not material information under 37 CFR 1.56. *See*, the petition under 37 CFR 1.59 at page 3. Thus, submission of the June 17, 2010 IDS does not appear to be necessary.

<sup>10</sup> Petition under 37 CFR 1.59 at page 3.

In this instance, petitioner has not established that the subset of protected information submitted with the June 17, 2010 IDS is not covered by the May 4, 2009 protective order. For example, petitioner has not pointed to any paragraph of the protective order indicating that submission in a related litigation of any of information subject to the protective order would render that information no longer covered by the protective order. Thus, the Office continues to deem the information submitted with the June 17, 2010 IDS to be protected information that is subject to the May 4, 2009 protective order.

Because no evidence has been submitted that Delta Airlines, Inc. has consented to waiver of the protective order with respect to the subset of protected information submitted with the June 17, 2010 IDS, and no evidence has been submitted that Office personnel are permitted to review the information, it is inappropriate to submit such information and cause a potential violation of a protective order. Accordingly, the June 17, 2010 IDS submission is being expunged from the record of the '1194 proceeding as an improper paper by marking the papers "closed" and "not public" in the Image File Wrapper (IFW). As noted in Section (II)(A) of this decision, information covered by the court's protective order is not to be submitted without evidence that permission has been granted for public disclosure of the information, and further filings that include information covered by the protective order will be expunged until such permission has been provided in this proceeding.

### **III. The Petition under 37 CFR 1.182/1.183**

Petitioner patent owner submitted, concurrently with the petition under 37 CFR 1.59, a petition under 37 CFR 1.182 to decide a question not specifically provided for under the rules, or in the alternative under 37 CFR 1.183 to suspend the requirements set forth in MPEP 724.05. In the petition under 37 CFR 1.182/1.183, petitioner requests that Delta Air Lines, Inc., rather than AMBIT Corporation, be permitted to retain the information to be expunged (i.e., the inadvertently submitted protected information filed with the March 25, 2010 IDS) for the period of any patent which issues from the application, because patent owner (AMBIT Corporation) "cannot legally retain a copy of this document beyond ninety (90) days after termination of the 10217 or the 11408 litigations."<sup>11</sup> In view of the dismissal of the concurrently-filed petition under 37 CFR 1.59, as set forth herein, the instant petition under 1.182/1.183 is dismissed as moot.

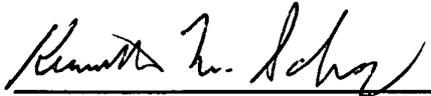
### **CONCLUSION**

1. Patent owner's June 17, 2010 petition under 37 CFR 1.59 is dismissed as moot.
2. Patent owner's June 17, 2010 petition under 37 CFR 1.182/1.183 is dismissed as moot.
3. The March 25, 2010 and the June 17, 2010 IDS submissions are being expunged from the file wrapper of the '1194 proceeding by marking the papers "closed" and "not public."

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<sup>11</sup> Petition under 37 CFR 1.182/1.183 at page 4.

4. Jurisdiction for the '1194 reexamination proceeding is being returned to the Central Reexamination Unit (CRU).
5. Telephone inquiries with regard to this decision should be directed to Nicole Dretar, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7717, or in her absence, to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726.



---

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

9-21-2010



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7590 02/08/2011  
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Date:

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**FEB 08 2011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001194

PATENT NO. : 7400858

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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D. N. HALGREN  
35 Central St.  
Manchester MA 01944

(For Patent Owner)

MAILED

FEB 08 2011

Richard D. McLeod  
Klarquist Sparkman LLP  
121 SW Salmon St., #1600  
Portland, OR 97204

(For Requester)

CENTRAL REEXAMINATION UNIT

*In re: Crowley et alia*  
Reexamination Proceeding  
Control No. 95/001,194  
Request Deposited: May 29, 2009  
For: U.S. Patent No. 7,400,858

:  
:  
: **DECISION**  
:  
:

The *inter partes* reexamination proceeding is before the Central Reexamination Unit to address the Patent Owner (PO) papers filed November 23, 2009 and April 9, 2010 entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906" and the Third-Party Requester (3PR) paper filed December 23, 2009 entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906".

The patent owner papers appear to question an action taken by the examiner.

The patent owner petitions are **dismissed** and/or addressed to the extent below set forth below.

**BACKGROUND**

A non-final office action was mailed on September 23, 2009. PO responded with arguments and no amendments to the claims on November 23, 2009. PO supplemented the response with an additional paper entitled, "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906". After the PO

Art Unit: 3992

response of November 23, 2009 was held defective, PO filed a corrected response on April 9, 2010. PO supplemented the corrected response with an additional paper entitled, "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906".

### DECISION, FINDINGS AND ANALYSIS

Initially, it is noted that the later supplemental paper of April 9, 2010 contains the same arguments against the office action mailed September 23, 2009 that were presented in the initial supplemental paper of November 23, 2009. To the extent that the paper of April 9, 2010 can be considered a petition, it is **dismissed as untimely**.

Due to the fact that PO has re-submitted their supplemental paper entitled "PETITION TO COMPEL THE EXAMINER TO COMPLY WITH THE LIMITED SCOPE OF EXAMINATION SET FORTH IN 37 C.F.R. 1.906" with the corrected response of April 9, 2010, the paper appears to be a supplement to their response rather than a petition. If the paper was intended to be a petition, there would have been no need to refile the paper with their corrected response.

Furthermore, the papers question the correctness of a perceived rejection of original claims under 35 USC 112 first paragraph. Arguing the merits of a rejection is an issue subject to appeal to the Board of Patent Appeals and Interferences and is thus not a petitionable issue. This decision makes no comment on the merits of any rejection.

However, it is noted that there is no rejection under 35 USC 112 first paragraph in the non-final office action mailed September 23, 2009. PO appears to be confusing a rejection under 35 USC 112 first paragraph with an analysis to determine the effective date of the claims. Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972).

### CONCLUSION

1. Petitioner's request is **dismissed**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Control Number: 95/001,194

Page 3

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



---

Eric Keasel

Supervisory Patent Examiner  
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,196	06/04/2009	7330952	2805.002REX9	8788

26111 7590 09/07/2010

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

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/07/2010

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



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United States Patents and Trademark Office  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David M. O'Dell

HAYNES AND BOONE, LLP, IP SECTION

2323 Victory Avenue, Suite 700

Dallas, TX 75219

Date: **MAILED**

**SEP 07 2010**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001196

PATENT NO. : 7330952

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

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

HAYNES & BOONE, LLP IP SECTION :  
2322 VICTORY AVENUE : (For *inter partes* Requester)  
SUITE &)) :  
DALLAS, TX 75219 :

*In re* Barth *et al.* : DECISION DISMISSING  
*Inter partes* Reexamination Proceeding : PETITION FOR EXTENSION  
Control No.: 95/001,196 : OF TIME  
Filed: June 4, 2009 : [37 CFR § 1.956]

This is a decision on the September 2, 2010 patent owner "Petition for an Extension of Time Pursuant to 37 CFR § 1.956," requesting that the time for responding to the Office action mailed August 9, 2010 to be extended by one-month.

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

The petition is Dismissed for the reasons set forth below.

**Statement of Relevant Facts**

1. On June 5, 2009 a request was deposited for *inter partes* reexamination with the Office requesting all claims (claims 1 – 28) of US Patent 7,330,952 (the '952 patent) be reexamined. The request was assigned Control No. 95/001,196. The '952 patent claims 21, 22 and 24 were subject to reexamination in *ex parte* proceeding 90/009,371 when the *inter partes* request was filed.
2. On August 13, 2009 the Office issued an order granting the '1196 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that claims 1 – 28 (all claims of the patent) would be subject to reexamination.
3. On October 16, 2009, the Office, *sua sponte* issued a decision merging the ' 1196 *inter partes* reexamination proceeding with the 90/009371 *ex parte* reexamination proceeding (the merged proceeding).

4. On October 16, 2009, patent owner filed a petition requesting reconsideration of the merger of the ' 9371 *ex parte* proceeding, with the ' 1196 *inter partes* proceeding.
5. On December 2, 2009, the Office issued a first Office action on the merits in the merged proceeding, setting a two month period for response.
6. Patent owner requested a one month extension of time on December 16, 2009 to respond to the merged office action on the merits. A one month extension was granted on December 23, 2009.
7. On December 17, 2009 the Office issued a decision dismissing patent owner's October 21, 2009 petition requesting reconsideration of the October 2, 2009 decision to merge the ' 1196 *inter partes* and ' 10365 *ex parte* reexamination proceedings.
8. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.
9. On March 1, 2010, patent owner timely filed responsive comments to the December 2, 2009 Office action, including an amendment to some of the claims.
10. On March 31, 2010, third party requester timely filed responsive comments.
11. On June 28, 2010 the Office granted owners requested relief and dissolved the merger of the '1196 *inter partes* proceeding and the '9371 *ex parte* proceeding.
12. On August 9, 2010 the Office issued a non final rejection in the '1196 proceeding. The office action set a one month period for response.
14. On September 2, 2010 owner filed the instant petition requesting a one month extension of time in the '1196 proceeding.

### Discussion

The Patent Owner requested a one (1) month extension of time on September 1, 2010 in which to file a response to the non-final Office action was mailed August 9, 2010. The non-final Office action provided a one (1) month period for response. The petition request included payment for the \$200 petition fee under 37 CFR §1.17 (g). This is the second request for reconsideration for the extension of time in this *inter partes* proceeding.

*37 CFR § 1.956. Patent owner extensions of time in inter partes reexamination. The time for taking any action by a patent owner in an inter partes reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.*

Addressing the requirement of 37 CFR § 1.956 to make a showing of “sufficient cause” to grant an extension request, MPEP § 2665 states, in pertinent part:

As noted above, a request for extension of time under 37 CFR § 1.956 will be granted only for sufficient cause, ...

Evaluation of whether “sufficient cause” has been shown for an extension must be made by **balancing** the desire to provide the patent owner with a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. § 314(c), that the proceedings be conducted with special dispatch. ...

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor. The reasons must include (A) a statement of what action the patent owner has taken to provide a response, to date as of the date the request for extension is submitted, and (B) why, in spite of the action taken thus far, the requested additional time is needed. The statement of (A) must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

Any petition request must include the required petition fee as set forth according to 37 CFR § 1.17 (g) and 37 CFR § 1.956.

### Decision

In the petition patent owner’s representative requests a one-month extension of time to (i) perfect the patent owner’s declaration under 37 CFR 1.131, (ii) a perfected declaration under Rule 131 will reduce issues and (iii) because patent owner has three other responses to office actions in other related cases due on the same day.

In further support of the request for additional time, patent owner’s representative submits 1) patent owner requires additional time to further investigate the details behind its actual reduction to practice, 2) patent owner may seek additional declaratory evidence pursuant to 37 CFR 1.132 and 3) patent owner has seven additional responses due in related proceedings that will benefit from additional time being granted in the instant proceeding.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner’s representative has conducted various ‘reviews’. The outlined behavior includes reviewing the outstanding office action and making a contact regarding further investigation and preparing responses and perfecting declarations for other related reexamination proceedings. See page 7 of the petition for details.

With respect to point 1) it must be noted that the review of the record reveals the failings of the proffered 37 CFR 1.131 declaration as outlined in the August 9, 2010 office action are not new to patent owner. While the decision dissolving merger of June 28, 2010 does vacate the prior office actions and responses, it does not erase the record. Patent owner has been fairly noticed in the prior first office as to the Office position regarding the submitted evidence. No explanation is offered in the instant petition as to why the required “additional investigations” are needed presently when they were not needed prior, or why they were not earlier conducted in as much as the same rejections were set forth in the prior Office actions. The issues regarding the evidence have been

fairly notice to patent owner for over ten months while the only diligent behavior directed to this point discussed in the petition is establishing an initial contact regarding further investigations.

As to point 2), similarly the petition fails to address why at this point in time new evidence is under consideration for presentation. That the proposed declarant had limited availability during the month of August does not address why the declarations are necessary at this time.

Finally with respect to point 3) the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Absent sufficient cause, the mere number of related proceedings fails to override the requirement of the statute.

The petition fails to demonstrate sufficient cause to warrant the requested extension of time. It is further noted prosecution of the instant *inter partes* reexamination proceeding has been pending over one year and the underlying patent is subject to concurrent litigation. Even a modest extension of one month at this point in the proceeding, absent sufficient cause, would impact the mandate for special dispatch.

On balance, it does not appear patent owners reasoning as to why additional time is needed, in light of the review actions taken thus far outweigh the need for special dispatch given the prolonged prosecution in the instant proceeding. Sufficient cause has not been shown. Therefore, the request fails to meet the requirements as outlined in MPEP 2665 for granting of a request for extension of time under 37 CFR 1.956.

The petition for extension of time is hereby dismissed.

### Conclusion

1. The Patent Owner's petition for reconsideration of the extension of time filed on September 1, 2010 is dismissed.
2. The period for response is not extended beyond the shortened statutory period for response of one (1) month as recited in the outstanding Office action mailed August 9, 2010.
3. All correspondence involving this proceeding may be addressed to the following:

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

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

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

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are “soft scanned” (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the “soft scanning” process is complete.

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

/J. Harrison/

---

J. Harrison  
Supervisory Patent Examiner AU 3992  
Central Reexamination Unit



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CENTRAL REEXAMINATION UNIT

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

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)  
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SUITE 700  
DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)  
Attn: William H. Wright  
IP Prosecution Department  
4 Park Plaza, Suite 1600  
Irvine, CA 92614

<i>In re Barth et al.</i>	:
<i>Inter partes</i> Reexamination Proceeding	:
Control No.: 95/001,196	:
Filed: June 4, 2009	:
For: U.S. Patent No. 7,330,952	: DECISION
	: ON
<i>In re Barth et al.</i>	: PETITION
<i>Ex Parte</i> Reexamination Proceeding	:
Control No.: 90/009,371	:
Filed: December 22, 2008	:
For: U.S. Patent No. 7,330,952	:

This is a decision on third party requester's July 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on July 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The June 28, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On February 12, 2008, the Office issued U.S. Patent No. 7,330,952 (the '952 patent) to Barth *et al.*
2. The '952 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-28 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 22, 2008, a request for *ex parte* reexamination of claims 21, 22 and 24 of the '952 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,371 (the '9371 proceeding).
5. On February 20, 2009, the Office issued an order granting the '9371 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 21, 22 and 24 of the '952 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9371 *ex parte* reexamination proceeding expired on April 20, 2009.<sup>1</sup>
7. On April 29, 2009, the Office issued a first Office action on the merits in the '9371 *ex parte* reexamination proceeding.
8. On June 4, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '952 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,196 (the '1196 proceeding).
9. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '952 patent. Therefore, the '952 patent is no longer involved in the ITC investigation.
10. On July 29, 2009, Patent Owner filed a response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.<sup>2</sup>
11. On August 13, 2009, the Office issued an order granting the '1196 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '952 patent, claims 1-28, would be subject to reexamination.
12. On August 25, 2009, Patent Owner filed a supplemental response in the '9371 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.
13. On October 16, 2009, the Office, *sua sponte*, issued a decision merging the '1196 *inter partes* reexamination proceeding with the '9371 *ex parte* reexamination proceeding (the merged proceeding).

---

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

<sup>2</sup> Patent Owner petitioned for and was granted a one month extension of time to respond to the April 29, 2009 Office action.

14. Also on October 16, 2009, patent owner filed a petition requesting prevention of merger of the '9371 *ex parte* proceeding with the '1196 *inter partes* proceeding.
15. On December 2, 2009, the Office issued a first Office action on the merits in the merged proceeding.
16. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1196 *inter partes* and '9371 *ex parte* reexamination proceedings.<sup>3</sup>
17. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.
18. On March 1, 2010, patent owner timely filed responsive comments to the December 2, 2009 Office action, to include an amendment to the claims.<sup>4</sup>
19. On March 31, 2010, third party requester timely filed responsive comments.
20. On June 28, 2010, the Office issued a decision dissolving the merger of the '1196 and the '9371 proceedings.
21. On July 10, 2010, the Office issued non-final Office Actions in both the '1196 and the '9371 proceedings.
22. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.
23. On August 9, 2010, the Office issued another non-final Office Action in the '1196 proceeding.
24. Also on August 9, 2010, the Office issued a final Office Action in the '9371 proceeding.
25. On September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '1196 proceeding.
26. Also on September 9, 2010, patent owner timely filed a response to the August 9, 2010 Office action in the '9371 proceeding.

---

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

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

27. On October 8, 2010, third party requester timely filed its comments in the '1196 proceeding.
28. On December 21, 2010, the Office issued an Action Closing Prosecution (ACP) in the '1196 proceeding.

## DECISION

### I. Issues Raised and Relief Requested

Third party requester contends that the Office's June 28, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the June 28, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

### II. Discussion of Previous Petitions and Decisions

#### a. The October 16, 2009 Patent Owner Petition and December 17, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "*ex parte* reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of

the public is the requester in an *inter partes* proceeding for the same patent; (2) No “*ex parte* right” was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party’s rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

**b. The February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision**

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner’s previous petition. Patent owner’s February 5, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner’s previous petition.

On June 28, 2010, the Office issued a decision granting patent owner’s February 5, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

**III. Findings and Analysis**

**a. The June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion**

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

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

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

In response:

The June 28, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>6</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '952 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the July 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>7</sup>

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '952 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '952 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

- 1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.
- 2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the

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<sup>6</sup> Id.

<sup>7</sup> See MPEP 2686.01 IV.

filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>8</sup> 37 CFR 1.989(a),<sup>9</sup> MPEP 2686.01 I,<sup>10</sup> MPEP 2686.01 IV,<sup>11</sup> MPEP 2283,<sup>12</sup> and MPEP 2286.<sup>13</sup> See also “Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

#### **b. The June 28, 2010 Office decision is not a violation of Requester’s Rights**

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

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<sup>8</sup> “If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will **usually** be merged and result in the issuance and publication of a single certificate under § 1.570. . . .” (Emphasis added).

<sup>9</sup> “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).

<sup>10</sup> “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.’”

<sup>11</sup> “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.”

<sup>12</sup> “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.’”

<sup>13</sup> “[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with ‘special dispatch.’”

The dissolution decision does not alter the requester's rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester's rights upon filing of each request for reexamination. The Office's merger of proceedings does not alter a party's rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

**c. The June 28, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would

also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>14</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

**d. The June 28, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 28, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merge. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>15</sup> In the present instance, as noted in

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<sup>14</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

<sup>15</sup> See MPEP 2686.01 IV.

the June 28, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The June 28, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a "quick" request, simply to "get" something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester's institution of two separate reexamination proceedings for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office's decision whether or not to merge requester's piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester's assertions.

The June 28, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged

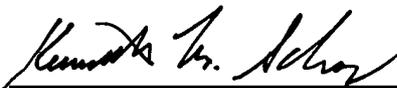
pending Office proceedings on the same patent when a reexamination certificate issues.<sup>16</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 28, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>17</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### IV. Summation

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

#### CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

1/5/11

<sup>16</sup> See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>17</sup> See Petition at page 9, section E.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,196	06/04/2009	7330952	2805.002REX9	8788
26111	7590	08/05/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 8-5-11

David M. O'Dell  
HAYNES AND BOONE, LLP, IP SECTION  
2323 Victory Avenue, SUite 700  
Dallas, TX 75219

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

REEXAMINATION CONTROL NO. : 95001196  
PATENT NO. : 7330952  
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 05 2011

Sterne Kessler, Goldstein, & Fox, PLLC  
1100 New York Avenue, N.W. CENTRAL REEXAMINATION UNIT : (For Patent Owner)  
Washington, DC 20005 :

Haynes & Boone, LLP IP Section :  
2323 Victory Avenue : (For Requester)  
Suite 700 :  
Dallas, TX 75219 :

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

This is a decision on the June 10, 2011 third party requester petition entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.183 To Waive § 1.116(f) and Admit Evidence."

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

The petition is **dismissed**.

**PERTINENT BACKGROUND<sup>1</sup>**

1. On June 4, 2009, a request for *inter partes* reexamination of all of the claims (claims 1-28) of U.S. Patent Number 7,330,952 to *Barth et al.* was filed by a third party requester. The real party in interest was identified as NVIDIA Corporation. This request was assigned Control No. 95/001,196 ("the '1196 proceeding").
2. On August 13, 2009, the Office issued an order granting the '1196 request for *inter partes* reexamination on claims 1-28.
3. Prosecution continued, until on May 4, 2011, the Office issued a right of appeal notice ("RAN") rejecting claims 1-11 and 13-28, and confirming claim 12.

<sup>1</sup> See the reexamination file for the full history.

4. On June 6, 2011, patent owner filed a notice of appeal and a petition entitled "Petition Under 37 CFR 1.183 to Waive § 1.116(f) and Admit Evidence."
5. On June 9, 2011, third party requester filed an notice of cross-appeal.
6. On June 10, 2011, third party requester filed the instant paper entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.183 To Waive § 1.116(f) and Admit Evidence."

### APPLICABLE RULE(S)

#### 37 C.F.R. § 1.183 provides:

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

### DECISION

The instant third party requester petition filed on June 10, 2011, to request that the Office deny patent owner's June 6, 2011 petition requesting waiver of the rules. Third party requester provides no authority for the entry of such a petition filed merely to oppose another party's petition to waive the rules. The present opposition petition is not provided for by statute or rule, and is being expunged as will now be explained.

The involvement of a third party requester in an *inter partes* reexamination proceeding is limited to that provided for by statute. Pursuant to 35 U.S.C. 314(b)(2), an *inter partes* reexamination proceeding shall be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133."

With respect to the June 10, 2011 third party requester paper opposing patent owner's June 6, 2011 petition under 37 C.F.R. § 1.183, neither the laws nor the regulations provide any right for the requester to file an opposition to, or comment on, a patent owner's petition to request waiver of the rules for the purpose of entering an evidence submission. A request for waiver of the rules governing entry of an evidence submission goes to an issue that is directed solely to formal requirements and is a matter within the jurisdiction and discretion of the Office.

Stated differently, the requester's submission is directed neither towards the merits of the initial examination nor towards the merits of the appeal, but is instead commenting on whether the Office should grant a petition for waiver of one of its rules. Such waiver is clearly a matter within the discretion of the USPTO Director, for which parties to the reexamination were not

granted a comment right by statute. There is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that either party was granted any right to challenge the granting of another party's petition that requests waiver of the rules for the purpose of entering an evidence submission. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress. In addition, entry and consideration of oppositions to such discretionary actions of the Office would not further the statutory mandate of special dispatch pursuant to 35 U.S.C. 314(c). Requester's opposition to patent owner's petition for waiver of the rules (for the purpose of entering an evidence submission) is therefore not enterable into the record.

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

Pursuant to 37 CFR 1.939(a), "[I]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned. For the reasons discussed above, the requester's opposition filed on June 10, 2011, to the patent owner's petition for waiver of the rules for the purpose of entering an evidence submission, does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the patent owner. Rather, the patent owner's petition will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

## CONCLUSION

1. The June 10, 2011 third party requester petition to oppose the granting of patent owner's June 6, 2011 petition is refused entry, as it is an improper paper. The opposition petition paper is not enterable into the record of the present reexamination proceeding, because such a submission is not authorized by the reexamination statute or the regulations promulgated under the statute.
2. Because the opposition petition paper was previously incorporated into the IFW for the present proceeding before discovery of its impropriety, the opposition paper is being expunged by closing the paper in the Image File Wrapper (IFW) for the proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.
3. A copy of this decision will be made of record in the IFW record of the present reexamination proceeding.

4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or to the undersigned at (571) 272-7726.

*Pinchus M. Laufer*

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

August 4, 2011



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

DATE MAILED: 08/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David M. O'Dell  
HAYNES AND BOONE, LLP, IP SECTION  
2323 Victory Avenue, Suite 700  
Dallas, TX 75219

Date: 8-18-11

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Inter Partes Reexamination**

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AUG 18 2011

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1100 New York Avenue, N.W.  
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CENTRAL REEXAMINATION UNIT :  
: (For Patent Owner)  
:

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2323 Victory Avenue : (For Requester)  
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Dallas, TX 75219 :

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

The petition is **dismissed**.

**PERTINENT BACKGROUND<sup>1</sup>**

1. On June 4, 2009, a request for *inter partes* reexamination of all of the claims (claims 1-28) of U.S. Patent Number 7,330,952 to Barth *et al.* was filed by a third party requester. The real party in interest was identified as NVIDIA Corporation. This request was assigned Control No. 95/001,196 ("the '1196 proceeding").
2. On August 13, 2009, the Office issued an order granting the '1196 request for *inter partes* reexamination on claims 1-28.
3. Prosecution continued, until on May 4, 2011, the Office issued a right of appeal notice ("RAN") rejecting claims 1-11 and 13-28, and confirming claim 12.
4. On June 6, 2011, patent owner filed a notice of appeal and the instant petition entitled "Petition Under 37 CFR 1.183 to Waive § 1.116(f) and Admit Evidence."

<sup>1</sup> See the reexamination file for the full history.

5. On June 9, 2011, third party requester filed an notice of cross-appeal.
6. On June 10, 2011, third party requester filed a paper entitled "Third Party Requester's Opposition to Patent Owner's Petition Under 37 C.F.R. § 1.183 To Waive § 1.116(f) and Admit Evidence."
7. On July 28, 2011, the third party requester filed an appellant's brief.
8. On August 5, 2011, the Office issued a decision dismissing and expunging the June 10, 2011 third party requester opposition petition.

### APPLICABLE RULE(S)

#### 37 C.F.R. § 1.183 provides:

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

### DECISION

Patent owner petitions for waiver of the provision of rule 1.116(f) which states that "no affidavit or other evidence can be made in an *inter partes* reexamination after the right of appeal notice." In the instant proceeding, the right of appeal notice ("RAN") was issued on May 4, 2011. Patent owner petitions to enter a submission filed with the petition, on June 6, 2011, which submission includes evidence. The submission is barred under rule 1.116(f), and patent owner petitions for waiver of the relevant provisions of that rule.

Patent owner's petition is submitted under § 1.183, which permits waiver of a rule, which is not a requirement of the statutes, in an "extraordinary situation, when justice requires" the requested relief. Relief may be granted, therefore, if the existence of an extraordinary situation such that justice requires relief can be found in the current instance.

Patent owner sets forth the following rationale for entry of the evidence submission: (1) to complete the file record, (2) to ensure consistency with other reexamination proceedings, (3) that there is no prejudice to third party requester, and (4) entry would not impact the Office's mandate for special dispatch.

With respect to these rationales, it is instructive to first explore the Office's balance between entering additional evidence after a RAN and ensuring a timely reexamination. This balance can

be seen in the provisions of 37 C.F.R. § 1.116, which set forth the requirements for entry of amendments and evidence after close of prosecution in applications and reexaminations. Where an *inter partes* reexamination has proceeded to a post-ACP stage, entry of an evidence submission requires good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Where an *inter partes* reexamination has proceeded to a post-RAN stage, the Office permits no entry of an evidence submission, regardless whether the evidence is necessary and/or whether there are good and sufficient reasons why the evidence was not earlier presented.

With respect to petitioner's first rationale, ensuring completeness of the file record, the balance set forth in § 1.116 illustrates that entry of the proffered evidence is outweighed by administrability considerations where the proceeding has advanced past the RAN stage. If each new item of evidence proffered to accomplish what petitioner terms as completing the record, a reexamination proceeding could go on indefinitely to "add" information; but this is clearly contradictory to the Office's statutory mandate for special dispatch in resolution of the substantial new question of patentability raised in reexamination. Looking to the facts of this case, petitioner desires entry of the instant affidavit to "describe ... in more detail the content of Exhibit CD." Exhibit CD was submitted by the patent owner petitioner, who could have included the "more detail" at the point of submission. Furthermore, Exhibit CD was submitted on February 16, 2010. Since that submission, the Office has mailed actions on August 9, 2010 (non-final), December 21, 2010 (ACP), and May 4, 2011 (RAN), and petitioner has had ample time to submit the "more detail" within the dictates of the rules.

Patent owner could have entered the instant evidence submission as a matter of right at any point prior to the December 21, 2010 ACP; alternatively, patent owner could have entered the instant evidence submission upon a showing of good and sufficient reasons why the submission was necessary and not earlier presented at any point up to the issuance of the May 4, 2011 RAN. Such would not have required a revisiting of a RAN, which is a final Office action setting up appeal rights.

With respect to petitioner's second rationale - consistency between related reexamination proceedings - the petition alleges only that the evidence has been submitted in related proceedings, it has not been entered in any related proceedings. It is also noted that is noted that each proceeding is decided on its own merits, and even if the same evidence is entered in other proceedings, it does not necessitate entry of that same evidence in the instant proceeding. Petitioner's second rationale would lead to the conclusion that evidence can be entered at the appeal stage of the proceeding ready for decision after the matter has been briefed, simply because such evidence was entered after a first Office action in a different proceeding; this is clearly untenable.

With respect to petitioner's third rationale - lack of prejudice to the third party requester - it is noted that it is not a persuasive argument to state that the actual delay is harmless. As stated in *Myers v. Feigelman*, 455 F.2d 586, 601, "the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the

purpose of the rules.”<sup>2</sup> Moreover, the public and the third party requester would be damaged by virtue of the delay in resolution of the substantial new question of patentability raised in the reexamination request.

With respect to petitioner’s fourth and final rationale - impact on the Office’s mandate for special dispatch - this is duly noted. However, the default balance between entry of evidence and administrability of Office reexamination proceedings, as discussed above, disfavors entry of evidence submissions after issuance of a RAN. Further, the impact on the Office’s mandate for special dispatch has been discussed above in this decision.

Having weighed all of the facts and circumstances pertinent to the petition, third party requester has failed to establish the existence of an extraordinary circumstance such that justice requires entry of the evidence submission filed with the petition. For that reason, relief may not be provided under § 1.183, and third party requester’s June 6, 2011 petition under § 1.183 is **dismissed**.

### CONCLUSION

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



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

August 17, 2011  
Kenfinal rej+ACP –after it/...

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<sup>2</sup> *Myers v. Feigelman*, 455 F.2d 586, 601, 172 USPQ 580, 584 (CCPA 1972). *Accord B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d at 1908 (stating “the mistake was the result of counsel’s failure to review the rule. Similarly rejected is petitioner’s argument that the lack of substantive injury or harm to respondent is a basis for granting an extension of time. As indicated in *In re Sivertz*, *supra*, 227 USPQ at 256, lack of injury to another party or to the public is not recognized as a sufficient basis for waiving provisions of the rules. “To do otherwise would defeat the purpose of the rule.” *Id.*”)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,199	06/17/2009	7428472	2483.091REX0/DKSC/RDC	1429
22909	7590	06/29/2011	EXAMINER	
BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			ART UNIT	PAPER NUMBER

DATE MAILED: 06/29/2011

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



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE N.W.  
WASHINGTON, D.C. 20005

Date:

**MAILED**

**JUN 29 2011**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001199  
PATENT NO. : 7428472  
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 29 2011

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD. : (For Patent Owner)  
1100 13<sup>TH</sup> STREET, N.W. :  
SUITE 1200 :  
WASHINGTON, DC 20005-4051 :

Mark W. Rygiel : (For Third Party Requester)  
STERNE, KESSLER, GOLDSTEIN :  
& FOX P.L.L.C. :  
1100 NEW YORK AVE., NW :  
WASHINGTON, DC 20005 :

*In re: Darley et al.* :  
*Inter Partes* Reexamination Proceeding : **DECISION ON PETITION**  
Control No.: 95/001,199 : **UNDER 37 CFR § 1.181**  
Deposited: June 17, 2009 :  
For: U.S. Patent No.: 7,428,472 :

This is a decision on a petition filed by the patent owner on March 1, 2011, entitled: "Petition to the Director Under 37 C.F.R.. § 1.181 To Order Withdrawal of an Action Closing Prosecution" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to withdraw an Action Closing Prosecution as being incomplete and premature.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,428,472 issued on September 23, 2008.
- A request for *inter partes* reexamination was filed and assigned control no. 95/001,199, receiving a filing date of June 17, 2009.
- *Inter partes* reexamination was ordered on July 30, 2009 and a non-final rejection was mailed on July 20, 2010.
- After the patent owner responded to the Office action the third party requester filed comments on October 20, 2010.
- An action closing prosecution was mailed January 7, 2011. In it, the examiner stated that certain proposed rejections introduced in the October 20 comments were not considered as they were not compliant with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3).
- On March 1, 2011, the third party requester filed the instant petition.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

#### II. CONTENT

\* \* \*

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. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

## DECISION

The third party requester ["petitioner"] argues that the action closing prosecution mailed January 7, 2011 ["ACP"] was premature and improper because it did not consider all of the proposed rejections from the October 20, 2010 comments submission ["Comments"]. The examiner did not consider some of the proposals because he stated they were non-compliant, and petitioner argues that if this was the case it should have received a Notice Re Defective Paper and an opportunity to correct the defects. The Director agrees.

Original claims 1-19 were amended, directly or by depending from an amended claim, and new claims 20-24 were added in patent owner's response filed September 20, 2010. In the ACP, the examiner stated that the original rejections from the Request were not adopted in view of patent owner's amendments. ACP pp. 5-6. The examiner then stated that the new prior art rejections proposed in the Comments were not compliant with the requirement of 35 U.S.C. § 311(b)(2)

and 37 CFR § 1.915(b)(3) to set forth the pertinency and manner of applying the cited art to every claim for which reexamination is requested. ACP pp. 6-10.

MPEP § 2666.05(II) states that when a third party requester submits new proposed rejections based on new prior art submitted under 37 CFR 1.948, the proposals must be in compliance with the guidelines set forth in MPEP § 2617. That is, the proposed rejections must comply with the requirements of 35 U.S.C. § 311(b)(2) and 37 CFR § 1.915(b)(3) to set forth the pertinency and manner of applying the art to the claims, which the examiner found were not satisfied by the proposals in this case. MPEP § 2666.05(II) goes on to say that when the submission of new prior art is not satisfactory the comments are improper and will be returned/expunged from the record. In such instance, the MPEP says, the third party will be notified and given a time period of 15 days to rectify and refile the comments. Any replacement comments must be strictly limited to and may not go beyond what was stated in the original returned/expunged submission.

Here, the examiner found the submission of new art was not satisfactory because the third party did not set forth the pertinency and manner of applying the art to the claims. Rather than notify the third party of the defect and give it 15 days to rectify and refile the Comments, the examiner merely declined to consider the Comments to the extent they were non-compliant. This goes against the practice as set forth in the MPEP, therefore the examiner's action was improper to the extent that he did not give the third party an opportunity to rectify and refile the Comments. Accordingly, the petition is granted and the ACP is hereby withdrawn.

#### Discussion of Requested Relief and Paper to Be Issued

Petitioner requests that, should the ACP be withdrawn as is done herein, that one of two papers be issued: (1) a Notice Re Defective Paper detailing the defects in the Comments and giving an opportunity for correction, or (2) a new Office action that affirmatively addresses and adopts/does not adopt each of the proposed rejections. The decision as to what action to issue is an examination decision, and is not properly before the Director in the supervisory role of the instant Decision. It is therefore up to the examiner whether to issue a new Office action or a Notice Re Defective Paper in response to this Decision. The Director does have the following comments on the discussion of the rejections found in the ACP.

The Comments proposed that claims 1-24 be rejected under 35 U.S.C. 112, second paragraph. Comments p. 8 at n. 5. The examiner in the ACP did not mention this proposal. While the proposal was made almost in passing with little explanation, it should either be deemed non-compliant or addressed on its merits. If an ACP is issued, the proposal should be addressed and either adopted or not adopted. If the examiner finds such proposal is not compliant, explanation should be given in a Notice Re Defective Paper.

As to the proposed prior art rejections, the examiner stated the following in explaining the non-compliance:

More specifically, with respect to the newly proposed rejection of claims 1-14, Third Party Requester did not set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

More specifically, with respect to the newly proposed rejection of claims 15-24, Third Party Requester did not set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. See for example, Third Party Requester's newly proposed rejection claim chart in pages 19,20,24, where it is indicated "see above" does not comply with the requirements of 35 U.S.C. 311(b)(2) and 37 CFR § 1.915(b)(3). The use of the term "see above" lacks the specificity as is required by statute and rule to fully comply as a proposed rejection to the claims.

ACP pp. 9-10.

The statement as to claims 1-14 is essentially a statement that "the proposals are not compliant because they are not compliant." It is noted that the Comments did *appear* to explain how the old art, Comments pp. 8-11, or how the new art (Damen, Whalen, or Fyfe), Comments pp. 12-16, reads on the amended limitations, and discussion of the old limitations is already found in the Request. In light of the lack of explanation, it is not clear why the proposals were found to be non-compliant. If the examiner again finds the proposals to be non-compliant as failing to set forth the pertinency and manner of applying the art, more explanation should be given in the Notice Re Defective Paper.

The statement as to claims 15-24 is that "see above" in the claim charts lacks specificity and renders the discussion non-compliant. The Director declines to adopt a *per se* rule that a third party cannot merely reference things already described in proposing a rejection. The limitations where the third party said "see above" are essentially the same as other limitations in the claim chart (they are performance of "second" steps during "a second" interval, where it was already explained how the "first" steps during "a first" interval were found in the references). It is feasible in such a case that "see above" might be sufficient in setting forth the pertinency and manner of applying the art; in other words, "see above" is not in itself enough to render the proposal non-compliant. If the examiner again finds the proposals to be non-compliant, more explanation should be given in the Notice Re Defective Paper.

Accordingly, the petition is granted.

### CONCLUSION

1. The petition filed March 1, 2011 is granted. The Action Closing Prosecution mailed January 7, 2011 is withdrawn.
2. In due course the examiner will issue either a Notice Re Defective Paper in *Inter Partes* Reexamination, or a new Office action. If the former, the examiner should more fully explain the reasons for non-compliance of the Comments, and grant the third party a time period of fifteen (15) days from the mailing date of such paper to rectify and refile the Comments. If the latter, the examiner should fully consider all of the rejections proposed in the Comments.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



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Irem Yucel  
Director, Central Reexamination Unit



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DALLAS, TX 75219

(For *inter partes* Requester)

JAN 06 2011

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ORRICK, HERRINGTON & SUTCLIFFE, LLP  
Attn: William H. Wright  
IP Prosecution Department  
4 Park Plaza, Suite 1600  
Irvine, CA 92614

(For *ex parte* Requester)

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

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: DECISION  
: ON  
: PETITION

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

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This is a decision on third party requester's July 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on July 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The June 28, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On February 12, 2008, the Office issued U.S. Patent No. 7,330,953 (the '953 patent) to Barth *et al.*
2. The '953 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-28 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claim 25 of the '953 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,369 (the '9369 proceeding).
5. On March 6, 2009, the Office issued an order granting the '9369 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claim 25 of the '953 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9369 *ex parte* reexamination proceeding expired on May 6, 2009.<sup>1</sup>
7. On May 19, 2009, the Office issued a first Office action on the merits in the '9369 *ex parte* reexamination proceeding.
8. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '953 patent. Therefore, the '953 patent is no longer involved in the ITC investigation.
9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-28) of the '953 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,201 (the '1201 proceeding).
10. On August 12, 2009, the Office issued an order granting the '1201 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '953 patent, claims 1-28, would be subject to reexamination.
11. On August 19, 2009, Patent Owner filed a response in the '9369 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.<sup>2</sup>
12. On October 16, 2009, patent owner filed a petition in the '9369 proceeding to prevent merger with the '1201 *inter partes* proceeding.
13. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1201 *inter partes* and '9369 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).
14. On February 3, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.

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

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

15. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision dismissing.
16. On April 2, 2010, patent owner timely filed responsive comments to the February 3, 2010 Office action, to include an amendment to the claims.
17. On April 30, 2010, third party requester timely filed responsive comments.
18. On June 28, 2010, the Office issued a decision dissolving the merger of the '1201 and the '9369 proceedings.
19. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.
20. On August 20, 2010, the Office issued a non-final Office action in the '1201 proceeding.
21. Also on August 20, 2010, the Office issued a final Office action in the '9369 proceeding.
22. On September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '1201 proceeding.
23. Also on September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '9371 proceeding.
24. On October 15, 2010, third party requester timely filed its comments in the '1201 proceeding.

## **DECISION**

### **I. Issues Raised and Relief Requested**

Third party requester contends that the Office's June 28, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

Third party requester requests the relief of vacatur of the June 28, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

## II. Discussion of Previous Petitions and Decisions

### a. The October 16, 2009 Patent Owner Petition and December 17, 2009 Office Decision

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "ex parte reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No "ex parte right" was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party's rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

### b. The February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes* participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an "expectancy" to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner's previous petition. Patent owner's February 5, 2010 petition

requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner's previous petition.

On June 28, 2010, the Office issued a decision granting patent owner's February 5, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

### III. Findings and Analysis

#### a. The June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment<sup>3</sup> and argues that the June 28, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

In response:

The June 28, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>4</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the '953 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the July 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination

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<sup>3</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

<sup>4</sup> Id.

proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>5</sup>

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '953 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '953 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.

2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>6</sup> 37 CFR 1.989(a),<sup>7</sup> MPEP 2686.01 I,<sup>8</sup> MPEP 2686.01 IV,<sup>9</sup> MPEP 2283,<sup>10</sup> and MPEP 2286.<sup>11</sup> See also "Revisions and Technical

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<sup>5</sup> See MPEP 2686.01 IV.

<sup>6</sup> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

<sup>7</sup> "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).

<sup>8</sup> "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.'"

<sup>9</sup> "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."

<sup>10</sup> "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.'"

<sup>11</sup> "[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the

Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

**b. The June 28, 2010 Office decision is not a violation of Requester’s Rights**

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

The dissolution decision does not alter the requester’s rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester’s rights upon filing of each request for reexamination. The Office’s merger of proceedings does not alter a party’s rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

**c. The June 28, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider

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

previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>12</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

#### **d. The June 28, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself.

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<sup>12</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 28, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>13</sup> In the present instance, as noted in the June 28, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The June 28, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

In response, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a

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<sup>13</sup> See MPEP 2686.01 IV.

reexamination request is filed, rather than doing a “quick” request, simply to “get” something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent.

Requester’s institution of two separate reexamination proceedings for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office’s decision whether or not to merge requester’s piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester’s assertions.

The June 28, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.<sup>14</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 28, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>15</sup> As to whether the subsequent request filed is anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

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<sup>14</sup> See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

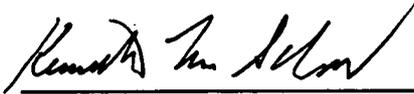
<sup>15</sup> See Petition at page 9, section E.

#### **IV. Summation**

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

#### **CONCLUSIÓN**

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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

1/5/11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,202	06/23/2009	7,207,949	03190.005200	2860
26191	7590	12/07/2010	EXAMINER	
FISH & RICHARDSON P.C. (TC) PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT	PAPER NUMBER

DATE MAILED: 12/07/2010

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



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FITZPATRICK, CELLA, HARPER & SCINTO  
1290 AVENUE OF THE AMERICAS  
NEW YORK, NY 10104-3800

Date:

**MAILED**

**DEC 07 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001202  
PATENT NO. : 7207949  
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 *Inter Partes* Requester)

**MAILED**

**DEC 07 2010**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,202  
Filed: June 23, 2009  
For: U.S. Patent No. 7,207,949

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:  
: **CENTRAL REEXAMINATION UNIT**  
: **DECISION**  
: **DISMISSING**  
: **PETITION**  
:

This is a decision on third party requester's September 30, 2010 petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

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

The petition is dismissed.

**FEES**

The petition fee of \$400 for third party requester's petition under 37 CFR 1.183 pursuant to 37 CFR 1.17(f) was charged to Deposit Account No. 50-3939 on October 1, 2010.

**REVIEW OF THE RELEVANT FACTS**

1. On April 24, 2007, United States Patent Number 7,207,949 (the '949 patent) issued.
2. On June 23, 2009, a request for *inter partes* reexamination of all the claims (1-38) of the '949 patent, assigned Reexamination Control No. 95/001,202 (the '1202 proceeding), was filed by a third party requester.
3. On August 14, 2009, the Office issued an order granting *inter partes* reexamination and an Office action on the merits in the '1202 proceeding.
4. On October 14, 2009, patent owner filed an "AMENDMENT IN REPLY TO THE ACTION OF AUGUST 14, 2009," which amended original claim 6, added new claims 39-204 (166 new claims) and retained original claims 1-38.

5. On November 13, 2009, third party requester filed a "RESPONSE TO PATENT OWNER'S AMENDMENT," which included a 39 page remarks section, a four page affidavit and 138 pages of claim charts.
6. Concurrently, on November 13, 2009, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).
7. On April 2, 2010, the Office issue a decision granting third party requester's November 13, 2010 petition, giving requester 123 additional pages due to patent owner's February 18, 2010 amendment that added 166 new claims.
8. On June 16, 2010, the Office issued a non-final Office action on the merits.
9. On June 25, 2010, the Office issued a corrected non-final Office action on the merits.
10. On August 25, 2010, patent owner timely filed a response to the outstanding Office action.
11. On September 30, 2010, third party requester filed a "RESPONSE TO PATENT OWNER'S AMENDMENT," which included a 33 page remarks section, and 159 pages of claim charts.<sup>1</sup>
12. Concurrently, on September 30, 2010, third party requester filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.183" requesting waiver of the page limit requirement of 37 CFR 1.943(b).

## 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.

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<sup>1</sup> Requester's response is timely as patent owner's response was erroneously served upon requester at a previous correspondence address, and actually received by requester on August 31, 2010.

MPEP 2666.50 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.

The Notice will set a period of 15 days from the date of the notice to respond. If no response is received, the improper patent owner submission will not be considered. If the submission was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding is either terminated pursuant to 37 CFR 1.957(b) or limited pursuant to 37 CFR 1.957(c). Any previously submitted third party comments in response to this improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules.

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.

### **Third Party Requester's Petition under 37 CFR 1.183**

Third party requester's petition under 37 CFR 1.183, requests waiver of the 50-page limit of 37 CFR 1.943(b) for the concurrently filed requester comments, including five claim charts appendices that are already of record, but with italicized revisions to reflect the most recent amendments to the claims submitted by patent owner.

Requester has concluded that the arguments section of requester's comments and the revised supplemental claim chart appendices, exceed the 50-page limit set forth in 37 CFR 1.943(b).

Only those pages of third party requester's September 30, 2010 comments upon which argument appears will be included against the page limit count. See MPEP 2667(I)(A)(2). The comments portion is 33 pages in length and includes - a cover sheet, a signature page and a two page summary listing of all proposed rejections, which are exclusive of argument. Therefore the comments contain a total of 31 pages of argument that are counted against the 50 page limit of 37 CFR 1.943(b). Pursuant to MPEP 2667(I)(A)(2), claim charts applying the art to the claims are not excluded from the appeal brief 30-page limit required by 37 CFR 1.943(c). *A fortiori* claim charts applying the art to the claims in a comments submission pursuant to 37 CFR 1.947

likewise are not excluded from the even greater 50-pages authorized by 37 CFR 1.943(b). Therefore, the September 30, 2010 37 CFR 1.947 response's five claim chart appendices are included in the regulatory page count. The September 30, 2010 response under 37 CFR 1.947 contains 159 pages of claim chart appendices having the same content as the claim charts that are already of record, except for italicized revisions to reflect the most recent amendments to the claims submitted by patent owner. Accordingly, Requester's response totals 190 pages which exceeds in the regulatory 50-page limit set forth in 37 CFR 1.943(b) by 140 pages.

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In this instance, third party requester has not made an adequate showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b). The requester has not provided an explanation of how the submitted response economizes, excludes extraneous material, and is arranged so as not to repeat information already of record. Requester notes that efforts to be as brief as possible were taken to respond to patent owner's amendment resulting in a 31 page arguments section in the comments, but does not justify the wholesale resubmission of the claim charts where approximately only 33 claims were amended, many in a *de minimus* manner for parallel claims of the various claim sets, e.g. the insertion of the claim term "pivotable." Such could be explained by a representative set of only claims changed, and description of parallel changes made in the other claims. Requester notes that Office guidance indicates that the best way to provide a limitation-by-limitation patentability analysis of claims is by using claim charts; however, requester has already done so in the November 13, 2009 submission.

Waiver of the rules under 37 CFR 1.183 may be suspended in an *extraordinary situation when justice requires*. The wholesale repetition of over 100 pages of information already of record when twenty-one pages<sup>2</sup> is available to present a limitation-by-limitation analysis of only the newly added limitations does not present an *extraordinary situation* under 37 CFR 1.183 to justifying suspension of the rules. Therefore, justice does not require suspension of the rules. Accordingly, the present petition is DISMISSED.

#### ADDITIONAL DISCUSSION/GUIDANCE

Requester's September 30, 2010 submission is improper. See MPEP 2667, Part I.A.2. The copy of the September 30, 2010 submission was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Therefore, the IFW copy of the entire September 30, 2010 comments submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the September 30, 2010 submission by patent owner exceeded the 50-page limit established by 37 CFR 1.943(b). However, from the record it is apparent that requester's submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, requester may, within 15 days from the date of this notice, exercise one of the following two options:

---

<sup>2</sup> The difference between the regulatory amount of 50-pages and the 31 pages of arguments currently submitted.

1. Submit re-drafted remarks that do not exceed the 50 page limit; or,
2. File a copy of the original remarks with pages redacted to satisfy the page limit requirement.

**This 15-day period for reply is not extendable.**

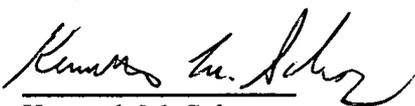
Requester is reminded that, under the requirements of 37 CFR 1.903, any paper submitted pursuant to this Notice must be served on the patent owner.

If no response from requester is received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from requester.

Requester is advised that submissions should be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

#### CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is dismissed.
2. Requester's September 30, 2010 comments submission is an improper paper and will not be considered. The comments submission is being expunged by being closed in the '1202 proceeding's Image File Wrapper (IFW) and marking "non-public." The September 30, 2010 comments submission will not constitute part of the record of the present reexamination proceeding.
3. A copy of this decision will be made of public record.
4. 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  
Office of the Deputy Commissioner  
for Patent Examining Policy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,203	06/24/2009	7410272	27451C-014100US	4902
34026	7590	08/13/2010	EXAMINER	
JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES, CA 90071			ART UNIT	PAPER NUMBER

DATE MAILED: 08/13/2010

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

Date:

**MAILED**

**AUG 13 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001203  
PATENT NO. : 7410272  
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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ALEXANDRIA, VA 22313-1450  
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Jones Day  
555 South Flower Street  
Fiftieth Floor  
Los Angeles, CA 90071

(For Patent Owner)

**MAILED**

**AUG 13 2010**

**CENTRAL REEXAMINATION UNIT**

Townsend and Townsend and Crew LLP  
Two Embarcadero Center  
8<sup>th</sup> Floor  
San Francisco, CA 94111

(For Requester)

In re Christopher Lee Halasz  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,203  
Filed: June 24, 2009  
For: U.S. Patent No. 7,410,272

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

This is a decision on the July 19, 2010 patent owner petition under 37 CFR 1.137(b) to accept an unintentionally delayed response to Office action and revive the present terminated reexamination proceeding ("the July 19, 2010 patent owner petition to revive").

The July 19, 2010 patent owner petition to revive is before the Office of Patent Legal Administration (OPLA) for consideration.

The July 19, 2010 patent owner petition to revive is **granted**.

The July 26, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.

**STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

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

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

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

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

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

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

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

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

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

\*  
\*

(d) *Terminal disclaimer*.

\*  
\*

- (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

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

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

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

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed

to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

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

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

**MPEP 2668 provides, in pertinent part:**

II. PETITION BASED ON UNINTENTIONAL DELAY

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

\*  
\*

IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS

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

**DECISION**

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

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

Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the October 14, 2009 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The October 14, 2009 Office action set a two-month period for response, and a one-day extension to the two-month

period was granted by a decision dated February 19, 2010. A proper response to the October 14, 2009 Office action was not filed until January 14, 2010, which was untimely. However, for the purpose of evaluating whether the July 19, 2010 patent owner petition to revive is a grantable petition, the submission of the January 14, 2010 Patent Owner's Response To The October 14, 2009 Office Action satisfies item (1).<sup>1</sup>

A petition fee and a proper statement under 37 CFR 1.137(b)(3) have been submitted with the July 19, 2010 patent owner petition to revive, which satisfy items (2) and (3), respectively.

Accordingly, the July 19, 2010 patent owner petition to revive is **granted**.

The July 26, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.

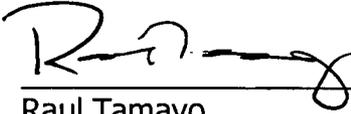
### CONCLUSION

1. The July 19, 2010 patent owner petition under 37 CFR 1.137(b) is **granted**.
2. The July 26, 2010 Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) based on the termination of prosecution for failure to file an appropriate timely response is **withdrawn**.
3. Patent owner's response to the October 14, 2009 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947. It is noted that third party requester filed comments to patent owner's response as per 37 CFR 1.947 on February 16, 2010.
4. Jurisdiction over this reexamination proceeding is being returned to the Central Reexamination Unit, Art Unit 3992, for treatment of the January 14, 2010 Patent Owner's Response To The October 14, 2009 Office Action and the February 16, 2010 Third Party Comments After Patent Owner Response.

---

<sup>1</sup> This decision is not directed to the persuasiveness and propriety of the arguments presented in the January 14, 2010 Patent Owner's Response To The October 14, 2009 Office Action as to each of the rejections set forth in the October 14, 2009 Office action; such is the examiner's province.

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



---

Raul Tamayo  
Legal Advisor  
Office of Patent Legal Administration

August 12, 2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,203	06/24/2009	7410272	27451C-014100US	4902
34026	7590	09/03/2010	EXAMINER	
JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES, CA 90071			ART UNIT	PAPER NUMBER

DATE MAILED: 09/03/2010

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TOW EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

Date:

**MAILED**

**SEP 03 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001203  
PATENT NO. : 7410272  
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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JONES DAY : (For Patent Owner)  
555 SOUTH FLOWER STREET :  
FIFTIETH FLOOR :  
LOS ANGELES, CA 90071 :

**MAILED**

**SEP 03 2010**

Roger D. Wylie : (For Third Party  
TOWNSEND AND TOWNSEND : Requester)  
AND CREW LLP :  
TWO EMBARCADERO CENTER :  
EIGHTH FLOOR :  
SAN FRANCISCO, CA 94111 :

**CENTRAL REEXAMINATION UNIT**

*In re*: Halasz :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/001,203 : UNDER 37 CFR § 1.181  
Deposited: June 24, 2009 :  
For: U.S. Patent No.: 7,410,272 :

This is a decision on a petition filed by the patent owner on August 12, 2010, entitled  
"PETITION UNDER 37 C.F.R. § 1.181 BY PATENT OWNER SEEKING SUPERVISORY  
REVIEW OF A DECISION BY THE REEXAMINATION DIRECTOR"

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to  
reconsider a previous decision by the Director on a 1.181 petition.

The petition is before the Director of the Central Reexamination Unit. The petition is dismissed  
as moot.

### REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,410,272 issued on August 12, 2008.
- A request for *inter partes* reexamination was filed on June 24, 2009 and assigned control no. 95/001,203. Reexamination was ordered on July 24, 2009.
- A non-final rejection was mailed on or about October 14, 2009.
- On December 10, 2009, the Office received a request by patent owner for a two month extension of time to respond to the Office action.
- The Office dismissed the petition for extension of time in a letter mailed December 29, 2009.
- On January 14, 2010, patent owner filed a request for reconsideration of the dismissal along with a response to the Office action
- On February 19, 2010, the Office responded to patent owner's request for reconsideration, granting a one day extension of time.
- On April 15, 2010, patent owner filed a petition for the Director to reconsider the extension of time request.
- On June 24, 2010, the Director denied the April 15<sup>th</sup> petition, stating only the one day extension would be granted.
- A petition to revive under 37 CFR § 1.137(b) was filed July 19, 2010.
- A Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) was mailed July 26, 2010.
- On August 12, 2010 the instant petition was filed.
- On August 13, 2010 the Office granted the petition to revive and withdrew the NIRC.

### DECISION

Patent owner ("Petitioner") requests review of the Director's decision mailed June 24, 2010, upholding the Supervisory Examiner's denial of additional time to respond to the previous Office action. Petitioner additionally requests on page 10 of the petition, as an alternative ground of relief, that its petition to revive this proceeding be granted. The Office has already granted the petition to revive in a Decision mailed August 13, 2010. As the Office has already granted one of the requested grounds of relief, the instant petition is dismissed as moot.

### CONCLUSION

1. The petition filed August 12, 2010 is dismissed as moot as requested relief has already been granted.
2. The proceeding has been revived in the decision mailed August 13, 2010. In accordance with that decision, the January 14, 2010 response has been entered and jurisdiction has been returned to the examiner for treatment of that response and the associated comments.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-3838.



---

Gregory A. Morse  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,203	06/24/2009	7410272	27451C-014100US	4902
34026	7590	10/07/2010	EXAMINER	
JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES, CA 90071			ART UNIT	PAPER NUMBER

DATE MAILED: 10/07/2010

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SAN FRANCISCO, CA 94111-3834

Date:

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**OCT 07 2010**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NO. : 95001203  
PATENT NO. : 7410272  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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

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

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

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



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OCT 07 2010

Jones Day  
555 South Flower Street  
Fiftieth Floor  
Los Angeles, CA 90071

(For Patent Owner) **CENTRAL REEXAMINATION UNIT**

Roger D. Wylie  
Townsend and Townsend and Crew LLP  
Two Embarcadero Center  
Eighth Floor  
San Francisco, CA 94111-3834

(For Third Party Requester)

*In re* Halasz  
*Inter Partes* Reexamination Proceeding  
Control No. 95/001,203  
Filed: June 24, 2009  
For: U.S. Patent No. 7,410,272

:  
: **DECISION**  
: **DISMISSING PETITION**  
: **UNDER § 1.183**  
:

This is a decision on the August 12, 2010 patent owner petition entitled "PETITION UNDER 37 CFR § 1.183."

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

The petition under 37 C.F.R. § 1.183 is **dismissed**.

**DECISION**

Patent owner petitions for entry of patent owner's January 14, 2010 response to the October 14, 2009 Office action. In a decision mailed on August 13, 2010, the Office of Patent Legal Administration granted a petition for revival of the present proceeding, and directed that the January 14, 2010 patent owner response be entered. Therefore, the instant patent owner petition is **dismissed as moot**.

**CONCLUSION**

1. The patent owner petition is **dismissed as moot**.

2. A copy of this decision will be made of record in the reexamination file.
3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan  
Legal Advisor  
Office of Patent Legal Administration

October 6, 2010  
Ken pet 8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,205 <b>96009370</b>	07/01/2009	7360050	2805.002REXB	4486
26111	7590	01/06/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 01/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-6-11

David M. O'Dell

HAYNES AND BOONE, LLP, IP SECTION

2323 Victory Avenue, Suite 700

Dallas, TX 75219

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

REEXAMINATION CONTROL NO. : 95001205 → 901009370

PATENT NO. : 7360050

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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

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

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

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



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

HAYNES & BOONE, LLP IP SECTION (For *inter partes* Requester)  
2323 VICTORY AVENUE  
SUITE 700  
DALLAS, TX 75219

ORRICK, HERRINGTON & SUTCLIFFE, LLP (For *ex parte* Requester)  
Attn: William H. Wright  
IP Prosecution Department  
4 Park Plaza, Suite 1600  
Irvine, CA 92614

<i>In re Barth et al.</i>	:
<i>Inter partes</i> Reexamination Proceeding	:
Control No.: 95/001,205	:
Filed: July 1, 2009	:
For: U.S. Patent No. 7,360,050	: DECISION
	: ON
<i>In re Barth et al.</i>	: PETITION
<i>Ex Parte</i> Reexamination Proceeding	:
Control No.: 90/009,370	:
Filed: December 23, 2008	:
For: U.S. Patent No. 7,360,050	:

This is a decision on third party requester's July 21, 2010 petition entitled "THIRD PARTY REQUESTER'S PETITION FOR RECONSIDERATION OF DECISION DISSOLVING MERGER OF REEXAMINATION PROCEEDINGS AND FOR REINSTITUTION OF THE PROSECUTION RECORD".

The fee set forth in 37 CFR 1.17(f) for the petition is \$400, which was charged to requester's Deposit Account No. 08-1394 on July 22, 2010, pursuant to the authorization for same in requester's EFS-WEB fee transmittal.

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

## SUMMARY

The petition is **dismissed**.

As discussed below, requester chose to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain of the *ex parte* reexamination treatment of the first proceeding. Requester did so despite the fact the MPEP points out (see below in the body of this decision) that the Office retains absolute discretion regarding whether or not to merge, should an *inter partes* reexamination request be subsequently filed. The subsequent filing of an *inter partes* request for a reexamination proceeding does not alter the fact that the requester filed an initial request as a request for an *ex parte* reexamination proceeding. Therefore, it was requester that determined that the issues raised in first request would be given *ex parte* reexamination treatment. The Office's decision has not impacted upon any rights or expectations of the requester. Requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and thus, now, has no basis to complain that *inter partes* rights are not being afforded.

The June 28, 2010 merger dissolution decision has not been shown to be inappropriate; rather, the merger dissolution decision maintains the requester's and the patent owner's rights as to both the *ex parte* and *inter parte* reexamination proceedings. Merger and dissolution of the merger did not alter any party rights that were established in accordance with the relevant regulations and statutes, based on the filings. Further, the authority of the Office to dissolve (demerge, or sever) a merged proceeding at the point when it is found to frustrate/impede the Office's ability to conduct the reexamination proceedings in accordance with the Office's statutory mandate of special dispatch is no different than the Office's authority to merge when it is found to further/facilitate the Office's ability to conduct the reexamination proceedings with special dispatch.

## REVIEW OF FACTS

1. On April 15, 2008, the Office issued U.S. Patent No. 7,360,050 (the '050 patent) to Barth *et al.*
2. The '050 patent is subject to litigation in the United States District Court for the District of Northern California, in *Rambus Inc. v. Nvidia Corp.*, {Civil Action No. 3:08-cv-3343-SI}. The initial complaint was filed July 10, 2008. Based upon the record, patent owner is seeking to enforce at least one of claims 1-31 against the requester in the litigation.
3. On November 6, 2008, an International Trade Commission (ITC) action was filed. The ITC investigation is docketed as *Certain Semiconductor Chips Having Synchronous Random Access Memory Controllers and Products Containing Same, Including Graphics Cards and Motherboards*, Docket No. 2637.

4. On December 23, 2008, a request for *ex parte* reexamination of claims 29 and 31 of the '050 patent was filed by third party requester, NVIDIA Corporation. The request was assigned Control No. 90/009,370 (the '9370 proceeding).
5. On March 16, 2009, the Office issued an order granting the '9370 request for *ex parte* reexamination and setting a two month time period for a patent owner's statement. The order stated that claims 29 and 31 of the '050 patent, would be subject to reexamination.
6. The time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '9370 *ex parte* reexamination proceeding expired on May 16, 2009.<sup>1</sup>
7. On May 19, 2009, the Office issued a first Office action on the merits in the '9370 *ex parte* reexamination proceeding.
8. On June 22, 2009, the ITC granted patent owner's motion for partial termination of proceedings with respect to the '050 patent. Therefore, the '050 patent is no longer involved in the ITC investigation.
9. On June 23, 2009, a request for *inter partes* reexamination of all the claims (claims 1-31) of the '050 patent was filed by the same third party requester (NVIDIA Corporation). The request was assigned Control No. 95/001,205 (the '1205 proceeding).
10. On August 13, 2009, the Office issued an order granting the '1205 request for *inter partes* reexamination and stating that a first action on the merits would be issued in due course. The order stated that all the claims of the '050 patent, claims 1-31, would be subject to reexamination.
11. On August 19, 2009, Patent Owner filed a response in the '9370 *ex parte* reexamination proceeding. The response did not amend, cancel or add new claims.<sup>2</sup>
12. On October 16, 2009, patent owner filed a petition in the '9370 proceeding requesting prevention of merger with the '1205 *inter partes* proceeding.
13. On December 17, 2009 the Office issued a decision dismissing patent owner's October 16, 2009 petition requesting prevention of merger of the '1205 *inter partes* and '9370 *ex parte* reexamination proceedings and merged the reexamination proceedings (the merged proceeding).

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

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

14. On February 3, 2010, the Office issued a non-final Office action on the merits in the merged proceeding.
15. On February 5, 2010, patent owner filed a petition requesting reconsideration of the Office's December 17, 2009 decision.
16. On April 2, 2010, patent owner timely filed responsive comments to the February 3, 2010 Office action, to include an amendment to the claims.
17. On May 3, 2010, third party requester timely filed responsive comments.<sup>3</sup>
18. On June 28, 2010, the Office issued a decision dissolving the merger of the '1205 and the '9370 proceedings.
19. On July 21, 2010, third party requester filed the present petition, requesting reconsideration of the June 28, 2010 decision.
20. On August 20, 2010, the Office issued a non-final Office action in the '1205 proceeding.
21. Also on August 20, 2010, the Office issued a final Office action in the '9370 proceeding.
22. On September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '1205 proceeding.
23. Also on September 20, 2010, patent owner timely filed a response to the August 20, 2010 Office action in the '9370 proceeding.
24. On October 15, 2010, third party requester timely filed its comments in the '1201 proceeding.

## **DECISION**

### **I. Issues Raised and Relief Requested**

Third party requester contends that the Office's June 28, 2010 decision is: (1) Arbitrary, capricious and an abuse of discretion; (2) A violation of third party requester's rights; (3) impermissible substantive rule making; (4) Contrary to public and Office policy; and (5) contrary to special dispatch.

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<sup>3</sup> Third party comments were timely in accordance with 37 CFR 1.7(a) as May 2, 2010 was a Sunday.

Third party requester requests the relief of vacatur of the June 28, 2010 decision, to thereby restore the merged proceeding and to reinstate the prosecution history of the merged proceeding. If the Office does not grant the relief requested, third party requester requests the Office issue a final agency action.

## **II. Discussion of Previous Petitions and Decisions**

### **a. The October 16, 2009 Patent Owner Petition and December 17, 2009 Office Decision**

In the original petition challenging merger, patent owner asserted: (1) The filing of an *ex parte* reexamination request followed by the filing of an *inter partes* reexamination request on the same patent, is precluded by statute, 35 U.S.C. 317(a); (2) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings denies patent owner of "ex parte reexamination rights"; and (3) Requester's reexamination filing pattern combined with a merger of the two reexamination proceedings expands the requester's *inter partes* rights. Patent owner's original petition requested the remedies of: (1) Vacatur of the merged proceeding; (2) Demerger of the *inter partes* and *ex parte* reexamination proceedings and suspension of the *inter partes* reexamination proceeding; or (3) Waiver of 37 CFR 1.989(b) to permit patent owner to exercise the *ex parte* interview right, if the *inter partes* and *ex parte* reexamination proceedings were neither vacated nor demerged.

The Office issued a decision dismissing patent owner's original petition challenging merger. The decision pointed out that: (1) the filing of an *ex parte* reexamination proceeding did not violate nor circumvent 35 U.S.C. 317(a), as an *ex parte* reexamination proceeding was not an *inter partes* reexamination proceeding and that 35 U.S.C. 302 permits any member of the public the right to file a request for *ex parte* reexamination on an issued patent, even if the member of the public is the requester in an *inter partes* proceeding for the same patent; (2) No "ex parte right" was being denied by the merger, e.g. no statutory right to interview exists, and therefore, merging *ex parte* and *inter partes* reexamination proceedings could not divest patent owner of a right that did not exist; and (3) Neither party's rights were altered. Accordingly, the decision found that patent owner had not established on the record a basis to justify the relief requested and the petition was dismissed.

### **b. The February 5, 2010 Patent Owner Petition and June 28, 2010 Office Decision**

On February 5, 2010, patent owner filed a petition requesting reconsideration of the December 17, 2009 decision refusing to dissolve the merger. Patent owner asserted in the February 5, 2010 petition: (1) Merger of the present *ex parte* and *inter partes* reexamination proceedings violates 35 U.S.C. 305 and 37 C.F.R. § 1.501 *et seq.*; (2) Neither statute nor the rules permit merger of the present *ex parte* and *inter partes* reexamination proceedings; (3) Merger of the present *ex parte* and *inter partes* reexamination proceedings gives the *ex parte* third party requesters *inter partes*

participation in an *ex parte* reexamination, contrary to 37 C.F.R. § 1.989(b); (4) The Office has ignored the statutory restrictions that govern *ex parte* reexamination in an effort to conduct the *inter partes* reexamination with special dispatch; (5) Merger of an *ex parte* and *inter partes* reexamination proceeding deprives patent owner of an “expectancy” to conduct an interview on the merits as to issues raised in the *ex parte* proceeding; and (6) A blanket reassertion of all arguments raised in patent owner’s previous petition. Patent owner’s February 5, 2010 petition requested the remedies of: (1) Reversal of the decision to merge the present *ex parte* and *inter partes* proceedings; (2) Staying the merged proceeding until the present petition is decided; (3) Staying the *inter partes* proceeding upon dissolution of the merged proceeding; (4) Prosecution of the *ex parte* and *inter partes* proceedings in parallel upon dissolution of the merged proceeding; and (5) A blanket request for all requests for relief made in patent owner’s previous petition.

On June 28, 2010, the Office issued a decision granting patent owner's February 5, 2010 petition, dissolving the merger in accordance with special dispatch and based upon the specific facts and circumstances of the proceedings.

### III. Findings and Analysis

#### a. The June 28, 2010 Office decision is not Arbitrary, Capricious and an Abuse of Discretion

Requester cites to an Office Federal Register rulemaking preamble comment<sup>4</sup> and argues that the June 28, 2010 decision overturns long standing Office policy regarding merger and is without any rational connection between the facts found and the decision rendered.

In response:

The June 28, 2010 decision to dissolve the merged proceeding is based upon factually distinct circumstances that are significantly different from the scenario which the cited Federal Register general policy comment is based upon.<sup>5</sup> The present circumstance involves the same third party requester first filing an *ex parte* reexamination request for the ‘050 patent on a limited number of claims; then later filing an *inter partes* reexamination proceeding for the same patent, but on all the claims. The later request uses the same prior art reference from the first filed *ex parte* proceeding, but in a more expansive manner, while also using additional prior art references. The cited comment by requester in the July 21, 2010 petition addressed a circumstance where an *inter partes* reexamination proceeding was the prior ordered proceeding, was under active

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<sup>4</sup> Third party requester petition at page 3, footnote 1 citing Federal Register, Vol. 65, No. 67 at 18154, 18164, 18168-69 (2000).

<sup>5</sup> Id.

examination, and a requester newly discovered relevant information that could not be admitted directly into the *inter partes* reexamination proceeding via 37 CFR 1.948.

Under circumstances where an *inter partes* request has already been ordered, the filing of a second *inter partes* request by the *inter partes* requester is proscribed by statute. No such proscription exists as to subsequent reexamination filings, when an *ex parte* proceeding is first filed and ordered. Nor is there any requirement upon the Office to merge multiple reexamination proceedings on the same patent. Previous Office decisions are not binding on the Office with regard to merger, since the decision to merge is addressed on a case-by-case basis.<sup>6</sup>

In this instance:

Requester initiated reexamination proceedings before the Office, choosing to file an *ex parte* request based upon an SNQ analysis of the Gillingham reference relative to only a few of the claims in the '050 patent. Subsequently requester filed an *inter partes* request providing an SNQ analysis of Gillingham reference relative to a substantial number of the claims in the '050 patent. There are two possibilities here as to what requester was aware of when it filed the first request:

1) If, at the time of filing the first request, requester was unaware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for the first request, requester should have filed the first request as an *inter partes* request. Requester chose not to do so.

2) If, at the time of filing the first request, requester was aware of the issues of patentability that were newly presented in the second request (for *inter partes* reexamination) and requester wanted *inter partes* rights for all issues of patentability then requester could have delayed the filing of the *ex parte* request for reexamination until the SNQ analysis was more fully developed. Given that the rules and the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not reasonably rely upon the merger of two different types of proceedings in the hope of obtaining *inter partes* participation for all issues raised in both requests. See 37 CFR 1.565(c),<sup>7</sup> 37 CFR 1.989(a),<sup>8</sup> MPEP 2686.01 I,<sup>9</sup> MPEP

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<sup>6</sup> See MPEP 2686.01 IV.

<sup>7</sup> "If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will **usually** be merged and result in the issuance and publication of a single certificate under § 1.570. . . ." (Emphasis added).

<sup>8</sup> "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).

<sup>9</sup> "Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (**in its discretion**) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole

2686.01 IV,<sup>10</sup> MPEP 2283,<sup>11</sup> and MPEP 2286.<sup>12</sup> See also “Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

In summary, requester made the conscious choice to present the issues in the first request as a request for *ex parte* reexamination, which does not provide requester with *inter partes* rights. Thus requester, at the time of filing the *ex parte* request, had no expectancy of any other rights, and has no basis to complain for obtaining *ex parte* reexamination treatment of the first proceeding.

**b. The June 28, 2010 Office decision is not a violation of Requester’s Rights**

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

The dissolution decision does not alter the requester’s rights for each reexamination proceeding as filed by the requester. To the contrary, the dissolution decision retains the *status quo* of requester’s rights upon filing of each request for reexamination. The Office’s merger of proceedings does not alter a party’s rights, as merger is an administrative consolidation of cases with common issues to further special dispatch and not a merger of legal claims nor a joinder of parties. The third party requester, upon filing of an *ex parte* request had no expectation of any *inter partes* rights as to the *ex parte* request issues. If third party requester wanted *inter partes* reexamination participation rights for the issues raised in the *ex parte* proceeding, then third party requester should have been filed an *inter partes* request raising the issues presented, instead of filing an *ex parte* request. Given that the MPEP makes clear that merger is within the sole discretion of the Office, the requester could not rely upon merger of the two proceedings as a vehicle to attempt to obtain *inter partes* participation on issues raised in the *ex parte* request.

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discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with ‘special dispatch.’”

<sup>10</sup> “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.”

<sup>11</sup> “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.’”

<sup>12</sup> “[T]he proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination with ‘special dispatch.’”

**c. The June 28, 2010 Office decision is not Substantive Rule Making**

Requester has asserted the Office cannot dissolve merged reexamination proceedings due to the absence of any positive rule that permits the dissolution of previously merged reexamination proceedings.

The discretion to merge or not merge inherently includes the discretion to demerge in accordance with special dispatch. Furthermore, the Office retains the discretion to reconsider and vacate any previous decision. Petitioner implicitly recognizes this Office discretion to reconsider previously made decisions directed to the merger issue, by the filing of the present petition. Petitioner's listing of several rights that are altered by the decision to demerge is untenable, as the act of a consolidation of cases for administrative convenience does not alter the rights of the parties. Petitioner alleges that proof of the existence of substantive rule making by dint of the dissolution decision occurred because the following rights were altered: (1) The patent owner right to an interview; (2) Third party requester's right to comment; and (3) Third party requester's right to appeal. Petitioner is in error, as none of the alleged rights were altered by either merger or the dissolution of the merger. Merger and dissolution of the merger left unchanged the 'rights' of all parties as their 'rights' were established in accordance with the relevant statutes before upon filing of the proceedings.

More significantly, withdrawal of an action by the Office is not substantive rule making, even if it does affect rights. The Office can always reconsider a position and restore an action to pre-action status. If the Office withdraws an Office action allowing claims, an applicant's (or patent owner's) rights as to the invention of that claim are altered; yet, clearly, no substantive rule making is involved. In so far as the petitioner argues that the dissolution of the merger in this instance is substantive rule making (and thus improper) due to rights it altered, then the original merger would also have altered those same rights from their pre-merger status and thus would also be substantive rule making (and thus improper). This would void the original merger, and the parties would be back to the pre-merger status anyway.<sup>13</sup>

In conclusion, the decision to demerge is not tantamount to substantive rule making. Both merger and dissolution decisions are purely administrative procedural determinations regarding the propriety of consolidating related proceedings to facilitate the Office's statutory mandate of special dispatch.

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<sup>13</sup> It is the Office's position that merger determinations are not substantive rule making. The point being made here is that even if a merger decision could be argued to be substantive rule making, that would mean the original merger decision also constituted substantive rule making. Thus, petitioner could not obtain the benefits of merger, because the Office would then be required to dissolve the merger, and the petition could not be granted.

**d. The June 28, 2010 Office decision is not Contrary to Special Dispatch**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to special dispatch.

All determinations of merger are made on a case-by-case basis. In the present instance combining the two proceedings would require constant monitoring of the rights of each party due to the nature of the issues raised by each party in the various filings, coupled with decision on petitions and oppositions related to what the merger does or does not permit (as has been the case thus far). Stated another way, the confusion caused by the nuances of the issues raised by the parties in the present proceeding gives rise to a plurality of challenges by each party in the merged proceeding to the point that special dispatch is frustrated, e.g. the issue of merger itself. Contrary to requester's concerns regarding the decision's restarting the proceedings to a point from a year ago, since dissolution both proceedings have advanced without complication. Furthermore, inconsistencies can be resolved and prevented in accordance with the procedural guidance set forth in the June 28, 2010 dissolution decision along with current Office policy, practice and procedure regarding issuance of a reexamination certificate for a patent while another reexamination proceeding on the same patent is still pending. As both proceedings have substantially advanced without complication and special dispatch would not be served by remerging the proceedings and re-opening prosecution.

Finally, the Office is in the best position to determine what will facilitate the Office's discharge its statutory duty of special dispatch in accordance with 35 U.S.C. §§ 305 and 314(c), since the Office best knows its inner workings. As noted previously, the Office has sole discretion regarding issues of merger. It is appropriate that the Office has sole discretion in this matter, since it is the Office that is charged by statute with duty of special dispatch – not the parties. In the present proceedings, the most efficient manner to address the issues raised in each request is to not merger. Previous Office decisions, are not binding on the Office with regard to merger, as the decision to merge is addressed on a case-by-case basis.<sup>14</sup> In the present instance, as noted in the June 28, 2010 decision, and for the reasons discussed above, the Office determined that special dispatch was best served by dissolution of the merger and requester's arguments to the contrary are found non-persuasive.

**e. The June 28, 2010 Office decision is not Contrary to Public and Office policy**

Requester has asserted the Office cannot dissolve merged reexamination proceedings as dissolution of merged proceedings runs contrary to policy considerations that keep reexamination proceedings from being slowed. Requester asserts that policy considerations dictate that merger is to be effected when multiple, co-pending proceedings on the same patent exist.

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<sup>14</sup> See MPEP 2686.01 IV.

In response, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since, for the reasons stated above in the previous section, the decision best achieves the special dispatch mandated by 35 U.S.C. §§ 305 and 314(c), in resolving the substantial new questions raised for both proceedings. The realization that the proceedings can be resolved most efficiently as separate proceeding serves the public policy of resolving the substantial new questions raised for both proceeding as rapidly as possible.

In addition, the June 28, 2010 dissolution decision is in accord with and not contrary to public policy, since the decision encourages the comprehensive filing of a single *inter partes* reexamination request instead of the piecemeal filing of multiple reexamination requests over an extended period of time. In other words, it encourages a complete analysis of the issues when a reexamination request is filed, rather than doing a “quick” request, simply to “get” something before the Office, and then supplementing with one or more later requests. By promoting the filing of a single, comprehensive reexamination request, the decision promotes the compact prosecution of all issues of patentability with regard to an issued patent, which will translate into more timely notice to the public regarding the rights ascribed to a given issued patent. Requester’s institution of two separate reexamination proceedings for the same patent, albeit each supported by distinct substantial new questions of patentability, is the source of the policy concerns requester voices, and not the Office’s decision whether or not to merge requester’s piecemeal reexamination request filings. Petitioner asked for separate proceedings for separate issues of patentability on the same patent, and the Office is honoring that request. The resolution of one separate and distinct substantial new question of patentability is not necessary to resolve a different, and distinct substantial new question of patentability found to exist in any other co-pending proceeding. However, the handling of multiple, distinct substantial new questions of patentability in a merged proceeding may deter and not promote special dispatch. Therefore, merger, in given instances, may very well result in the slowing of reexamination, contrary to requester’s assertions.

The June 28, 2010 dissolution decision, the MPEP, and Office practice and procedure provide a mechanism by which the public is placed on notice as to the existence of related, unmerged pending Office proceedings on the same patent when a reexamination certificate issues.<sup>15</sup> The dissolution decision, minimizes the consumption of Office resources, promotes special dispatch, and will minimize the filing of merger related petitions and prevent delays caused by the filing of multiple reexamination proceedings to be considered for merger, because it will promote the filing of a single, comprehensive reexamination request. The June 28, 2010 dissolution decision does not alter the viability of reexamination as an alternative to litigation. Petitioner further argues that the merger dissolution decision will promote the filing of anonymous *ex parte* requests for reexamination to achieve merger.<sup>16</sup> As to whether the subsequent request filed is

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<sup>15</sup> See the June 22, 2010 Office decision section IV pgs. 6-7; See also MPEP §§ 2295 *et seq.* and 2695 *et seq.*; See *e.g.* *Ex Parte* Reexamination Certificate (7412<sup>th</sup>) No. 6188988 C1, right column notice under the abstract.

<sup>16</sup> See Petition at page 9, section E.

anonymous or not, the identity of the requester is not determinative/dispositive with regard to merger, since whether to merge is determined by the specific facts and circumstances of each proceeding on a case-by-case basis in accordance with special dispatch. It is noted that public policy does not call for providing an *ex parte* requester with *inter partes* rights. Finally, as pointed out public policy is best served by the resolution of a substantial new question of patentability in each reexamination by using the vehicle of reexamination that provides the optimal special dispatch in resolving the SNQs raised. Accordingly, the dissolution decision is not contrary to the relevant issues of public policy as asserted by requester.

#### IV. Summation

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

#### CONCLUSION

1. The petition is **dismissed**.
2. Telephone inquiries related to the present decision should be directed to Joseph F. Weiss, Jr., Reexamination Legal Advisor, at 571-272-7759.



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